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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

omelko

Mailed: November 19, 2003

Opposition No. 91101602

CHOSEN SONS OF GOD MOTORCYCLE
CLUB MINISTRIES

v.

SONS OF GOD MOTORCYCLE CLUB
MINISTRY, INC.

Before Simms, Hohein and Hairston,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of opposer's motion (filed May 9, 2003) for summary judgment, to which applicant has filed a response; and applicant's cross-motion (filed June 5, 2003) for summary judgment, to which opposer has not filed a response.

Summary judgment is an appropriate method of disposing of a case or a claim in which there are no genuine issues of material fact in dispute, thus leaving the case or claim to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual

dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter 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), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence 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 (Fed. Cir. 1993), and *Opryland USA, supra*.

It is well established that each party, in regard to its own motion for summary judgment, bears the burden of showing the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett, supra*. In assessing each motion, the evidence must be viewed in a light 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., supra*; *Opryland USA Inc. v. Great American Music Show Inc., supra*; and *Olde Tyme Foods Inc. v. Roundy's Inc., supra*.

The mere fact that both parties have filed motions for summary judgment does not necessarily mean that there are no genuine issues of material fact, and that trial is

unnecessary. See *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); and Vol. 10A Wright, Miller & Kane, *Federal Practice & Procedure: Civil 3rd*, § 2720 (1998).

As background, we note that Chosen Sons of God Motorcycle Club Ministries (hereafter "opposer") has opposed the application of Sons of God Motorcycle Club Ministry, Inc. (hereafter "applicant") to register the mark shown below,



as a collective membership mark "to indicate membership in a motorcycle club ministry."¹ As grounds for opposition, opposer has alleged that it was the first to use the mark that is the subject of the involved application; that it has

¹ Serial No. 74563551 filed August 19, 1994 claiming first use and first use in commerce of March 1976. The phrase "SONS OF GOD MC" and the representation of Jesus Christ are disclaimed apart from the mark as shown.

registered "the design embodied in said mark" with the U.S. Copyright Office; that it has filed an application to register a virtually identical mark, namely CHOSEN SONS OF GOD MC NEW JERUSALEM and design (Serial No. 74/639,235); that it has used this mark continuously since 1984 in connection with its ministerial services; and that applicant's use of the applied-for mark is likely to cause confusion, mistake or to deceive. Opposer has further alleged that applicant committed fraud "by falsely attempting to pass itself off as the Ohio corporation formerly operating under the name Sons of God Motorcycle Club Ministries"; and that the "applicant has committed fraud on the Patent and Trademark Office by claiming a false date of first use." In its amended answer, applicant denied the salient allegations of the opposition and asserted the affirmative defense of *res judicata* based on a judgment entered in a civil action involving the parties. Applicant admitted that it set forth an incorrect date of first use in its application and stated that it first used the mark in 1981.

On March 21, 2003, the Board, among other things, denied applicant's prior motion for summary judgment in which applicant maintained that opposer lacks standing to proceed in this case by virtue of the final decision of the U.S. District Court of the Southern District of Ohio.

In its decision in favor of applicant, issued June 21, 1999, the United States District Court for the Southern District of Ohio, Western Division at Dayton specifically referenced Article X, §A of applicant's by-laws, which states as follows:

"Colors. Men's colors will consist of a five piece back patch; top rocker, two bottom rockers, MC and center patch. Top rocker will be dark maroon background with white border and white "Old English" letters stating "SONS OF GOD." Bottom rocker will be the same as top with the letters stating "NEW JERUSALEM." The M.C. patch will also be white on dark maroon. Center patch is a large gold and black Jesus head on a gold background." (Page 4 of the order.)

The court further noted that:

"[t]he parties have heretofore stipulated that [applicant] has all intellectual property interests (copyright and/or trademark) in the corporate colors which are more fully described in Article X, §A of the original By-Laws and at Article XII, §A of the Constitution and By-Laws adopted at the November, 1994 national meeting." (Page 11 of the order.)

The court then found that:

"[a]ll right, title, and interest in and to the colors, including any copyright and/or trademark interests, are, and always have been, the property of [applicant]. (Page 12 of the order.)

The court then permanently enjoined opposer from:

"using the colors in any way without express written permission from [applicant]" (Page 12 of the Order.)

In the penultimate paragraph of the order, the court stated:

"This is not a final appealable order because there may be additional damages issues. Counsel for each of the parties shall file with the Court, not

later than July 6, 1999, a statement of any remaining issues they believe require trial."

Applicant has submitted, with its cross motion for summary judgment, a paper entitled "Judgment in a Civil Case" with the stamp of Kenneth J. Murphy, Clerk for the United States District Court for the Southern District of Ohio, Western Division at Dayton, and dated August 2, 1999, which states:

"X DECISION BY THE COURT: This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that [applicant] is awarded damages in the amount of fifty dollars and no cents (\$50.00)"

We will first dispense with opposer's motion for summary judgment in which opposer asks the Board to grant:

summary judgment in opposer's favor dismissing the applicant's application and granting opposer's application. The ground for granting this motion is the applicant's answer to the discovery interrogatory mailed on April 29, 2003. Opposer's motion is supported by this memorandum and based on the United States District Court for the Southern District of Ohio Western Division of Dayton's decision that the applicant's colors were the ones described in their corporate constitution and also two Trademark Trial and Appeal Board Judges decisions that the applicant's application mark and the applicant's corporate constitution mark are not the same, along with the opposer's stipulation that the mark in the corporate constitution belongs to applicant. The applicant has shown no ownership to the mark in the application and still claims it to be the same mark as shown in their corporate constitution and to be made by the same person at the same time.

Included with other exhibits of things already of record in this proceeding,² is a copy of applicant's responses to opposer's interrogatories. None of the responses have any bearing on the issue before us, that is, whether the court decision was specifically referring to applicant's applied-for mark when the term "colors" was used.

It appears that opposer is arguing that because the Board did not grant summary judgment in favor of applicant, opposer is entitled to judgment. Opposer is wrong. In order to prevail on a motion for summary judgment, the movant must persuade the Board that there are no genuine issues of material fact and that the movant is entitled to judgment as a matter of law. In denying applicant's motion for summary judgment, the Board merely found that there was at least a genuine issue of material fact requiring that the parties proceed to trial. We conclude that opposer has not met the burden it assumed when it moved for summary judgment, that is, it has not shown it is entitled to judgment as a matter of law.³

² Filing copies of previously submitted documents should be avoided because of the administrative burden they impose on the Board. *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021 (TTAB 1998).

³ Prior to filing its motion for summary judgment, opposer filed a document entitled "Opposer's Proposed Findings of Fact and Conclusions of Law" which the Board has considered for no other purpose than as support for opposer's motion for summary judgment.

We turn now to applicant's motion for summary judgment. Opposer has filed no response and, upon further review, the Board finds that it is clear from the court decision and applicant's by-laws that applicant is entitled to summary judgment in its favor. Furthermore, applicant has provided declarations of two of applicant's officers concerning the use of the applied-for mark, including an exhibit showing the applied-for mark in *The Christian Biker News*, with the date of August 1986.

The Board now finds that there is no genuine issue of fact that the court determined that applicant owned the "colors" that were described in applicant's by-laws; and that the description of the "colors" in applicant's by-laws is the same as applicant's applied-for mark. Since the court has determined that applicant is the owner of the "colors," the "colors" do in fact describe applicant's mark herein sought to be registered, and opposer was enjoined from using the "colors," opposer cannot prevail on its claim of priority of use and likelihood of confusion. Because the court has determined that applicant owns the mark and has enjoined opposer from ever using the applied-for mark without applicant's express written permission, opposer's claim of priority of use, a necessary element of its claim of priority of use and likelihood of confusion, fails.

Moreover, opposer cannot prevail on its claim of fraud, either. Essentially, opposer alleges that applicant has committed fraud on the Patent and Trademark Office by falsely attempting to pass itself off as the Ohio corporation formerly operating under the name Sons of God Motorcycle Club Ministries; that applicant formed a "copycat club" in April of 1994; that applicant has never exercised control of the Ohio corporation; that applicant was aware at all relevant times that opposer used the mark in interstate commerce to represent its services; and that applicant's claim of March of 1976 as its date of first use is inaccurate and fraudulent. With respect to the issue of ownership of the applied-for mark, the court has determined that applicant, not opposer, has rights in this mark. With respect to applicant's claimed dates of use, applicant, in its amended answer has indicated that the dates of use claimed in the application were incorrect.

In view thereof, opposer's motion for summary judgment is denied; applicant's cross motion for summary judgment is granted.

Applicant is allowed **thirty days** from the mailing date of this order to submit an amendment to its dates of use reflecting those set out in its amended answer. The amendment must be supported with an affidavit or declaration under Trademark Rule 2.20. See Trademark Rule 2.71(c).

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Since the amended dates are subsequent to those previously claimed in the application, the mark will be republished for opposition. See TMEP § 1505.01(d).

Once applicant has filed its properly supported amendment to its dates of use, the opposition will be dismissed with prejudice.