

TTAB TIPS: MOTIONS FOR SUMMARY JUDGMENT



Hon. Michael Adlin, *Administrative Trademark Judge*
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USPTO, Trademark Trial and Appeal Board



Trademark Trial and Appeal Board

**Summary Judgment Motions
Procedures, discovery, and accelerated case
resolution (ACR) with the
United States Patent and Trademark Office
Trademark Trial and Appeal Board**



Summary Judgment: TTAB

Summary Judgment Basics



Summary Judgment Basics

- Provided for by Fed. R. Civ. P. 56
- A pre-trial device to dispose of cases in which “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.” Fed. R. Civ. P. 56(a).
- Purpose: judicial economy



Reasons for filing a motion for summary judgment

- If you are going to file a motion for summary judgment, you must know why you are doing it. There are two reasons: either to completely delete a part of the other party's claim(s) or defense(s); or, to win the entire case.
- Hence, a motion for summary judgment can knock out the adverse party's entire case or defense, a portion of it, or decide a major issue prior to trial



Multiple Claims

- Determination of one claim ends the case
 - Summary judgment motion on all claims
 - Summary judgment motion on fewer than all claims



Summary Judgment Basics

- Movant's burden: to demonstrate the absence of any genuine dispute of material fact and that it is entitled to judgment as a matter of law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256-57 (1986).
- A material fact is a fact that could matter to (have legal impact on) the outcome of the case. *Anderson* at 248.
- If met, non-movant must proffer countering evidence to show there is a genuine dispute for trial. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).
- Non-movant is given benefit of doubt. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993)
- See also TBMP § 528.01



TTAB Summary Judgment Data

- Contested Summary Judgment Motions, FY13
- Number decided: 153
 - Moved by plaintiff: 101
 - Moved by defendant: 52

Granted	21
Partially Granted	9
Denied	106
Denied w/o Prejudice	4
Not Considered/Deferred	5
Other*	8



TTAB Summary Judgment Data

- Cross Motions for Summary Judgment: 28 of 153
- Uncontested Summary Judgment Grants: 43
 - Moved by Plaintiff: 30
 - Moved by Defendant: 13

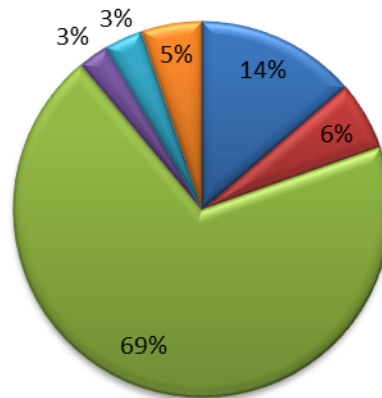
SJ Cross Motions Denied	24
SJ Cross Motions Partially Granted	1
SJ Cross Motions - Other/Not Decided	3



TTAB Summary Judgment Data

SJ Decisions

- Granted
- Partially Granted
- Denied
- Denied w/o Prejudice
- Not Considered/Deferred
- Other*





TTAB Summary Judgment Data

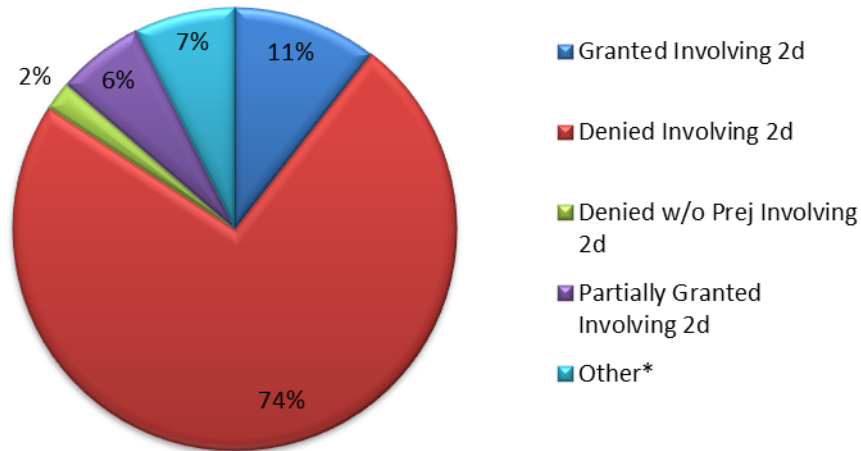
- Contested motions involving a likelihood of confusion claim: 95

Granted Involving 2d	10
Denied Involving 2d	70
Denied w/o Prej Involving 2d	2
Partially Granted Involving 2d	6
Other*	7



TTAB Summary Judgment Data

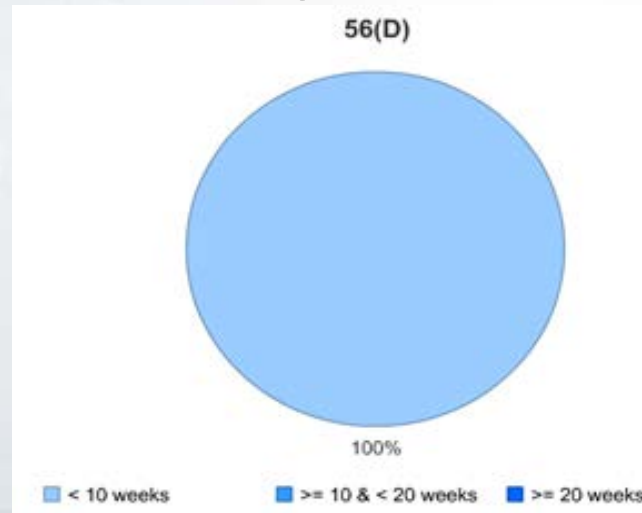
SJ Decisions Involving 2d claims





TTAB Dashboard - SJ Snapshot

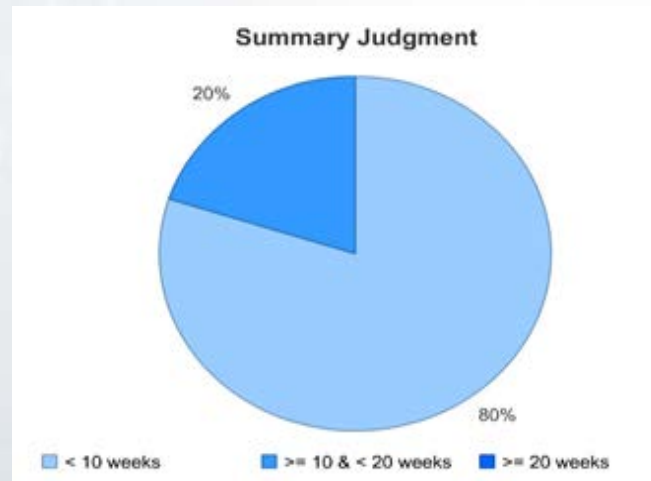
- <http://www.uspto.gov/dashboards/TTAB/main.dashxml>
- Fourth Quarter, FY 13 – FRCP 56(d) motions
 - 100% were pending less than 10 weeks





TTAB Dashboard-SJ Snapshot

- Fourth Quarter, FY 13 – Summary Judgment
 - 80% of the motions were pending less than 10 weeks
 - 20% of the motions were pending between 10-20 weeks





Summary Judgment Basics

- Timing
 - After service of initial disclosures unless based on 1) claim or issue preclusion or 2) lack of Board jurisdiction
 - Before opening of the first testimony period
 - 37 C.F.R. § 2.127(e)(1); TBMP § 528.02
- Due Dates
 - Responsive brief or motion for Fed. R. Civ. P. 56(d) discovery: 30 days from date of service
 - Reply brief: 15 days from date of service of responsive brief
 - 37 C.F.R. § 2.127(e)(1); TBMP §§ 502.02, 528.02
 - **Reminder:** add an additional 5 days to the due date for the responsive and reply briefs where service was made by first-class mail, "Express Mail," or overnight courier. 37 C.F.R § 2.119(c); TBMP § 113.



Summary Judgment: Suspension

When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the motion is decided.

Trademark Rule 2.127(d); TBMP 528.03

Super Bakery Inc. v. Benedict, 96 USPQ2d 1134, 1135 (TTAB 2010),
clarified, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011).



Summary Judgment: Suspension

- Compliance with other obligations
- Point in the proceeding when summary judgment motion is filed
- Suspension for civil action after summary judgment motion filed
- Suspension for settlement after summary judgment motion filed



Summary Judgment/56(d) when filed

- Must be filed within 30 days from the date of service of the summary judgment motion (35 days if 37 CFR. § 2.119(c) applies)
- Time for filing a motion for Fed. R. Civ. P. 56(d) discovery will not be extended. 37 C.F.R. § 2.127(e)(1).
- *McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013).



Summary Judgment Basics

- Briefs - length
 - Motion and responsive briefs: 25 pages
 - Reply brief: 10 pages
 - 37 C.F.R. § 2.127(a); TBMP §§ 502.02(b) and 528.01
- Cross Motions
 - Same issues, combined response to cross motion and reply
 - Different issues, separate response to cross motion, separate reply, different due dates
 - Brief length for motion, cross motion and response, and combined response to cross motion and reply : 25 pages
 - Reply brief length on cross motion: 10 pages
 - TBMP § 528.01.



Summary Judgment Basics

Summary Judgment Motion	Suspension order	Combined Response and Cross Motion	Supplemental Suspension & Scheduling order may issue	Combined Response to Cross Motion and Reply	Reply on Cross motion
25 pages		25 pages, due 30 days from service		25 pages, due 30 days from service	10 pages, due 15 days from service

Summary Judgment	Suspension order	Response to Motion for summary judgment; cross motion	Supplemental Suspension & Scheduling order may issue	Reply on Motion	Response to Cross Motion	Reply on Cross Motion
25 pages		25 pages, due 30 days from service		10 pages; due 15 days from service	25 pages; due 30 days from service	10 pages; due 15 days from service



Summary Judgment: Evidence

- Types of Matters and Evidence considered: pleadings, written disclosures or disclosed documents, discovery depositions, produced documents, electronically stored information, affidavits or declarations and accompanying evidence, stipulations, admissions, interrogatory answers, registrations, printed publications and official records, Internet evidence, testimony from another proceeding. 37 C.F.R. § 2.127(e)(2); TBMP § 528.05



Partial Summary Judgment

- Partial summary judgment may narrow the issues for trial, promote settlement, and encourage the parties to elect ACR.
 - Will movant only gain that which is not at issue for trial, e.g., priority in an opposition
- Strategic timing: what point in the proceeding
- Typical issues
 - Standing
 - Priority in an opposition
 - Likelihood of confusion



Partial Summary Judgment - Examples

- *Valent U.S.A. Corporation v. Florida Garden Supplies, Inc.*, Opposition No. 91202421 (January 15, 2014).
 - Granted on standing and priority, denied on likelihood of confusion
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=91202421&pty=OPP&eno=25>
- *Hershey Chocolate & Confectionery Corporation v. Kenneth B. Wiesen*, Opposition No. 91200575 (December 27, 2013).
 - Granted on standing, priority and likelihood of confusion, opposition sustained
 - Trademark Act § 2(a) claim not reached. 15 U.S.C. § 1052(a)
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=91200575&pty=OPP&eno=32>



Partial Summary Judgment - Examples

- *Patterson Enterprises v. Denise R. Selk*, Opposition No. 91207808 (December 5, 2013)
 - Granted for opposer on standing and likelihood of confusion; denied on priority; applicant's cross motion denied.
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=91207808&pty=OPP&eno=10>
- *The Armor All/STP Product Company v. Limited liability company "Autoplastic,"* Cancellation No. 92056035 (November 14, 2013)
 - Granted on standing, priority and likelihood of confusion
 - Petitioner allowed time to inform the Board if it wishes to go forward with claims of abandonment and dilution
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=92056035&pty=CAN&eno=27>



Tips on Summary Judgment Basics

- Mind the timeliness of a summary judgment filing
- Mind page limits and due dates for briefs
- Remember the time for filing a 56(d) motion and a reply cannot be extended
- Remember the heightened burden of proof
- Be strategic about the point in the proceeding when the summary judgment motion is filed
- Be strategic about the claim(s) for which summary judgment is sought
- Consider ACR



Motions for Rule 56(d) discovery

RULE 56(d)



Federal Rule of Civil Procedure 56(d)

If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:

- (1) defer considering the motion or deny it;
- (2) allow time to obtain affidavits or declarations or to take discovery; or
- (3) issue any other appropriate order



Rule 56(d) Motion

- In lieu of responsive brief to summary judgment motion
- Limited discovery
- Movant bears burden



Rule 56(d) Motion

- Not a substitute for full-blown pre-trial discovery
- Not a substitute for a motion to compel
- Not appropriate where able to raise dispute with own evidence



Rule 56(d) Motion

Timing

- Likely granted if early in proceeding
- May deny if dilatory or undue delay in pursuing discovery



Rule 56(d) Motion

Steps:

- Prepare motion
- Include affidavit or declaration



Rule 56(d) Motion

Tips for content of affidavit:

- Avoid speculation
- Should contain type of information and facts sought



Rule 56(d) Motion

- Available discovery devices
- Targeted 56(d) discovery
- Discovery within knowledge and control of moving party



Rule 56(d) Motion

- If denied, file substantive response to motion
- When may Rule 56(d) motion be rendered moot?



Rule 56(d) Cases

- *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 (TTAB 2008);
- *Orion Group Inc. v. The Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989).
- *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995).
- *Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988) .
- *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992).
- *Exigent Technology Inc. v. Atrana Solutions Inc.*, 442 F.3d 1378 USPQ2d 1321, 1327 (Fed. Cir. 2006).
- *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987).
- *Keebler Co. v. Murray Bakery Products*, 866 F2d 1386, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989).
-



Summary Judgment

Common Problems and Solutions



Summary Judgment Preparation Common Problem

- Discovery responses not supportive
- Early use of discovery
- Craft a discovery plan



Summary Judgment Common Problems

- Insufficient or unpleaded claims
Insufficient or unpleaded defenses
- Timing and page limits



Summary Judgment Preparation

- Have you evaluated the pleadings?
 - Legal requirements
 - Necessary elements
 - Address defects
- Review Rules pertaining to page limits and timing



Summary Judgment Common Problems

- Citation to incorrect legal authorities
- Arguing incorrect legal principles



Summary Judgment Common Problems

Evidentiary Problems

- Lack of evidence
- Insufficient evidence
- Attorney argument



Summary Judgment

Practice tips

- Assess the state of the evidence
- Match evidence to undisputed facts
- Prepare affidavits
- Check admissibility and authentication



Summary Judgment

Practice Tips Submitting Evidence

- Complete exhibits
- Reference exhibits
- Relevant portions of discovery and depositions
- Avoid cumulative and duplicative evidence
- Confidential matter – over designation



Summary Judgment

Practice tip

- Undisputed facts- utility
- Tips on drafting
- Cite to evidence



Summary Judgment Reminders Moving Party

- Critically review the propriety of summary judgment
- Review the pleadings
- Determine what evidence is needed
- Assess the evidence
- Attach all evidence



Summary Judgment Nonmoving Party

- Defending against summary judgment
- Considerations in drafting opposition:
 - Review opponent's "undisputed facts"
 - Analyze the sufficiency of evidence
 - Analyze legal arguments of moving party



Summary Judgment Nonmoving Party

Best Practices – nonmoving party

- Disputed material facts
- Additional material facts
- Evidence in record
- Countering admissible evidence
- Avoid concessions – undisputed facts



Summary Judgment Nonmoving Party

- Frivolous summary judgment – response required?
- Advisability of cross-motion



Summary Judgment

Reply brief practice tips

- Clarify issues
- Address arguments raised
- No reargument



Summary Judgment

- Evidence submitted of record only for consideration of motion
- For consideration of evidence at final decision
 - Must introduce evidence at trial
 - Parties may stipulate
 - Consider ACR



Summary Judgment

- *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed.Cir.2005) (“Attorney argument is no substitute for evidence”).
- *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984).
- *Akers v. Beal Bank*, 845 F.Supp.2d 238, 243 (D.D.C. 2012).
- *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009).
- *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007).
- *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010).
- *Kallamni v. Khan*, 101 USPQ2d 1864, 1865 (TTAB 2012).
- *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007).
- *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010)
Edwards Lifesciences Corp. v. VigiLanz Corp., 94 USPQ2d 1399, 1402 (TTAB 2010).



Summary Judgment

Summary Judgment Considerations and ACR



Remember What Motions for Summary Judgment are *Not*

- Board's jurisdiction limited to determining right to registration (both in appeals and trial cases)
- In many cases, Board looks only at marks and goods or services in application(s) and registration(s), not marketplace realities, so evidence of actual goods/services, as opposed to those identified in application, may not be relevant
- Channels of trade, if there are no limitations on channels of trade in involved application or registration, are often irrelevant
- Even when actual use considered, priority often not at issue if registration pled; ITU applicant often has no use prior to filing date; geographic territories irrelevant (except for CU); and our decisions rarely turn on evidence on remaining *DuPont* factors



Board Does Not Consider:

- Use of house mark or limited fonts/colors/displays
- That actual goods or services are narrower than ID
- That class of consumers or channels of trade may in fact be limited – ID is almost always controlling
- Expensive cost of goods/services, unless ID limited
- For all the discovery taken and evidence submitted re: intent in adoption, decisions turning on a finding of bad intent are exceedingly rare



Board Must Assume

- Standard character mark can appear in any form
- Goods, services include very cheap & very costly
- Goods, services marketed in any possible way to all potential buyers
- Registered mark in use and for all items within ID
- **Practice tip**—ask whether adversary's discovery requests are overbroad/unduly burdensome given circumstances of case and Board's limited jurisdiction (avoid asserting boilerplate objections)



Types of Claims Most Amenable to Summary Judgment

- Issue or Claim Preclusion
 - Mere comparison of facts and claims to previous case
- Genericness/descriptiveness
 - Dictionary definitions
 - Third party and media uses
 - Even cases involving experts



Types of Claims Least Amenable to Summary Judgment

- Ownership disputes not based on contracts
- Priority disputes
- Likelihood of confusion claims where there are differences between the marks and/or goods
- Dilution
- Fraud



Types of Claims Least Amenable to Summary Judgment

- *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) (“as a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment”)
- *Confederated Tribes of Colville Reservation v. United States*, 964 F.2d 1102, 1109 (Fed. Cir. 1992) (noting that for fact-intensive issues, the trial court has the discretion to deny summary judgment)
- *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 962 (TTAB 1986) (summary judgment is notoriously inappropriate for determination of claims in which issues of intent, good faith and other subjective feelings play dominant roles)



Summary Judgment and ACR

Don't be Surprised!

- Board has discretion after receiving fully briefed motion for summary judgment to suggest fast-track decision of case using Accelerated Case Resolution (ACR)
- Typical case: Section 2(d) claim where priority is not an issue



Forms of ACR

- First, as a summary bench trial, use predates 2007 amended rules.

Miller Brewing Co. v. Coy Int'l Corp., 230 USPQ 675 (TTAB 1986)

- Second, parties can stipulate to facts (some, many or all), and/or evidence to be considered, and methods of introduction.

Target Brands, Inc. v. Shaun N.G. Hughes, 85 USPQ2d 1676 (TTAB 2007)

First option is more relevant to motions for summary judgment



ACR Basics

- Raise issue in conference; revisit after disclosures, some discovery
- May also decide to proceed under ACR in the middle (or even end) of discovery, or on the eve of trial
- Look for savings in time and resources
- Parties do not forfeit right to oral hearing
- Full appeal options retained
- Decision in 50 days for true ACR cases



ACR Summary Judgment Model

- Record for the case provided by parties' summary judgment submissions
- Testimony will be presented by affidavit or declaration
- Any exhibits referenced by the affiants or declarants
- Exhibits to brief are any materials that, in a typical trial, could be submitted by notice of reliance



ACR Summary Judgment Model

- The parties must provide a stipulation that the Board may resolve any genuine disputes of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing
- Parties should file a joint stipulation of undisputed facts
- The parties are free to enter into other stipulations regarding the submission of evidence



ACR Summary Judgment Model

- ACR summary judgment may be a single motion or in the form of cross-motions
- 25 pages for brief, inclusive of table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument and summary
- 10 pages for reply brief
- Oral hearing available but will affect Board's commitment to rendering decision in 50 days



ACR Summary Judgment Model

- “While we commend the parties for agreeing to efficiencies intended to facilitate the introduction of evidence at trial, ideally, “ACR” (i.e., Accelerated Case Resolution) cases do not merely facilitate introduction of more evidence, but should also limit the amount of evidence placed before the Board. . . . A larger record is not necessarily a better record.”
- *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1345 n.5 (TTAB 2013).



ACR and Motions for Summary Judgment

- **Practical Consideration**: After briefing a motion for summary judgment, is it cost-justified, or will your presentation of evidence benefit, by doing it all again at trial? Might it be preferable to simply allow the Board to resolve genuine disputes of fact on the summary judgment record, perhaps with agreed supplementation?
 - Evidence submitted with msj is only of record for that motion, and if you go to trial, you must resubmit it if you want Board to rely on it
 - Why go to expense of reintroducing evidence? Why pay for travel, court reporters and transcripts to obtain testimonial depositions when declarations containing relevant facts are already completed?
- With permission Board will resolve genuine disputes as to material facts on parties' more focused, perhaps stipulated record, or even on complex record



ACR and Motions for Summary Judgment—Examples

- “Moreover, we note that the identifications of goods in opposer’s pleaded registration and applicant’s involved application both include “pillows” and “mattresses.” As noted *supra*, in determining whether or not there is a likelihood of confusion, we must presume that the scope of the goods encompasses all of the goods of the nature and type described, that they would travel in all channels of trade normal for those goods and to all classes of prospective purchasers for those goods. See *Canadian Imperial Bank v. ells Fargo Bank*, *supra*. Thus, because the parties’ goods are identical in part, the disposition of this case will likely turn on the similarity of the marks and the scope of protection to be accorded each of the involved marks. Accordingly, this case may be appropriate for a decision on an accelerated case resolution (ACR) record. The parties may wish to consider supplementing their cross-motions for summary judgment and providing the Board with a stipulation allowing the Board to decide disputed issues of fact in a final decision on the merits based on such record. Information concerning use of ACR in Board proceedings is available online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.”
 - *Dan Foam ApS v. Sleep Innovations, Inc.*, Cancellation No. 92054201, May 13, 2013
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=92054201&pty=CAN&eno=42>



ACR and Motions for Summary Judgment—Examples

- “As borne out by the excessive record created in this case, the parties introduced what can be characterized as cumulative and irrelevant testimony and evidence (e.g., many documents were introduced three times and testimony regarding how the bombs work was not relevant to the question whether PAVEWAY is a generic term or a mark). Most noteworthy, however, is that there was no real dispute about the operative facts; rather the parties disagreed as to what the facts meant under applicable law. Under these circumstances, this case was a good candidate for the Board’s ACR procedure . . . Had the parties opted for ACR, proceedings would have been expedited and resulted in savings of time, money and effort. These savings would have included the Board’s effort in having to slog through the cumulative and irrelevant testimony and evidence introduced by the parties.”
 - *Lockheed Martin Corporation v. Raytheon Company*, Opposition Nos. 91167189 and 91174152, September 27, 2011
<http://ttabvue.uspto.gov/ttabvue/v?pno=91167189&pty=OPP&eno=148>



ACR and Motions for Summary Judgment—Examples

- “We note that the record in this proceeding is already extensive, and the parties are well-acquainted with the relevant facts and legal issues. Accordingly, the parties may wish to stipulate to resolution of this proceeding by means of the Board’s accelerated case resolution (“ACR”) procedure, either on the current record, or on the current record as supplemented by the parties pursuant to an agreement on proceeding under ACR. The parties are therefore encouraged to jointly contact the interlocutory attorney responsible for this proceeding by telephone to discuss the possibility of ACR, any supplementation of the record and an agreed schedule for proceeding under ACR. The Board’s ACR procedures can be tailored to the parties’ needs, positions and schedules. The Board has already considered multiple motions for summary judgment in this proceeding, and therefore hereby exercises its authority to manage the cases on its docket by precluding either party from filing any additional motions.”
 - *Amazon Technologies, Inc. v. Wax*, Opposition No. 91187118, December 21, 2011
 - <http://ttabvue.uspto.gov/ttabvue/v?pno=91187118&pty=OPP&eno=139>



ACR Resources

- **Practice tip**: Board web site includes ACR FAQs, model schedules that can provide starting point for discussion with adversary, and a list of cases utilizing some form of ACR or ACR-like efficiencies. Access the docket entries and filings for these cases through TTABVUE:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>



TTAB TIPS: Motions for Summary Judgment

QUESTIONS?

U.S. Patent and Trademark Office, Trademark Trial and Appeal Board

TTAB Tips: Motions for Summary Judgment, An Outline

Cheryl Goodman, Interlocutory Attorney; Cheryl Butler, Senior Counsel and
TBMP Editor; Hon. Michael Adlin: March 25, 2014

Summary Judgment Basics

1. Provided for by Fed. R. Civ. P. 56

A pre-trial device to dispose of cases in which “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.”

2. TTAB’s jurisdiction

The Board is empowered to determine only the right to register. 15 U.S.C. § 1067, 15 U.S.C. § 1068, 15 U.S.C. § 1070, 15 U.S.C. § 1092.

3. Parties’ burdens

A. Movant: to demonstrate the absence of any genuine dispute of material fact and that it is entitled to judgment as a matter of law.

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256-57 (1986).

B. Non-movant: proffer countering evidence to show there is a genuine dispute for trial.

Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

4. Time for filing motion

A. May not be filed until a party has made its initial disclosures unless based on:

- a. Claim or issue preclusion
- b. Lack of Board jurisdiction

37 CFR § 2.127(e)(1).

B. Must be filed prior to the commencement of the first testimony period. 37 CFR § 2.127(e)(1).

Once the first testimony period commences, however, any summary judgment motion filed thereafter is untimely, even if filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff, and even if no trial evidence has actually been introduced by the plaintiff in a previously open, but later reset trial period. TBMP § 528.02.

5. Briefs: page limits

- A. Moving brief and responsive brief: 25 pages
- B. Reply brief: 10 pages

The Board will not consider over length briefs.

Mattel Inc. v. Brainy Baby Co., 101 USPQ2d 1140, 1141 (TTAB 2011)
(reply brief not considered because it exceeded the page limit)

6. Briefs: due dates

- A. Response to a summary judgment motion: 30 days from date of service of motion
- B. Reply: 15 days from date of service of responsive brief.
- C. Cross motions:
 - 1. Same claim: combined response to cross motion and reply to initial motion for summary judgment: 30 days from service of combined response and cross motion.
 - 2. Different claims: reply to initial motion – 15 days from cross motion and response; response to cross motion – 30 days from cross motion and response.
- D. Additional 5 days when applicable. 37 C.F.R §§ 2.119(c) and 2.127(e)(1).

7. Suspension

- A. When a party files a timely motion for summary judgment, the Board generally will issue an order suspending proceedings in the case with respect to all matters not germane to the motion.

37 CFR § 2.127(d)

- B. The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended only when the Board issues an order to that effect.

37 CFR § 2.127(d); *Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1135 (TTAB 2010) (mere filing of motion for summary judgment does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect), clarified, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011).

Rule 56(d) and Summary Judgment Common Problems/Practice Tips Outline

1) Rule 56(d)

a) Provided for by Fed. R. Civ. P. 56(d):

- i) If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:
 - (1) defer considering the motion or deny it;
 - (2) allow time to obtain affidavits or declarations or to take discovery; or
 - (3) issue any other appropriate order.

Relevant cases:

Land O' Lakes Inc. v. Hugunin, 88 USPQ2d 1957, 1960 (TTAB 2008);

Orion Group Inc. v. The Orion Insurance Co. P.L.C., 12 USPQ2d 1923, 1924-25 (TTAB 1989).

b) When is Rule 56(d) is not appropriate

- i) 56(d) discovery not appropriate where non-moving party is able to demonstrate, at the very least, a material dispute of fact to defeat summary judgment through its own affidavits, and by relying on its own witnesses and documents.

c) Utility

- i) Filed in lieu of filing a responsive brief on the merits of the motion for summary judgment.
- ii) Party seeking Rule 56(d) discovery bears the burden of establishing why discovery is needed to respond to summary judgment motion.
- iii) Fed. R. Civ. P. 56(d) motion will be denied if substantive response to summary judgment motion filed in conjunction with motion.
- iv) If Board denies motion for Rule 56(d) discovery, non-moving party still entitled to file a responsive brief on the merits of motion for summary judgment.

Relevant Case:

Dyneer Corp. v. Automotive Products plc, 37 USPQ2d 1251, 1253 (TTAB 1995).

d) Rule 56(d) is limited

- i) 56(d) discovery is not a substitute for full-blown pre-trial discovery nor a substitute for a motion to compel.

- ii) 56(d) discovery is limited to discovery non-moving party must have in order to respond to motion for summary judgment.
- iii) Whether to grant a Rule 56(d) motion depends in part on what particular information is sought and how, if uncovered, it would preclude summary judgment; facts seeking to be uncovered must be sufficient to raise genuine dispute.
- iv) If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment.

Relevant Cases:

Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988) .

Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923, 1924-25 (TTAB 1989).

e) 56(d) Timing and Discovery

- i) When a motion for summary judgment motion is filed early in the proceeding before the non-moving party has had a realistic opportunity to pursue discovery, Rule 56(d) motion would likely be granted.
- ii) "The Board is apt to look with disfavor upon a party which seeks to delay a case for Rule [56(d)] discovery, if the party made no effort to obtain discovery during the discovery period" or was dilatory in seeking discovery prior to summary judgment even if discovery remains open.

Relevant Cases, Articles:

Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992).

Exigent Technology Inc. v. Atrana Solutions Inc., 442 F.3d 1378 USPQ2d 1321, 1327 (Fed. Cir. 2006).

See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990).

f) 56(d) Affidavit Requirement

- i) A party requesting Rule 56(d) discovery should make the request by affidavit.

- ii) The party seeking Rule 56(d) discovery must state, under oath, why it is unable to present specific facts that show the existence of a genuine dispute of fact for trial.
- iii) If not presented in affidavit form, the Rule 56(d) request may be denied.

Relevant Case:

Sweats Fashions Inc. v. Pannill Knitting Co. Inc., 833 F2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987).

- iv) A conclusory statement that crucial information is within its opponent's knowledge and control or that discovery is necessary, is insufficient; mere speculation that unspecified facts will be uncovered is insufficient.

Relevant Case:

Keebler Co. v. Murray Bakery Products, 866 F2d 1386, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989).

- v) Available discovery devices for targeted 56(d) discovery:
 - (a) *Specific* Interrogatory requests
 - (b) *Specific* Document requests
 - (c) Requests for Admissions directed to issues to raise a genuine dispute
 - (d) Depositions directed to specific facts (e.g., as set forth in a moving party's affidavit)

2) Summary Judgment Preparation

a) Discovery Plan

- i) Early use of discovery is always a good idea, since it permits, at an early stage, a party to discover strengths and weaknesses in its own or its adversary's case, discover corroborative facts for its claims or defenses or the lack of contradictory facts available to its adversary, and otherwise to be more fully informed of the opponent's case and facts prior to the filing of a motion for summary judgment.
- ii) Summary Judgment Preparation: Have you evaluated the pleadings?
 - a. Do the pleadings contain all the necessary elements of each cause of action or defense that must be proved to prevail on the motion?

- b. If there are defects on the face of the pleadings, will opposing counsel stipulate to amend the pleading? If counsel will not stipulate, have you filed a motion to amend?

b) Common Problem – Insufficiently Pleaded or Unpleaded Claims

- i) The Board does not consider insufficient or unpleaded claims or defenses on summary judgment.

Relevant Cases:

Asian and Western Classics B.V. v. Selkow, 92 USPQ2d 1478, 1480 (TTAB 2009).

Giersch v. Scripps Networks Inc., 85 USPQ2d 1306, 1309 n.3 (TTAB 2007).

American Express Marketing & Development Corp. v. Gilad Development Corp., 94 USPQ2d 1294, 1297 (TTAB 2010). (The “Board will not hesitate to deny any motion for summary judgment on an unpleaded claim or defense unless the motion for summary judgment is accompanied by an appropriate motion to amend or is withdrawn and refiled with such a motion to amend.”)

c) Common problem – No evidence submitted or insufficient evidence submitted to support an undisputed material fact.

- i) Determine what evidence is needed in support of the summary judgment motion:
- ii) Review interrogatories, requests for admissions, documents, discovery deposition transcripts, or other documentary evidence that supports your claims or defenses.
- iii) Determine which evidence correlates to each fact and/or element of a claim or defense.

d) Properly Support Motions for Summary Judgment

- i) Attorney arguments or assertions do not form a basis for summary judgment and therefore, must be properly supported.
- ii) Relevant Cases:
Invitrogen Corp. v. Clontech Labs., 429 F.3d 1052, 1068 (Fed.Cir.2005) (“Unsubstantiated attorney argument . . . does not, and cannot, support [defendants'] burden on summary judgment”) .

S. Bravo Sys., Inc. v. Containment Techs. Corp., 96 F.3d 1372, 40 USPQ2d 1140, 1144 (Fed. Cir. 1996) (unsupported assertions do not satisfy requirement of designating specific evidence to create genuine dispute).

Enzo Biochem, Inc. v. Gen-Probe Inc., 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed.Cir.2005) (“Attorney argument is no substitute for evidence”).

vi) Self-authenticating vs. non-self-authenticating materials.

The 2010 amendments to Fed. R. Civ. P. 56(c)(2), “eliminated the unequivocal requirement that documents submitted in support of a summary judgment motion must be authenticated.” *Akers v. Beal Bank*, 845 F.Supp.2d 238, 243 (D.D.C. 2012).

- a. The lack of authentication is now grounds for objection, but only on the basis that the evidence cannot be presented in a form that would be admissible in evidence. Rule 56(c)(2).

Relevant Cases:

Akers v. Beal Bank, 845 F.Supp.2d 238, 243 (D.D.C. 2012).

Slate v. Byrd, No. 1:09CV852, 2013 WL 1103275, at * 2 (M.D.N.C. March 15, 2013);

Foreword Magazine, Inc. v. Overdrive, Inc., No. 1:10-cv-1144, 2011 WL 5169384, at *2 (W.D. Mich. Oct. 31, 2011).

- b. Nonetheless, it is good practice to submit evidence in admissible form to avoid objections and unnecessary motion practice.

e) Determine Material Facts

- i) The question of whether a disputed fact is material presents a question of law to be determined under the substantive law governing the claim.
- ii) By reviewing the facts in your case, you can determine whether there are material facts in dispute for each claim/cause of action or defense.
- iii) In many inter partes cases, there is often no dispute as to most of the underlying facts.
- iv) Counsel, in moving for summary judgment, should be acutely aware that, in such situations, he or she needs to show the Board the difference between a lack of dispute as to facts and a disagreement as to the interpretation to be placed upon such facts.

Relevant Case:

Kallamni v. Khan, 101 USPQ2d 1864, 1865 (TTAB 2012) (“The parties agree that the material facts are not in dispute with regard to this claim, but their opinions diverge on the legal conclusions to be drawn from such facts, which are questions of law”).

- v) Best practice: In drafting your motion for summary judgment, a listing of material facts not in dispute, with specific references to evidence, is a great help to the Board.

Relevant Case:

Paris Glove of Canada Ltd. v. SBC/Sporto Corp., 84 USPQ2d 1856, 1860 (TTAB 2007) (“a listing of undisputed facts . . . to a motion for summary judgment is often proffered and is preferred by the Board”).

f) Determine Relevant Evidence

- i) Review interrogatories, requests for admissions, documents, discovery deposition transcripts, or other documentary evidence that supports your claims or defenses.
- ii) Determine which evidence correlates to each fact and/or element of a claim or defense.

g) Evidentiary Submissions Practice tips

- i) Avoid Cumulative and Duplicative Evidence:
- ii) *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010). (The Board and the parties would be well-served if a motion for summary judgment is focused on the most relevant facts and issues, and if the parties refrain from the “needless presentation of cumulative evidence.”).
- iii) Avoid over designation of confidential material; provide redacted copy for public record.

Edwards Lifesciences Corp. v. VigiLanz Corp., 94 USPQ2d 1399, 1402 (TTAB 2010). (“We further note the excessive marking of various information as confidential and urge parties to limit such designations. It greatly complicates the record, and frequently the matter is improperly designated or not useful to the disposition of the case.”).

- iv) Submit only relevant portions of evidence.

Sports Authority Michigan Inc. v. PC Authority Inc., 63 USPQ2d 1782, 1787 (TTAB 2001) (“First, each party has submitted discovery deposition transcripts

in toto, i.e., has made no apparent effort to identify and introduce only those portions that are relevant to our determination of the pleaded claims. While not improper, it is more effective to file only those portions that are relevant and explain their relevancy in the notice of reliance.”).

h) Clearly identify evidentiary submissions:

i) Best practices:

- a. When referring to evidence in your summary judgment brief or response, identify where that evidence can be found.
- b. Depositions: Give the page of the transcript of cited deposition testimony.
- c. Answers to Interrogatories and Admissions (Fed. R. Civ. P. 36): State the number of the interrogatory or admission
- d. Other Admissions: The identity of the document, the number of the page, and paragraph of the document in which that admission is made.
- e. Affidavits: The page and paragraph number, and supporting exhibit.
- f. It is up to the parties to assure that their submissions (exhibits) are accurate when filed in connection with a motion for summary judgment. The Board will rely heavily on your exhibits to support the arguments you make, so make sure that each exhibit has actually been submitted, is complete, and is properly referenced in your brief.

i) Nonmoving Party – responding to motion for summary judgment

- i) 1). If the motion for summary judgment is properly supported, the responding party must similarly set forth facts to show that one or more genuine issues remain for trial. If the motion is not properly supported, or if the responding party believes that the movant is not entitled to judgment as a matter of law, a brief pointing out why summary judgment should not be granted would be a proper response.
 - a. Your opposition memorandum should:
 - i. Meet each of the moving party’s arguments,
 - ii. Address whether the moving party has met its initial

burden on summary judgment, or identify disputed factual issues, and

iii. Negate cases supporting the moving party's position.

j) Nonmoving party – best practice

- i) A non-movant should not merely state in conclusory fashion that "facts are in dispute," leaving to the Board the tedious task of digging out the disputed fact(s), if indeed any exists.
- ii) The far better practice, and the one strongly encouraged by the Board, is for the non-movant, in its brief, to specifically identify or list the material fact(s) in dispute and point to the particular evidence which shows that the fact(s) is in dispute.

Relevant Cases:

Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) ("non-movant may not rest on its conclusory pleadings").
National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1215 (TTAB 1990) ("unsupported speculation" does not avoid summary judgment).

k) Don't Concede

- i) A failure to respond to a motion for summary judgment may be taken as a concession of the motion, which may then be granted on that basis. 37 C.F.R. § 2.127(a).
- ii) Accordingly, even if a motion for summary judgment appears to be bad on its face, the nonmoving party should file, at the very least, a brief pointing out the deficiencies of the motion so as to avoid losing the motion by concession.

l) Cross-motions

- i) The filing of cross-motions does not necessarily mean that no genuine dispute of material fact remains.
- ii) No Throwaways:
 - a) Avoid "me too" motions i.e., filing a cross-motion when genuine dispute remain or evidence does not support such a motion.
 - b) Avoid one sentence cross-motions.

Relevant Case:

Fishking Processors Inc. v. Fisher King Seafoods Ltd., 83 USPQ2d 1762, 1764 (TTAB 2007) (“The mere fact that cross-motions for summary judgment have been filed does not necessarily mean that there are no genuine issues of material fact, and that a trial is unnecessary.”).

m) Reply Briefs

- i) It is not for purposes of reargument.
- ii) A reply brief may:
 - a. Clarify Issues
 - b. Address Nonmoving Party’s arguments.

Relevant cases:

S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221, 1223 n.4 (TTAB 1987) (mere reargument in reply brief not considered).

Avon Products, Inc. v. MarCon, Ltd., 225 USPQ 977, 979 (TTAB 1985) (permissible to respond to new issues raised and to clarify matters for the Board in reply brief).

n) Summary Judgment Denied – Evidence Submitted not in Record for Trial

- i) Evidence submitted of record only for consideration of motion.
- ii) For consideration of evidence at final decision:
 - (a) Must introduce evidence at trial
 - (b) Parties may stipulate
 - (c) Consider ACR.

List of Cases Illustrating Interplay Between Motions for Summary Judgment and ACR
(As of 7/25/12)

Lebanon Seaboard Corp. v. R&R Turf Supply, Inc. (91197241) (PRECEDENTIAL): Shortly before the close of discovery, parties stipulated to ACR without contacting the assigned Board attorney. In footnote 9, the Board states that it is “better practice when parties discuss... the proposed process with a Board attorney, either to help frame the agreement, or to modify or amend an agreement, as may be necessary to promote clarity...” However, because the parties in this case did not contact a Board attorney there was some procedural confusion. The Board explained that when facts and issues are stipulated to, it is unnecessary for the parties to submit evidence on those points. The Board further clarified that when the parties stipulate to ACR in lieu of summary judgment, the parties should stipulate that the Board may resolve any disputed issues of material fact in making a final determination on the merits, which is normally used to avoid trial. However, when the case is already going to trial, it is not necessary to so stipulate because the Board will resolve any disputed issues of material facts at trial as a matter of course.

MyShape, Inc. v. Athletetech Apparel Group (91186671): Suggestion in footnote of decision denying summary judgment on 2(d) claim and dismissing 2(a) claim that parties proceed via ACR on remaining 2(d) claim. Later motion for involuntary dismissal granted.

The Chamberlain Group, Inc. v. Hormann KG Antriebstechnik (91181028): Suggestion in decision denying summary judgment motion that parties stipulate to ACR and providing detailed information and procedures for doing so. Opposition later withdrawn.

Merz Pharmaceuticals, LLC v. Montani Cosmetics Inc. (92051832): Suggestion in decision denying summary judgment motion that it may be helpful, if the parties believe the proceeding may be resolved without resorting to a formal trial, to utilize ACR.

HB Sealing Products, Inc. v. S&B Technical Products, Inc. (91188961): Parties filed several interlocutory motions. The Board prohibited both parties from filing any further motions for summary judgment regarding opposer’s asserted claim of priority and likelihood of confusion or concerning any of applicant’s asserted defenses or affirmative defenses. The Board then went on to suggest the parties stipulate to ACR.

Business Startups, Corp. v. The Law Firm of Jeffrey L. Solomon, PLLC (91197772): Suggestion in decision denying summary judgment motion to use ACR in order to determine case “quickly and without a trial...”

Amazon Technologies, Inc. v. Jeffrey S. Wax (91187118):

After parties' cross-motions for summary judgment were denied, and the Board noted that the record had already become extensive, the Board suggested the parties resolve the case via ACR. Subsequently, the parties stipulated to ACR and the Board decided the case based upon the filed cross-motions. The defendant has since filed an appeal with the United States Court of Appeals for the Federal Circuit.

E. & J. Gallo Winery v. Christopher M. Malek (91199089):

The interlocutory attorney assigned to the proceeding suggested ACR to the parties upon review of the parties' cross-motions for summary judgment. The interlocutory attorney advised that the existence of genuine issues of material fact would likely preclude the Board from granting either party's motion. Following this advice, the parties stipulated to ACR; specifically, that the evidence and briefs attached with their cross-motions would be treated as the final record and briefs.

Pignatello LLC v. Halloween Town, Inc. (Opposition No. 91193738):

Opposer's counsel filed notice of parties' stipulation to ACR on cross-motions for summary judgment and schedule therefor.

Get It In Writing Inc. v. IQ in Tech, Inc. and Get It In Writing, Inc. (92046274):

Case commenced more than a year prior to amendment of Board rules for inter partes cases. After MSJ, parties moved for ACR and asked that their cross-motions for SJ be treated as briefs and that any evidence of record in motions be deemed properly of record.

Weatherford/Lamb, Inc. v. C & J Energy Services, Inc. (92050101) 96 USPQ2d 1834 (TTAB 2010):

Parties stipulated that the Board may consider their cross-motions for summary judgment as briefs and evidence at final hearing and resolve any issues of material fact presented by such cross-motions. On final, Board interpreted parties' ACR stipulation as including a timely motion to strike certain evidence submitted at summary judgment.

Caterpillar Inc. v. Alan Sadler (91198463):

Parties stipulated to elect the ACR procedure. Via ACR, they stipulated to limit discovery and trial procedures. However, parties later modified their ACR stipulation to allow time for the Board to consider cross motions for summary judgment. Thus, the ACR proceedings were suspended pending disposition of the cross motions for summary judgment. Ultimately, the Opposer's MSJ was granted and the ACR mechanism was moot.

Merelinda Farms L.L.C. DBA Alpaca.com L.L.C. v. The American Breeders Co-op (91167038):

Board suggested ACR based upon untimely motion for summary judgment. Parties agreed, schedule for additional submissions and briefing set. Parties agreed to consider filing stipulation of facts no later than due date for rebuttal ACR submission, but case would proceed on ACR schedule regardless. Parties agreed to Board deciding any issues of material fact. No stipulation of facts filed.

Eveready Battery Company, Inc. v. Green Planet, Inc., 91 USPQ2d 1511 (TTAB 2009) (91180015):

Case commenced just prior to amendment of Board rules for inter partes cases.

Parties agreed to ACR just after trial began based upon parties' briefing and extensive record created for opposer's denied motion for summary judgment.

ACR briefing schedule set with instruction as to how, in such briefs, to refer to evidence previously submitted in briefing the MSJ.

M2 Software, Inc. v. M2 Communications, Inc. (91158118) (ACR final decision nonprecedential; affirmed 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006):

Case commenced and decided long before enhanced promotion of ACR, in conjunction with 2007 amendment of rules for Board inter partes cases. Board suggested ACR based upon pro se opposer's and applicant's over length cross-motions for summary judgment.

NSM Resources Corp. v. Rising High Enterprises, LLC (91191140):

Pro se applicant requested ACR, pro se opposer responded with motion for summary judgment; granted as conceded.

Freeman v. National Association of Realtors, 64 USPQ2d 1700 (TTAB 2002) (92027885 & 92028047):

Parties stipulated that case would be decided on petitioner's motion for summary judgment and respondent's response.

*NOTE: this proceeding is listed in section Non-ACR Cases decided in whole or in part based on stipulated facts or records.

Miller Brewing Co. v. Coy International Corp., 230 USPQ 675 (TTAB 1986) (91068606):

After fully briefing cross-motions for summary judgment, the parties filed a stipulation that the affidavits and exhibits before the Board for purposes of the pending motion and cross-motion for summary judgment shall be the testimony and evidence of the parties for purposes of final hearing; that the briefs in support of and in opposition to the pending motion and cross-motion for summary judgment shall be deemed to be the briefs at final hearing pursuant to Trademark Rule 2.128; and that all office records, matters of public record, discovery deposition excerpts and the like incorporated in or annexed as exhibits to the briefs or affidavits shall be deemed to have been properly filed pursuant to notice of reliance pursuant to Trademark Rule 2.122(e). *Id.* at 676.

*NOTE: this proceeding is listed in section Non-ACR Cases decided in whole or in part based on stipulated facts or records.

L-Com, Inc. v. Elecom Co. Ltd. (91192293):

Parties stipulated that the record on cross motions for summary judgment may be used in notices of reliance and that their briefs on the cross motions will be treated as final briefs in the case.

IPO Education Foundation PTO Day 2014

March 25, 2014

Review of Recent TTAB Precedential Decisions



Cindy B. Greenbaum
Administrative Trademark Judge





Non-Traditional Marks

- Sound
- Color
- Flavor and Scent



Electronic Chirps

- In re Powermat USA, LLC, 105 USPQ2d 1789 (TTAB 2013)
 - Five short electronic chirps in ascending or descending pitches for battery chargers – inherently distinctive?



In re Powermat

- Evidentiary Issue
 - Hyperlinks to Internet videos not allowed!



In re Powermat

- Sounds can function as marks BUT
- “can never be inherently distinctive” if emitted only in ordinary course
- “Look-for” advertising can support claim of acquired distinctiveness for sounds



Color Marks

- In re Florists' Transworld Delivery, Inc., 106 USPQ2d 1784 (TTAB 2013)



- Color black applied to packaging for "flowers and live cut floral arrangements"
- Registration sought under §2(f)



In re Florists' Transworld Delivery, Inc.

- Applicant's specimen:





In re Florists' Transworld Delivery

- Aesthetically functional - §2(e)(5)?
- Ornamental/decorative, not perceived as a mark - §§1, 2 and 45?



Aesthetic Functionality – Competitive Need Test

- Utilitarian vs. Aesthetic Functionality
- Aesthetic Functionality: competitors' significant, non-reputational disadvantage



Aesthetic Functionality-Evidence

- Internet evidence including non-US websites
- Significance of color in floral industry
- Role of packaging
- Third-party registrations and other floral boxes



Failure to Function/Acquired Distinctiveness

- Black – merely ornamental or decorative, or perceived as a mark?
- Applicant's "difficult burden" to show distinctiveness in color mark
 - In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 227 USPQ 417, 424 (Fed. Cir. 1985)



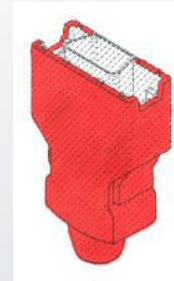
Evidence of Acquired Distinctiveness

- Evidence of acquired distinctiveness?
 - Declaration from corporate officer
 - "Look for" advertisements-length of time
 - Four consumer declarations
- Concurring opinion-"first principles"



Color Marks

- Covidien LP v. Masimo Corp., 109 USPQ2d 1696 (TTAB 2014)
 - Use of Section 18 to partially cancel or restrict a registration of a color mark to a particular shade of that color





Flavor & Scent Marks

- In re Pohl-Boskamp GmbH & Co. KG,
106 USPQ2d 1042 (TTAB 2013)
 - Flavor and scent of peppermint for
“medicines, namely, pharmaceutical
formulations of nitroglycerin”



Flavor-Utilitarian Functional

- Peppermint flavor: Utilitarian functional?
 - Evidence: Study cited in third-party patent
 - Peppermint makes product work more effectively



Flavor & Scent-Failure to Function

- Flavor and scent of peppermint – source indicators or mere attributes?
- Evidence of acquired distinctiveness?



Flavor & Scent-Acquired Distinctiveness Evidence

- Length of time?
- Exclusivity?
- “Look for” advertising?
- Promotional expenditures in U.S.?
- Promotion related to the marks?
- Testimonials?



-



Title of Single Work/Name of Performer

- Additional samples of packaging:





Title of Single Work/Name of Performer

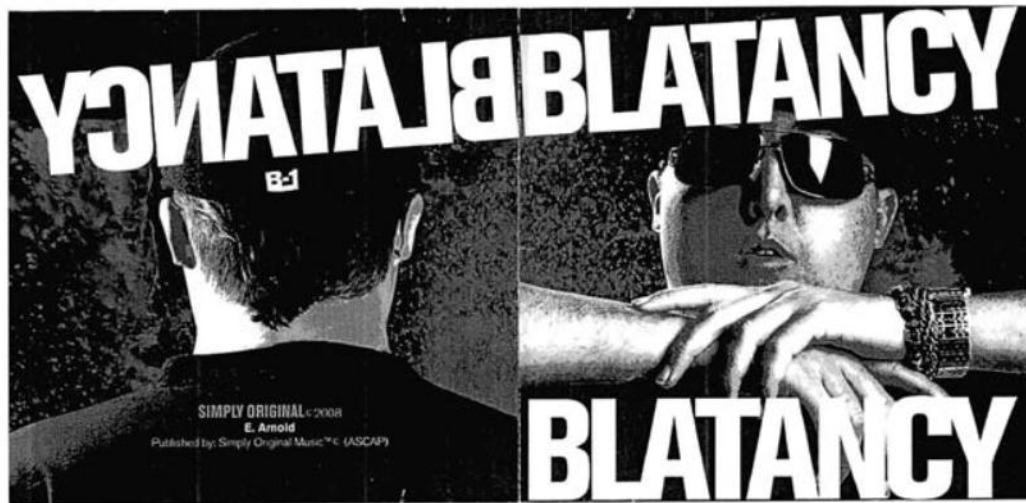
- Applicant also provided an additional CD





Title of Single Work/Name of Performer

- Additional usage



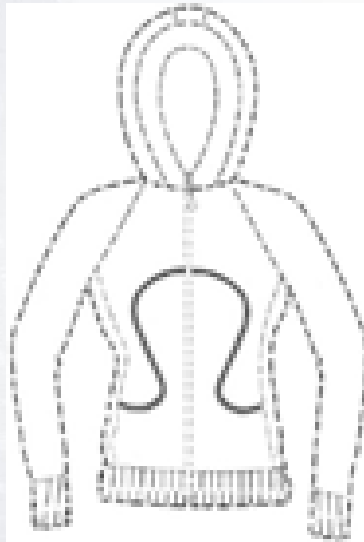


Title of Single Work/Name of Performer

- Use on two CDs - title of a single work?
- Name of artist, or source of services?
 - Who controls nature and quality of the goods and use of name?
 - Wide recognition?



Single Line Wave Design Merely Ornamental?





Effect of Size of Mark on Clothing?

- In re Lululemon Athletica Canada Inc., 105 USPQ2d 1684 (TTAB 2013)
 - Size of mark on clothing-just one consideration, no per se rule
 - Consumer perception
 - Evidence of secondary source



Failure to Function

- In re Hulting, 107 USPQ2d 1175 (TTAB 2013)





Ornamental?





Section 2(a)

- Scandalous or Immoral
- Disparagement
- False Suggestion of a Connection
- Deceptiveness



Scandalous or Immoral

- In re Star Belly Stitcher, Inc., 107 USPQ2d 2059 (TTAB 2013)
 - AWSHIT WORKS for baseball caps and other clothing items



Scandalous-Evidence

- Dictionaries including Urban Dictionary
- Newspaper articles & other media
- Recent Supreme Court decision
 - Use of "s***"



Disparagement

- In re Tam, 108 USPQ2d 1305 (TTAB 2013) (now on appeal)
 - THE SLANTS for “entertainment services in the nature of live performances by a musical band”



Disparagement Test

- Likely meaning?
- Disparaging to substantial composite?
 - In re Lebanese Arak Corp., 94 USPQ2d 1215, 1217 (TTAB 2010)



Disparagement - Evidence

- Dictionaries and reference works
- Wikipedia entry for applicant's band
- Online articles
- Objections from individuals and groups in Asian community



False Suggestion of Connection

- In re Pedersen, 109 USPQ2d 1185 (TTAB 2013)
 - LAKOTA for medicinal herbal remedies and preparations, and related goods
 - False suggestion of connection with Native American Lakota people?



False Suggestion of Connection-Test

- Same or close approximation?
- Uniquely and unmistakably points to that person or institution?
- No connection?
- Fame or reputation=Presumed connection?
 - » In re Jackson Int'l Trading Co., 103 USPQ2d 1417, 1419 (TTAB 2012)



False Suggestion of Connection

Evidence: Multiple dictionary definitions

Finding: Lakota identifies a person or institution



False Suggestion of Connection

- Is applicant connected to the Native American Lakota people?
- Fame or reputation of Lakota people?



In re AOP LLC, 107 USPQ2d 1644 (TTAB 2013)

- AOP for "wine"
- AOP = Appellation d'Origine Protegee
- Section 2(a) deceptive
- Four other refusals



In re AOP – Additional Refusals

- Section 2.61(b) information requirement
- Section 2(e)(1) descriptive/deceptively misdescriptive



In re AOP-Failure to Function





Section 2(b)-Government Seals

- Federal Circuit Affirms TTAB



- In re City of Houston and In re The Government of the District of Columbia, 108 USPQ2d 1226 (Fed. Cir. 2013)



ID/Classification

- In re Fiat Grp. Mktg. & Corporate Commc'ns S.p.A., 109 USPQ2d 1593 (TTAB 2014)
 - 66(a) application for FIAT 500



ID/Classification-In re Fiat

- Original ID-Class 35 heading:

“advertising services; business management; business administration; office functions”



In re Fiat

- Proposed amendment:

“advertising services; retail store and on-line retail store services featuring a wide variety of consumer goods of others”



In re Fiat

- “Ordinary Meaning” test
- VS.
- “Class heading covers all”



In re Fiat: Board Applies “Ordinary Meaning” Test

- “Retail store” language-within Class 35
- BUT beyond scope of original recitation
- EVEN THOUGH original recitation is identical to Class 35 class heading
- “Business management” ≠ “retail store”



Goods in Trade

- In re Thomas White Int'l Ltd., 106 USPQ2d 1158 (TTAB 2013)
 - Annual report=goods in trade or incidental to applicant's own business?



Specimens

- In re Gulf Coast Nutritionals, Inc., 106 USPQ2d 1243 (TTAB 2013)
 - PLAQUE-ZAPPER for edible pet treats





Specimens-Catalogs

- In re U.S. Tsubaki, Inc., 109 USPQ2d 2002 (TTAB 2014)
 - Catalog=proper specimen for the goods?
 - Statements from applicant's counsel?



Family of Marks

- In re Hitachi High-Technologies Corp.,
109 USPQ2d 1769 (TTAB 2014)
 - “Family of marks” not applicable in *ex parte* context



In re Hitachi

- BUT multiple registrations owned by one party may be useful under ninth *du Pont* factor
- Ninth *du Pont* factor = variety of goods on which a prior mark is used



Abandonment- TREASURYNET

- City National Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc., 106 USPQ2d 1668 (TTAB 2013)
 - Solely internal use ≠ use in commerce



The End!

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