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TTAB

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Trademark Trial and Appeal Board
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November 19, 2021

Cancellation No. 92070823

*ICware Systems, Inc. dba BatchTest
Corporation and BatchTest Corporation*

v.

Ikonix USA LLC

**Before Mermelstein, Adlin, and Dunn,
Administrative Trademark Judges.**

By the Board:

This case is before the Board for consideration of the following fully-briefed motions filed by Petitioner on June 27, 2021:

- 1) For leave to file a third amended petition to cancel and to extend discovery;
- 2) For summary judgment on all pleaded grounds of likelihood of confusion, abandonment and descriptiveness in the proposed third amended petition to cancel.

By its order of July 7, 2021 suspending this proceeding for consideration of the motion for summary judgment, the Board declined to consider Petitioner's

concurrently filed motion for discovery sanctions noting that no order compelling discovery had issued.¹

The Board has carefully considered all of the parties' arguments and evidence, presumes the parties' familiarity with the factual bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

This proceeding was instituted March 17, 2019.² Petitioner alleges that it is “a designer, producer and marketer of electronic boards & devices, Integrated Systems, Software, and other related products and services in the fields of Automation, Medical Devices, Secure Communications, Embedded Systems and Contract Manufacturing,” claims common law rights in the mark BATCHTEST for unspecified “goods and services in Classes 9 and 42,” and alleges that it has previously used the mark as its trade name.³

Respondent is the owner of a registration for the standard character mark BATCHTEST for,

software for use in testing electrical safety products to ensure compliance with regulations, and to set up electrical safety products for their intended use, and to analyze the results of the tests of electrical safety products; computer software for recording test data, archiving test data, importing test data into a spreadsheet or database, logging test data, statistically analyzing test data, and reviewing test data,

¹ 45 TTABVUE.

² 2 TTABVUE.

³ 16 TTABVUE 2-3.

in International Class 9.⁴

Following the discovery conference, during which Petitioner's claims of non-ownership, false suggestion of a connection, fraud, and misrepresentation of source were stricken, Petitioner filed with permission an amended petition to cancel.⁵ In response to Respondent's motion to dismiss the amended petition to cancel, Petitioner filed a second amended petition to cancel.⁶ On March 31, 2020, the Board granted Respondent's motion to dismiss the second amended petition to cancel as to the re-pleaded claims of non-ownership, false suggestion of a connection, and fraud, finding only the likelihood of confusion claim sufficient. On September 21, 2020, the Board, among other things, denied Petitioner's request for reconsideration.⁷

Respondent's answer denies the salient allegations of the second amended petition to cancel, alleging an affirmative defense of laches.⁸

II. Motions for Leave to Amend the Pleadings Again and to Extend Discovery

Petitioner moves the Board for leave to file a third amended petition to cancel that would plead a second pending trademark application, which has been refused registration based on Respondent's involved registration. Petitioner also proposes to add claims of abandonment and that Respondent's mark is merely descriptive.

⁴ Registration No. 4499170, registered March 18, 2014, claiming dates of first use anywhere and in commerce of July 8, 2013. An acceptance under Section 8 was issued August 22, 2019.

⁵ 13 TTABVUE.

⁶ 16 TTABVUE.

⁷ 31 TTABVUE 7.

⁸ 23 TTABVUE 7.

Petitioner argues that Respondent has, “failed to produce any evidence whatsoever of actual use of its mark in commerce”⁹ on Class 9 goods, which gives rise to its claim of abandonment, and that Respondent’s previously rejected specimen, filed November 12, 2012 in Respondent’s underlying application file, evidences that Respondent’s mark is merely descriptive. Petitioner requests that if summary judgment does not dispose of this proceeding, it be granted three additional months of discovery on the proposed claims.¹⁰ Petitioner also argues that “no amount of discovery can change the material facts upon which” its motion for summary judgment on all counts is based.¹¹

Respondent argues that the additional claims are “conditional,” are an attempt by Petitioner to “buy time,” and are based on information that was known to Petitioner long before the original petition to cancel was filed.¹² Respondent contends that there is no basis for alleging abandonment as it uses its goods for testing tangible electrical safety products during production, that the USPTO’s acceptance of Respondent’s Section 8 declaration and accompanying specimens are part of the record, and evidence Respondent’s continuing use of its mark on its software goods.¹³ Further Respondent argues, as to the existing likelihood of confusion claim, Petitioner has not shown that its software products are the same or similar to Respondent’s software.

⁹ 38 TTABVUE 3-4.

¹⁰ *Id.* at 5.

¹¹ *Id.* at 25.

¹² 47 TTABVUE 4-6.

¹³ *Id.* at 4-5.

At this stage of the proceeding where discovery was set to close six weeks after the filing of the motions, Petitioner may amend its petition to cancel only by written consent of Respondent or by leave of the Board. *See* Fed. R. Civ. P. 15(a)(2); Trademark Rule 2.107, 37 C.F.R. § 2.107. In general, under Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings when justice so requires. In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *See Foman v. Davis*, 371 U.S. 178, 182 (1962).

This is the third instance where Petitioner has sought leave to amend its petition to cancel. Petitioner claims its motion stems from Respondent's failure to provide "any discovery whatsoever" while also citing in its declaration to Respondent's discovery responses and documents and the underlying application file.¹⁴ Respondent's underlying application file has been of record since before this proceeding was instituted, and it is hard to understand how this can serve as a basis for Petitioner's sudden discovery of proposed new claims in this proceeding which has been underway since March 2019.¹⁵ Rather than abandonment, Petitioner's claims appear to be directed to priority of use, an element of likelihood of confusion. Petitioner's arguments regarding descriptiveness, and why its own mark is not descriptive, are lifted largely from the examining attorney's refusal of Petitioner's

¹⁴ *See, e.g.*, 39 TTABVUE 39. Exhibit T was filed under seal.

¹⁵ *See, e.g., Id.* at 162-67.

underlying application, and are not evidenced by any new information not previously available to Petitioner.¹⁶

To the extent Petitioner seeks to amend the pleadings to allege ownership of its application Serial No. 88750323, the motion is **granted**. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 (TTAB 1990) (granting motion to amend to allege registration acquired after proceeding was instituted).

Leave to plead additional claims is denied because of undue delay in filing the motion for leave to amend. Indeed, the underlying information has been known, or should have been known, to Petitioner since well prior to its filing of the petition to cancel and its two prior amended pleadings. In addition, even with our liberal pleading standard, we find Petitioner's inconsistent allegations of nonuse fail to state a legally sufficient claim of abandonment. Further, Petitioner seeks even more time for discovery in order to bolster its assertions. The motion to amend to add claims of abandonment and mere descriptiveness is **denied**.

In view of the foregoing, Petitioner is allowed until December 3, 2021 to file and serve an amended petition to cancel alleging ownership of its application Serial No. 88750323 to the extent discussed in this order.

Respondent is allowed until December 17, 2021 to file and serve its amended answer.¹⁷

¹⁶ *See Id.* at 119.

¹⁷ Respondent's denial of the amended petition to cancel is assumed for purposes of considering the motion for summary judgment.

III. Motion for Summary Judgment

A. Legal Standard

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). A movant for summary judgment carries the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the Board's function is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. *See Dyneer Corp. v. Auto. Prods. PLC*, 37 USPQ2d 1251, 1254 (TTAB 1995). When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA*,

Inc. v. Great Am. Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

B. Arguments

In support of its motion for summary judgment, Petitioner has submitted the declaration of its president and predecessor in interest, Dinesh Patel, together with invoices, product images, email communications, internet printouts, specimens filed by Petitioner, a TESS search printout, software screenshots, Petitioner's photographs and promotional material. In its declaration, Petitioner's software is described as, "software for creating Human-Machine-Interface, graphics, and industrial automation animations, and downloadable website plugin to facilitate automated data and content management updates and website publishing from its SKYNET automation platform;"¹⁸ and its services as,

providing of engineering services for research, design, and development of consumers' products, including medical devices; ... engineering services [offered to] medical device, biotech and pharmaceutical consumers regarding 510(k) submissions to the U.S. Food & Drugs [sic] Administration (the "FDA.") Petitioner also provides services to design and setup consumers' industrial automation per their needs; provides website for temporary use of non-downloadable software for graphics, industrial automation animations, and Human-Machine-Interface; provides Software-As-A-Service ("SAAS") for use by others for licensing

¹⁸ 39 TTABVUE 6-7. Petitioner also describes its goods as, "SKYNET Automation Platform software and related custom hardware, SKYNET-Server and related hardware, Automated Power Supplies & Power Distribution Units, Remote Input/Output ("I/O") Distribution Units, Automated Heater Controllers, Automated Embedded Controller for pneumatics, solenoid valves, and flow-meters, electronic circuit boards for I/O controls and signal measurement, industrial automation fixtures, and user-configurable IoT and embedded systems boards for use as low-cost automation devices for industrial and home automation processes." *Id.*

and activation, security, updates, and remote maintenance of consumers' products and services.¹⁹

Petitioner argues that it has prior common law rights in the mark, based at least in part on its previously abandoned application for the mark LVREMOTE and its prior ownership of the BATCHTEST.COM website; the marks and goods are identical; the goods and services move in the same channels of trade and target the same consumers; and that confusion is inevitable.

In response, Respondent submits the declaration of its vice president Andrew Braverman averring that its trademark has been used in commerce, although a date is not specified.²⁰ Respondent argues that Petitioner has not met its burden of proof as to priority because Petitioner's alleged evidence of priority relates to use with SKYNET, but not BATCHTEST, and that while Petitioner alleges use since 2007, the most recent invoice provided as evidence of use is dated over three years ago.²¹ Respondent also argues it has provided evidence to show that its software for use in testing electrical safety products is different from the purpose and function of Petitioner's software and hardware goods and services.

C. Decision

¹⁹ 39 TTABVUE 9.

²⁰ Without evidence of earlier use, the earliest date on which Respondent can rely is the filing date of its underlying application. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 962, 144 USPQ 435 (CCPA 1965) ("A certificate of registration constitutes prima facie evidence of ownership and ownership imparts prima facie evidence of use even though there be no evidence of record relative to such use. The presumption of use emanating from the fact of registration relates back to the filing date of the application on which the registration is predicated.").

²¹ 47 TTABVUE 10.

Consideration of the issue of likelihood of confusion in the context of summary judgment requires an analysis of all of the undisputed facts in evidence that are relevant to the evidentiary factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Any of the *DuPont* factors “may from case to case play a dominant role.” *Id.* Thus, we look to whether there are genuine disputes with respect to any of the *DuPont* factors which would be material to a decision on the merits.

Petitioner has not made clear which mark or what goods and services it uses the unspecified mark with, nor has it clearly established a priority date for use of its unspecified mark with goods and services that are related to Respondent’s goods.

After reviewing the parties’ arguments and evidence, we therefore find that disposition of this case by summary judgment is inappropriate. At a minimum, there are genuine disputes of material fact as to whether the parties’ software is related and as to priority of use. *See DuPont* 177 USPQ at 1361. In view thereof, Petitioner’s motion for summary judgment is **denied**.²²

IV. Accelerated Case Resolution (ACR)

The parties may wish to consider using the Board’s Accelerated Case Resolution (ACR) procedure. This procedure is similar to the use of cross-motions for summary

²² Evidence submitted in connection with the motion for summary judgment, or in opposition thereto, is of record only for consideration of that motion. To be considered at final hearing, all evidence must be properly introduced in evidence during the appropriate trial period. *See Land O’ Lakes, Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); *Univ. Games Corp. v. 20Q.net, Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464 (TTAB 1993). Furthermore, the fact that we have identified certain genuine disputes of material fact sufficient to deny the motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

judgment, but the parties must stipulate that, in lieu of trial, the Board may resolve any genuine disputes of material fact. Should the parties agree to use of ACR, they may stipulate to facts, the form of evidence, and/or a shortening of the trial periods. The Board's ACR procedure is detailed under the heading "Alternate resolution options" at: <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board>. The parties are encouraged to contact the assigned Interlocutory Attorney if they wish to discuss use of ACR in this proceeding.

V. Duty to Cooperate and Confidentiality Designations

It appears from Petitioner's confidential Exhibit T to its motion for summary judgment that Respondent has designated all of its responses to written discovery and the entirety of its document production to Petitioner as "Confidential."²³ The Board does not have the time or resources to independently examine each discovery response or document to determine the propriety of Respondent's designations. However, we note that Board proceedings are designed to be public and only truly confidential material should be so designated. Over designation of material as confidential makes it more difficult to make findings of fact, apply facts to the law, and write decisions that make sense when facts may not be discussed. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010). Where a party has over-designated material as confidential at trial, the Board may require that party to resubmit documents so that only truly confidential material is redacted. *See Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1736

²³ See 39 TTABVUE 231.

(TTAB 2012) (party required to resubmit deposition testimony with only confidential information redacted). Or, the Board may remove the confidential designation, making all over-designated documents publicly available.

VI. Pro Se Information

The Board notes that Petitioner is representing itself through its president in this proceeding. Although Patent and Trademark Rule 11.14 permits an entity to represent itself, it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

VII. Schedule

To summarize, for the reasons discussed herein, Petitioner's motion to amend its pleading is granted to the extent that it may amend its pleading to allege ownership of its application Serial No. 88750323, and is otherwise denied. Petitioner is allowed until December 3, 2021 to file and serve its amended petition to cancel to the extent

discussed in this order. Respondent is allowed until December 17, 2021 to file and serve its amended answer. Petitioner's motion for summary judgment is denied.

Proceedings are resumed. Dates are reset as set out below.

Petitioner's Amended Pleading Due	12/3/2021
Respondent's Amended Pleading Due	12/17/2021
Expert Disclosures Due	12/29/2021
Discovery Closes	1/28/2022
Plaintiff's Pretrial Disclosures Due	3/14/2022
Plaintiff's 30-day Trial Period Ends	4/28/2022
Defendant's Pretrial Disclosures Due	5/13/2022
Defendant's 30-day Trial Period Ends	6/27/2022
Plaintiff's Rebuttal Disclosures Due	7/12/2022
Plaintiff's 15-day Rebuttal Period Ends	8/11/2022
Plaintiff's Opening Brief Due	10/10/2022
Defendant's Brief Due	11/9/2022
Plaintiff's Reply Brief Due	11/24/2022
Request for Oral Hearing (optional) Due	12/4/2022

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, the manner and timing of taking testimony, matters in evidence, 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

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final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).