UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: April 12, 2013

Opposition No. 91200197
(parent case)

Sigler Companies, Inc.
v.
TSDC, LLC

Opposition No. 91201807
Opposition No. 91201812
Opposition No. 91201815
Opposition No. 91201819
Opposition No. 91201820
Opposition No. 91201821
Opposition No. 91201822
Opposition No. 91201825
Opposition No. 91201826

TSDC, LLC
v.
Sigler Companies, Inc.

Before Bucher, Zervas and Bergsman,
Administrative Trademark Judges.

By the Board:

In parent Opposition No. 91200197, TSDC, LLC ("TSDC") filed an application to register the mark FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER (standard characters; CLUB disclaimed) for the following International Class 45 services:

> organizing and providing an on-line support group for those who suffer or are affected by ailments and life-threatening diseases.[1]

[1] Application Serial No. 85022163, filed April 23, 2010 based on a bona fide intent to use the mark in commerce pursuant to Trademark Act 1(b), and asserting a date of first use anywhere

Sigler Companies, Inc. ("Sigler") opposes registration on the ground of priority and likelihood of confusion under Trademark Act Section 2(d), asserting common law rights in the mark FIGHT LIKE A GIRL for

> charitable fundraising services, manufacture and sale of apparel and merchandise, retail store services, marketing services, public relations services, creative services, printing services, and publishing services.

See notice of opp., para. 3.

Sigler filed a motion pursuant to Fed. R. Civ. P. 56, seeking summary judgment on the following issues with respect to priority:

1) TSDC cannot rely on any alleged use prior to its formation in April 2010;

2) TSDC is not entitled to tack alleged use of the mark I FIGHT LIKE A GIRL. WANNA SEE? onto any use of FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER or FIGHT LIKE A GIRL.

Sigler also seeks summary judgment on the following:

> TSDC's opposed application is void ab initio because it was filed by TSDC, which was not entitled to use the mark as of the April 23, 2010 filing date.

The motion for summary judgment has been fully briefed.

Analysis

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or

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and date of first use in commerce of May 12, 2010 pursuant to the July 8, 2010 filing of an amendment to allege use.

is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Products,* 25 USPQ2d at 2029. *See also* TBMP § 528.01, and cases cited therein.

TSDC's reliance on use prior to April 2010

Sigler seeks summary judgment on the issue that TSDC cannot rely on any use of its mark prior to April 1, 2010. It bases this primarily on a portion of an interrogatory response made by TSDC which reads: "On September 27, 2011, Sandy Ellis transferred all her intellectual property rights, including all goodwill attached thereto, to TSDC, LLC, effective as of the date of its formation, April 1,

2010." (supplemental response to Interrogatory No. 44). Sigler argues two main points, namely, that 1) the purported assignment is a verbal, nunc pro tunc assignment that is invalid because Ellis did not actually intend to transfer rights in the mark to TSDC as of April 1, 2010, and 2) subsequent to the purported assignment, Ellis continued to assert rights in the mark. In support of this, TSDC notes that *both* Ellis and TSDC filed three proceedings subsequent to April 1, 2010, namely, 1) a civil action filed September 14, 2010 in the United States District Court for the Northern District of Ohio, against a third party, asserting rights in the marks FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER and FIGHT LIKE A GIRL CLUB; 2) Opposition No. 91197393 filed on November 15, 2010, against a third party, asserting rights in the marks FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER and FIGHT LIKE A GIRL CLUB; and 3) a civil action filed November 11, 2011 in the United States District Court for the Middle District of North Carolina, against a third party, asserting rights in FIGHT LIKE A GIRL.

For its part, TSDC argues that it is a small business run solely by Ellis as its sole principal, that the assignment is valid, that there never was a change in control over the quality of the services whether they were provided by TSDC or by Ellis, and that there has been a complete continuity of exclusivity of ownership, as well as unity of control relative

to TSDC's use of the mark. Under Ellis' declaration, TSDC introduces an undated written assignment (which was not previously produced during discovery), the substance of which sets forth an assignment from Ellis to TSDC, "effective April 1, 2010 … of all right, title and interest in and to the common law trademark and service mark rights relating to 'FIGHT LIKE A GIRL'" (Ellis Decl., para. 3). In her declaration, Ellis also states that TSDC's use of its marks was at all times at Ellis' direction, that TSDC was entitled to use the mark at all times, and that the mark at issue – FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER – was not affected by the assignment and was always the property of TSDC. Ellis also states that she filed the proceedings against the third party in the name of both herself and TSDC on the advice of her counsel.

With the submission of Ellis' declaration and the written assignment document alleged to have been located subsequent to Sigler's filing of its summary judgment motion, TSDC has put forth evidence which, at a minimum, raises a genuine dispute with respect to the validity of the alleged assignment of rights in the mark. There are, at a minimum, genuine disputes with respect to the factual issues of when any verbal assignment took place, when the assignment that is now of record was reduced to writing, and the nature and circumstances of the relationship between Ellis and TSDC vis-à-vis the mark

FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER surrounding the time of the assignment.

Tacking

Sigler's seeks summary judgment on the issue of tacking, specifically requesting judgment that TSDC cannot tack use of the mark I FIGHT LIKE A GIRL. WANNA SEE? to use of the marks FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER or FIGHT LIKE A GIRL. Sigler also notes that TSDC did not plead the affirmative defense that it plans to rely on use of the mark I FIGHT LIKE A GIRL, WANNA SEE? to prove its first and prior use of the applied-for mark.

In response to the motion, TSDC states that nowhere in the record is there any indication that it asserts the existence of the mark I FIGHT LIKE A GIRL. WANNA SEE? TSDC opines that Sigler's argument is based merely on TSDC's production in discovery of a catalog image of a t-shirt bearing the wording I FIGHT LIKE A GIRL. WANNA SEE?

Turning to the merits of the motion, Sigler is correct that on the present record, TSDC did not plead tacking, and may not rely on an unpleaded tacking doctrine. *See The H.D. Lee Co., Inc. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008). If TSDC seeks to rely on tacking of use of the mark I FIGHT LIKE A GIRL, WANNA SEE?, or of any other mark, it is be required to specifically plead the matter so as to put Sigler on notice that Sigler must prove priority predating the

priority date that TSDC would attempt to prove through tacking. *The H.D. Lee Co., Inc. v. Maidenform, Inc.*, 87 USPQ2d at 1720.

Accordingly, on the present record, Sigler's motion for summary judgment on this issue is denied inasmuch as it concerns an issue that is not pleaded in the case. Moreover, the parties are advised that, if tacking were pleaded, the summary judgment motion would likely have been granted inasmuch as the marks are not legal equivalents. The standard for tacking is very strict, and tacking in general is permitted only in "rare instances." *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1635 (TTAB 2007), *citing Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1869 (Fed. Cir. 1991).

Application is void ab initio

A party may not obtain summary judgment on an issue that has not been pleaded. Fed. R. Civ. P. 56(a). *See also* TBMP § 528.07(a). Sigler did not plead as a ground for opposition that the application is void ab initio, and did not move to amend its pleading to assert the ground. Nevertheless, the parties, in briefing the motion, have treated the unpleaded issue on its merits, and TSDC did not object to the motion on the basis that the ground is unpleaded. Accordingly, the Board deems the pleadings to have been amended, by agreement of the parties, to allege the ground for purposes of summary judgment, but not for trial.

Sigler predicates its argument that the application is void ab initio on its position that, because the alleged assignment is invalid, TSDC was not the owner of the mark and thus was not entitled to use the mark when it filed the application.

As we note above, there are genuine issues of fact that remain for trial relevant to the validity of the alleged assignment. These same unresolved issues of fact preclude us from finding on summary judgment that Sigler is entitled to judgment as a matter of law that the applicant was void ab initio.

Accordingly, Sigler has failed to meet its burden of demonstrating a lack of genuine dispute with respect to its claim that the application is void ab initio. Accordingly, its motion for summary judgment is denied.[2]

Schedule

Proceedings are resumed. Discovery, disclosure and trial dates are reset as indicated below:

Expert Disclosures Due	May 13, 2013

[2] Any evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, e.g., Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993).
The fact that we have identified certain issues in dispute in denying portions of opposer's summary judgment motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

Discovery Closes	June 12, 2013
Plaintiff's Pretrial Disclosures due [parent case]	July 27, 2013
30-day testimony period for plaintiff's testimony to close [parent case]	September 10, 2013
Defendant's Pretrial Disclosures [non-parent cases]	September 25, 2013
30-day testimony period for defendant [parent case] and plaintiff [non-parent cases] to close	November 9, 2013
Defendant's [non-parent cases] and Plaintiff's [parent case] Rebuttal Disclosures Due	November 24, 2013
30-day testimony period for defendant [non-parent cases] and rebuttal testimony for plaintiff [parent case] to close	January 8, 2014
Plaintiff's Rebuttal Disclosures [non-parent cases] Due	January 23, 2014
15-day rebuttal period for plaintiff [non-parent cases] to close	February 22, 2014

BRIEFS SHALL BE DUE AS FOLLOWS:

Brief for plaintiff [parent case] due	April 23, 2014
Brief for defendant [parent case] and plaintiff [non-parent cases] due	May 23, 2014
Brief for defendant [non-parent cases] and reply brief, if any, for plaintiff [parent case] due	June 22, 2014
Reply brief, if any, for plaintiff [non-parent cases] due	July 7, 2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after

completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.