

Goodman

**THIS OPINION IS NOT
A PRECEDENT OF
THE T.T.A.B.**

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

Mailed: May 27, 2008

Opposition No. 91176664

COMPX INTERNATIONAL INC.

v.

Robert Walter Harvey

Before Hairston, Kuhlke and Ritchie de Larena,
Administrative Trademark Judges.

By the Board:

Applicant Robert Walter Harvey has applied to register the mark COMPX in standard character form, for "computational modeling services for use in a variety of physical processes; development and custom design of computer software" in International Class 42.¹

Registration has been opposed by opposer CompX International Inc. on the grounds of descriptiveness and deceptive misdescriptiveness. Opposer has pleaded ownership of five COMPX and COMPX formative marks for goods in International Classes 6, 9 and 20.²

¹ Application Serial No. 78859637, based on intent-to-use.

² Plain copies of the registrations were attached as exhibits to the notice of opposition. They are as follows: Reg. No. 2681063 for "locks, latches, catches, bolts, keys, key blanks and cabinet door slides and hinges, work station and table support mechanisms and drawer slides all made of metal" in International Class 6 and for "computer furniture hardware; namely, mouse support

In its answer, applicant denied the salient allegations of the notice of opposition.

This case now comes up on opposer's motion, filed December 19, 2007, for sanctions, or alternatively for summary judgment or alternatively, to compel³, and applicant's cross-motion for summary judgment, filed January 14, 2008.

We turn first to the parties' cross-motions for summary judgment.

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). All reasonable inferences must be drawn in favor of the nonmoving party. The mere fact that cross-motions

platforms, keyboard platforms and keyboard support arms" in International Class 20.
Reg. No. 2169134 for "locks, latches, catches, bolts, keys, key blanks and drawer slides, all of metal" in International Class 6 and "computer furniture hardware, namely, keyboard support arms" in International Class 20.
Reg. No. 2841552 for "locks, latches, catches, bolts, keys, key blanks and cabinet door slides and hinges, work station and table support mechanisms and drawer slides all made of metal" in International Class 6 and "computer furniture hardware; namely, mouse support platforms, keyboard platforms and keyboard support arms" in International Class 20.
Reg. No. 3133472 for "computer accessories, namely, computer keyboard arms and support platforms, mouse support platforms, monitor bases, CPU holders, and laptop lockers" in International Class 9.
Reg. No. 3034053 for "electronic locks, namely, electronic locks that interface with and/or employ solenoid and/or motor-driven latches, and/or for electronic locks that maintain an operations audit trail that includes date, time, user name, and/or access attempt information" in International Class 9.

for summary judgment on an issue have been filed does not necessarily mean that there are no genuine issues of material fact, and that trial is unnecessary. See TBMP Section 528.01 (2d ed. rev. 2004) and cases cited therein.

Opposer's motion for summary judgment is based solely on its position that no genuine issues of material fact exist as to its descriptiveness claim due to its requests for admissions being deemed admitted by virtue of applicant's failure to serve responses thereto.

Admissions obtained by Fed.R.Civ.P. 36 may form a proper basis for summary judgment if there are no genuine issues as to any material fact. 8A Charles A. Wright, Arthur R. Miller & Richard L. Marcus, *Federal Practice and Procedure* Section 2264 (2d ed. 1994). However, in order for admissions to form the basis for summary judgment, those facts deemed admitted must be directed to the essential allegations of the case. See e.g., *M.L.E. Music v. Kimble, Inc.*, 109 F.Supp.2d 469, 472 (S.D.W.Va. May 23, 2000) (when essential allegations in a case have been admitted, summary judgment is proper).

A review of opposer's request for admissions reveals that even if these requests are deemed admitted, they do not concede or reduce the factual questions at issue in this

³ Opposer also seeks a 90-day extension of the discovery and testimony periods in the event that its motion for sanctions or alternative motion for summary judgment is denied.

matter inasmuch as the requests do not prove any of the essential elements of opposer's descriptiveness claim. Accordingly, applicant cannot be deemed to have admitted all material facts in dispute via opposer's request for admissions. Inasmuch as genuine issues of material fact remain with regard to the descriptiveness claim, opposer's motion for summary judgment is denied.

We now turn to applicant's motion for summary judgment which we construe as a motion for summary judgment based on opposer's lack of standing.⁴

Applicant has argued that "CompX International's business is sufficiently different from APPLICANT'S" stating that "R.W. Harvey and his group of scientists . . . obtain funding for performance of fusion energy research under the name CompX" and that "[i]n CompX business, there is no conflict at all with CompX International . . . APPLICANT performs computational modeling, and OPPOSER represents a manufacturing company. The businesses are very different."

⁴ In paragraph 10 of his answer applicant alleges: "There is no potential for OPPOSER and APPLICANT to be competitors. OPPOSER shows no experience in computational modeling of various physical processes performed by APPLICANT nor is it a logical extension of its business. Applicant has no background or connection with OPPOSER'S type of business. There is no potential whatsoever that OPPOSER and APPLICANT will be competitors." In paragraph 24 of its answer applicant alleges: "No damage accrues to OPPOSER since there is no potential for COMPX INTERNATIONAL taking up a competing position. OPPOSER is involved in a very different business, nor would it be plausible for it to extend into computational modeling of physics [sic] processes."

In response, opposer argues that applicant's motion for summary judgment should be denied as it appears to be based on likelihood of confusion and "any such issue is totally moot" because the opposition does not include such a claim.

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case, *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). 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.

To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the opposition. *Ritchie*, 50 USPQ2d at 1023. Facts regarding the legitimate personal interest are a part of the plaintiff's case and must be proved. *Lipton Industries*, 213 USPQ at 189. With regard to a Section 2(e) descriptiveness or misdescriptiveness claim, opposer needs to show that "it is engaged in the manufacture or sale of the same or related goods as those listed in the defendant's involved application or registration and that the product in

question is one which could be produced in the normal expansion of plaintiff's business; that is, that plaintiff has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively in its business." *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

Opposer has failed to address the issue of standing in its motion papers and thus has not demonstrated the existence of any genuine issue of material fact as to standing. On this basis alone, summary judgment is appropriate. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986) ("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"); *Coup v. Vornado Inc.*, 9 USPQ2d 1824 (TTAB 1988) (petitioner's failure to prove standing warrants grant of summary judgment for respondent).

Additionally, we conclude that even if opposer's silence did not operate as a concession of lack of standing, there are no genuine issues of material fact that opposer has no standing to oppose.

In this case, opposer, in the notice of opposition, has pleaded ownership of registrations for its COMPX marks that relate to electronic locks or metal locks, latches, bolts, and keys and the like as well as computer furniture hardware or computer accessories such as mouse support platforms, keyboard support platforms and keyboard support arms. Paragraphs 5-9; exhibits A-E, notice of opposition. Opposer also alleges that "[a]pplicant is at least a potential competitor of Opposer." Paragraph 10, notice of opposition.

Applicant's services are identified as "computational modeling services for use in a variety of physical processes; development and custom design of computer software" and applicant's discovery responses⁵ indicate that applicant provides highly specialized computational modeling and custom development of computer software in the field of physics:

CompX is a consulting group comprised of a project director and several physicists who focus on

⁵ We find that applicant's December 17, 2007 correspondence, which was a response to opposer's November 13, 2007 correspondence regarding outstanding discovery, is partially responsive to opposer's discovery requests, particularly to Opposer's First Set of Interrogatory nos. 20, 29 and 30 and at least some of opposer's requests for production. With regard to the requests for production, applicant has stated "[w]ith regard to notes in our patent application folder from the time we originally applied for the CompX service mark in 1995, there are none." This correspondence was an exhibit to opposer's combined motion and was also filed with the Board on December 18, 2007. Applicant provided additional discovery responses (i.e., documents) in his cross-motion for summary judgment and response to opposer's combined motion which are responsive at least to opposer's request for production nos. 7, 8, 10, 24, 29, and 32.

computational modeling of the auxiliary heating of magnetic confinement, fusion energy and plasma devices. We are engaged in long term development and upgrading of computer modeling codes which give phase-space distributions of electrons and ions resulting from rf wave and plasma sources in toroidal magnetic confinement devices. These comprehensive physics-based models have proven useful for the interpretation and projection of plasma heating, current drive, and particle source experiments in tokamak, spherical tokamak and reverse field pinch plasmas.⁶

We find that there is no genuine issue of material fact that opposer is not currently engaged in providing "computational modeling services for use in a variety of physical processes; development and custom design of computer software." Additionally, we find that there is no genuine issue of material fact that opposer's electronic locks, metal locks, latches, bolts, keys, key blanks, drawer slides, cabinet door slides, mouse support platforms, keyboard support platforms and keyboard support arms and applicant's identified services are not similar nor competitive. We also find that there is no genuine issue of material fact that the goods currently provided by opposer are not logically related to applicant's identified services nor would they be part of the natural or normal expansion of opposer to extend its business from its current products to applicant's identified services. Therefore, we find, based on the evidence of record, that there is no genuine issue of material fact that the parties are not competitors nor are

⁶ Applicant's partial discovery response as set forth in his

they potential competitors. *Compare Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003) ("On this record, we cannot conclude that petitioner is . . . "in a position" to use (or have the right to use) the Bell symbol in its business, or that petitioner is engaged in any "business" at all which would give it a real interest in the outcome of this proceeding").

In view thereof, we find that there is no genuine issue of material fact and that therefore, opposer has no standing to maintain this proceeding. Accordingly, applicant's motion for summary judgment is granted on the basis of lack of standing; judgment is entered against opposer based on lack of standing; and the opposition is dismissed with prejudice.⁷

December 17, 2007 response to opposer's November 13, 2007 letter.

⁷ Opposer's motion for sanctions, alternative motion to compel, and motion to extend are moot.