

THIS DISPOSITION  
IS NOT CITABLE AS  
PRECEDENT  
OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

KSK

Mailed: January 7, 2003

Opposition No. 122,612

Westheimer Corporation

v.

Noriyuki Yusa

Before Quinn, Bucher and Bottorff, Administrative  
Trademark Judges.

By the Board:

This case now comes before the Board for  
consideration of applicant's motion (filed July 24, 2002)  
for summary judgment on the issue of priority with regard  
to opposer's claim of likelihood of confusion under  
Section 2(d) of the Trademark Act. The motion has been  
fully briefed.

**BACKGROUND/PLEADINGS**

Applicant has filed an application for registration  
of the mark shown below for "guitars" in Class 15.<sup>1</sup>

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<sup>1</sup> Application Serial No. 75/439,289 filed on February 23, 1998  
and claiming a bona fide intent to use the mark in commerce.



In its notice of opposition, opposer alleges, inter alia, that "on February 23, 1998, [a]pplicant filed Application Serial No. 75/439289 to register the word mark and logo MOSRITE in International Class 015 for guitars...applicant had applied to register for a mark which was owned by a previous individual, to wit, Semie Moseley (Reg. No. 1155520, cancelled March 24, 2000)...opposer submitted an application on or about October 21, 2000 to register the mark MOSRITE...for use in connection with...acoustic and electric guitars...the date of first use in commerce claimed by the opposer in the MOSRITE application is September 21, 2000...[and] applicant's claimed MOSRITE mark is identical to opposer's mark and the goods of the respective parties so related as to be likely to cause confusion or mistake."

Applicant denied the salient allegations in its answer.

**SUMMARY JUDGMENT STANDARD**

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA,*

**Opposition No. 113,802**

*Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

**THE PARTIES' EVIDENCE AND ARGUMENTS**

Applicant has moved for summary judgment in its favor on the issue of priority.

In support of its motion, applicant has presented evidence showing that opposer did not use the mark prior to September 21, 2000 (Exh. E, Opposer's Response to Applicant's First Request for Admissions; Exh. D, Opposer's Response To Applicant's First Set of Interrogatories).

Applicant's evidence on summary judgment includes the declaration of Robert Alpert, applicant's outside counsel with the law firm of Ladas & Parry, together with the exhibits identified therein.

In response, opposer has submitted the "affirmation" of Ronald S. Bienstock, opposer's outside counsel with the law firm of Bienstock & Michael, P.C.

Applicant argues that no genuine issue as to any material fact concerning priority exists inasmuch as applicant's filing date is February 23, 1998 and opposer alleges in its notice of opposition and expressly admits

**Opposition No. 113,802**

in its response to applicant's request for admissions that it first used the mark on September 21, 2000. Therefore, applicant argues, opposer lacks standing to pursue this opposition.

In response, opposer states that discovery opened on May 22, 2001 however opposer "has not had an opportunity to serve its discovery requests...[c]onsequently, opposer has not been able to obtain a significant portion of the facts relevant to this proceeding from applicant." Opposer argues that "there are several current issues of fact and prospective issues of fact which opposer has yet to learn via discovery which may warrant this court to rule that due to equitable considerations priority must be determined in favor of opposer" and "[i]f the facts reveal that applicant applied for the mark without a genuine intention on using the mark in interstate commerce, equity may require this court to rule for priority in favor of opposer." Further, opposer submits that "there are many different facts that opposer has not yet discovered that, when revealed to this court, would mandate a ruling that opposer has superior rights to the trademark notwithstanding applicant's calendar priority. Opposer argues that "the law clearly states that calendar priority is not always dispositive, and summary judgment

**Opposition No. 113,802**

is not appropriate when equitable considerations may exist which can give opposer priority."

In reply, applicant states that opposer has had over a year to take discovery but chose not to do so. Further, applicant argues that opposer's counsel does not allege that applicant adopted the mark in bad faith, but merely states that applicant might have done so.

**DECISION**

After a careful review of the record in this case, we find that there are no genuine issues of material fact relating to the issue of priority and that applicant is entitled to judgment as a matter of law.

It is well settled that Section 7(c) of the Trademark Act provides an intent-to-use applicant with superior rights over anyone adopting a mark after applicant's filing date, contingent upon applicant's ultimate registration of the mark. *Zirco Corporation v. American Telephone and Telegraph Company*, 21 USPQ2d 1542 (TTAB 1991).

With regard to opposer's arguments concerning any possible bad faith in adoption of the mark or lack of a bona fide intent-to-use, these allegations were not pleaded and, therefore, no consideration will be given to arguments regarding these unpleaded issues. See Fed. R.

**Opposition No. 113,802**

Civ. P. 56(a) and 56(b); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994). Moreover, opposer has had more than ample time to take discovery in order to explore a possible claim on these issues yet has chosen not to do so. The question of when summary judgment can be granted in the absence of discovery has been addressed by the Federal Circuit many times. See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 627, 222 USPQ 741, 744 (Fed.Cir.1984); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed.Cir.1989) (citations omitted). As stated in *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.* summary judgment need not be denied merely to satisfy a litigant's speculative hope of finding some evidence [through discovery] that might tend to support a complaint. *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1567; 4 USPQ2d 1793, 1799 (Fed. Cir. 1987).

It appears that opposer would have us infer bad faith because of applicant's possible awareness of a third-party's prior use of the mark. However, an inference of "bad faith" requires something more than mere knowledge of a prior similar mark. See *Sweats*

**Opposition No. 113,802**

*Fashions, Inc. v. Pannill Knitting Co., Inc., supra.* Not only has opposer failed to demonstrate more than a "speculative hope" of finding evidence to support a possible claim of bad faith or lack of bona fide intent, it has also failed to avail itself of the protection of Fed. R. Civ. P. 56(f) by not filing an affidavit explaining why it could not respond to the summary judgment motion without discovery.

The evidence of record clearly establishes the lack of a genuine issue of material fact as to the issue of priority. Thus, for purposes of this opposition, applicant has established priority and is entitled to summary judgment in its favor.

**Opposition No. 113,802**

Accordingly, applicant's motion for summary judgment on the issue of priority under Section 2(d) of the Trademark Act is granted and judgment in favor of applicant is hereby entered, subject to applicant's establishment of constructive use.<sup>2</sup> The time for filing an appeal or for commencing a civil action will run from the date of the present decision. See Trademark Rules 2.129(d) and 2.145. When applicant's mark has been registered or the application becomes abandoned, applicant should inform the Board, so that appropriate action may be taken to terminate this proceeding.

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<sup>2</sup> In view of the above, applicant's motions to extend the discovery period and to extend its time to serve discovery responses on opposer are moot. We note, however, with regard to the motion to extend applicant's time to respond to opposer's discovery requests, opposer did not serve those requests until September 13, 2002, two months after applicant filed his summary judgment motion and seventeen days prior to the Board's October 1, 2002 order suspending proceedings. In view of the filing of the summary judgment motion and the subsequent suspension of proceedings prior to any possible due date, applicant was under no obligation to serve responses prior to the Board's decision on its summary judgment motion.