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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: February 5, 2013

Opposition No. **91204116**

Award Pictures, LLC

v.

Renaissance Pictures Ltd.

Before Seeherman, Taylor, and Lykos, Administrative Trademark Judges.

By the Board:

As background, proceedings herein were suspended for the parties' civil action, which action became final during the pendency of this proceeding. This case now comes up on applicant's renewed motion for summary judgment based on a permanent injunction entered by the district court.[1] We must give deference to the determinations of the district court and consider the terms of permanent injunctions. *See*

[1] *Renaissance Pictures, Ltd., v. Award Pictures, LLC.*, CV12-3805, United States District Court, Central District of California, Western Division. The Board previously found applicant's August 28, 2012 motion for summary judgment premature because the decision of the district court was not final. The Board noted in that order that the motion for summary judgment was based on preclusion, and may be considered before service of initial disclosures.

DaimlerChrysler Corp. v. Maydak, 86 USPQ2d 1945, 1950 (TTAB 2008).

Summary Judgment

In a motion for summary judgment, the moving party has the burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). A genuine dispute with respect to a material fact exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). All doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Parties' Arguments and Evidence

In support of its motion, applicant submits that opposer lacks standing to maintain this opposition in view of the final order of the district court which acknowledges the court's prior entry of default judgment against opposer and held that opposer is "permanently enjoined from any and all use of the EVIL DEAD mark, or any similar mark, in connection with the promotion, development, distribution or production of any motion pictures or entertainment or

related goods or services." Included with applicant's motion is the declaration of Michael Chiappetta (Chiappetta declaration) which declares that "entry of judgment was entered against Opposer in the Civil Action on August 23, 2012" and that the deadline for appeal was September 22, 2012 and opposer did not file a notice of appeal by that date "or at any time thereafter." The order of judgment accompanies the Chiappetta declaration.

In response, opposer argues that applicant has not shown that the default judgment was the final judgment as "a Motion to Vacate (Set Aside) Default Judgment in the Civil Action will be submitted in a timely manner to the U.S. District Court." Opposer contends that since opposer has a right to move to vacate the judgment, "the default judgment entered in the Civil Action is not the final judgment in the Civil Action."

Opposer further states that it had "entered into an attorney-client relationship with California Attorney Charles R. Sutton" to defend the civil action which Sutton "negligently and incompetently failed to do." Opposer further advises that it has "retained Robert Sirianni Jr. Esq. and his associated attorneys at Brownstone Law, P.A. to vacate the default judgment in the Civil Action on motion" and that on this basis "Applicant's statement that 'the Judgment is final' is incorrect." Opposer has submitted

three affidavits of Glen MacCrae-Gray and two affidavits of Graham MacCrae-Gray, and as exhibits, an unsigned copy of a retainer agreement between opposer and Brownstone Law P.A. dated September 13, 2012 and an unsigned retainer agreement between "Glenn MacCrae and Graham MacCrae" and attorney Charles Sutton dated July 30, 2012 which has a note that a signed copy was returned to Mr. Sutton.

In reply, applicant argues that opposer has not disputed that a judgment was entered against it or that the time to appeal has passed. Applicant points out that opposer's argument is solely based on some "vague plans to make a motion to vacate the default judgment" "at some undetermined time in the future." Applicant argues that there is no basis for vacating default as opposer specifically advised the court by letter dated July 5, 2012 that it did not intend to defend the lawsuit. Applicant submits that the order issued by the district court is a final judgment and that a motion for relief from judgment under Fed. R. Civ. P. 60(c)(2) "does not affect the judgment's finality or suspend its operation" until an order under Rule 60 issues.

Applicant has included the declaration of Barbara Solomon (Solomon declaration) with its reply which declares that she contacted the Brownstone Law Firm on October 26, 2012 to "ascertain if in fact the firm was representing

Opposer in connection with the Civil Action." Ms. Solomon declares that she was advised by the business manager of the Brownstone Law Firm that the firm does not represent opposer and that the "retainer process has not been completed, and that it is not known if it will be completed." The Solomon declaration also declares that no papers seeking to vacate the default judgment have been filed in the Civil Action as shown in Pacer. A copy of opposer's July 5, 2012 letter to the district court by which opposer's representative advised that it was unable to hire counsel due to the expense and that "it appears that . . . the case will be decided by our default" accompanies the Solomon declaration.

Finality of Judgment

While any final judgment may be the subject of a motion to vacate pursuant to Fed. R. Civ. P. 60(b), the pendency of such a motion does not alter a judgment's finality nor suspend the time for taking an appeal. See Fed. R. Civ. P. 60(b); *In re Austrian German Holocaust Litigation*, 250 F.3d 156, 165 (2d Cir. 2001); *Burnam v. Amoco Container Co.*, 738 F.2d 1230, 1232 (11th Cir. 1984). Thus, the fact that a judgment may be subject to relief under Fed. R. Civ. P. 60(b) does not affect the finality of the judgment. *Williams v. Int'l. Board of Elec. Workers, Local 520 (In re Williams)*, 298 F.3d 458, 462 n.3 (5th Cir. 2002).

Accordingly, applicant's motion for summary judgment is ripe for consideration because the August 23, 2012 judgment is a final order of the district court.

We now turn to consideration of whether applicant has established that there is no genuine dispute of material fact that opposer lacks standing to maintain this opposition proceeding.

Standing

Standing is a threshold issue that must be proved in every inter partes case. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982). The facts regarding the legitimate personal interest of the plaintiff are a part of the plaintiff's case and must be affirmatively proved. *Lipton Industries*, 213 USPQ at 189.

In the case of a notice of opposition, the standing requirement of a plaintiff has its statutory basis in Section 13 of the Trademark Act, 15 U.S.C. Section 1063, which provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register . . . may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office . . . ." A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). A plaintiff's belief in damage must have some reasonable basis

in fact. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012).

The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Industries, Inc.,* 213 USPQ at 189. Standing must be present not only at the pleading stage but present at any time the question of a plaintiff's real interest is before the Board. *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1883 (TTAB 1990) (Simms, dissenting).

In this case, opposer has alleged in the amended notice of opposition its direct commercial interest by its allegations that it has used EVIL DEAD as a motion picture title element in United States commerce, that it has entered into motion picture distribution contracts for one of its motion picture properties that uses EVIL DEAD as a motion picture title element, that it is using the mark EVIL DEAD on its company website, and that it has attempted to register the mark EVIL DEAD as its company's mark.[2]

Permanent Injunction

[2] The amended notice of opposition alleges claims under Sections 2(d) and 2(e)(1), as well as claims of abandonment due to non-use and loss of trademark significance, fraud and lack of bona fide intention to use the mark in commerce.

By its terms, the permanent injunction permanently enjoins ". . . Defendant Award Pictures, LLC, its principals, members, officers, shareholders, partners, and directors, and all persons who ... act in concert or in participation with them . . ." from doing any of the following:

(a) Using the EVIL DEAD name or mark or any derivation or colorable imitations thereof or any name or mark that is confusingly similar thereto, including but not limited to the names Evil Dead; Evil Dead: Genesis of Necronomicon; Evil Dead: Genesis of the Necronomicon, Part 2; Evil Dead: Consequences, (collectively, the 'Prohibited Names") as part of the title of a motion picture, television program, video game, play, book or any other form of entertainment provided or to be provided through any media, or in connection with the promotion, development, distribution or production of any form of entertainment;

(b) Using any of the Prohibited Names in connection with the promotion, development, distribution or production of motion pictures or any entertainment-related goods or services, or to otherwise promote Award Pictures, LLC or any of Award Pictures, LLC's goods or services;

(c) Making or employing any other commercial use of any of the Prohibited Names on any website or in any markeing [sic] or promotional materials, regardless of media;

(d) Representing to third parties by acts of omission or commission that Defendant owns rights in the EVIL DEAD name or mark, that Defendant's works are associated with or approved by Plaintiff or were created, prepared or distributed with the consent or permission of Plaintiff, or that Defendant is intending on or is producing any form of entertainment under the Prohibited Names;

(e) Using any other false designation of origin or false description or representation or any other thing calculated or likely to cause confusion or

mistake in the mind of the trade or public or to deceive the trade or public into believing that Defendant's activities are in any way sponsored, licensed, endorsed, authorized by or affiliated or connected with Plaintiff or originate from Plaintiff or to otherwise cause the public or trade to believe that Defendant has rights to any Prohibited Names on or as the title of any works;

(f) Doing any other acts or things calculated or likely to cause confusion or mistake in the mind of the public or to lead purchasers or consumers or investors into the belief that the products or services promoted, offered or sponsored by Defendant emanate from or originate with Plaintiff or its licensees, or are somehow sponsored, licensed or endorsed, authorized by or affiliated or connected with Plaintiff, or originate from Plaintiff or to otherwise cause the public or trade to believe that Defendant has rights to use any Prohibited Names on or as the title of any works;

(g) Further infringing Plaintiff's EVIL DEAD mark and damaging Plaintiff's goodwill;

(h) Applying to register the EVIL DEAD mark, or any confusingly similar mark, with the United States Patent and Trademark Office or any other trademark office or governmental authority;

(i) Interfering with Plaintiff's use, registration or attempts to register EVIL DEAD as a mark with the U.S. Patent and Trademark Office or any state trademark authority.

In view of the permanent injunction, we find that there is no genuine dispute of material fact that opposer lacks a legitimate commercial interest in the EVIL DEAD mark, due to the prohibition against use of any kind, and that, as a result, its belief in damage resulting from the registration of applicant's EVIL DEAD mark is wholly without merit. In particular, under the terms of the permanent injunction,

opposer cannot establish in this proceeding its commercial interest in using the EVIL DEAD mark as opposer is permanently enjoined from using the "EVIL DEAD name or mark or any derivation or colorable imitations thereof or any name or mark that is confusingly similar thereto . . ." for any commercial use, on any website, in marketing or promotional materials, and in conjunction with the promotion, development, distribution or production of any form of entertainment related goods or services provided through any media. Additionally, opposer is enjoined from interfering with applicant's attempts to register the EVIL DEAD mark with the USPTO.

As a matter of law, opposer has no standing to maintain this proceeding because it lacks a legitimate commercial interest in the EVIL DEAD mark, is prohibited from using the EVIL DEAD mark, and cannot demonstrate any real interest in this proceeding.

Accordingly, applicant's motion for summary judgment is granted on the basis of lack of standing. *See e.g., Coup v. Vornado Inc.*, 9 USPQ2d 1824 (TTAB 1988) (petitioner's failure to prove standing warrants grant of summary judgment for respondent).

Judgment is hereby entered against opposer, and the opposition is dismissed.