

Summary Judgment at the TTAB: *Is It Worth Pursuing?*

by Christopher P. Foley

Failure to resolve cases that could be decided on summary judgment has important business ramifications. Sophisticated businesses select marks after carefully evaluating competing uses and registrations. Once the mark is selected and an application is filed, considerable time and investment are directed toward product development, beta testing and marketing. From an applicant's perspective, an unanticipated opposition puts that investment in jeopardy. Similarly, an application for a similar mark for related goods or services can encroach on the goodwill in another's mark and threaten to short-circuit that investment, justifying an opposition. If the only issue is the application of law to undisputed facts, then the case is ripe for summary judgment.

The Trademark Trial and Appeal Board (TTAB or Board) routinely acknowledges in every case involving a motion for summary judgment that Rule 56(c) of the Federal Rules of Civil Procedure provides an appropriate method for disposing of cases with no genuine issues of material fact in dispute. Meeting this standard at the Board, however, has proved particularly difficult in recent years. Consideration of successful cases and pitfalls faced by some litigants may help summary judgment become a more useful tool.

Seven years ago, an administrative law judge at the Board and two other authors reported that summary judgments were losing ground at the TTAB.¹ In evaluating TTAB decisions between 1998 and 2000, the authors found that three-quarters of such motions were denied.

The authors discovered that likelihood of confusion was a ground for seeking summary judgment in 55 percent of 205 motions considered, yet 75 percent of the motions based on likelihood of confusion were rejected.

Those authors concluded that the trend may have derived from a series of federal circuit decisions that reversed TTAB summary judgment determinations, particularly on claims of likelihood of confusion. The decisions represented a break from precedent, which touted the use of summary judgment as an expeditious vehicle for resolving TTAB cases.²

Recent TTAB cases suggest that the reluctance toward granting judgment has not changed. A review of 108 TTAB decisions involving motions for summary judgment published over a 14-month period beginning January 2006 reveals that 32 of the motions were granted in whole or in part.³ Of the 108 decisions involving summary judgment, likelihood of confusion was raised 55 percent of the time, the same figure as in the 1998–2000 study. In the cases in which motions were granted, likelihood of confusion was an issue half of the time. In 95 percent of those cases, the TTAB found a likelihood of confusion. Significantly, however, the TTAB still denied 75 percent of the cases based on this ground—the same percentage reported by the prior study.

The TTAB's reluctance toward granting summary judgment raises the questions of who pursues summary judgment, what motions are successful, why they are suc-

cessful, and whether there are frequent pitfalls faced by litigants seeking summary judgment. Sixty-four percent of recent motions for summary judgment were filed by opposers to a trademark application or petitioners seeking cancellation of a registration. Thirty-three percent of those motions were successful. Applicants in opposition proceedings and respondents in cancellation actions pursued summary judgment in only 36 percent of the cases in which summary judgment was raised, and their success rate was less than 25 percent.

Likelihood of confusion is raised more frequently than any other issue by parties seeking summary judgment before the TTAB.⁴ To prevail, however, § 2(d) of the Lanham Act generally requires the dominant portion of the marks to be identical, and evidence must clearly establish an overlap in goods or services, or both.

An example of a case in which an opposer was successful on summary judgment is *Venture Out Properties LLC v. Wynn Resorts Holding, LLC*,⁵ which involved Wynn's applications to register a CABANA BAR & CASINO in a standard character form and a word form for "casino services," as well as applications to register CABANA BAR for "restaurant bar and cocktail lounge services." Opposer, Venture Out Properties, offered evidence that it provided "hotel services" predating Wynn's date of first use—the date applicant's hotel offering casino services opened. In evaluating the similarity of the marks, the TTAB emphasized that the involved marks "share and stress" the same term—namely CABANA—and that

the other terms are generic. While opposer's hotel was in Hawaii, where gambling is illegal, the TTAB emphasized that there was substantial evidence of record, through third-party uses and registrations, of a relationship between opposer's hotel services and applicant's services. The TTAB also referred to earlier decisions finding hotel and restaurant services to be related. Accordingly, the TTAB found the services to be closely related and granted opposer's motion.

In *Concord Apparel LLC v. International Mark Management SA*,⁶ involving Registration No. 2,378,903 covering various clothing items for a design featuring a stylized "Z" and the term ZAGATO, petitioner moved for summary judgment on the ground of likelihood of confusion based on its prior use and registration of ZAGATO for overlapping apparel. While respondent asserted that the configuration of the "Z" for both marks was visually dissimilar, the TTAB was compelled by the distinctiveness of the dominant literal terms, which were identical.

*Dole Fresh Fruit Co. v. Economy Cash & Carry LP*⁷ was an opposition proceeding involving an application for the mark TROPICAL GOLD for "nonalcoholic beverages, namely, noncarbonated flavored drinks and fruit juice." Dole Fresh Fruit Company, the opposer, cited prior use and registration of the identical mark for fresh fruit. Opposer also submitted a declaration identifying the use by many companies, including Ocean Spray, Sunkist and Tropicana, which sold fresh fruit and fruit juices under the same marks. In light of this evidence, the TTAB concluded that purchasers would likely assume that applicant's and opposer's goods came from the same source.

A registration for the IMPERIAL mark for "paper products . . ." was cancelled on summary judgment on the basis of uncontroverted evidence of use of the same mark for the same types of products offered in the same channels of trade. *Sysco Corp. v. Princess Paper Inc.*⁸ Similarly, Chemical Financial Corporation succeeded on summary judgment in

opposing an application to register CHEMICAL BANK for banking and financial services. *Chemical Financial Corp. v. 200 Kelsey Associates*.⁹ In that case, opposer submitted extensive evidence that it used the mark CHEMICAL BANK as a trademark and commercial name for its subsidiaries for more than 100. In granting summary judgment, the TTAB concluded that identical marks and virtually identical services can create a likelihood of confusion even among sophisticated customers in the banking field.

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Where the difference in the marks is one word versus two or singular versus plural, the TTAB has found when the marks are viewed in their entireties, no issue of material fact regarding similarity in sound, appearance and commercial impression. See, e.g., *Fram Trak Industries v. WireTracks LLC*¹⁰ (a cancellation action between WIRE TRAK versus WIRETRACKS for electrical, telephone and signal wires); *Acosta v. Barmar LLC*¹¹ (another cancellation action between the marks LAS PALAPAS and LAS PALAPA for restaurant services).

Well-known marks apparently receive greater latitude in obtaining summary judgment on a § 2(d) claim. For example, in *Warner Bros. Entertainment Inc. v. Los*

Primos Productions,¹² the TTAB held that applicant's use of the name HARRY POTHEAD in an animated production as a prominent means to poke fun at something was not a parody or fair use of the popular HARRY POTTER name. Accordingly, summary judgment was granted despite the obvious difference in connotation and appearance. In *Amazon.com Inc. v. Von Eric Lerner Kalaydjian*,¹³ the TTAB held that COSMETICSAMAZON for retail-store and online ordering services for skin-tanning services and various lotions was likely to be confused with AMAZON.COM for soaps, perfumery and cosmetics. In granting summary judgment, the TTAB concluded that consumers would view AMAZON as the source-identifying element and discount the generic word COSMETICS. Further, in *Hearst Communications Inc. v. TVNESS LLC*,¹⁴ the TTAB was presented with an application to register COSMO PARTY. The application was opposed on the basis of the COSMOPOLITAN mark owned by Hearst Communications Inc., and opposer's family of COSMO marks, including COSMO GIRL and COSMO QUIZ. In this case, opposer's activities related to magazines and collateral goods, whereas applicant's sought to register the COSMO PARTY mark in connection with an Internet-dating Web site, among other things, and certain entertainment services. The TTAB sustained the opposition on likelihood of confusion.

Despite commonality in goods or services, questions regarding the similarity in appearance, sound and connotation in marks can avoid summary judgment. Cases include the following marks: RESVIS XR v. RESIVIT,¹⁵ CHARLOTTE v. CHARLOTTE TILBURY,¹⁶ MILK DUDS v. MILKDUDZ—NOT YOUR MOMMAZ NURSING WEAR,¹⁷ CHARLOTTE v. CHARLOTTE RONSON,¹⁸ WRITEABOUT and WRITE@BOUT v. WRITE!,¹⁹ TWENTY BENCH v. TWENTY ROWS,²⁰ BIG O, BIG FOOT and BIG v. BIG HOSS,²¹ HOME OF THE NO JOB LOAN v. HOME OF THE COST LOAN,²² STUDIO v. STUDIO SERIES,²³ IMMUNOTECH IMMUNOCALL v. IMMUNOCELL,²⁴ BONGOS CUBAN

CAFE v. COCO BONGO HOUSE OF ROCK & POP,²⁵ and LEDISON v. EDISON.²⁶

Marks may be substantially identical, but factual disputes over the relatedness of goods and services can preclude summary judgment. In *Casper's Ice Cream v. Corn Products International Inc.*,²⁷ applicant sought to register the mark CASCO for unmodified corn starch used as an ingredient in various food products and was opposed by opposer's registration and longstanding use of CASCO for confections. The Board denied applicant's motion for summary judgment, finding genuine issues of material fact regarding the overlap of purchasers, trade channels, marketing environments and strength of mark. See also *L.C. Licensing Inc. v. Cory Berman*²⁸ (ENYCE for automatic accessories versus ENYCE, ENYCE and design, and LADY ENYCE for men's, women's and children's apparel); *Nanogen Inc. v. Pharmwest Inc.*²⁹ (NANOGEN for cosmetics and nonmedicated skin and hair preparations versus NANOGEN for medical reagents and assays); and *Centex Homes v. Citihomes Realty Corp.*³⁰ (CITIHOMES for real estate brokerage services versus CITYHOMES residential home construction and real estate development).

The TTAB will not grant summary judgment based on likelihood of confusion if it detects issues on the distinctiveness and strength of the nonmovant's mark. In *Delegats Wine Estate Limited v. The Fresh Oyster LLC*,³¹ applicant filed an application to register THE FRESH OYSTER for wines and was opposed on the basis of opposer's use and registration of OYSTER BAY and design for wines. The Board denied applicant's motion because it found genuine issues on whether Oyster Bay was a known geographic location, whether the location was associated with wine, and whether the location would be material to a consumer's purchase. See also *Health Venture Partners v. Meta Balance, Inc.*³² (NATURE'S LABEL versus NATURE'S CODE for related goods, namely vitamins); and *Mrs. United States National Pageant Inc. v. Richardson*³³ (MRS. U.S. INTERNATIONAL v. MRS.

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But the Board will grant summary judgment of no likelihood of confusion where the evidence shows a distinct difference in sound, appearance, connotation and commercial impression. *Inspiration Software Inc. v. Teachers Inspired Practical Stuff Inc.*³⁴ In this case, applicant filed an application to register the mark T.I.P.S.—TEACHER INSPIRED PRACTICAL STUFF for course material for elementary school children. Inspiration Software Inc. opposed, asserting its registration INSPIRATION for computer programs in the field of idea development. The Board, in granting applicant's motion, cited the different visual appearance and sound of the two marks and the lack of common terms to offset those differences. Some pitfalls were observed in recent summary judgment proceedings. One of the most common is pursuing summary judgment on an unpleaded issue. Under § 528.07(a) of the Trademark Trial & Appeal Board Manual of Procedures (TBMP), a party may not obtain summary judgment on an issue that has not been pleaded. This rule is frequently overlooked by litigants, causing many motions to be denied that otherwise might have had merit. For example, in *Hurley*

International LLC v. Volta,³⁵ opposer filed an initial motion for summary judgment based on a claim of fraud. The TTAB, however, held that the fraud claim had not been properly pleaded in the notice of opposition. Similarly, in *Kidsart Inc. v. Kidzart Texas LLC*,³⁶ opposer argued that "if its mark is generic or nondistinctive, so too is applicant's mark." The notice of opposition did not include this allegation. While opposer's motion was granted, the TTAB instructed opposer to file an amended notice of opposition, if it intended to press its claim regarding the generic nature or nondistinctiveness of applicant's mark.

In another situation, a petitioner in a cancellation action sought summary judgment on a claim of likelihood of confusion with respect to a family of marks. *Orozco et al. v. Hwang*.³⁷ Two of the marks argued in petitioner's brief in support of the motion were not pleaded in the petition to cancel. Accordingly, the TTAB held that the petitioner could not obtain summary judgment on a claim of likelihood of confusion with respect to those marks.

As noted in *Kidsart Inc.*, when a party desires to pursue summary judgment on an unpleaded ground, the appropriate procedure is to move to amend the notice of opposition or petition to cancel. TBMP, § 528.07(a). In *Hurley International*, after the TTAB denied its initial motion, the opposer filed a combined motion to amend its notice of opposition and a motion for summary judgment. Despite claims of prejudice by the applicant, the TTAB held that leave to amend should be freely given, citing Fed. R. Civ. P. 15(a) and TBMP § 507.02. See also *Asics Corp. v. Paragon Development Corp.*,³⁸ *Drive Trademark Holdings v. Inofin*,³⁹ and *Florida Engineered Construction Products Corp. v. Cast-Crete Inc.*⁴⁰

Summary judgment motions frequently are denied as untimely. TBMP § 504.01 explains that the testimony periods in an *inter partes* proceeding before the TTAB corresponds to the trial phase in a court proceeding. Therefore, to be timely, a motion for summary judgment must be

filed before the opening of the first testimony period.

Parties often fail to respond to discovery, including requests for admissions, only to have that oversight be deemed an admission on summary judgment. In *Hearst Communications*,⁴¹ *supra*, applicant failed to respond to 116 requests for admission relating to priority, fame, distinctiveness and confusing similarity. As a result of this failure, opposer filed a motion for summary judgment asserting that applicant's failure to respond was an admission. Applicant ignored the ramifications for not responding and all 116 requests were held to be admitted.⁴²

In *Florida Engineered Construction Products Corporation*,⁴³ opposer served requests for admissions regarding, among other things, likelihood of confusion. Applicant failed to respond to the requests, and opposer moved the TTAB to deem the requests admitted. The motion was granted. On summary judgment, the TTAB did not consider applicant's arguments on likelihood of confusion. The Board found that the admissions demonstrated no genuine issue of material fact with respect to opposer's 2(d) claim. Thus, requests for admission are a very useful tool for parties seeking summary dismissal of a case.

Parties commonly introduce arguments during briefing that are not supported in the record. Facts must be in evidence to be considered by the Board. In *International Flora Technologies v. Desert Whale Jojoba Co.*,⁴⁴ petitioner failed to introduce any evidence during its assigned testimony period. Instead, petitioner attached various exhibits to its main brief, including copies of its pleaded registrations. Not surprisingly, the Board deemed petitioner's tactic a request to take judicial notice of the registrations.

Finally, the Board will not resolve issues of fact against a nonmoving party. *Gamers Inc. v. Game-Expert Inc.*⁴⁵ In pursuing summary judgment, movants must rely on uncontroverted evidence in the record to prevail. *Hoganas AB v. Konica Minolta*



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*Printing Solutions USA Inc.*⁴⁶ Therefore, in preparing declarations and supporting exhibits, litigants must avoid facts for which the nonmoving party has contradictory evidence, but litigants must recognize that expressing disagreement with the facts does not by itself raise a genuine issue. *Id.*, citing the Federal Circuit in *Otocom Systems Inc. v. Houston Computer Services Inc.*⁴⁷

While statistical analysis might suggest reluctance by the Board to grant summary judgment, the details of cases involving such motions indicate that litigants can do a much better job presenting the Board with sustainable motions. With closer attention given to the marks at issue and the rules of practice, the percentage of granted motions should increase. Therefore, summary judgment remains a viable strategic alternative, particularly for a litigant who is mindful of the rules and is careful to rely on facts not in dispute. ♪

Endnotes:

- 1 Linda K. McLeod, Erin M. Falk & May F. Walters "Summary Judgment Is Losing Ground Before Panel," *Nat'l L.J.*, May 1, 2000, at c6. Linda K. McLeod is a former administrative law judge and currently is of counsel at Finnegan Henderson.
- 2 In the fall 2006 meeting of the Virginia State Bar Intellectual Property Section, Administrative Trademark Judge Gerard F. Rogers acknowledged the effect of the Federal Circuit decisions on summary judgment determinations by the board. Gerald F. Rogers, Administrative Trademark Judge, Address at the Meeting of the Virginia State Bar Intellectual Property Section, *Prosecuting and Defending Opposition and Cancellation Actions Before The Trademark Trial and Appeal Board* (Oct. 6, 2006).
- 3 The summary judgment decisions were identified through analysis of the Westlaw database. The author wishes to acknowledge the assistance of Dr. Marcus Luepke, a member of Finnegan Henderson's Trademark and Copyright Practice Group, in providing invaluable research in support of this article.

- 4 Priority and standing follow likelihood of confusion in terms of the frequency of issues raised in motions for summary judgment. No other issues are presented with any regularity.
- 5 Opposition Nos. 91167237, 91167238, 9116752 and 91168647, 2007 WL 39112 (TTAB Jan. 3, 2007).
- 6 Cancellation No. 92044693, 2006 WL 2558350 (TTAB Aug. 22, 2006).
- 7 Opposition No. 91164233, 2006 WL 2927867 (TTAB Sept. 28, 2006).
- 8 Cancellation No. 92042937, 2006 WL 752426 (TTAB Mar. 22, 2006).
- 9 Opposition No. 91163169, 2006 WL 717523 (TTAB Mar. 6, 2006).
- 10 77 U.S.P.Q.2d 2000 (TTAB Jan. 23, 2000).
- 11 Cancellation No. 92043837, 2006 WL 3540109 (TTAB Nov. 30, 2006).
- 12 Opposition No. 91156299, 2006 WL 2850871 (TTAB Sept. 13, 2006).
- 13 Opposition No. 91122000, 2006 WL 2860228 (TTAB Sept. 22, 2006).
- 14 Opposition No. 91162261, 2007 WL 616038 (TTAB Feb. 20, 2007).
- 15 *Biofutura Pharma v. Day Corp.*, Opposition No. 91169267, 2006 WL 3736516 (TTAB Dec. 12, 2006).
- 16 *GMA Accessories v. Charlotte Tilbury Ltd.*, Opposition No. 91171089, 2006 WL 3776384 (TTAB Dec. 8, 2006).
- 17 *Hershey Chocolate & Confectionary Corp. v. Wall*, Opposition No. 91166974, 2006 WL 3776385 (TTAB Dec. 6, 2006).
- 18 *GMA Accessories, Inc. v. Sanei Charlotte Ronson, LLC et al*, Opposition No. 91167353; 91168148 & 91172117, 2006 WL 3337623 (TTAB Nov. 6, 2006).
- 19 *Curriculum Associates, Inc. v. Scholastic, Inc.*, Opposition No. 91166288, 2006 WL 3043977 (TTAB Oct. 20, 2006).
- 20 *Unfiltered Napa LLC v. Twenty Rows LLC*, Opposition No. 91168224, 2006 WL 2804131 (TTAB Sept. 26, 2006).
- 21 *Big O Tires Inc. v. Gale Banks Engineering*, Opposition No. 91169596, 2006 WL 2513919 (TTAB Aug. 16, 2006).
- 22 *Alpine Mortgage Corp. v. The Mortgage Department*, Opposition No. 91166379, 2006 WL 2401271 (TTAB Aug. 14, 2006).
- 23 *Gibson Guitar v. First Act, Inc.*, Opposition Nos. 91162183 & 91163660, 2006 WL 1864809 (TTAB June 30, 2006).
- 24 *Immunotech Research v. Rath*, Opposition No. 91162850, 2006 WL 1488837 (TTAB May 25, 2006).

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- 25 *Estefan Enterprises v. Robert Noble and Bongo, S.A.*, Opposition No. 91121980 & Cancellation No. 92042251, 2006 WL 690684 (TTAB Mar. 14, 2006).
- 26 *Cooper Industries, LLC v. Mule Lighting, Inc.*, Cancellation No. 92042545, 2006 WL 148628 (TTAB Jan. 13, 2006).
- 27 Opposition No. 91159086, 2006 WL 332549 (TTAB Feb. 8, 2006).
- 28 Opposition No. 91162330, 2006 WL 983337 (TTAB Apr. 11, 2006).
- 29 Opposition No. 91167477, 2006 WL 1355819 (TTAB May 15, 2006).
- 30 Opposition No. 91161887, 2006 WL 1876344 (TTAB July 3, 2006).
- 31 Opposition No. 91164955, 2007 WL 745238 (TTAB Feb. 28, 2007).
- 32 Opposition No. 91159353, 2006 WL 1931866 (TTAB July 10, 2006).
- 33 Opposition No. 91165290, 2007 WL 745240 (TTAB Feb. 28, 2007).
- 34 Opposition No. 91164083, 2007 WL 760522 (TTAB Mar. 7, 2006).
- 35 Opposition No. 91158304, 2007 WL 196407 (TTAB Jan. 23, 2007).
- 36 Opposition No. 91166639 & Cancellation No. 92045114, 2006 WL 2007542 (TTAB July 13, 2006).
- 37 Cancellation No. 92043811, 2006 WL 2482428 (TTAB Aug. 22, 2006).
- 38 Opposition No. 91160352, 2007 WL 775578 (TTAB Feb. 28, 2007).
- 39 Opposition No. 91168402, 2007 WL 616039 (TTAB Feb. 22, 2007).
- 40 Opposition No. 91159554, 2006 WL 1087855 (TTAB Apr. 13, 2006).
- 41 *See Supra* at note 14.
- 42 Rule 36(b) permits a motion to amend or withdraw admissions. In *Work 'n Gear, LLC v. Work-N-Wear, Inc.*, Opposition No. 91165686, 2006 WL 833977 (TTAB Mar. 26, 2006), the TTAB considered applicant's response to a motion for summary judgment, together with applicant's cross-motion for summary judgment, to be effectively a motion to withdraw.
- 43 *See Supra* at note 40.
- 44 Cancellation No. 92045643, 2006 WL 3192313 (TTAB Oct. 25, 2006).
- 45 Opposition No. 91164969, 2007 WL 745241 (TTAB Feb. 27, 2007).
- 46 Opposition No. 91168421, 2006 WL 3825182 (TTAB December 18, 2006).
- 47 918 F.2d 937, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990).