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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91117598
Party	Plaintiff NOMEN INTERNATIONAL, S.A. NOMEN INTERNATIONAL, S.A. ,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 75/731,861
Published in the Official Gazette of December 6, 2005

NOMEN INTERNATIONAL, S.A., Opposer, vs. R. SAMUEL BIRGER, Applicant.	Opposition No. 117,598

RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Opposer, through counsel, submits the within Response to Applicant's Motion For Summary Judgment on Applicant's counterclaim for cancellation of U.S. Trademark Registration No. 2,380,302 (the '202 registration) for alleged abandonment or failure to initiate use of the '302 registration.

I. Summary

To succeed on the Motion For Summary Judgment of Applicant's abandonment counterclaim, Applicant must establish that there is no genuine issue of material fact with respect to (1) Opposer's alleged non-use of the NOMEN trademark in the bona fide course of trade in the United State and, assuming such showing, (2) Opposer's alleged intent not to resume such use. Under applicable law governing what constitutes use, the subjective intent necessary for abandonment, and the summary judgment standard, Applicant cannot establish these two elements in light of documentary evidence and sworn statements submitted with this Response.

II. Summary Judgment Standard

The Board may not resolve any issue of material fact in deciding a summary judgment motion, rather, the Board may only determine whether genuine issues of material fact exist and should grant such motions only to avoid what would be a useless trial. *No Fear, Inc.*, 54 U.S.P.Q.2d 1551, 200 WL 390033 (T.T.A.B. 2000). In deciding a motion for summary judgment, the Board must resolve any doubt as to whether material factual issues exist in favor of the non-moving party and must view all inferences to be drawn from the undisputed facts in the light most favorable to the non-moving party. *Meyers v. Brooks Shoe, Inc.*, 912 F.2d 1459, 16 U.S.P.Q.2d 1055 (Fed. Cir. 1990) (overruled on other grounds by *A. C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.3d 1020, 22 U.S.P.Q.2d 1321, (Fed. Cir. 1992).

III. Legal Standard of Use

The federal definition of "use" of a mark is "the bona fide use of mark in the ordinary course of trade" and abandonment of a mark requires non-use with "intent not to resume such use." Lanham Act § 45, 15 U.S.C. § 1127. Applicant must prove two separate elements to successfully assert the defense of abandonment: (1) that Opposer ceased using the NOMEN mark; and (2) that Opposer did so with intent not to resume its use. *See Cumulus Media, Inc. v. Clear Channel Comm., Inc.*, 304 F.3d 1167, 1174 (11th Cir. 2002); *Citibank, N.A. v. Citibanc Group, Inc.,* 724 F.2d 1540, 1545 (11th Cir.1984); *Emergency One, Inc. v. Am. FireEagle, Ltd.,* 228 F.3d 531, 535 (4th Cir.2000) ("[A] party claiming that a mark has been abandoned must show 'non-use of the name by the legal owner and no intent by that person or entity to resume use in the reasonably foreseeable future.' ") (quoting *Stetson v. Howard D. Wolf & Assocs.,* 955 F.2d 847, 850 (2d Cir.1992)).

The second, intent-based element for abandonment requires proof of the subjective intent of the owner of the mark. The Lanham Act provides that such subjective intent may be "inferred from circumstances" and that a showing of three years of consecutive non-use creates a rebuttable presumption of intent not to resume use. 15 U.S.C. § 1127. However, these provisions do not eviscerate the requirement that abandonment may only be established upon a finding of both non-use and an intent not to resume use.

Courts have readily found that even low level commercial use is sufficient to constitute "use" to preclude a finding of abandonment. *See Cumulus Media* (holding that continuous low level use on business cards and an office sign constituted "use" to prevent a finding of abandonment at the preliminary injunction stage.)

The Board should note in particular with the present matter that NOMEN is use by Opposer as a service mark and that "a service mark is different from a mark for goods, especially in the manner it is used in commerce." *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 768 (Fed. Cir. 1993). Because service marks are used in connection with the offering and providing of services, rather than by placement directly on goods, courts have emphasized that advertising and promotional activities alone are sufficient to establish use of, and rights to, a service mark, in contrast to a mark for goods, where advertising and promotional activities alone may not be sufficient. *See Id; Amica Mutual Insurance Co. v. R.H. Cosmetics Corp.,* 204 USPQ 155, 162 (TTAB 1979).

The Board should note also with regard to Opposer's use of the NOMEN mark that it is used by Opposer not merely as a service mark but as a tradename. NOMEN appears in the corporate name of Opposer and each of Opposer's subsidiaries. Accordingly, any use of a NOMEN-based trade name for a business that conducts transactions in the U.S., or that is

promoted in U.S. by its trade name, necessarily constitutes use of the NOMEN mark in U.S. commerce.

IV. Argument

Applicant's abandonment counterclaim rests entirely on the factual assertions that (1) Opposer ceased using the mark (or never began using the mark) and (2) Opposer had no intent to resume using the mark after the alleged non-use.

The Board should note that Applicant is not asserting that Opposer was not entitled to registration for the NOMEN mark. The Lanham Act is clear that Opposer was entitled to register the NOMEN mark under Section 44(e) based on foreign registration, even without a showing of use in U.S. commerce. Opposer was duly granted U.S. Trademark Registration No. 3,380,302 for NOMEN on August 29, 2000. Registration confers upon Opposer priority to NOMEN as of its filing date, March 5, 1998, which is long before any use or asserted use of NOMENON by Applicant.

The fact that Opposer's mark in this proceeding is registered and that Opposer has priority, is a fundamental distinction with the *First Niagra* case repeatedly cited by Applicant. *First Niagara Insurance Brokers, Inc. v. First Niagara Financial Group, Inc.*, 77 U.S.P.Q.2d 1334 (TTAB 2005). In *First Niagara*, the opposer was a Canadian company attempting to establish rights to and priority of a confusingly similar mark such that the applicant could not obtain registration. However, the opposer in *First Niagara* did not own a trademark registration and was attempting to show ownership and priority to a common law trademark by use alone. The Board held that the opposer's Canada-based common law usage of its mark had not sufficiently penetrated U.S. commerce as to establish common law trademark rights in the U.S.

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