

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: January 26, 2018

Cancellation No. 92064087 (Parent)  
Cancellation No. 92064098

*Local Foods, LLC*

*v.*

*Foodsmith Bowen Osborn*

**Before Wellington, Kuczma, and Gorowitz,  
Administrative Trademark Judges.**

**By the Board:**

This proceeding now comes before the Board for consideration of Petitioner's motion, filed September 26, 2017, for summary judgment in Cancellation No. 92064087 on the grounds that Respondent has abandoned the mark and that the mark is void because Respondent was not the owner of the mark on the filing date of the underlying application.<sup>1</sup> The motion is fully-briefed.<sup>2</sup>

By way of background, on August 25, 2016, Petitioner filed a consented motion to amend the petition for cancellation of the following word and design mark:

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<sup>1</sup> The motion does not seek summary judgment against the registration involved in Cancellation No. 92064098.

<sup>2</sup> The Board notes that Respondent has again filed a brief that is not double-spaced in compliance with Trademark Rule 2.126. *See* 21 TTABVUE 2 n.3. We exercise our discretion and give consideration to this brief. Respondent is advised that the Board may not consider any future filings which fail to comply with Rule 2.126.



for “Health food, namely freshly prepared meals consisting primarily of local and organic meat, fish poultry, vegetables, properly proportioned, for delivery and pickup” in International Class 29.<sup>3</sup> The grounds asserted in the amended petition are (1) likelihood of confusion, and (2) the registration is void because the mark was owned by a partnership comprising Jamie Smith, an officer of Petitioner, and Bowen Osborn at the time Respondent filed the underlying application.<sup>4</sup> In its answer to the amended petition, Respondent generally denied “each and every count of the Petition to Cancel.” 13 TTABVUE 2.

On June 7, 2017, the Board consolidated Cancellation No. 92064087 with Cancellation No. 92064098 because the parties to the proceedings are identical and the marks and issues are similar.<sup>5</sup>

On October 5, 2017, the Board issued an order noting that the proceeding was suspended as of the filing date of the motion for summary judgment. The Board

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<sup>3</sup> Registration No. 4661839 was registered on December 30, 2014, claiming July 1, 2013 as the date of first use anywhere and the date of first use in commerce. The underlying application for registration was filed on August 7, 2013, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

<sup>4</sup> Respondent is identified in the registration as Foodsmith Bowen Osborn, a California sole proprietorship comprised of Bowen Osborn. Mr. Osborn refers to himself as the owner of the registration.

<sup>5</sup> Cancellation No. 92064098 seeks cancellation of Registration No. 4870565 for the mark FOODSMITH and design.

further noted that Petitioner did not plead the abandonment claim in its amended petition. Accordingly, the Board advised the parties that it would not consider summary judgment with respect to the abandonment claim unless Petitioner timely filed a motion for leave to amend its pleading.

**I. Motion for Leave to Amend**

On October 6, 2017, Petitioner filed a motion for leave to amend its pleading. Respondent did not file a response to Petitioner's motion for leave to amend and did not oppose the amendment in its response to Petitioner's summary judgment motion. In view thereof, the motion for leave to amend the pleading is **granted** as conceded.<sup>6</sup>

**II. Standing**

Standing is a threshold issue that must be pleaded and proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 171 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); see also *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007). Thus, to prevail on its motion for summary judgment, Petitioner must establish its standing.

Here, Petitioner has pleaded a legally sufficient claim of likelihood of confusion based on prior common law use of a similar mark on the same or related goods.<sup>7</sup> See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir.

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<sup>6</sup> For purposes of the summary judgment motion, we deem the new allegations in the second amended pleading to be denied. See TBMP § 528.07(a) (June 2017).

<sup>7</sup> A plaintiff that is able to show standing on one ground has the right to assert any other grounds in an opposition or cancellation proceeding. See *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011).

2000). Thus, Petitioner may establish its standing by demonstrating common law rights in its mark. *See Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights). Although Petitioner has not submitted any testimony or direct evidence of its common law use of the mark,<sup>8</sup> Petitioner has introduced Respondent's responses to Petitioner's requests for admission which establish Petitioner's real interest in the proceeding. Specifically, in response to Petitioner's request that Respondent admit that Local Foods, LLC was using the FOOD SMITH mark in commerce at least as early as June 20, 2013,<sup>9</sup> Respondent answered "True."<sup>10</sup> *See Fed. R. Civ. P. 36(b); Texas Dep't of Transp. v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010) (admission conclusively establishes matter that is the subject of request for admission, subsequent argument to the contrary in response brief insufficient to raise genuine issue of material fact).

In view thereof, we find that Petitioner has established its standing to maintain this proceeding.

### **III. The Pleadings**

While we have accepted Petitioner's second amended pleading as the operative pleading, a decision on summary judgment necessarily requires a review of the pleading to determine the sufficiency of the claims asserted in the motion. *See Fed. R. Civ. P. 56(a); Asian & Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009); *Intermed Comm., Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977)

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<sup>8</sup> We note that the exhibits attached to Petitioner's original petition for cancellation are not evidence on behalf of Petitioner. Trademark Rule 2.122(c); *see* TBMP § 704.05(a) (June 2017).

<sup>9</sup> Petitioner's First Set of Requests for Admission No. 17, 24 TTABVUE 41.

<sup>10</sup> 24 TTABVUE 46.

“If a claim has not been properly pleaded, one cannot obtain summary judgment thereon.”<sup>11</sup>

**a. Abandonment**

Upon review of Petitioner’s second amended petition for cancellation, we find that Petitioner has pleaded a legally sufficient claim of abandonment due to Respondent’s alleged nonuse of the mark for at least three consecutive years.<sup>12</sup>

**b. Non-Ownership**

In the second amended petition, Petitioner also added an allegation that Respondent, Foodsmith Bowen Osborn, a California sole proprietorship composed of Bowen Osborn, was not the owner of the mark at the time the application was filed because Respondent did not file a fictitious business name statement with the county recorder as required by the California Business and Professions Code.<sup>13</sup> The second asserted ground in the motion for summary judgment is based on the new allegation. According to Petitioner, the registration is void as a matter of law because the sole proprietorship “did not exist at the time the application was filed or registered.” 24 TTABVUE 55.<sup>14</sup>

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<sup>11</sup> In its May 23, 2017 order, the Board found Petitioner’s first amended petition for cancellation legally sufficient, if proven, to establish Petitioner’s standing as well as its likelihood of confusion claim and its claim that the registration is void because Respondent was not the rightful owner of the involved mark when the underlying application was filed. However, Petitioner’s motion for summary judgment is not based on either of the claims in the first amended petition.

<sup>12</sup> Second Amended Petition for Cancellation, ¶¶ 32-39, 26 TTABVUE 14-16.

<sup>13</sup> *Id.* at ¶ 30, 26 TTABVUE 14.

<sup>14</sup> Petitioner does not assert the original non-ownership claim in its motion for summary judgment. *See* 24 TTABVUE 53-55.

Pursuant to Trademark Rule 2.71(d), 37 C.F.R. § 2.71(d), an application based on use in commerce under Trademark Act Section 1(a) that is not filed by the party that owns the mark on the application filing date is void. *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1027 (Fed. Cir. 2017). If there is a mistake in the manner in which the name is set in the application, the application may be amended to correct the name of the applicant. However, “the application cannot set forth a different entity as the applicant.” Rule 2.71(d).

In this case, we find that Petitioner’s new allegation in paragraph 30 of the second amended petition fails to state a separate claim of non-ownership upon which relief may be granted. The new allegation does not assert that the party that filed the application, namely, Bowen Osborn, was the wrong party. It merely alleges that the entity under which the application was filed was a non-existent entity. If the application is filed in the name of an entity that does not exist on the application filing date, the application is not void as a result of the error and may be amended to correct the applicant’s name. *See Accu Pers. Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1445 (TTAB 1996) (holding application not void *ab initio* where corporation named as applicant technically did not exist on filing date, since four companies who later merged acted as a single commercial enterprise when filing the application); *Argo & Co. v. Springer*, 198 USPQ 626, 635 (TTAB 1978) (holding that application may be amended to name three individuals as joint applicants in place of an originally named corporate applicant which was never legally incorporated, because the individuals

and non-existent corporation were found to be the same, single commercial enterprise); *see also* TMEP § 1201.02(c) (October 2017).

In view of the foregoing, Petitioner's allegation in paragraph 30 of the second amended petition is insufficient to state a separate claim of non-ownership under upon which relief may be granted. Rule 2.71(d). Because Petitioner's motion for summary judgment on the ground of non-ownership is based solely on the allegations in paragraph 30, the motion for summary judgment is deemed **moot** with respect to the asserted claim. *See Asian & Western Classics B.V. v. Selkow*, 92 USPQ2d 1480.

Accordingly, we consider Petitioner's motion for summary judgment solely with respect to the abandonment claim.

#### **IV. The Record**

For purposes of the summary judgment motion, the evidentiary record includes the pleadings and, by rule, the file of the involved registration. Trademark Rule 2.122(b). In support of its claim that Respondent has abandoned its mark, Petitioner introduced, *inter alia*, the following exhibits:

- The Foodsmith partnership agreement between Bowen Osborn and Jamie Smith (Exhibit 1);
- Petitioner's first set of requests for admission to Respondent (Exhibit 4);
- Registrant's response to Petitioner's requests for admission (Exhibit 5);
- Petitioner's first set of interrogatories to Respondent (Exhibit 6);
- Registrant's response to Petitioner's interrogatory requests (Exhibit 7);
- Copies of email communications between Bowen Osborn and Jamie Smith (Exhibits 8 and 9); and

- The Final Award for the Arbitration decision between the parties (Exhibit 10).<sup>15</sup>

Respondent has not introduced any evidence in connection with his response to the motion. Respondent argues, however, that he has not been given the opportunity to depose Petitioner. In addition, Respondent states that “[n]one of [his] key Requests for Admission were answered directly and it is imperative to my defense to have those questions answered.” 27 TTABVUE 3.

To the extent that the foregoing statements in Respondent’s response may be construed as a request for time to take discovery under Fed. R. Civ. P. 56(d), Respondent has not properly supported his statements by an affidavit or declaration showing that he cannot, for specific reasons therein, present facts essential to justify his opposition to the motion for summary judgment. *See* Fed. R. Civ. P. 56(d); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992). Thus, Respondent has failed to support the request. In addition, a request for discovery under Rule 56(d) should be clearly made and not filed in connection with a response to the motion for summary judgment on the merits. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930 (TTAB 2015) (Fed. R. Civ. P. 56(d) motion denied as moot because party filed substantive response to summary judgment motion).

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<sup>15</sup> We note that, contrary to self-authenticating official records, the documents in Exhibits 1, 8, 9, and 10 are not self-authenticating and have not been properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(c)(4). *See* TBMP § 528.05(e). However, inasmuch as Respondent has not objected to the evidence on the basis that it cannot be presented in a form that would be admissible at trial, we have considered the Exhibits. *See* Fed. R. Civ. P. 56(c)(2) (Advisory Committee notes) (2010 amendment).

In view of the foregoing, and to the extent Respondent requests additional discovery to respond to the motion, the request is **denied** as moot. Moreover, we note that the information regarding the issue of abandonment raised in the motion is largely within the control of Respondent.

**V. Summary Judgment**

Turning to the merits of the motion for summary judgment with respect to the abandonment claim, Petitioner argues that Respondent has not used the involved mark in commerce in connection with the goods identified in the involved registration since the underlying use-based application was filed in 2013. In support of its position, Petitioner has provided Respondent's responses to Petitioner's requests for admission. Based on the responses, Petitioner argues that Respondent has admitted that he has abandoned the mark due to nonuse for at least three consecutive years. In addition, Petitioner argues that there was no license agreement between Respondent and the former partnership and that Respondent was unable to provide any evidence of such an agreement in response to Petitioner's interrogatory requests.<sup>16</sup>

In response, Respondent argues that he "let the company, Local Foods, LLC use the Foodsmith trademark through an implied license as part of doing business." 27 TTABVUE 2. Respondent states that the mark is currently in use on his website. However, because he is awaiting the outcome of the cancellation proceeding, he has "not yet used the Foodsmith trademark in commerce." *Id.*

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<sup>16</sup> 24 TTABVUE 57, 61.

In its reply, Petitioner states that Respondent has only provided conclusory assertions in his response to the motion. In addition, Petitioner points out that Respondent has not addressed the lack of evidence of an agreement to license the mark to the partnership.<sup>17</sup>

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all justifiable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). In addition, the Board may not resolve disputes of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

A party moving for summary judgment has the burden of demonstrating a particular fact is not disputed by citing to particular parts of materials in the record, including affidavits or declarations, admissions or interrogatory answers; or showing that the cited materials do not establish the absence or presence of a genuine dispute,

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<sup>17</sup> Petitioner also submitted evidence with its reply brief. Because we have denied Respondent's request for additional discovery, the evidence is unnecessary for the determination of the issues in the motion. In addition, the copy of the web page from [www.foodsmith.com](http://www.foodsmith.com) is not self-authenticating in accordance with Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). Thus, we have not considered any of the evidence submitted with the reply brief.

or that the adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c)(1). *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986).

When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden of production shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

With respect to the abandonment claim, under Trademark Act Section 45, a mark is deemed statutorily abandoned when:

its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127. Thus, if a petitioner can show three consecutive years of nonuse, it has established a *prima facie* showing that the registrant has abandoned the mark without intent to resume use. The burden then shifts to the registrant to produce evidence that it has either used the mark, or intended to resume use. *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012).

Here, Petitioner supported its allegations of abandonment with evidence that Respondent did not use the mark in commerce for at least three consecutive years. In response to requests for admission, Respondent admits that he did not use the involved mark in commerce in connection with any of the goods in the registration from 2013, the year the used-based application was filed, through 2017. 24 TTABVUE

38-43, 46-47. In addition, in his response to the motion for summary judgment, Respondent states that he has “not yet used the Foodsmith trademark in commerce.” 27 TTABVUE 3. Respondent’s admissions are sufficient to establish that he has abandoned the mark. *See ShutEmDown Sports Inc.*, 102 USPQ2d at 1042.

Respondent, as the non-moving party, has failed to provide any evidence in response to the motion that would raise a genuine dispute of material fact that the mark was in use by the former partnership through an “implied license” or that he intends to resume use of the mark. *See Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990) (to overcome *prima facie* showing, registrant must provide evidence that it discontinued use without an intent not to resume). While Respondent indicates that he intends to use the mark in commerce pending the outcome of this proceeding,<sup>18</sup> Respondent has provided no documentary evidence of his plans to use the mark in commerce and has provided no evidence to support his statement that he has used the mark on packaging and brochures for meal tastings. Thus, Respondent has failed to rebut Petitioner’s *prima facie* showing that he has abandoned the registered mark. *See Venture Out Props. LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007); *see also* Fed. R. Civ. P. 56(c)(1). (“The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the

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<sup>18</sup> We note that the Board’s authority is limited to determining the right to registration. *See* TBMP § 102.01 (June 2017). The Board is not authorized to determine the right to use a mark. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007).

record or produce additional evidence showing the existence of a genuine issue of material fact for trial.”).

In view of the foregoing, we find that, based on the record herein, Petitioner has met its burden of demonstrating that no genuine dispute of material fact exists regarding whether Respondent has abandoned the involved mark.

Accordingly, Petitioner’s motion for summary judgment on the asserted abandonment claim is **GRANTED**, summary judgment is entered on the issue of abandonment and Registration No. 4661839 will be cancelled in due course.

In view of the foregoing, the two cancellation proceedings are no longer consolidated, proceedings in Cancellation No. 92064098 will resume on a separate schedule and the Board will issue an order setting the remaining dates in the proceeding.