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

Proceeding	92061951
Party	Defendant Great Concepts, LLC
Correspondence Address	LISEL M FERGUSON PROCOPIO CORY HARGREAVES & SAVITCH LLP 525 B STREET, SUITE 2200 SAN DIEGO, CA 92101 UNITED STATES lisel.ferguson@procopio.com, michele.fuger@procopio.com,fred.taylor@procopio.com, fua.akeli@procopio.com
Submission	Motion for Summary Judgment
Filer's Name	Lisel M. Ferguson
Filer's e-mail	lisel.ferguson@procopio.com,michele.fuger@procopio.com,calendar@procopio.com,ftk@procopio.com
Signature	/Lisel M. Ferguson/
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Attachments	2016-01-25_Great_Concepts_s_Motion_for_Summary_Judgment_re_Res_Judicata.PDF(96970 bytes) 2016-1-25_Declaration_of_Frederick_Taylor_ISO_Great_Concepts_s_Motion_for_Summary_Judgment_re_Res_Judicata.PDF(32055 bytes) Exhibit A - Great Concept's Registration.pdf(47229 bytes) Exhibit B - Petition to Cancel from Prior Cancellation Proceeding-1.pdf(1660813 bytes) Exhibit C - Combined Declaration under Sections 8 and 15.pdf(3515202 bytes) Exhibit D - Combined Notice of Acceptance and Acknowledgement of Declaration.pdf(18433 bytes) Exhibit E - Request to Remove Suspension of Proceedings.pdf(1393247 bytes) Exhibit F - Order to Resume Prior Cancellation Proceedings.pdf(39868 bytes) Exhibit G - Certificate of Service or Request to Remove Suspension of Proceedings.pdf(17356 bytes) Exhibit H - Order to Show Cause Why Prior Cancellation Proceeding Should Not Be Dismissed.pdf(24529 bytes) Exhibit I - Order Dismissing Prior Cancellation Proceeding.PDF(21892 bytes) Exhibit J - Section 8 and 15 Declaration from S Industries v. Covington Industries case.pdf(252237 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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CHUTTER, INC.,)	
)	
Petitioner,)	CANCELLATION NO. 92061951
)	
v.)	
)	
GREAT CONCEPTS, LLC,)	
)	
Registrant.)	

**GREAT CONCEPTS, LLC’S MOTION FOR SUMMARY JUDGMENT UNDER
FED.R.CIV.P. 56 REGARDING CHUTTER, INC.’S PETITION TO CANCEL**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Registrant Great Concepts, LLC (“Registrant”) respectfully submits the following motion for summary judgment based on the doctrine of res judicata with respect to Petitioner Chutter, Inc.’s (“Petitioner”) Petition to Cancel Registration No. 2,929,764 (the “Registration”).

I. INTRODUCTION

Nearly ten years ago, Petitioner’s predecessor-in-interest, Dan Tana (“predecessor-in-interest” or “Tana”) brought a prior petition to cancel the Registration before the Trademark Trial and Appeal Board (the “Board”). That petition to cancel was suspended temporarily while the Petitioner’s predecessor-in-interest pursued a civil action in the Northern District of Georgia for infringement against Registrant. While the petition to cancel and the civil action were still pending, Registrant publicly filed a combined declaration of continued use and incontestability relating to its Registration with the USPTO, and the USPTO publicly issued a Combined Notice of Acceptance and Acknowledgement of the declaration. After the Northern District of Georgia granted summary judgment in favor of Registrant and the U.S. Court of Appeals for the Eleventh Circuit affirmed, the petition to cancel resumed. However, despite being specifically ordered by the Board to amend its petition in light of the decision in the civil action, Petitioner’s predecessor-in-interest demonstrated an “apparent loss of interest” and the Board terminated the

petition to cancel.

Now, in an effort to pursue the legal strategy that its predecessor-in-interest opted to forgo, Petitioner has filed the present Petition to Cancel the Registration. Petitioner now asserts a cause of action based on the alleged fraud in Registrant's filing an incorrect combined declaration of use and incontestability under Sections 8 and 15. Although Registrant strongly disputes the merits of both the intent and materiality aspects of this fraud cause of action, Petitioner's claim to cancel the Registration precluded by the doctrine of res judicata. Petitioner's predecessor-in-interest had at least constructive or inquiry notice of the publicly filed declaration of use and incontestability, particularly since the declaration was filed while the Tana was actively litigating against the Registration in both the civil action and the prior cancellation proceeding. Despite having such notice, Petitioner allowed the Board to dismiss its claim against Registrant with prejudice due to its "apparent loss of interest."

Petitioner should not be permitted to have this improper second bite at the apple. There are no genuine issues of material fact allowing the Petitioner to re-litigate its precluded claim, and Registrant respectfully requests that the Board dismiss the present Petition to Cancel.

II. FACTUAL AND PROCEDURAL BACKGROUND

The United States Patent and Trademark Office issued Registration No. 2,929,764 to Registrant for the mark DANTANNA'S in connection with steak and seafood restaurants in International Class 43 (the "Registration") on March 1, 2005. Declaration of Frederick K. Taylor ("Taylor Decl."), ¶ 3; Petition to Cancel, ¶ 9.

On June 6, 2006, Petitioner's predecessor-in-interest Tana filed with the Board a petition to cancel the Registration, Cancellation No. 92045947 (the "Prior Cancellation Proceeding"), which involved Registrant's right to register and use the mark DANTANNA'S for "restaurant services." Taylor Decl., ¶ 3; Petition to Cancel, ¶¶ 1, 10. Petitioner's predecessor-in-interest Tana then commenced a civil action for infringement against Registrant on March 13, 2008, in the United States District Court for the Northern District of Georgia, Civil Action No. 1:08-CV-

975-TWT (the “Civil Action”), which also involved Registrant’s right to register and use the mark DANTANNA’S for “restaurant services.” Taylor Decl., ¶ 5; Petition to Cancel, ¶ 10.

On March 8, 2010, while the Prior Cancellation Proceeding and the Civil Action were still pending, Registrant’s counsel, Frederick K. Taylor, signed and filed with the USPTO on behalf of Registrant a “Combined Declaration of Use and Incontestability under Sections 8 & 15” (the “Declaration”) with respect to the Registration. Taylor Decl., ¶ 6; Petition to Cancel, ¶ 22. The Declaration incorrectly stated that, at the time, there were no pending proceedings involving Registrant’s rights in the Registration. Petition to Cancel, ¶¶ 23, 28. The USPTO issued a combined Notice of Acceptance (as to Section 8) and Notice of Acknowledgement (as to Section 15) (the “Combined Notice”) with respect to the Registration on March 26, 2010, which was over eight months before the Board dismissed the Prior Cancellation Proceeding on December 14, 2010. Taylor Decl., ¶ 7; Petition to Cancel, ¶ 37.

The Civil Action subsequently ended after the U.S. Court of Appeals for the Eleventh Circuit issued a mandate on August 13, 2010 for its opinion affirming the district court’s judgment and order granting summary judgment in favor of Registrant. Taylor Decl., ¶ 8; Petition to Cancel, ¶¶ 13-16.

On September 1, 2010, Registrant filed a request with the Board to resume the Prior Cancellation Proceeding against the Registration. Taylor Decl., ¶ 9; Petition to Cancel, ¶¶ 18, 35. The Board issued an order on September 7, 2010 to resume the Prior Cancellation Proceeding, in which the Board instructed Petitioner to amend its petition to cancel from the Prior Cancellation Proceeding. Taylor Decl., ¶ 10. Registrant served a copy of Registrant’s Request to Remove Suspension of Proceedings to counsel for the Petitioner on September 8, 2010. Taylor Decl., ¶ 11.

Despite having at least constructive or inquiry notice of the Declaration filed on March 8, 2010, Petitioner’s predecessor-in-interest Tana made no attempt to amend its petition in the Prior Cancellation Proceeding to include fraud as a ground for cancellation. Taylor Decl., ¶ 12; Petition to Cancel, generally.

On October 26, 2010, the Board issued an “order to show cause why [the Prior Cancellation Proceeding] should not be dismissed with prejudice based on petitioner’s apparent loss of interest.” Taylor Decl., ¶ 13. Subsequently, the Prior Cancellation Proceeding ended when the Board entered an Order terminating the proceeding on December 14, 2010, as a result of default by Petitioner’s predecessor-in-interest Tana. Taylor Decl., ¶ 14; Petition to Cancel, ¶ 19. The Board’s order stated as follows: “In view of petitioner’s failure to respond to the order to show cause that the Board issued on October 26, 2010, the petition to cancel is dismissed with prejudice based on petitioner’s apparent loss of interest.” Taylor Decl., ¶ 14, Exhibit I.

Despite the fact that the Northern District of Georgia and the Eleventh Circuit both ruled against Petitioner in the Civil Action (Petition to Cancel, ¶¶ 13, 16), and the fact that the Board dismissed Petitioner’s Prior Cancellation Proceeding with prejudice (Petition to Cancel, ¶ 19), Petitioner has since filed application Serial No. 86-452,290 for the mark DAN TANA’S for “restaurant services” in International Class 43 on November 12, 2014. Petition to Cancel, ¶ 6.

Finally, on July 29, 2015, Petitioner filed the present Petition to Cancel Registrant’s Registration on the ground of fraud. *See* Petition to Cancel, ¶ 45.

III. LEGAL STANDARD

Entry of summary judgment is appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment 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. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts on summary judgment; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme*

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