

THIS OPINION IS NOT
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TTAB

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

Skoro

Mailed: May 30, 2007

Cancellation No. 92043631

ER MARKS, INC.

v.

QUARLES PETROLEUM, INC.

Before Bucher, Holtzman and Mermelstein,
Administrative Trademark Judges.

By the Board:

Quarles Petroleum, Inc. owns U.S. Reg. No. 2071555, issued on June 17, 1997, on the Principal Register for the mark QCARD and design for "credit card services" in Class 36.

On August 16, 2004, ER Marks, Inc. filed a petition to cancel the registration claiming that "respondent discontinued with the intent to abandon, use of the mark..."; that "respondent also did not submit acceptable evidence of use of the mark Q CARD and design in commerce to support the §8 Declaration of Use filed on December 17, 2003"; and "accordingly, the registration should be cancelled under § 14 of the Trademark Act of 1946 because of respondent's abandonment of the mark and false representation of

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continued use of the mark..."; and that it "should also be cancelled for failure to file an acceptable specimen to evidence continued use within the prescribed time of the Trademark Statute" (Petition at ¶¶ 5-7). Petitioner alleges that respondent's continued registration of QCARD and design in connection with the identified services will continue to block petitioner's pending application for QCARD.

Respondent denied all of the salient allegations.

This case now comes up on petitioner's motion for summary judgment, filed September 26, 2006. As grounds for the motion, petitioner contends that respondent has abandoned its mark in that the signage used by respondent for the past 6 years, "does not reference any credit card services",¹ and (2) that respondent's failure to use the mark "as registered" for six years, *i.e.*, with the word CARD directly below the Q, also constitutes an abandonment of the mark. (Br. at 5). Petitioner concludes, based on these asserted facts, that there is no genuine issue that respondent has abandoned its mark and that the same should be cancelled. (Br. at 7, 11, 13-14).

In support of its motion petitioner has submitted documentary evidence. Petitioner admits that respondent uses the mark, but argues that its use on road signs does

¹ To the extent petitioner may be alleging no valid service mark use as a claim separate from abandonment, such claim is not available after five years. See 15 U.S.C. § 1064.

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not identify credit card services and that it uses the mark only at some of its locations, not all, and in a manner different from how the mark is shown on the certificate of registration (Br. at 4 and 5). Respondent answers that the evidence submitted by petitioner establishes good service mark use; that the Office accepted such evidence by way of specimens when it filed its Section 8 & 15 affidavits; and that its customers associate its mark with its unattended locations where only respondent's credit card holders can purchase fuel.

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences that may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471

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(Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Petitioner's ground of attack on the subject registration, to the extent we can understand it, is abandonment, and it is presented in a twofold argument: (1) that the signage used by respondent for the past six years, does not show use of the mark in connection with credit card services, *i.e.*, that the mark is not used on credit cards themselves and the signs do not contain a reference to those services; and (2) that respondent's failure to use the mark as registered for six years, *i.e.*, with the word CARD directly below the Q, constitutes an abandonment of the mark.

Petitioner's claim of abandonment based on the asserted failure of the signage to show service mark use is not a valid claim. The examples of signage that petitioner is challenging are the same as those submitted by respondent as specimens in connection with the filing of its Section 8 and 15 affidavits. Thus, by this claim, petitioner is essentially arguing that the specimens of use are unacceptable. However, the question of whether the signage would constitute an acceptable specimen of use, is solely an *ex parte* examination issue and does not constitute a valid ground for cancellation. See *Saint Gobain Abrasives Inc. v. Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1359

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(TTAB 2003); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000); and *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). The Office has accepted the photographs of the signage as good service mark use for the identified services.² See *In re Royal Viking Line A/S*, 216 USPQ 795, 796 (TTAB 1982).

Additionally, we find no merit in petitioner's argument for finding abandonment simply because the record does not show that the mark is used directly on the credit cards themselves. We are unaware of any requirement that a provider of credit card services must demonstrate use of its mark on the credit card itself.

Furthermore, petitioner's arguments on the merits of good service mark use are not well taken. Petitioner submitted evidence of respondent's current use of the mark; and the evidence shows use of the mark in connection with fueling services that are accessed by use of a credit card. There is agreement that respondent's mark is in current use and that such use is on signage associated with the use of a credit card to obtain fuel.³ Thus, based on the undisputed facts, we find that there is no genuine issue of material

² Photographs of the mark used on signage were submitted to the Office as specimens in support of its application and its Section 8 & 15 affidavits and were accepted as good service mark use.

³ See Petitioner's Exhibit 4, Natvig Deposition at p.10, lines 12-15 and p. 26, lines 18-24.

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fact that respondent's use of the mark identifies its credit card services.⁴

As to petitioner's argument that respondent does not always use the mark in the same manner as it was registered, and it has thus abandoned its mark, we note that the evidence petitioner submitted, *i.e.*, signage, shows use of the registered mark,⁵ or substantially the same mark⁶ on signage and the mark is used in conjunction with obtaining fuel through the use of a credit card. Despite the word "card" being moved from below the letter Q or to the right of it, it is substantially the same mark. *See Visa International Service Assn v. Life-Code Systems Inc.*, 220 USPQ 740, 743 (TTAB 1983).

Likewise, whether respondent uses a different mark (or a different version of the same mark) in some locations is irrelevant. As long as the registered mark is in use, there is nothing that prevents a respondent from using other marks or other versions of the registered mark elsewhere. The Board finds that there is no genuine issue as to any fact that would be material to the issue of abandonment, and that

⁴ In the Natvig deposition, Mr. Natvig, when asked to describe the signage, attested: "This is a sign to let people who use - to identify that this is a Quarles Fuel Network location, and it's for the use of people who carry the fuel card only, and that if they need any information about the site, we give them a number, an 800 number, toll-free number for them to call". (Natvig dep. At p.26, ll. 18-24).

⁵ Photo dated 10/06/05 provided as Exhibit 4 to Natvig Dep.

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respondent is entitled to judgment on this issue as a matter of law.

The Board thus finds that while petitioner, the moving party, is not entitled to summary judgment, respondent, the non-moving party, is so entitled on the issue of abandonment. In such circumstances, the Board may enter the proper judgment, although a cross-motion therefor was not made. Rule 54(c) of the Federal Rules gives the Board the power to enter final judgment to which the prevailing party is entitled, even if the party has not demanded such relief. *See Missouri Pacific Railroad Co. v. National Milling Co., Inc.*, 409 F.2d 882 (3rd Cir. 1969).

Therefore, because the Board finds that there is no genuine issue of material fact regarding abandonment, and because respondent is entitled to judgment as a matter of law on this issue, petitioner's motion for summary judgment is denied, and summary judgment in favor of respondent is hereby entered. The petition to cancel is dismissed with prejudice.

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⁶ Photo dated 10/11/05 provided as Exhibit 4 to Natvig Dep.