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

Proceeding no.	92075375
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

COMMON SENSE PRESS INC DBA
POCKET JACKS COMICS,

Petitioner,

v.

Cancellation No. 92075375

ETHAN VAN SCIVER AND
ANTONIO J. MALPICA.,

Registrants.

**PETITIONER’S MOTION IN OPPOSITION TO
DEFENDANT’S CROSS-MOTION FOR SUMMARY JUDGMENT AND
REPLY IN SUPPORT OF PETITIONER’S MOTION FOR SUMMARY JUDGMENT
FOR COUNT III OF THE PETITION FOR CANCELLATION:
NO USE OF THE MARK IN COMMERCE BEFORE
THE STATEMENT OF USE WAS FILED**

Pursuant to TBMP §528 and Fed. R. Civ. P. 56, the Petitioner, COMMON SENSE PRESS INC DBA POCKET JACKS COMICS (hereafter “Petitioner”), respectfully submits this Brief in Opposition to the Cross-Motion for Summary Judgment (hereafter “Cross-Motion”) filed by ANTONIO J. MALPICA and ETHAN VAN SCIVER (hereafter collectively “Registrant(s)” or “Defendant(s)”). Petitioner requests that the Trademark Trial and Appeal Board deny Registrants’ Cross-Motion, and grant Petitioner’s Motion for Summary Judgment, for the reasons set forth below.

BACKGROUND¹

On October 1, 2020, Petitioner filed the instant cancellation proceeding. After numerous filings made by the then sole registrant, Mr. Malpica, then appearing pro se, the Board reset the proceedings on July 6, 2021 and joined Mr. Van Sciver as a party defendant.

On August 2, 2021, Registrants filed a motion to dismiss which was ultimately denied by the Board on November 26, 2021. Pursuant to the Board's November 26, 2021 order, the Registrants filed an answer on December 29, 2021. Since new regulations implementing the Trademark Modernization Act of 2020 ("TMA") went into effect on December 18, 2021, Petitioner then filed the new ex parte petition for reexamination on March 23, 2022, and also moved to suspend the instant cancellation the same day.

On May 19, 2022, the Board suspended the instant cancellation pending the outcome of the reexamination proceeding.

On January 6, 2023, after several responses from Registrants during the ex parte petition for reexamination, the USPTO ultimately terminated the reexamination proceeding without cancellation of the subject registration.

On January 9, 2023, Registrants filed a motion informing the Board of the same, and also moved for judgment on Counts I and III of Petitioner's Petition for Cancellation.

¹ The Petitioner takes issue with Registrants' Cross-Motion's stylization that ¶¶ 1-24 are "Undisputed Facts." While some paragraphs are simple descriptions of past actions that are objectively and verifiably true (e.g., "On Sep. 3, 2018, Antonio Malpica, acting pro se, applied for the COMICSGATE trademark..."), others are conclusory in nature and rely upon facts that are certainly disputed (e.g., "Poulter knew the use of the COMICSGATE mark on the comic books is confusingly similar..."). Accordingly, the Petitioner does not waive its right to dispute such facts as raised by Registrants and as such is setting forth its own description of facts which it reasonably believes are objectively undisputed between the parties.

On May 19, 2023, the Board resumed proceedings and denied Registrants' motion for judgment.

On June 30, 2023, the Petitioner moved to amend its complaint, which was denied by the Board on November 3, 2023, with the proceedings then being resumed. Of note, the Board in denying Petitioner's motion to add a paragraph on naked licensing (as well as an additional Count IV and V) did so because Petitioner "bases these claims on its contention that 'Registrant Ethan Van Sciver (the sole owner of Registration No. 6102744) has admitted that he was always the owner of the trademark such that the original Registrant (Antonio J. Malpica) was never the true owner of the mark and has misrepresented the source of goods in which the mark is used rendering the underlying application void *ab initio*.'" 35 TTABVUE 4-5. The Board, in explanation of why it was denying the motion to amend stated that "[a]lthough Petitioner's motion for leave to amend its petition was filed merely ten days after Mr. Van Sciver's Twitter posts, the putative revelation that Mr. Van Sciver claims ownership of the mark since 2018 cannot be said to have been 'only recently discovered' considering such information was provided to Petitioner as early as February of 2022 as part of [Registrants] initial disclosures, yet Petitioner did not promptly seek leave to amend its petition, opting instead to seek reexamination of the registration." *Id.* at 5.

Since resumption of the proceedings, the Petitioner has taken the depositions of both Registrants Antonio J. Malpica and Ethan Van Sciver, and the Registrants have taken the deposition of Preston Poulter of the Petitioner-Company.

Based on the testimony of the Registrants, as well as the uncontradicted facts of this case, Petitioner is entitled to judgment as a matter of law as there are no material facts in dispute.

ARGUMENT

I. Standard for Summary Judgment

A motion for summary judgment is an appropriate method for disposing of an *inter partes* proceeding when “there is no genuine issue as to any material fact [such] that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see also* 37 CFR §2.116(a) (Federal Rules of Civil Procedure generally apply to *inter partes* proceedings). Summary judgment “is regarded as ‘a salutary method of disposition,’ and the Board does not hesitate to dispose of cases on summary judgment when appropriate.” TMBP §528.01.

Under Fed. R. Civ. P. 56(a), “The [Board] shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” The Federal Circuit has stated that, “the basic purpose of summary judgment procedure is...to save the time and expense of a full trial when it is unnecessary because essential facts necessary to decision of the issue can be adequately developed by less costly procedures...” *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 USPQ 741 (Fed. Cir. 1984).

In this case, there is no genuine factual dispute that would preclude summary judgment in favor of Petitioner on Count III. However, there are genuine disputes over material facts such that granting summary judgment in favor of the Registrants on Count I, II, or III is inappropriate.

II. Petitioner’s Opposition to Registrants’ Cross-Motion for Summary Judgment

Petitioner, in filing its motion for summary judgment, appropriately limited it solely to Count III of the Petition for Cancellation. This was intentional as there are material facts that are still in dispute between the parties vis-à-vis Counts I and II of the Petition for Cancellation. In responding to Petitioner’s Motion for Summary Judgment, the Registrants have filed a cross-

motion for summary judgment on Counts I, II, and III of the Petition for Cancellation. *See* 49 TTABVUE 9 (“Registrant requests that all three counts of this cancellation proceeding be DISMISSED and any other remedy the Board sees fit and proper.”).

A. Petitioner is Not Seeking Summary Judgment on Grounds the Board Explicitly Denied Petitioner. Petitioner Seeks Summary Judgment Based on the Plain Language of Count III in the Original Petition for Cancellation.

As was stated above, the Board, in dismissing Petitioner’s Motion to Amend, did so because Ethan Van Sciver was disclosed in 2022. *See supra*. Here, Registrants’ arguments completely omit this fact. The Registrants have in effect missed the point. Specifically, the entire motion to amend was based upon statements made by *Ethan Van Sciver*, whereas Petitioner’s Motion for Summary Judgment on Count III is entirely based upon the statements made by *Antonio J. Malpica*. As was stated in Petitioner’s Motion for Summary Judgment, what was not clear to Petitioner until Petitioner deposed Mr. Malpica, was that Mr. Malpica had never used the mark in commerce, with the only “use” being the result of an invalid license.² No amount of disclosures made prior by Registrants could have disclosed this fact to Petitioner until Petitioner deposed Mr. Malpica. During his deposition, Mr. Malpica made clear that he never personally used the COMICS GATE mark in commerce, and during additional questioning, also made clear that the license he granted to Mr. Romano was an invalid license. Besides the motion for summary judgment and motion to amend the petition for cancellation both mentioning a naked license, the two could not be more different as they are based not only on different counts

² While the Petitioner firmly believes its motion for summary judgment on Count III is not in contravention of the Board’s November 3, 2023, order, as it squarely involves Registrant Antonio J. Malpica’s lack of use as set forth in Count III, should the Board be unpersuaded, the Petitioner seeks leave to amend its petition to make clear that Malpica’s lack of use before the relevant date is based upon Malpica’s sole use being that of a naked license. As bears repeating, this was not known to Petitioner until Malpica was deposed and is independent of the prior motion to amend which was based upon Ethan Van Sciver’s statements.

(Count I in the proposed amended complaint and Count III in the motion for summary judgment), but also very different facts stemming from statements made by two different people.

B. Petitioner's Counts I and II Should Not be Dismissed

As Registrant has pointed out, both Counts I and III of the Petition for Cancellation revolve around non-use of a trademark. *See* 49 TTABVue 6. Count I is regarding lack of use such that the mark was abandoned and Count III is regarding lack of use before the deadline of filing a statement of use.

While Petitioner believes that the evidence shows that Registrants have abandoned the COMICS GATE mark (Count I) and have committed fraud upon the USPTO (Count II), several important material facts remain in dispute.

For example, with respect to Count I, whether Registrants intended to abandon the trademark and whether they intended to resume use. This is why Petitioner limited its summary judgment motion to Count III which is more narrow as it involves use before a particular date.

Similarly, Count II (Petitioner's Fraud Claim) should not be dismissed as there are material facts in dispute. Like Count I, Count II also involves the issue of intent, and in the case of Count II, whether Registrant intended to deceive the USPTO and knowingly made a false, material, and intentionally deceptive representation to the USPTO.

The factual question of intent, an element of both the abandonment claim (Count I) and the fraud claim (Count II), is particularly unsuited to disposition on summary judgment. *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991); *DaimlerChrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1090 (TTAB 2010).

i. Count I: Petitioner's Abandonment Claim Should Not Be Dismissed as There Are Material Facts in Dispute.

Here, the Registrants have argued that the undisputed facts show that the mark was used in commerce prior to the statement of use deadline. 49 TTABVUE 6. Registrants are wrong. The Registrants have in effect treated the reexamination as having foreclosed any collateral attack against Registrants' COMICS GATE mark on the grounds that they abandoned it or failed to use before the statement of use deadline. If this were the case, the Board would not have denied Registrants' motion for judgment. See 31 TTABVUE (where the Board denied Registrants' motion for judgment noting that reexamination proceedings have no preclusive effect in TTAB proceedings against non-parties to those ex parte proceedings).

Indeed, on face value, with nothing more said or no additional questions asked, and looking solely to the evidence introduced by Registrants during ex parte reexamination it appears on face value that perhaps the mark was in use before the statement of use deadline. However, this was plainly not the case. And while the completion of the reexamination is where Registrants would like to stop, it is not the end the analysis.

In moving for summary judgment, Petitioner has demonstrated no disputed material fact as to Count III of its Petition for Cancellation. At no point in their Cross-Motion, do Registrants take issue with Petitioner's use of Mr. Malpica's testimony, and that is for the simple reason that it speaks for itself. Specifically, Registrants have stated that there was no abandonment because the "USPTO has recognized this use and, indeed, the mark is still in use to this date. Ex. 10 (Notice of Termination of Re-examination...)" 49 TTABVUE 6. What Registrants importantly omit however, is that this purported license to Mr. Romano, which was the reason why the COMICS GATE mark survived reexamination was not a genuine license that Registrant Malpica could rely upon. During his deposition, Mr. Malpica repeatedly made clear that he exercised

absolutely no control over the nature or the quality of the goods produced. *See* 47 TTABVUE (where copy of Malpica deposition is introduced). Such use, under a licensee, cannot inure to the benefit of the licensor. Because this was the sole basis for showing use before the statement of use deadline, and because use is the result of a naked or otherwise invalid license, it is axiomatic that there was no use before the statement of use deadline.

Furthermore, the Registrants are incorrect in presenting Petitioner's motion for summary judgment as presenting a new ground of cancellation "abandonment due to naked licensing." 49 TTABVUE 6. First, this is not a new claim, as it fits squarely within the original Count III set forth in the original petition for cancellation. "Naked licensing" is not an independent cause of action, but a fact to be proven, which here, Petitioner has proven. As bears repeating, Petitioner has proven that Registrant Malpica has not used the mark in commerce before the deadline of filing his statement of use, with the sole basis for that use being a naked license as was revealed by Mr. Malpica during his deposition. Second, and perhaps more importantly, it would not be abandonment via naked licensing, but rather a naked license being insufficient to show use before the deadline for filing a statement of use, the latter of which is plainly set forth in Count III of the Petition for Cancellation.³

Additionally, Registrants have spent a substantial portion of their Cross-Motion urging the Board to adopt the holding in *Boss Products, Inc. v. Port-A-Pit Bar-B-Que of Edgerton Inc.*,

³ Petitioner likewise takes issue with Registrants' reframing of Petitioner's motion for summary judgment as being abandonment due to naked licensing, as it appears Registrants are attempting to mislead the Board by framing the motion for summary judgment as nothing more than a repeat of Petitioner's motion to amend its pleading. As was stated previously, while both involve a naked or invalid license, the two involve different counts of the petition as well as completely different facts as well as different people (Malpica presently vs. Van Sciver previously).

No. 3:05-CV-293 RM (N.D. Ind. Feb. 4, 2009).⁴ Reliance on this case by Registrants is severely misplaced.

First, aside from important factual differences, this is a mere trial case from a district court in Indiana, and it does not preempt either Board precedent or the precedent of the U.S. Court of Appeals for the Federal Circuit. *See* TBMP § 101.03 (“The Board relies primarily on precedent from the Court of Appeals for the Federal Circuit. The Federal Circuit is the Board’s primary reviewing court since by statute, any applicant or party to an inter partes proceeding who is dissatisfied with the Board’s decision may seek review of the decision in the Federal Circuit. Also, the Federal Circuit’s cases address registration issues more specifically.”). The Board is under no obligation to accept the ruling of this Court, especially when, as here, it conflicts with Federal Circuit and Board precedents.

Second, this case is also factually distinct from the present case. *Boss* involved a contractual relationship between the parties that was decades in length, with the parties’ agreements beginning in the early 1970’s. *See Boss Products, Inc. v. Port-A-Pit Bar-B-Que of Edgerton Inc.*, No. 3:05-CV-293 RM (N.D. Ind. Feb. 4, 2009). Furthermore, the case also revolved around several *written* agreements entered into between the parties. *Id.* Here, the “license” entered into between Malpica as the then-owner of the COMICS GATE mark and Mr. Romano was oral, and Malpica, when questioned, could not recall when the agreement was even made other than it being in Spring 2020, or what books Mr. Romano even made.

Third, and perhaps most importantly, this case conflicts with the prior precedent of the Board as well as the Federal Circuit. Parties may cite to non-precedential decisions, but they are

⁴ It is noted that the *Boss* case appears to have been decided by the Northern District of Indiana in 2009 as opposed to 2017 in the Southern District of Indiana as cited by Registrants.

not binding on the Board. *In re Luxuria s.r.o.*, 100 USPQ 2d 1146, 1151 n.7 (TTAB 2011). *See Authentic Apparel Group, LLC v. United States*, 989 F.3d 1008 (Fed. Cir. 2001) (explaining that “naked licensing” as “the grant of licenses without the retention of control” (citing *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 367 (2d Cir. 1959)). *See also E.I. Du Pont de Nemours & Co. v. Celanese Corp. of America*, 167 F.2d 484 (CCPA 1948) (“it is well settled that one who assigns his trade-mark with or without the business which it has been used abandons his mark” and that a license agreement cannot be “merely a naked license to use”). *See also Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.*, 906 F.2d 1568 (Fed. Cir. 1990) (explaining that a trademark licensor “may license his mark if the licensing agreement provides for adequate control by the licensor over the quality of goods or services produced under the mark by a licensee. The purpose of such a requirement is to protect the public from being misled.” (citing *Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 261, 198 USPQ 610, 613 (CCPA 1978)). Here, Registrant Malpica has done just that. He entered into a purported oral “license” agreement that he could not fully recall which also lacked any control mechanisms. Mr. Malpica couldn’t even fully recall the books produced by Mr. Romano. Registrants’ contention that their “quality control” was their selection of those who appeared on Van Sciver’s YouTube Channel (49 TTABVUE 4) doesn’t pass the proverbial smell test. First, Registrant Van Sciver did not own the trademark during the period for filing a statement of use (Mr. Malpica purportedly licensed the mark to Mr. Romano while he was the *sole* owner). Second, it also puts the proverbial cart before the horse as it is essentially an admission that there was no control over the actual *goods or services* produced, not the *person* picked (not to mention that it directly contradicts the sworn affidavits made by Registrants during reexamination (*see infra*)).

And finally, Registrants also argue that there is now a missing element from Petitioner's abandonment claim. *See* 49 TTABVue 8. Specifically, that "Petitioner CSP allegations [of abandonment] are faulty and incomplete and do not properly allege all the elements for a finding of abandonment." *Id.* Setting aside that Petitioner has moved for summary judgment on non-use before the statement of use deadline (Count III) and not its abandonment claim (Count I), Registrants are again arguing that Count I is not properly pleaded, re-litigating its same motion to dismiss that was denied by the Board years ago. *See* 23 TTABVue (where the Board ruled that Petitioner had entitlement to a statutory cause of action). Now, Registrants argue that Petitioner must also prove that the COMICS GATE mark has lost all capacity to function as a source indicator for Registrants' comics. 49 TTABVue 8. Registrant is again wrong. *See Vans, Inc. v. Branded, LLC*, Cancellation Nos. 92066859 and 92066876 (TTAB Aug. 11, 2022) (precedential) ("As set forth in Section 45 of the statute, there are two elements to a nonuse abandonment claim: (i) nonuse of the mark (ii) with an intent not to resume use of the mark."). Here, Petitioner has done just that. Petitioner has pleaded that Registrant is not currently using the mark and that Registrant's intended not to resume use. *See* 1 TTABVue 2-3. Accordingly, Petitioner is under no obligation to prove an additional element.

Turning to the portion of the Cross-Motion whereby Registrant wants judgment in its favor on Count I, it should be denied. As previously stated, there are material facts in dispute. First, the parties dispute whether Registrant has not used the mark for the past three years. And second, and more importantly, there is a factual dispute as to the intent of the Registrants not to resume use. Registrants have admitted that they have only recently issued any kind of "Quality Standards," which according to Registrant, were only done after Van Sciver "took over ownership of the mark." *See* 49 TTABVue 5. Based on the Registrants' lack of proper license

agreements alone, Petitioner is entitled to judgment in its favor on Count I. Nevertheless, a highly fact-specific issue such as intent not to resume use is clearly disputed by the parties, rendering summary judgment inappropriate at this time as to Count I.

ii. Count II: Petitioner's Fraud Claim Should Not Be Dismissed as There Are Material Facts in Dispute.

Similarly, Registrants' request to grant dismissal of Count II (or summary judgment in their favor) should similarly be dismissed.

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration, or a registrant in a post registration setting, knowingly makes a false, material representation of fact in connection with an application to register, or a post registration document, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *In re Bose Corp.*, 580 F.3d 1250, 1245, 91 USPQ2d 1938, 1939-40 (Fed. Cir. 2009); *Chutter, Inc. v. Great Management Group, LLC*, Opposition No. 91223018 and Cancellation No. 92061951 (TTAB 2021) (precedential). The Registrants are correct insofar as the Federal Circuit has stated that the intent to deceive is an indispensable element of the analysis in a fraud case.

Setting aside that like Count I, the Count II claim for fraud was properly pleaded, based on the undisputed actions of Malpica alone, Petitioner is entitled to judgment in its favor on Count II. As was stated above, the sole reason the COMICS GATE mark survived reexamination was due to the alleged license to Mr. Romano by Mr. Malpica. At no point have Registrants otherwise stated or argued that the specimens submitted by Mr. Malpica in his original statement of use were proper. Indeed, Registrants appear to have conceded this fact. *See* 1 TTABVue 3-4. The specimens at issue so transparently lacked any indication that the mark was in use that even Mr. Malpica, a lay person, acted with reckless disregard for the truth or falsity of a material statement in filing such specimens with the USPTO. "As a matter of law...reckless

disregard satisfies the requisite intent for fraud on the USPTO in trademark matters.” *Chutter, Inc.* at *6. With respect to the specimens of use for the comic book originally submitted by Malpica, Mr. Malpica clearly and unambiguously testified that it was not finished as of 2024. *See infra*. Nevertheless, a highly fact-specific issue such as intent to deceive is clearly disputed by the parties, rendering summary judgment inappropriate at this time as to Count II. *See Copelands’ Enterprises Inc. v. CNV, Inc.*, 945 F.2d 1563 (Fed. Cir. 1991) (explaining that summary judgment may not be appropriate where a reasonable inference can be drawn in favor of the nonmovant).

C. Count III: Registrants Did Not Use the COMICS GATE Mark in Commerce Prior to the Deadline of their Notice of Allowance. Petitioner’s Count III Should be Granted in Favor of the Petitioner.

As stated prior, Petitioner’s motion for summary judgment is specifically regarding Petitioner’s Count III in the original Petition for Cancellation filed on December 1, 2020. Count III alleges, *inter alia*, that Registrant Antonio Malpica had not used his mark in commerce as of the filing of his Statement of Use on April 24, 2020 (or as of the registration date of his mark (July 14, 2020), or as of the time by which he was required to file his statement of use), such that Registrant’s COMICS GATE mark should be considered void. *Id.* at 4-6. The relevant time by which Registrant Antonio Malpica was required to file his statement of use was August 13, 2020.

Based on the testimony of Antonio Malpica as well as the uncontroverted facts of this case, it is clear that as a matter of law, Antonio Malpica had not used the mark in commerce within the meaning of the Lanham Act by the time by which he was required to file his statement of use. Please *see* Exhibit A in Petitioner’s Motion for Summary Judgment which consists of a certified copy of the deposition testimony of Antonio Malpica (hereafter “Malpica Dep.”).

i. The Basis for Malpica's Use in Commerce is through a License Agreement to Anthony Romano

In the present case, the sole reason for the continued registration of Antonio Malpica's trademark is through his license to Anthony Romano.

As stated above, Petitioner filed an ex parte petition for reexamination on March 23, 2022, specifically on the issue of whether Antonio Malpica used his trademark in commerce by the time he was required to file a statement of use (August 13, 2020). Please see Exhibit B in Petitioner's Motion for Summary Judgment which consists of a copy of the Combined Notice of Institution and Nonfinal Office Action instituted by the USPTO.

On August 4, 8, and 9, Registrant filed a response to the Nonfinal Office Action. Copies of the respective responses are attached as Exhibits, C, D, and E, respectively in Petitioner's Motion for Summary Judgment. Registrant, in response, stated that Mr. Malpica licensed the trademark to Anthony Romano, who produces comic books. Registrant further stated that Mr. Romano issued two comic books at least as early as June 30, 2020, namely two comic books called "Wart the Wizard" and "Dark of Midnight: The Art of Anthony Romano." *See, e.g.*, Exhibit C.

The USPTO was unpersuaded by the August 4, 8, and 9 responses, and instituted a Final Office Action on October 25, 2022, noting that the evidence supplied up to that point did not show that the comic books were "actually sold to consumers." Please see Exhibit F in Petitioner's Motion for Summary Judgment which consists of a copy of the Final Office Action.

On November 15, 2022, Registrant filed a request for reconsideration, which was ultimately accepted by the USPTO, thus allowing the COMICS GATE mark to remain registered. Please see Exhibit G in Petitioner's Motion for Summary Judgment which consists of

a true and correct copy of Registrant's Request for Reconsideration. In responding, the Registrant reiterated that Anthony Romano is a licensee of Registrant's (Antonio Malpica) mark and creates comic books under the name "DarkGift Comics." See Exhibit G at *5. Registrant further stated that Anthony Romano created "Dark of Midnight: The Art of Anthony Romano" which he sold to U.S. consumers at least as early as May 31, 2020. *Id.* In responding, Registrant provided sales data from Lulu.com which consisted of sales dates for 33 sales in the period from May 8, 2020 through August 4, 2020. *Id.* at *5-6.

However, as was clear from the deposition of Registrant Antonio Malpica, there was in fact no such valid license to Anthony Romano, and at best, the license was a naked license whereby Antonio Malpica exercised no control over the nature and quality of the goods manufactured by Mr. Romano, or otherwise monitored use of the mark by Mr. Romano.

ii. Malpica Has Not Used the COMICS GATE mark in Commerce within the meaning of the Trademark Act on or before August 13, 2020

The entire basis for Malpica's surviving the petition for reexamination was the alleged sales that took place before August 13, 2020, vis-à-vis Mr. Malpica's license to Mr. Romano.

During the reexamination proceeding, Registrant introduced the signed declaration of Antonio Malpica. See Exhibit E at *4-5. Mr. Malpica declared that "[o]n or about the Spring of 2020, Mr. Ramono contacted me and in the subsequent course of events he requested a license to use the COMICS GATE trademark for certain comic books his company was creating. *Id.* at *4. "I granted the requested license." *Id.* "I have monitored Mr. Romano's use of the trademark, two examples are attached, and found that they met all applicable standards under the trademark." *Id.* Of note, the two examples were the aforementioned comic books "Wart the Wizard" and "Dark of Midnight: The Art of Anthony Romano." *Id.* at *6-9.

During Mr. Malpica's deposition, it became clear that Registrant had not truly licensed the trademark COMICS GATE to Mr. Romano based on his review of not only his own prior declaration, but the declarations made by Anthony Romano. *See* Malpica Dep. Page 123, Lines 20-25 – Page 132, Lines 1-13.

In the pertinent portions of Registrant Antonio Malpica's deposition, Mr. Malpica's testimony made clear that he did not in fact make a valid oral license of the trademark to Mr. Romano, which was the sole basis for his proof of use in commerce before the August 13, 2020 deadline for filing a statement of use. *See Infra*. During the period from when Mr. Malpica filed his statement of use (April 24, 2020) to the deadline to file a statement of use (August 13, 2020), when Mr. Malpica was questioned whether he made any alleged licensing agreements with any other people besides Mr. Romano, Mr. Malpica testified definitively: "No. Not that I can recall. *Id.* at Page 132, Lines 4-12. In going through all of the pages from Lulu.com showing proof of sales, when Mr. Malpica was questioned whether he saw any books listed besides Dark of Midnight: The Art of Anthony Romano, Mr. Malpica testified: "It looks like it's the only book on there." *Id.* at Page 131, Lines 24-25. In other words, the other comic book Wart the Wizard made no such sales, such that the only comic book allegedly showing use in commerce was Dark of Midnight the Art of Anthony Romano, which was not the subject of a valid oral license.

Mr. Malpica's testimony regarding his alleged license with Mr. Romano is likewise clear in that he did not make a *valid* oral license of the trademark to Mr. Romano.

It is well-settled that use of a mark by a licensee inures to the benefit of the trademark owner. *See Gen. Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179, 1184 (TTAB 2008) ("A trademark owner can rely on the use of a licensee for its priority."); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB

2007) (“A basic principle underpinning trademark law in the United States is use of a mark in commerce; and years of precedent make it very clear that proper use of a mark by a trademark owner’s licensee or related company constitutes ‘use’ of that mark attributable to the trademark owner.”); *Chem. New York Corp. v. Conmar Form Sys., Inc.*, 1 USPQ2d 1139, 1143 n.10 (TTAB 1986) (“Except as otherwise indicated, ‘opposer’, when used hereafter in the singular, refers to Chemical New York, which, of course, is entitled to rely not only upon its registrations but also upon the use made by Chemical Bank, the licensee and wholly owned subsidiary of Chemical New York.”); *see also* Section 5 of the Trademark Act, 15 U.S.C. § 1055 (“Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and shall not affect the validity of such mark or of its registration.”).

More importantly though, a licensor, like Registrant Malpica *must* control the quality and nature of the goods produced under the mark by their licensee (Mr. Romano). *Visa, U.S.A., Inc. v. Birmingham Trust Nat’l Bank*, 696 F.2d 1371, 216 USPQ 649, 653 (Fed. Cir. 1982) (quality control provision in written license).

Here, the issue, properly framed, is whether Registrant Malpica exercised control over the nature and quality of Mr. Romano’s licensed goods bearing the COMICS GATE mark for that use to insure to Mr. Malpica’s benefit. *See Pneutek, Inc. v. Scherr*, 211 USPQ 824, 833 (TTAB 1981).

In the present case, the Registrant plainly did not, and Mr. Malpica clearly testified as such. During Mr. Malpica’s deposition, and before questioning, Mr. Malpica was given a chance to review both his own declaration and the declaration of his alleged licensee Mr. Romano. Copies are located in Exhibit E at *4-15. Likewise, Mr. Malpica, before questioning, was given

a chance to review the additional declaration of his alleged licensee Mr. Romano regarding the sales of his books on the website Lulu.com. A copy is located in Exhibit G at *9-10. An additional copy of the index of exhibits introduced in the deposition are attached as Exhibit H in Petitioner's Motion for Summary Judgment. *See* Malpica Dep. Page 4, Lines 1- 25.

When questioned regarding Mr. Romano's oral license, Mr. Malpica was able to recall the declaration he made: "Yes, I recognize this page." Malpica Dep. Page 125, Line 4.

Mr. Malpica was asked whether he recalled that he was the holder of the COMICS GATE trademark and that he was knowledgeable about it and that he licensed the trademark to Mr. Anthony Romano, and Mr. Malpica testified: "I recall this document, but I don't recall the way the transaction, everything went down. *Id.* at Page 125, Lines 13-14.

What is clear is that Mr. Malpica remembers speaking with Mr. Romano, but did not exercise any control over the nature or quality of the sole book for which Registrant introduced to show proof of use in commerce before the August 13, 2020, deadline:

A I -- I remember speaking with Anthony Romano.

Q Okay. Do you recall giving him a license?

A I recall we told him about him being able to use the Comics Gate trademark.

Q Okay. About being able to use it on comic books.

A Yeah.

Q Maybe nothing so formal as a license, though?

A **No.**

Q No. Okay. So in this declaration [of Antonio Malpica], it looks like you spoke with Mr. Romano in the spring of 2020. I believe that's also in your interrogatories as to when you first spoke to him about being able to use the Comics Gate name in connection with his books. It's -- I know it's hard to pinpoint an exact date, but what spring of 2020 mean? Does that mean January? Is that March?

A I couldn't tell you because I wouldn't. I don't remember.

Q You don't remember?

A No.

Q Okay. What would be your best guess?

A I wouldn't know.

Q So spring -- would it be fair to say that that's maybe spring, maybe March, April, or May typically?

A That would be fair to say.

Q That's fair to say any time of that three-month period maybe. Okay. Now if I bring us to page 7, you should see declaration of Anthony Romano. Do you see that?

A Yes.

Q Now, obviously, I can't -- I don't -- you can't testify as to what Mr. Romano necessarily knows, but there is part of -- there is a degree of overlap between you and Mr. Anthony Romano. So when you spoke with Mr. Romano about his being able to use Comics Gate for his actual comics, based on his declaration here in the first paragraph, he's declaring that it was two books. One was Wart The Wizard: Sunday Follies, and a second one called Dark of Midnight: The Art of Anthony Romano; is that correct?

A I remember Wart The Wizard.

Q Okay. What about Dark of Midnight: The Art of Anthony Romano?

A We may have spoke about it, but I can't recall the title.

Q Okay. So you never reviewed the Dark of Midnight: The Art of Anthony Romano with him at all? You didn't, like, give him notes, you didn't tell him to change some aspect of it?

A Not at all. I didn't even look at his book.

Q Okay. I understand. I'm going to bring this down to page 10. Hopefully that skips. This -- do you see the book? It kind of has a creature holding a pencil, Dark of Midnight on the top of it.

A Correct. I see it.

Q This is the book that I was referring to. The second book, Wart The Wizard, you seem to recall.

A Yeah. The cover looks familiar, but I can't -- I can't recall the book.

Q You don't recall the book. Okay. The next couple of pages, if you keep scrolling down, like, page, page 11 and page 12 are the same book just from, I think one's the back cover, and then one is on page 12, you can see a Comics Gate comics logo. You see that?

A Yes, I see it.

Q Are you familiar with that logo at all?

A No, I have -- like, I never got to see it. Malpica Dec. Page 125, Lines 16-25 -- Page 128, Lines 1-9 (emphasis added).

What is clear from the above is that Registrant Antonio Malpica never exercised any control over the nature or quality of any comic books produced by Mr. Romano. This directly contradicts Mr. Malpica's declaration made during reexamination wherein he affirmed that he

had “monitored Mr. Romano’s use of the trademark, two examples are attached [Wart the Wizard and Dark of Midnight: The Art of Anthony Romano],and found that they met all applicable standards under the trademark.” See supra. Registrant Malpica plainly and unequivocally testified that he never even looked at the Dark of Midnight: The Art of Anthony Romano comic book. It is axiomatic that Registrant Malpica could not have exercised any control over the nature or quality of the goods produced if he never even looked at the book.

When questioned regarding the request for reconsideration filed by Registrant in response to the reexamination proceeding, Mr. Malpica was questioned regarding the aforementioned additional declaration submitted by his alleged licensee Anthony Romano and the sales that took place on Lulu.com:

Q Okay. As part of the request for reconsideration, an additional declaration of Mr. Romano was made. I'll bring you to that. It should be page 22. It should just say declaration of Anthony Romano at the top.

A Okay.

Q You're able to see it?

A Yes.

Q Okay. So essentially, Mr. Romano is declaring here again, under penalty of perjury, that he has sold the books under the Comics Gate mark as early as May 8th, 2020. You can see that in the second paragraph, you see May 8th, 2020?

A Correct.

Q So that's in your period because it's from when you filed the statement of use in April all the way to that August 13th date in the same year in 2020. So if I bring us down -- so like the USPTO requested, they wanted proof of sales.

A Right.

Q So I bring us -- the proof of sales was done through invoices, through a website called Lulu. I don't know if you're familiar with that website --

A No. I'm not.

Q -- at all or no. You can see what I'm talking about, though Exhibit -- it says Exhibit 2 Lulu is right under it?

A Okay. I see. Now Exhibit 2.

Q Yeah.

A I see Lulu. Correct.

Q So look at that page. And next, all the way to page 31, you'll see a lot of invoices. So you'll see the title of the book at issue and when the sale took place, the date. So this would be pages 27 --

A 31?

Q -- through. Ends at the bottom of page 30.

A 30, okay.

Q Or actually, I'm sorry. Top of page 31, technically it ends. Take a minute and look through that.

A Yes. I look through it. All the way to 31, right?

Q Yes. So in these invoices from Lulu, you can see beginning -- I think it's on page -- it's at the bottom of page 27. You can see it's done in a column. You can see it's the fourth column from the left, it says title Dark of Midnight: The Art of Anthony Romano. Do you see that?

A Yes.

Q In going through these pages all the way to the top of page 31, do you ever see a book besides Dark of Midnight: The Art of Anthony Romano?

A May I look at it again, please?

Q Of course.

A Thank you. It looks like it's the only book on there.

Q Right. So no other books besides the Dark of Midnight: The Art of Anthony Romano?

A Correct. Malpica Dep. Page 129, Lines 20-25 – Page 132, Lines 1-3 (emphasis added).

As bears repeating, and based on the testimony of Mr. Malpica, Registrant exercised no control over the nature or quality of the Dark of Midnight: The Art of Anthony Romano book. *See supra*. Likewise, Mr. Malpica confirmed that this was the only book sold before the August 13, 2020 deadline. *See supra*. Registrant Mr. Malpica then likewise testified and confirmed that no other persons were issued licensing agreements before the August 13, 2020 deadline:

Q Now, during this period, did you make any licensing agreements with any other people besides Mr. Romano? So this would be from when you filed the statement of use with those three pictures in the beginning, if you remember. So from when you did that, all the way to August 13 of 2020, besides Mr. Romano, in that time frame, was there anyone else that you licensed the trademark to?

A No. Not that I can recall.

Q Okay. Malpica Dep. Page 132, Lines 4-13 (emphasis added).

Registrant Malpica's oral license is invalid and is tantamount to a naked license as he exercised no control over the nature or quality of the goods produced. He is therefore, unable to have Mr. Romano's use, if any, inure to his benefit. Likewise, Registrant himself has not produced his own comic books and used them in commerce within the meaning of the Trademark Act. Registrant's sole book, "Detective Dead," which was submitted in Registrant's April 24, 2020 statement of use (see Exhibit I in Petitioner's Motion for Summary Judgment), was likewise unfinished as of Registrant's May 29, 2024 deposition.

Q Okay. Now, for these three pictures [submitted in Registrant's April 24, 2020 statement of use], what particular comic book was this supposed to show use for?

A Detective Dead.

Q Detective Dead. Now, is that comic book completed right now?

A **No, it's still in the process of being put together, composed, like, drawn out and coloring, all that stuff.**

Q Okay. About how far along would you say that that book is? How far completed?

A I would say I'm about 60 -- close to 70 pages

Q 60, 70. How long do you think the book is going to be when it's done?

A 132 pages. Malpica Dep. Page 20, Lines 21-25 – Page 21, Lines 1-10 (emphasis added).

Accordingly, it is clear, based on the undisputed testimony, that there is no genuine dispute as to any material fact as to the issue of whether Registrant Malpica used his trademark before the deadline of filing his statement of use (August 13, 2020). Thus, the only questions remaining are those of law, which can be properly determined by the Board.

CONCLUSION

Based on the disputed material facts detailed above, the Board should not grant Registrants' Cross-Motion for Summary Judgment as to Counts I and II.

As to Count III, the undisputed facts and evidence establish that Registrants did not use their trademark in commerce prior to their deadline for filing a statement of use. Thus, the Registrant's Registration should be cancelled as a matter of law.

Further proceedings would waste the Board's and the parties' resources. Petitioner therefore requests summary judgment in its favor and that the petition for cancellation be granted.

By:

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Dated: August 22, 2024

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing PETITIONER'S MOTION IN
OPPOSITION TO DEFENDANT'S CROSS-MOTION FOR SUMMARY JUDGMENT AND
REPLY IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY JUDGMENT FOR
COUNT III OF THE PETITION FOR CANCELLATION: NO USE OF THE MARK IN
COMMERCE BEFORE THE STATEMENT OF USE WAS FILED has been served on the
following via email:

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Dated: August 22, 2024