

**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

8/31/00

wellington

Cancellation No. 27,897

Tri-Star Apparel, Inc.

v.

Dan Dunn Associates,

Inc.

Before Cissel, Bucher, and Holtzman Administrative  
Trademark Judges.

By the Board:

This case now comes up on respondent's motion for  
summary judgment (filed July 19, 1999).

Tri-Star Apparel, Inc. has petitioned to cancel  
Registration No. 1,672,174 owned by Dan Dunn Associates,  
Inc. ("respondent"), for the mark ON BOARD for "retail  
clothing store services."<sup>1</sup> Petitioner alleges that it

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<sup>1</sup> Registration No. 1,672,174 issued to Elizabeth Dunn and Dennis  
Danner on January 14, 1992 and claims date of first use and  
first use in commerce of May 22, 1989. The entire interest and  
goodwill in the registration was assigned to Dan Dunn  
Associates, Inc. (recorded with the Assignment Division of the

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owns application Serial No. 75/276,569 for ON BOARD for "men's and boys clothing."<sup>2</sup> Petitioner alleges that its application for the mark ON BOARD has been refused registration under Section 2(d) of the Trademark Act in view of respondent's registration.

Petitioner claims that "registrant has abandoned said registered mark by discontinuing use of said mark with no intent to resume said use." Petitioner further alleges that "Petitioner is likely to be damaged by continuance on the register of said registration...."

On December 4, 1998, respondent filed an answer which denies the salient allegations of the petition to cancel.

As mentioned above, respondent filed its motion for summary judgment on July 19, 1999.

The motion has been fully briefed and the Board has carefully considered the parties' arguments and submissions.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues

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Trademark Office on January 29, 1990 at Reel/Frame No. 0689/0607).

<sup>2</sup> Office records indicate that the identification of goods for application Serial No. 75/276,569 is "imprinted T-shirts and

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of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In support of its motion for summary judgment, respondent argues that it "has never discontinued its use [of] the mark...," but rather that "uncontroverted evidence establishes that Dan Dunn has operated retail stores using the ON BOARD mark continuously since at least 1992." Respondent has attached, as Exhibit 1 to its

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caps." Application Serial No. 75/276,569 was filed on April 17, 1997 under Section 1(b) ("intent to use") of the Trademark Act.

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motion, its Declaration Under Sections 8 and 15 (filed with the Trademark Office on July 19, 1999) wherein respondent declares that its mark "has been in continuous use by Registrant in interstate commerce for five (5) consecutive years from the date of registration to the present, on all the services recited in the registration; that said mark is still in use on the services in interstate commerce as evidenced by the attached specimen showing the mark as currently used..." (with attached specimen evidencing use of said mark). Respondent has attached, as Exhibit 2 to its motion, a copy of a report identified by petitioner in its responses to respondent's interrogatories as an "industrial investigation report" executed by Mr. Seymour Adler and dated "May 6, 7, 1998." In this report, Mr. Adler states that he was able to locate two "On Board" retail clothing stores in California owned by respondent.<sup>3</sup>

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<sup>3</sup> In further support of its motion for summary judgment, respondent attached a copy of its first set of requests for admissions served on petitioner and requested that they be deemed admitted pursuant to Fed. R. Civ. P. 36(a) because of petitioner's failure to file answers to the requests for admissions. On August 2, 1999, petitioner filed a motion to make of record petitioner's responses to respondent's first set of requests for admissions. Petitioner stated that it did not receive a copy of said requests for admissions. Petitioner's motion is hereby granted inasmuch the requests for admissions shall not be deemed admitted.

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In response to respondent's motion for summary judgment, petitioner argued that a "threshold issue is whether registrant, possibly at the time of filing of the application resulting in registration in issue and certainly at the time of filing Sec. 8 and 15 affidavits, misrepresented to the PTO that the mark was used in interstate commerce."<sup>4</sup> Specifically, petitioner argues that the specimen showing use of the mark ON BOARD which was submitted with the Section 8 and 15 affidavit identifies only one store location and petitioner argues that this "indicates that Registrant did not make 'use in commerce' as defined in TMEP 1201.01..." Petitioner's allegation that respondent's use of the ON BOARD does not amount to use in interstate commerce was not pleaded in the petition to cancel. A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. See *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) and *Perma*

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<sup>4</sup> In response to respondent's motion for summary judgment, petitioner initially filed (on July 26, 1999) a motion to dismiss registrant's motion for summary judgment as untimely filed. On August 16, 1999, the Board denied petitioner's motion to dismiss respondent's motion for summary judgment and suspended proceedings pending the disposition of the motion for summary judgment.

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*Ceram Enterprises, Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992). See also TBMP §528.07(a) and authorities cited therein. In view thereof, the Board will not consider petitioner's claim regarding respondent's use of the mark in interstate commerce.

After reviewing the arguments and supporting evidence of the parties, the Board finds that respondent has met its burden of establishing that no genuine issues of material fact exists and has demonstrated that it is entitled to judgment as a matter of law. Specifically, respondent has provided evidence establishing that it has not abandoned its mark ON BOARD and continues to use said mark in commerce. Petitioner has not submitted any evidence to the contrary.

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Accordingly, judgment is entered against petitioner and the petition to cancel is dismissed with prejudice.

Robert F. Cissel

David E. Bucher

Terry E. Holtzman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board