ESTTA Tracking number: **ESTTA599846**

Filing date: **04/22/2014**

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

Proceeding	94002596
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Date	04/22/2014
Attachments	9006115_1.pdf(5090221 bytes) 9006185_1.pdf(2000949 bytes) 9006199_1.pdf(35564 bytes)

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

In the matter of Application Serial No.: 76/685,731
Filed: January 14, 2008
For the mark: MASA
Published in the Trademark Official Gazette on August 23, 2011

Masayoshi Takayama,

Plaintiff,

v. Concurrent Use No. 94002596

D'Amico Holding Company,

Defendant.

DEFENDANT'S RESPONSE TO PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

INTRODUCTION

Applicant failed to carry his burden with respect to his Motion for Summary Judgment. Applicant offers only conclusory statements about his erroneous interpretation of the parties' Confidential Settlement Agreement to support his argument that he is entitled to the geographic area identified in his Concurrent Use Application; namely, the entire United States except for Minnesota, 50 miles around Minneapolis, and Florida. There are genuine disputes of material fact with respect to the territory not specifically identified in the parties' Confidential Settlement Agreement. Therefore, D'Amico Holding Company ("D'Amico") respectfully requests that the Board deny Applicant's Motion for Summary Judgment.

STATEMENT OF DISPUTED FACTS

- Paragraph 1 of the Confidential Settlement Agreement established the geographic territory for Applicant's use of his alleged MASA mark as New York and 50 miles around New York City. [Decl. Plumley, Ex. A.]

- Paragraph 2 of the Confidential Settlement Agreement established the geographic territory for D'Amico's use of its MASA and MASA & Design marks as Minnesota, 50 miles around Minneapolis, and Florida. [*Id.*]

- Other than the territories expressly identified in Paragraphs 1 and 2, the Confidential Settlement Agreement does not designate a geographic territory for Applicant and D'Amico. [*Id.*]

ARGUMENT

I. PLAINTIFF HAS NOT DEMONSTRATED THE ABSENCE OF ANY GENUINE DISPUTES OF MATERIAL FACT

A. *Standard of Review*

A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *Copelands' Enterprises Inc. v. CNV Inc.*, 20 U.S.P.Q.2d 1295, 1298-99 (Fed. Cir. 1991) (moving party's conclusory statement as to intent insufficient). This burden is greater than the evidentiary burden at trial. *Gasser Chair Co. Inc. v. Infanti Chair Manufacturing Corp.*, 34 U.S.P.Q.2d 1822, 1824 (Fed. Cir. 1995). When considering a summary judgment motion, the Board must construe the facts and all inferences reasonably drawn therein in a light most favorable to the non-moving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992).

As the concurrent use applicant, Plaintiff has the burden to show that: (1) he made lawful concurrent use of the MASA mark in commerce prior to the filing dates of D'Amico's MASA and MASA & Design applications; and (2) that confusion, mistake, or deception is not likely to result from his continued use of the MASA mark in the areas in which he is currently using his mark. *Turdin, Jr. v. Trilobite, Ltd.*, 109 U.S.P.Q.2d 1473 (T.T.A.B. 2014).

There is no dispute that the first condition to the issuance of a concurrent use registration has been satisfied. *See id.* The parties acknowledged in the Confidential Settlement Agreement that Plaintiff used the MASA mark in connection with Japanese sushi restaurant and bar services in New York City, NY since at least 2004. [Decl. Plumley, Ex. A.] It is also undisputed that D'Amico filed its application to register its MASA mark for "restaurant and bar services" on June 20, 2005 and filed its application to register its MASA & Design mark for "restaurant and bar services" on November 30, 2006. [Decl. Walz, Exs. 1, 2.]

There is also no dispute that the second condition to the issuance of a concurrent use registration has been satisfied. *See Trilobite, Ltd.*, 109 U.S.P.Q.2d at 1473. Pursuant to Paragraph 1 of the Confidential Settlement Agreement, D'Amico will not provide restaurant or bar services under the MASA mark in New York or within 50 miles of New York City, NY. [Decl. Plumley, Ex. A.] Likewise, pursuant to Paragraph 2 of the Confidential Settlement Agreement, Plaintiff will not provide restaurant or bar services under the MASA mark in Minnesota, 50 miles of Minneapolis, MN, or Florida. [Decl. Plumley, Ex. A.] What remains in dispute are the registrable rights to the remainder of the United States possessed by each party.

B. *The Confidential Settlement Agreement is ambiguous and cannot be construed as a matter of law*

Plaintiff's sole basis for concluding that he is entitled to the entire United States except for Minnesota, 50 miles around Minneapolis, MN, and Florida is the parties' Confidential Settlement Agreement. [Pl.'s Br., at 1.] The parties did not include a governing law clause directing that the laws of any particular state apply. [Decl. Plumley, Ex. A.] Nevertheless, there is no conflict between Minnesota and New York law.

Under Minnesota law, "where [contract] language is ambiguous, resort may be had to extrinsic evidence, and construction then becomes a question of fact for the jury . . . ." *Bari v.*

Control Data Corp., 439 N.W.2d 44, 47 (Minn. App. 1989), *review denied* (Minn. July 12, 1989). "The language of a contract is ambiguous if it is susceptible to two or more reasonable interpretations." *Dykes v. Sukup Mfg. Co.*, 781 N.W.2d 578, 582 (Minn. 2010) (citations omitted). A contract is ambiguous if it is silent on a particular issue. *See Badger Equipment Co. v. Brennan*, 431 N.W.2d 900, 904 (Minn. App. 1988) (finding the Badger plan ambiguous because it was silent as to the priority of payment).

Under New York law, in determining the obligations of parties to a contract, the threshold determination as to whether an ambiguity exists is a question of law to be resolved by the court. *Agor v. Board of Educ.*, 981 N.Y.S.2d 485, 487 (N.Y.A.D. 3 Dept. 2014) (citations omitted). "A contract is ambiguous if the language used lacks a definite and precise meaning, and there is a reasonable basis for a difference of opinion" *Id.* A contract is ambiguous if it is silent on a particular issue. *See Spano v. Kings Park Cent. School Dist.*, 61 A.D.3d 666, 669 (N.Y.A.D. 2 Dept. 2009) (finding CBA ambiguous because it was silent on the issue of whether "continuous service" included only service as a permanent employee); *Village Sav. Bank v. Caplan*, 87 A.D.2d 145, 147 (N.Y.A.D. 1982) (finding the mortgage and accompanying document ambiguous because they were silent as to the maintenance and separate reserve accounts). "If the court concludes that a contract is ambiguous, it cannot be construed as a matter of law . . . ." *Agor*, 981 N.Y.S.2d at 487.

Applying either Minnesota or New York law, the Confidential Settlement Agreement is ambiguous with respect to the registrable rights to the remainder of the United States possessed by each party. It specifically identifies only each party's right to use its respective MASA mark outside of New York, 50 miles around New York City, NY, Minnesota, 50 miles around Minneapolis, MN, and Florida and is silent with respect to the rest of the United States. [Decl.

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