

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

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

9/30/02

Bottorff

Opposition No. 124,040

Jethro, Inc.

v.

I-Mode Retrieval
Systems, Inc.

Before Simms, Cissel and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

This case now comes up on applicant's motion for summary judgment, filed on May 10, 2002. The motion is fully briefed. After careful consideration of the evidence of record and the parties' arguments, and for the reasons discussed below, we find that no genuine issue of material fact exists and that applicant is entitled to judgment as a matter of law. Accordingly, we

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grant applicant's motion for summary judgment. See Fed. R. Civ. P. 56(c).

In the application involved in this opposition proceeding, applicant seeks to register the mark I-MODE, in typed form, for goods and services identified in the application as "computer software and electronic databases on CD-ROM and downloadable from a global computer network for use in electronic publishing and information compilation and retrieval," in Class 9, and "custom design and development of computer software, CD-ROMs and web pages for electronic publishing and information retrieval via a global network of computers and CD-ROM delivery," in Class 42.¹

Opposer filed a timely notice of opposition to registration of applicant's mark. Opposer's grounds of opposition are that (a) because applicant had not used the mark in commerce on or in connection with all of the goods and services identified in the application as of the date of first use claimed in the registration (June 1, 1989), the application is misleading and applicant is seeking to improperly expand its rights; and that (b) applicant's identification of goods and services in the

¹ Serial No. 76/056,328, filed May 19, 2000. The application is based on use in commerce, and June 1, 1989 is alleged in the

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application is overbroad, and applicant has not and cannot have used the mark on or in connection with all of the goods and services encompassed by the identification.

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

The record on summary judgment includes the pleadings, the file of the opposed application, and the affidavit (and attached exhibits) of applicant's president Robert J. Wiesenberg in support of applicant's motion for summary judgment. In his affidavit, Mr. Wiesenberg avers, in relevant part, that:

3. I-MODE INC. commenced doing business under its present name during 1989 and first used the trade and service mark I-MODE in connection with its primary business of custom designing and developing software and electronic databases for use in electronic publishing and information management and retrieval, and marketing the resulting software and databases, on June 1, 1989. It has used the mark I-MODE continuously for these goods and services since June 1, 1989.

4. I-MODE INC. expanded the scope of its business under the mark I-MODE in about the mid 1990s to include design and development services for Internet based, downloadable software and electronic databases and web pages for use in electronic publishing and information management and retrieval, and marketing the resulting software and databases. It has used the mark I-MODE continuously for these goods and services from

application as the date of first use anywhere and the date of first use in commerce.

the date of first use of the mark in connection therewith.

5. I-MODE INC.'s services are accurately described in the publications attached hereto as Exhibit A and entitled "Data Management Services," "Solutions for Electronic Publishers," "Solutions for Technical Publishers" and "I-Mode Publishing Services." The goods marketed by I-MODE INC. are the software and databases which result from I-MODE INC.'s consulting and development services.

6. I-MODE INC.'s goods and services are accurately described in its published application for trademark registration [the application involved in this proceeding].

7. I-MODE INC. has continuously offered in commerce, since June 1, 1989, one or more of the goods and one or more of the services set forth in [the involved application] by offering and rendering the service of designing and developing electronic databases onto CD-ROMs or the Internet, designing and developing web pages and designing and developing software primarily intended to permit searching and retrieval of information from the electronic databases, all for use in electronic publishing and information compilation and retrieval. In addition to offering the aforementioned services, I-MODE INC. has offered for sale or license and sold or licensed the resulting electronic databases and software.

8. Exhibit B is an illustrative sampling of invoices, redacted to remove only the identity of the customer, taken from the business records of I-MODE INC., which evidence the rendering of electronic database and software design and development services and the sale or licensing of CD-ROM and web-based electronic databases and software during the period from 1989 through 2001. The services were offered and rendered and the goods were sold on a continuing basis from the

date of first use for each, throughout the period.

In support of its summary judgment motion, applicant contends, generally, that opposer's pleaded grounds of opposition are legally insufficient on their face, and/or that, in view of the affidavit testimony of Mr. Wiesenberg, there are no genuine issues of material fact as to any of those grounds and applicant is entitled to judgment thereon as a matter of law.

Opposer submitted no affidavits or other evidence in support of its opposition to applicant's summary judgment motion. Instead, opposer has filed a brief of just over three pages in length, in which opposer argues, essentially, that:

Applicant's brief in support of its motion for summary judgment shows conclusively, on its face, that there are many issues of fact to be resolved in this case. Accordingly, Applicant's motion for summary judgment is premature and should be denied.

Instead of troubling itself with discovery, Applicant simply filed a motion for summary judgment based upon the self-serving affidavit of its president and several documents of unknown origin. Opposer has not had the opportunity to cross-examine Applicant's sole witness, nor to probe the veracity of Applicant's supporting documentation. Summary judgment is not proper on such a one-sided record.

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In its brief, Applicant raises numerous issues of fact and uses many factual assertions as the basis for its motion. Indeed, the existence of so many pages of exhibits on factual matters attached to the brief demonstrates that these issues are far too complex and fact-dependant [sic] to be decided at this stage in the proceeding as a matter of law. ...

[The statements of Mr. Wiesenberg upon which applicant relies in support of its summary judgment motion] are entirely self-serving and uncorroborated, and have not been vetted by Opposer. With its motion, Applicant is trying, in effect, to prove its entire case, fact and law, at the summary judgment stage, without the benefit of discovery and cross-examination by Opposer. To allow this kind of one-sided record to prevail on summary judgment would dispose of the need for discovery and testimony periods in all opposition proceedings. Applicant's showing is wholly inadequate and Opposer deserves the opportunity to develop its case through discovery and testimony.

Additionally, in footnote 2 to its brief, opposer asserts (without evidentiary support) that the credibility of applicant's sole witness Mr. Wiesenberg "is a significant issue in this case as this individual has already made false representations to an employee of Opposer's legal counsel in an effort to surreptitiously obtain information about the identity of Opposer." In footnote 3 to its brief, opposer argues that summary judgment is inappropriate because

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... Applicant's application has been cited against Opposer's later filed application on 2(d) grounds. It is entirely reasonable for Opposer to be given the opportunity to challenge the breadth of Applicant's recitation of goods and services (since they are the basis of the examining attorney's rejection of Opposer's application). Correspondingly, Opposer has the right to challenge Applicant's claimed date of first use of the subject mark, as that date goes to the priority of Applicant's claimed rights.

Finally, opposer contends that applicant has failed to respond to opposer's discovery requests, and requests that the Board order applicant to do so. However, opposer has not moved for discovery pursuant to Fed. R. Civ. P. 56(f), nor does it appear from the record that opposer has ever moved to compel discovery pursuant to Trademark Rule 2.120(e).

In its reply brief in support of its summary judgment motion, applicant essentially argues that it has demonstrated, in its summary judgment motion and supporting papers, the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law, and that opposer's response to applicant's motion "is nothing more than conclusory statements and assertions of counsel" which do not suffice to create a genuine issue of material fact which would defeat applicant's summary judgment motion.

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Applicant also argues that opposer's bare allegation that discovery is necessary is unavailing in view of opposer's failure to comply with the requirements of Fed. R. Civ. P. 56(f).

In deciding applicant's summary judgment motion, we keep the following principles in mind. 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. See Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case. See, e.g., *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). It is settled that the summary judgment procedure is "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate. See, e.g., *Sweats Fashions Inc. v. Pannill*

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Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

For purposes of summary judgment, a factual dispute is "genuine" only if, on the evidence of record, a reasonable fact finder could resolve the factual dispute in favor of the nonmoving party. See, e.g., *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). A factual issue is "material" only if its resolution would affect the outcome of the proceeding under the relevant substantive law. See *Opryland USA Inc. v. Great American Music Show, Inc.*, *supra*; *Olde Tyme Foods Inc. v. Roundy's Inc.*, *supra*; and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994). A dispute over a nonmaterial fact, i.e., a fact which would not alter the Board's decision on the legal issue in the case, will not prevent entry of summary judgment. See, e.g., *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Pure Gold, Inc., v. Syntex (U.S.A.), Inc.* *supra*.

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The 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 judgment as a matter of law. See, e.g., *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). However, where the ultimate burden of proof on the underlying legal claim or defense rests on the nonmoving party, the summary judgment burden of the moving party may be met by showing "that there is an absence of evidence to support the nonmoving party's case." See *Celotex Corp. v. Catrett*, *supra* ; *Anderson v. Liberty Lobby*, *supra* ; and *Kellogg Co. v. Pack'Em Enterprises Inc.*, *supra*.

In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990); *University Book Store v. University of Wisconsin Board of Regents*, *supra*. 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 reasonable inferences to be drawn from the undisputed

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facts, must be viewed in the light most favorable to the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, *supra*; *Opryland USA, Inc. v. Great American Music Show, Inc.*, *supra*; and *Olde Tyme Foods Inc. v. Roundy's Inc.*, *supra*.

However, when the moving party's motion is supported by evidence sufficient, if unopposed, to establish that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, *supra*; and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). If the nonmoving party fails to proffer such evidence, summary judgment may be granted to the moving party.

Opposer has pleaded its allegations under two general headings, which we presume to constitute opposer's grounds of opposition, i.e., "The Application is Misleading and Improperly Seeks to Expand Applicant's Trademark Rights," and "Applicant Has Not Used the

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Applied For Designation In Connection with All The Designated Goods and Services And The Description of Goods And Services is Therefore Overbroad.”²

The first claim, entitled “The Application is Misleading and Improperly Seeks to Expand Applicant’s Trademark Rights,” appears to be based on opposer’s premise that the date of first claimed in the application, June 1, 1989, is false. We find that there is no genuine issue of material fact as to this first claim which would preclude entry of summary judgment thereon in applicant’s favor. We also find that the claim fails as a matter of law in any event.

First, the application is not “misleading” in its allegation of June 1, 1989 as the date of first use of the mark. Contrary to opposer’s contention in Paragraph 6 of the notice of opposition, applicant’s allegation of June 1, 1989 as the date of first use is not an allegation that the mark was in use on all of the

² In its brief in response to applicant’s summary judgment motion, opposer does not specifically discuss or even identify the grounds of opposition at issue in this case. However, in footnote 3 of its brief, opposer argues that summary judgment is inappropriate because opposer should be given the opportunity “to challenge the breadth of Applicant’s recitation of goods and services” and “to challenge Applicant’s claimed date of first use of the subject mark.” We presume that these two subjects correspond to the above-quoted headings set forth in the notice of opposition as the grounds of opposition, albeit in reverse order.

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identified goods and services as of that date. In an application (such as applicant's) based on use in commerce under Trademark Act Section 1(a), the date of first use alleged in the application for each class of goods or services need not pertain to all items in the class; it may pertain only to one item. See Trademark Rule 2.34(a)(1)(v). The undisputed evidence of record establishes that applicant had used the mark on at least one item in each class as of the claimed first use date of June 1, 1989. See Wiesenberg affidavit, Paragraph 7. No genuine issue of material fact exists on this point.

More fundamentally, however, even if applicant had not used the mark on all of the identified goods and services as of the June 1, 1989 claimed first use date, as opposer has alleged, that fact would not constitute grounds for rejection of applicant's application. To secure registration, applicant is not required to have used the mark on all of the identified goods and services as of the claimed first use date. All that is required is that the mark must have been used on all of the identified goods and services prior to the application filing date, i.e., May 19, 2000. See Trademark Rule 2.34(a)(1)(i). The undisputed evidence of record

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establishes that applicant in fact had used the mark on all of the identified goods and services prior to the application filing date. See Wiesenberg affidavit at Paragraphs 3-4.

Finally, we reject as without merit opposer's claim that applicant is "improperly" seeking to expand its trademark rights by including in its present application goods and services which were not included in applicant's previous (now-cancelled) registration. As discussed above, applicant is entitled to register its mark for any goods and services on or in connection with which the mark was in use prior to the application filing date, regardless of whether those goods or services were included within the scope of applicant's previous registration. Because applicant had used the mark on all of the identified goods and services prior to the application filing date, it is immaterial that some of those goods and services might not have been included in the previous registration.

Thus, we find that there is no genuine issue of material fact as to opposer's first "claim," and that applicant is entitled to judgment thereon as a matter of law.

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We likewise grant summary judgment to applicant on opposer's second "claim," i.e., that "Applicant Has Not Used the Applied For Designation In Connection with All The Designated Goods and Services And The Description of Goods And Services is Therefore Overbroad." First, we note that opposer's claim is not a claim under Trademark Act Section 18 for partial restriction of applicant's identification of goods and services. See, e.g., *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994). Not only has opposer not pleaded the elements of a Section 18 partial restriction claim, see *Eurostar, supra* at 1270, but partial restriction is not even the relief opposer requests. Opposer specifically requests that applicant's application be rejected in its entirety, on the ground that the identification of goods and services is overbroad and that applicant therefore has not and cannot have used the mark on all possible goods and services encompassed by the identification. This is not a proper or legally cognizable ground of opposition, after *Eurostar*.

Moreover, the factual premise underlying opposer's claim is without merit, because applicant's identification of goods and services, i.e., "computer

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software and electronic databases on CD-ROM and downloadable from a global computer network for use in electronic publishing and information compilation and retrieval," in Class 9, and "custom design and development of computer software, CD-ROMs and web pages for electronic publishing and information retrieval via a global network of computers and CD-ROM delivery," in Class 42, is not "overbroad." The Wiesenberg affidavit establishes that applicant in fact uses the mark on and in connection with the goods and services identified in the application. It is undisputed that the identification of goods and services was suggested by the Trademark Examining Attorney during ex parte prosecution of the application, was adopted by applicant, and was accepted by the Office for purposes of publication of the mark. Opposer has presented no evidence (or even argument) on summary judgment to support its mere conclusory allegations in the notice of opposition that the identification of goods and services is overbroad. Those allegations in the pleading are not evidence, and they do not create a genuine issue of material fact.

In summary, we find that opposer's pleaded claims are without legal and/or factual basis, and that there are no issues which require trial for their resolution.

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There are no genuine issues of material fact, and applicant is entitled to judgment as a matter of law. Opposer's arguments to the contrary are wholly unpersuasive.

Decision: Applicant's motion for summary judgment is granted. The opposition is dismissed.