

03/13/01

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

GDH/gdh

U.S. PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Cancellation No. 29,311

Island Seafood & Trading
Company, Inc.

v.

Pedro Alvarez

Before Hohein, Hairston and Drost, Administrative Trademark
Judges.

By the Board:

Island Seafood & Trading Company, Inc. has filed an
amended petition to cancel the registration which is presently
owned, according to the Assignment Division records of the United
States Patent and Trademark Office, by Pedro Alvarez for the mark
"NATIVE SEAFOOD & TRADING CO" and design, as reproduced below,



Cancellation No. 29,311

for "retail store and wholesale distributorship services in the field of seafood products and restaurant services."¹

As grounds for cancellation, petitioner alleges that it "provides restaurant services under the mark *Native Seafood & Trading Company* and design and has done so since at least as early as November 25, 1995"; that, upon information and belief, use of the mark which is the subject of respondent's involved registration "has been abandoned by the owner with no intent to resume use"; that the assignor of the involved registration "has declared bankruptcy and is [no] longer in business"; that while the involved registration "has been assigned out of bankruptcy to the current Registrant[,] Pedro Alvarez," the "Trustee's Bill of Sale is defective in that it is an assignment in gross"; and that, accordingly, such registration "is invalid and should be canceled."

Respondent, in his answer, has admitted the allegation that petitioner "provides restaurant services under the mark *Native Seafood & Trading Company* and design and has done so since at least as early as November 25, 1995." Respondent also admits therein that "the Trustee's Bill of Sale is defective in that it is an assignment in gross" and that "a putative assignor of Reg. No. 1,774,541 filed a Chapter 7 petition in bankruptcy and is no longer in business." Respondent, however, has denied the remaining salient allegations of the petition to cancel and has

¹ Reg. No. 1,774,541, issued on June 1, 1993 from an application filed on July 6, 1992, which sets forth dates of first use of July 1989; combined affidavit §§8 and 15. The terms "SEAFOOD" and "TRADING CO" are disclaimed.

asserted, as an "affirmative defense," that petitioner "uses the subject mark by virtue of a license granted by Registrant."

This case now comes up on petitioner's contested motion, filed on January 31, 2000 as a motion for judgment on the pleadings, which was construed by the Board, in an order issued on June 15, 2000, as one for summary judgment "[b]ecause matters outside the pleadings have been referenced by the parties."² As grounds for summary judgment in its favor, petitioner argues that the undisputed facts in this proceeding, as revealed in the pleadings, "establish that the assignor of Registration No. 1,774,541 declared bankruptcy"; that such assignor is no longer in business; that the involved registration "has been assigned out of bankruptcy to the current registrant[,] Pedro Alvarez; and that the "Trustee's Bill of Sale is defective in that it is an assignment in gross" which was made without an accompanying assignment of the goodwill appurtenant to the mark. Petitioner consequently maintains that in view of the assignment in gross,

² In consequence thereof, the Board allowed petitioner until July 17, 2000 "to submit any additional material in support of its motion for summary judgment" and permitted respondent until August 16, 2000 "to submit any responsive material." Petitioner, by a certificate of mailing dated July 13, 2000, responded by essentially re-styling and re-filing its original motion as a motion for summary judgment, noting therein that because respondent admitted in his answer that the assignment to him of the involved registration was defective as an assignment in gross and hence, as a matter of law, was invalid, the Board "need not entertain any additional facts." Respondent, in its timely response filed on August 14, 2000, submitted additional evidence in opposition to petitioner's original motion and also moved "to strike Petitioner's second motion for summary judgment served July 13 2000" on the basis that such motion "is redundant." Inasmuch as the motion to strike is not only uncontested, but in any event is also well taken, petitioner's July 13, 2000 motion for summary judgment is hereby stricken as duplicative.

the registration is invalid as a matter of law and thus must be canceled.

Respondent, in opposition to the summary judgment motion, has submitted evidence consisting of his declaration and supporting documentary exhibits. Among other things, Mr. Alvarez states, on the basis of his "own personal knowledge" that:

2. I am the registrant of the mark "NATIVE SEAFOOD & TRADING CO AND DESIGN," Registration No. 1,774,541.

....

4. On or about February 6, 1991 I was instrumental in incorporating here in Florida a company known as Native Seafood & Trading Co., Inc.

5. Subsequently, I caused Native Seafood & Trading Co., Inc. to file an application to register the mark "NATIVE SEAFOOD & TRADING CO AND DESIGN" as a service mark on July 6, 1992, which application subsequently matured into Registration No. 1,774,541, which is the subject of the ... cancellation proceeding.

6. After that ... application was filed, I was instrumental in setting up another Florida corporation known as Native Seafood, Inc., which was incorporated on or about July 16, 1992 (10 days after said registration issued).

7. The second company, Native Seafood, Inc., was then licensed by Native Seafood & Trading Co., Inc. to use the trademark "NATIVE SEAFOOD & TRADING CO AND DESIGN" in its business.

8. Thereafter, the licensee, Native Seafood, Inc., filed a Chapter 7 petition in bankruptcy, and the ... registration was inadvertently and erroneously listed as one of the assets of that corporation.

9. Since I desired to continue using the mark, I subsequently made arrangements to

purchase the registration from the bankruptcy Trustee for a nominal sum, erroneously thinking that the Trustee had title to the registration.

10. The assignment (the "Bill of Sale" attached hereto) that I received for the bankruptcy Trustee was recorded in the Patent and Trademark Office at Reel #1668, Frame #0079.

11. I then licensed the subject mark to Island Seafood & Trading Company, Inc., the petitioner in the ... cancellation proceeding ..., and that license continues to the present time; I directly supervise the use of the mark.

12. When I learned of the error in the paper chain of title of ... Registration No. 1,774,541, I promptly caused a *nunc pro tunc* assignment to be made by the official registrant of the mark, Native Seafood & Trading Co., Inc.[,] to me, effective August 14, 1993, and said assignment, a copy of which is attached hereto ..., was recorded in the Patent and Trademark Office at Reel #1995, Frame #0597.

13. During its entire existence, I was an officer and director of the proper assignor of the subject mark to me, namely[,] Native Seafood & Trading Co., Inc., and it has never filed a petition in bankruptcy.

We agree with respondent that, in light of the above evidence, summary judgment in favor of petitioner is not warranted. As respondent carefully points out in his response:

The basis of Petitioner's cancellation petition and its ... motion is the premise that the Registrant claims ownership of the registration in question by virtue of an alleged assignment in gross. The accused assignment took the form of a "Bill of Sale" from a bankruptcy trustee handling the estate of a company known as Native Seafood, Inc., and it is true that the Bill of Sale document failed to mention the goodwill associated with the mark.

However, ... the registration for the subject mark was erroneously and inadvertently listed as an asset of the bankrupt corporation, when in fact that corporation was only a licensee. Note that the Bill of Sale specifically mentions the debtor corporation, Native Seafood, Inc., while the actual registration certificate names the proper registrant at that time, namely[,] Native Seafood & Trading Co., Inc.
....

In any event, when the current Registrant and Respondent in the instant cancellation proceeding discovered the inadvertent error, a *nunc pro tunc* assignment of the subject mark [and the registration therefor] was executed by Native Seafood & Trading Co., Inc. to him Said *nunc pro tunc* assignment was then promptly submitted to the Patent and Trademark Office for recordation

As shown in the declaration of Pedro Alvarez, ... the proper assignor, Native Seafood & Trading Co., Inc.[,] has never declared bankruptcy. [Thus,] ... the proper assignment is not an assignment in gross.

Petitioner's motion for summary judgment is accordingly denied.
Fed. R. Civ. P. 56(c).

In addition, in his response, which is entitled "REGISTRANT'S BRIEF OPPOSING SUMMARY JUDGMENT FOR PETITIONER AND SUGGESTING SUMMARY JUDGMENT FOR REGISTRANT," respondent "requests that this Board enter summary judgment in Registrant's favor, which it is permitted to do in situations such as this where the facts are uncontroverted and the undisputed material facts clearly show that Registrant is entitled to summary judgment in its favor as a matter of law."³ Among other things, respondent

³ In support of such action, respondent cites, *inter alia*, Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Tonka Corp. v. Tonka Tools,

points out in support of his request that, despite being allowed time to submit evidence, petitioner offered no evidence (beyond the admissions in the pleadings) to substantiate its contentions that the mark which is the subject of the involved registration has been assigned in gross, much less any evidence "to contradict the corrective *nunc pro tunc* assignment." No response to respondent's request for summary judgment has been received from petitioner.

Trademark Rule 2.127(a) provides in relevant part that, "[w]hen a party fails to file a brief in response to a motion, the Board may treat the motion as conceded." In view thereof, and since respondent's request, which is essentially an uncontested cross-motion for summary judgment in its favor, appears to be well taken, the request is granted. Fed. R. Civ. P. 56(c) and (e); and Trademark Rule 2.127(a). Summary judgment is hereby entered in respondent's favor and the petition for cancellation is accordingly dismissed with prejudice.

Inc., 229 USPQ 857 (TTAB 1987); Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984); Visa Int'l Service Ass'n v. Life Code Systems, Inc., 220 USPQ 740 (TTAB 1983); and TBMP §528.08.