UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

LMS

Mailed: October 8, 2004

Opposition No. **91158079**

Inspiration Software, Inc.

v.

Roy, Debra E.

Before Simms, Hanak and Bottorff
Administrative Trademark Judges

By the Board:

An application has been filed by Debra Roy for the mark INSPIRINGS for "preprinted cards bearing sayings, prayers or motivational messages sold individually or as a set and capable of being assembled or bound together" in Class 016.[1] The application has been opposed by Inspiration Software, Inc., claiming priority of use and ownership of two federal registrations for INSPIRATION for computer programs and computer education.[2] Opposer alleges that applicant's use

[1] Serial No. 76458575, filed October 16, 2002, alleging a bona fide intention to use the mark in commerce.

[2] Opposer claims ownership of U.S. Reg. No. 1768514, issued on May 4, 1993, renewed on April 19, 2003, for "computer programs in the field of idea development through visual diagramming, outlining and text creation" in Class 009; and U.S. Reg. No. 1864117, issued on November 22, 1994, Section 8 & 15 affidavits filed on June 30, 2000, for "computer education training" in Class 041.

of INSPIRINGS in connection with the identified goods is likely to cause confusion, mistake, or deception with its mark. Applicant denied all the salient allegations.

This case now comes up on applicant's motion for summary judgment, filed June 28, 2004. As grounds for the summary judgment motion, applicant states that because opposer has not answered her requests for admissions, such requests are deemed admitted thereby removing any genuine issue of material fact that there is likely to be any confusion between the parties' respective marks and their goods and services. In support of this motion, applicant submitted, *inter alia,* copies of the requests for admissions she served on opposer stating that they had not been responded to.

In response to the motion, opposer states that, although it has not answered the requests for admissions, there still remain genuine issues of material fact, namely, "the following LOC factors: similarity of the marks, goods/services, trade channels, strength of the mark, and applicant's intent in choosing the mark" (Brief at pp 1-2). No evidence was submitted in support of opposer's position.

If a party on which requests for admission have been served, fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of

excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and is granted by the Board. Responses to requests for admissions must be served within 30 days after the date of service. Fed. R. Civ. P. 36(a) and 37 CFR § 2.120(a).

There is no argument that opposer has not answered the requests for admissions and has not requested withdrawal or amendment of the admissions. Fed. R. Civ. P. 36(a) provides that a matter is admitted unless a response is timely served or "the [Board] on motion permits withdrawal or amendment of the admission".[3] In that opposer has not responded to applicant's requests for admissions, nor filed a motion to withdraw or amend those admissions, those matters are "conclusively established". Fed. R. Civ. P. 36(b).

We turn now to applicant's motion for summary judgment. A motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is

[3] The Board may not *sua sponte* withdraw or ignore admissions without a motion to withdraw or amend. *See American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 117, 19 USPQ2d 1142, 1144 (5th Cir. 1991). Further, a party may not be relieved of the untimeliness of its response when the reasons for failing to timely respond do not constitute excusable neglect. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990).

entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The burden of the moving party must demonstrate the absence of any genuine issue of material fact by showing "that there is an absence of evidence to support the nonmoving party's case.' *Celotex Corporation v. Catrett,* 477 U.S. 317, 325 (1986). The moving party, having met the initial burden of informing the Board of the basis for the motion requires the nonmoving party to go beyond the pleadings and designate specific facts showing that there is a genuine issue for trial. *Celotex supra* at 324.

In this case, applicant submitted in support of her motion, *inter alia*, a copy of the requests for admissions sent to opposer, photocopies of opposer's registrations and a printout from the USPTO TESS database of third-party marks. Opposer has not submitted any evidence in support of its assertion that there are genuine issues of fact.

Opposer argues that applicant's motion fails because there is "no testimonial support for its assertion that there are no genuine issues of material fact" (opposing brief at p. 2); that opposer disagrees with the assertion that its admissions are deemed admitted because applicant's attorney "has not communicated with opposer's counsel"[4]

[4] There is no burden on applicant to contact opposing counsel outside the context of a motion to compel. Opposer's duty to cooperate operates under the Federal Rules of Civil Procedure. Applicant has chosen not to file a motion to compel, but rather a motion for summary judgment. It is further noted that discovery

(*id.*); and that all of the likelihood of confusion factors are still genuine issues of material fact to be determined.

At the outset, opposer is advised that for purposes of summary judgment, an admission to a request for admission will be considered by the Board if a copy of the request for admission and the admission, or a statement that the party from which an admission was requested failed to respond thereto, is submitted. 37 CFR § 2.127(e)(2). Thus, viewing the evidence of record, namely the admissions, and any inferences which may be drawn from the underlying undisputed facts in the light most favorable to opposer, applicant has established: (1) that the marks as used by the parties, in connection with the identified goods and services, are different (R/A 15); (2) that the marks themselves are different, in appearance and meaning (R/A 4, 5, 6, and 14); (3) that the goods and services sold under the marks are different (R/A 1, 8, 9 and 10); (4) that the respective goods and services offered under the marks are unrelated (R/A 8); and (5) that the goods and services are sold in different channels of trade (R/A 11).

On the other hand, opposer has failed to demonstrate that there are genuine issues of material fact and that applicant is not entitled to judgment. *See Olde Tyme Foods*

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closed on April 27, 2004 and opposer has provided no reason for its failure to cooperate.

Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board agrees that there are no genuine issues of material fact to be determined. As stated by the Supreme Court in *Celotex:*

> The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be 'no genuine issue as to any material fact', since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.

Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986).

Even if we were not to consider the deemed admissions for failure of opposer to respond, we would find that there are no genuine issues of material fact, that is, there is no genuine issue that the respective marks are different in sound, appearance and meaning; and that there is no genuine issue that the respective goods and services (preprinted cards vs. computer programs and computer education services) are very different and would be offered in completely different channels of trade to different classes of purchasers.

Accordingly, applicant's motion for summary judgment is hereby granted. The opposition is hereby dismissed with prejudice.

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