ESTTA Tracking number: **ESTTA255547**

Filing date: **12/17/2008**

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

Proceeding	92048839
Party	Plaintiff Joseph Melluso
Correspondence Address	Keith E. Rounder Terrell, Baugh, Salmon & Born, LLP 700 South Green River Road, Suite 2000 Evansville, IN 47715 UNITED STATES krounder@tbsblaw.com, gprice@tbsblaw.com, pperry@tbsblaw.com
Submission	Opposition/Response to Motion
Filer's Name	Keith E. Rounder
Filer's e-mail	krounder@tbsblaw.com, gprice@tbsblaw.com, pperry@tbsblaw.com
Signature	/Keith E. Rounder/
Date	12/17/2008
Attachments	Response to Motion for Summary Judgment.pdf (22 pages)(585134 bytes)

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

JOSEPH MELLUSO,	)	
	)	Cancellation No. 92048839
Petitioner,	)	Reg. No. 2673458
	)	
vs.	)	
	)	
SEA DINING, LLC,	)	
	)	
Registrant.	)	

RESPONSE TO MOTION FOR SUMMARY JUDGMENT

Comes now the Petitioner, Joseph Melluso ("Melluso"), and files his Response to the Motion for Summary Judgment filed by the Registrant, Sea Dining, LLC ("Sea Dining's Motion" and "Sea Dining" respectively). Sea Dining's Motion is based on its affirmative defense of laches.[1] However, this defense must fail for the reason that there is inevitability of confusion between Sea Dining's trademark and Melluso's trademark. Sea Dining's Motion should therefore be denied as laches is inapplicable to the facts of this case.

Melluso's Brief on the issues presented is incorporated in this Response as set forth below.

Facts

Melluso does not dispute the facts set forth in Sea Dining's Motion. However, Melluso submits that the most critical facts for purposes of Sea Dining's Motion Response are that Melluso used the "The Tin Fish" mark in commerce prior to Sea Dining's application, that the respective marks of the parties are identical, and that both parties are engaged in the operation of

[1] In its Answer, Sea Dining also asserted the affirmative defense of acquiescence. However, Sea Dining's Motion appears to be solely based on laches, with only a passing reference to acquiescence in a footnote on page 6 of that Motion.

restaurants serving seafood. As set forth in the Affidavits of Joseph Melluso, Roberta Hepburn and Barry J. Williams which are attached to this Response, there have been numerous instances of confusion between Melluso's servicemark and Sea Dining's servicemark.

Legal Standard

Summary Judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute and the moving party is entitled to judgment as a matter of law. FRCP 56(c). The party moving for summary judgment has the burden of demonstrating that there is an absence of any genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence must be viewed in a light favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. In considering the propriety of summary judgment, the Trademark Trial and Appeal Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. *Lloyd's Food Products, Inc. v. Eli's Inc.*, 1987 F.2d 766 (Fed. Cir. 1993); *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847 (Fed. Cir. 1992) 23 USPQ2d 1471.

To successfully assert a defense of laches, the party asserting the defense must make a showing of (1) unreasonable delay in asserting one's rights against another and (2) material prejudice to the movant as a result of the delay. *Lincoln Logs, Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). The burden of proof is on the party that raises the

affirmative defense of laches. *Joseph E. Turner v. Hops Grill & Bar, Inc., and Apple South, Inc.*, 52 USPQ2d 1310 (TTAB 1999). The mere passage of time does not constitute laches. *Advanced Cardiovascular Systems v. SciMed Life Systems*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). The defense of laches requires factual development beyond the content of the pleadings and the facts evidencing unreasonableness of delay and material prejudice to the movant cannot be decided against the non-movant based solely on presumptions. *Aquion Partners Limited Partnership v. Envirogard Products Limited*, 1997 WL 288964 (TTAB 1997).

Even if a movant asserting a defense of laches can establish unreasonable delay and material prejudice, laches will not apply if the marks and goods or services of the parties are substantially similar and it is determined that confusion is inevitable. *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 USPQ2d 1041, 1409 (11th Cir. 1991); *Hops Grill and Bar*, 52 USPQ2d 1310, 1312 (TTAB 1999).

Argument

1. The Law concerning Inevitability of Confusion.

Even if Sea Dining could show both that Melluso unreasonably delayed asserting his rights to the Tin Fish trademark and that Sea Dining suffered material prejudice as a result, Sea Dining's Motion must still fail for the reason that there is inevitability of confusion between the Melluso trademark and the Sea Dining trademark. It is well-settled law that laches is not available as a defense to a cancellation petition when the similarity between trademarks is such that the

public will inevitably be confused between the goods and services of the parties. *Hops* at USPQ2d 1312. The reason for this is that the interest in protecting the public from confusion in the marketplace outweighs any injury to a party caused by another party's delay in asserting rights to a trademark. *Hops* at USPQ2d 1312-3. The interest in protecting the public from confusion between trademarks has consistently been held to be of paramount concern.

> However, even though proven, laches will not prevent cancellation where the marks and goods or services of the parties are substantially similar and it is determined that the confusion is inevitable. This is so because any injury to respondent caused by petitioner's delay is outweighed by the public's interest in preventing confusion in the marketplace. Consequently, if there is an inevitability of confusion, laches is not applicable and thus does not bar the claim.
>
> *Hops* at USPQ2d 1312-3 (citing *Coach House*).

The question then becomes, What constitutes inevitability of confusion? The recent history of the TTAB in this regard is to make reference to the factors governing likelihood of confusion set forth in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ2d 563 (CCPA 1973). An example is the case of *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203 (TTAB 2006). In *Teledyne* the petitioner sought to cancel a registration of the mark GOLD SEAL for "aircraft engines." The petitioner's mark GOLD SEAL was for ignition harnesses for aircraft engines. The respondent's GOLD SEAL mark was for entire aircraft engines. The respondent raised the issue of laches based on the fact that the petitioner had not asserted its rights until 2002 even though the evidence showed it was aware of the respondent's mark as early as

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.