

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X		
SIGLER COMPANIES, INC.,	:	
	:	
Opposer,	:	
	:	Opposition No. 91200197
v.	:	
	:	
TSDC, LLC,	:	
	:	
Applicant	:	
-----X		

**BRIEF IN OPPOSITION TO
SIGLER’S MOTION FOR SUMMARY JUDGMENT**

Applicant TSDC, LLC (“TSDC”) submits this Brief in opposition to the motion of Opposer, the Sigler Companies, Inc. (“Sigler”) for summary judgment.

TABLE OF CONTENTS

I. Introduction	1
II .Statement of Undisputed Facts	2
III. Standard for Summary Judgment	2
IV. Sigler is not entitled to Summary Judgment on the Issue of Priority	3
V. TSDC’s Assignment is Not Vitiating by Any Use of or Assertion of Rights in the Marks by Ms. Ellis	7
VI. TSDC’s Application is Not Void Ab Initio	10
VII. Sigler’s Argument against Tacking is Irrelevant Here, and is not Supported by the Law	13
VIII. Conclusion	16

I. Introduction

Sigler’s characterizations of the grounds on which it maintains it is entitled to summary judgment are misleading and self-serving. There was, it will be shown, no

“retroactive assignment,” but rather both a valid, timely formal assignment and a *de facto* unity of control for all purposes. Moreover, Sigler’s assertion that TSDC’s application is void ab initio is, itself, lacking in validity, as demonstrated below.

II. Statement of Undisputed Facts

The account of the relevant procedural facts set forth in Sigler’s motion for summary judgment is accurate, except to the extent it contains subjective characterizations of the facts. What is essential to note is that according to Sigler’s own recitations of the facts, there has been nothing less than a complete continuity, and exclusivity, of ownership and control respecting the marks in question here in only TSDC and its sole principal, Sandy Ellis. Moreover, in her Declaration submitted along with this brief, Ms. Ellis states that the marks at issue were always used by TSDC by virtue of her authorization as their original owner, regardless of how that authority was couched (¶1); that with respect to the Ohio litigation that Sigler refers to in its papers, and which it attaches as Exhibit F to its Declaration, that she was advised to sue in both her own name and in the name of TSDC but intended no derogation of the rights of TSDC (¶¶ 8-9) and that the quotations by Sigler of “her” allegations are, in fact, allegations made in those papers by all the plaintiffs collectively, one of which was TSDC; and that she has, nor has TSDC, ever claimed any rights in a trademark for the words I FIGHT LIKE A GIRL. WANNA SEE? (¶ 10).

III. Standard for Summary Judgment

Summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The Board does not resolve issues of fact on summary judgment; it only determines whether a genuine issue exists. *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 1461, 16 U.S.P.Q.2d 1055, 1056 (Fed.

Cir. 1990), *overruled on other grounds by A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1038-39, 22 U.S.P.Q.2d 1321, 1333 (Fed. Cir. 1992).

Sigler, as the party moving for summary judgment, has the burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322-37 (1986). To prevail on its motion, Sigler must establish that there is no genuine issue of fact regarding the issues at hand by clear and convincing evidence. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986). Sigler is held to a “stringent standard,” for summary judgment is “not a substitute for the trial of disputed issues of fact.” *Walters Gardens, Inc. v. Pride Of Place Plants, Inc.*, Opp’n No. 91153755, 2004 WL 1149499, at *6 (T.T.A.B. May 4, 2004) (nonprecedential) (copy attached).

For its part, in order to have the opportunity to submit proofs at trial, TSDC need only show that, on the evidence of record, a reasonable fact finder could resolve the matter in its favor. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 850, 23 U.S.P.Q.2d 1471, 1472-73 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 202, 22 U.S.P.Q.2d 1542, 1544 (Fed. Cir. 1992); *see also Visa Int’l Serv. Ass’n v. Life-Code Sys., Inc.*, 220 U.S.P.Q. 740, 742 (T.T.A.B. 1983) (on a summary judgment motion, “nonmoving party is not required to adduce evidence sufficient to prove its case . . . ”; it need only show “that there is a genuine issue as to a material fact and that, therefore, there is a need for a trial”). The evidence should be viewed in a light most favorable to TSDC as the nonmovant, and all justifiable inferences should be drawn in TSDC’s favor. *See Lloyd’s Food Prods. Inc. v. Eli’s Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 970 F.2d at 850, 23 U.S.P.Q.2d at 1472.

IV. Sigler is not entitled to Summary Judgment on the Issue of Priority

Sigler makes much of representations in pleadings and discovery as to whether TSDC has taken the position that it is “the owner” of the FIGHT LIKE A GIRL trademark or whether Sandy Ellis has, by purporting to retain some right therein, negated TSDC’s claims. Sigler’s arguments

on this point, however, are not only hyper-technical: They simply ignore the reality that this small business is essentially run by one person, has always been run by that one person, and that under the well-established “unity of control” standard applied by the Board, these technicalities are of little relevance. “[W]hether the focus is on consumer or producer, the touchstone of trademark law is use.” *Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 12 (D.D.C. 1998). As the Board explained in response to similar claims in *Airport Canteen Services, Inc. v. Farmer’s Daughter, Inc.*, 184 USPQ 622, 627 (TTAB 1974), the concern of the law is not with the form of ownership in a trademark but in the reality of its use as affects its function as a source indicator:

It is clear from the record that Mr. Guagenti has been the leading light or owner of what can be considered to be family enterprises or, if you will, corporate sales, and that, for purpose of convenience, he, at the advice of counsel or accountant, transferred ownership of his various interests to one or another of his corporations without disturbing, and that is the important fact, the continuance of operation of his different activities including that of the “FARMER’S DAUGHTER” restaurant. It is apparent that there was not nor is there any claim of adverse rights in the mark “FARMER’S DAUGHTER” by any corporation within Mr. Guagenti’s organization and that, in essence, any use of the mark by any of the corporations was for the benefit of and inured to the benefit of Mr. Guagenti.

See also, *Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1984 (TTAB 2010) (“Dr. Wiesman has been the central figure of what can be characterized as a number of research and development projects that are ultimately marketed by separate entities. ... the mark points to a single source: that is, the use of the SAVE mark was for the benefit of and inured to the benefit of Dr. Wiesman through his conglomerate”). Indeed, far from demonstrating inconsistency or a doctrinal defect compared to an idealized form of assignment or licensing agreement, the assignment referred to by Sigler only enhances TSDC’s position, for it extends this rule of reason beyond the parameters even of the unity of control test. As the Board as explained, “in some circumstances, where there is a

relationship, but perhaps not the ‘unity of control’ envisioned by the Wella doctrine, a consent from a related company may suffice.” *In re Wacker Neuson SE*, 97 USPQ2d 1408 (TTAB 2010), *citing*, *In re Sumitomo Electric Indus., Ltd.*, 184 USPQ 365 (TTAB 1974) (“the parties undoubtedly work hand-in-hand to avoid confusion in trade which would be inimical to their best interests”).

Sigler acknowledges that there is no inherent difficulty with a *nunc pro tunc* assignment of rights reflected by a “document merely reflects what actually occurred at that time.” *Redmond Products, Inc.*, CANCELLATION 22,285, 1998 WL 698407 (TTAB Sept. 18, 1998). Sigler’s quotation of and citation to *Redmond* is fortuitous, because the case bears far more similarities to the facts here than Sigler chooses to acknowledge:

In this case, while Dr. Davies and Mr. Agostinelli’s sunscreen products business was organized as a corporation, there is no question that this small business was operated solely by these two individuals. When the corporation was dissolved, the business, such as it was, was continued in an unchanged manner by, at least, Dr. Davies. . . .

There is no requirement that a formal assignment is necessary to pass a trademark or trade name from a predecessor to a successor and, when the business with which marks and a trade name were associated is transferred, the presumption is that rights to the marks and name were transferred with the business. *Stagecoach Properties, Inc. v. Wells Fargo & Company*, 199 USPQ 341, 347 (TTAB 1978), and cases cited therein. Certainly, the execution of a *nunc pro tunc* assignment was necessary to establish, in writing, a chain of title from Dagar to respondent herein for recordation with the PTO. . . .

Id. Here, too, the record on which Sigler itself relies is clear that there was never anything but continuity of use, origin and goodwill – whether before, after or even simultaneous with any attempt at formalizing some form of permission for the new corporate entity, that of applicant, to make use of and apply for registration of the trademark.

Sigler attempts, nonetheless, to analogize here to *Carson Chemical v. Trice Prods.*, 137 USPQ 457 (TTAB 1963), in which it was found that nothing in the record supported the existence of an oral agreement to make an assignment. Significantly, however, in *Carson Chemical* the Board noted – in language quoted by Sigler – “All the record discloses is that the registrant voiced no objection to applicant’s adoption and use” the mark, which “can not be construed as an oral assignment.” *Id.* at 540. How such a finding could be compared to the facts here is a puzzle. Sigler insists that despite the existence of the “alleged assignment,” Sandy Ellis continued to assert rights in the various trademarks, and that therefore, Sigler says, “There is no evidence that TSDC and Ellis actually intended (much less accomplished) a transfer of her intellectual property rights to TSDC on April 1, 2010.

In reality, Sigler’s own description of the facts comports far more with those recited in *Airport Canteen* and *Redmond* than with the totally inapposite facts of *Carson*. Notwithstanding what Sandy Ellis may have claimed in the Ohio litigation, the truth is that, as in *Airport Canteen*, “It is apparent that there was not nor is there any claim of adverse rights in the mark” by any entity with which Ms. Ellis is affiliated, “and that, in essence, any use of the mark by any of the corporations” – or by Ms. Ellis herself, under an oral license or otherwise – “was for the benefit of and inured to the benefit of” Ms. Ellis. It is this ongoing commonality and unity of ownership, use and source that makes the assignment an accurate description of what *Redmond* describes as “what actually occurred.” In contrast, the facts in *Carson* describe a situation involving entirely unrelated entities.

Here the Board is not being asked to choose between these competing readings of the cases – though if it were, it can hardly be doubted, upon close consideration of the

applicable facts, that they would, even upon the facts asserted by Sigler, favor TSDC. Rather, the question is whether the validity of the assignment from Ms. Ellis to TSDC is a proper subject for summary judgment on this record. It is not. See, e.g., *Glow Indus., Inc. v. Lopez*, 273 F. Supp. 2d 1095, 1116 (C.D. Cal. 2003) (triable issues of fact remain regarding validity of assignment);

V. TSDC’s Assignment is Not Vitiating by Any Use of or Assertion of Rights in the Marks by Ms. Ellis

In its moving brief, Sigler makes a major issue of its supposed “find” – “admissions,” via allegations in an earlier Ohio action, that Ms. Ellis claimed rights in the trademarks at issue here after the date of the assignment. This, Sigler claims, demonstrates as a matter of law that the assignment was never intended as or treated like a legitimate legal formality. But Sigler’s entire presentation of this topic is, to put it mildly, misleading, for it ignores the fact that throughout the Ohio complaint the quotations about the rights claimed by Ms. Ellis are, actually, rights claimed, for purposes of that litigation, by all the plaintiffs in that action collectively – one of whom was also TSDC. This entire section of Sigler’s brief should be ignored, if not stricken, because of the lack of candor displayed regarding this matter.

Moreover, Sigler’s tunnel-vision view of the history of these rights also ignores what would be entirely consistent with the common practice of licensing back, which is supported by Declaration of Sandy Ellis and at the very least raises a triable issue of fact. As was explained in *Visa, U.S.A., Inc. v. Birmingham Trust Nat. Bank*, 696 F.2d 1371 (Fed. Cir. 1982):

A license back of an assigned mark to enable the assignor-licensee to continue to conduct the same business or provide the same services under the mark is not a novelty. A number of courts, without discussion, tacitly have upheld the practice. E.g., *Geo. A. Hormel & Co. v. Hereford Heaven*

Brands, 341 F.2d 158, 52 Cust. & Pat.App. 1012, 144 U.S.P.Q. 493 (1965) (continued use by assignor-licensee does not affect assignee-licensor's claim to priority in opposition to registration); *Raufast S.A. v. Kicker's Pizzazz*, 208 U.S.P.Q. 699 (E.D.N.Y.1980) (license back to assignor did not mislead consumers); *Andrew Jergens Co. v. Woodbury, Inc.*, 273 F. 952 (C.D.Del.1921), *aff'd* 279 F. 1016 (3d Cir.1922); *but see Greenlon, Inc. of Cincinnati v. Greenlawn, Inc.*, 542 F.Supp. 890 (S.D.Ohio 1982) (assignment invalid when assignor continued to operate own business using mark concurrently with geographically remote use by assignee). Indeed, a leading trademark treatise, after stating that “[a]n assignment is valid even though it may reserve certain rights of use of the mark in the assignor,” suggests that “[u]sually such a situation should be handled by an assignment of the mark and good will, followed by license back to the assignor of the mark.” J. McCarthy, *Trademarks and Unfair Competition*, § 18.1(E) at 608 (1973).

Neither the Board nor Birmingham Trust has given any convincing reason for striking down this apparently well-settled commercial practice.

A license back is valid if it satisfies the conditions of validity for trademark licenses generally. **The principal requirement, and the only one here critical, is that “the licensing agreement provides for adequate control by the licensor over the quality of goods or services produced under the mark by a licensee....** The purpose of such a requirement is to protect the public from being misled.” *Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 261, 198 U.S.P.Q. 610, 613 (Cust. & Pat.App.1978).

Id. at 1376-77 (emphasis added). Significantly, whether or not there is evidence demonstrating the extent to which the licensor “has actually exercised real and effective control over the nature and quality” of the goods provided under the license it is not determinative; the burden of demonstrating that such a license relationship did not provide for adequate quality control is on the party attacking its validity. *Id.* at 1377.

Indeed, a court, faced with facts such as these will not pass on whether or not a license-back arrangement, or any license, whose existence is put in issue upon competent evidence is valid as a matter of law. As the court explained in *Doebler's Pennsylvania Hybrids, Inc. v. Doebler*, 442 F.3d 812, 824 (3d Cir. 2006), “Although it appears that there is no express written license agreement between the parties, a trademark license can

also be implied.” Thus it is not necessary for such a license-back arrangement to have been contemplated or recited in connection with the assignment itself. “It is irrelevant whether the parties thought of the arrangement at the time in terms of an implied license. The test for whether or not an implied license existed is based solely on the objective conduct of the parties.” *Villanova University v. Villanova Alumni Educational Foundation, Inc.*, 123 F.Supp.2d 293, 308 (E.D. Pa. 2000). *See also, L.F.P.IP., Inc. v. Hustler Cincinnati, Inc.*, 1:09CV0913 WOB, 2011 WL 5024356 (S.D. Ohio Oct. 20, 2011) (“whatever [assignee and assignor’s] original arrangement, it changed by mutual consent and without protest . . . and restructured the relationship between them”).

Here, of course, there is no assertion by Sigler – nor could there be, based not only on the facts of records but all reasonable inferences from them – that there is or was any change in control over the quality of goods and services whether provided by TSDC or by Sandy Ellis. “[T]he nature of the parties' relationship and conduct may evidence sufficient quality control. . . . Such a “special relationship” may exist [w]here . . . the litigants [are] closely-held business entities owned and managed by family members and which include[] a high degree of interlocking ownership and control.” *Doebler's Pennsylvania Hybrids*, 442 F.3d at 824. No “special relationship,” of course, could be more special than literal identity of principals, and Ms. Ellis happens to be the principal and sole employee of TSDC. Similarly, in a case cited by Sigler, *Tantra One LLC V Titas Inc.*, CANCELLATION 9204360, 2008 WL 1963600 (TTAB Apr. 30, 2008), the Board rejected a challenge to the chain of title to a trademark where it was “clear from the record that Mr. Singh [was] the ‘leading light’ or owner of a family enterprise engaged in the restaurant business” who had incorporated a new entity and transferred operations to them,

including the use of the service marks, without disturbing their continuous operation. Accordingly, the use of the marks . . . were for the benefit of and inured to the benefit of Mr. Singh. The determination by Mr. Singh that the ownership of the marks ultimately resides in petitioner does not create a break in the chain of title. Mr. Singh, India's Oven, Inc., and Tantra One, LLC are for all practical purposes the same entity, rendering the same services with substantially the same personnel, and therefore there has been a continuity of business operations by the entities.

Id. For these reasons it is certainly of no instance that, in other procedural contexts, Ms. Ellis herself took up the cudgel in litigation against an alleged infringer. While “only a registrant, and not a related company, can bring suit for trademark infringement under the Lanham Act . . . the term ‘registrant,’ as used in the Lanham Act, embraces ‘the legal representatives, predecessors, successors and assigns of such applicant or registrant.’ 15 U.S.C. § 1127. *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, 679 F. Supp. 2d 312, 327 (E.D.N.Y. 2010).

It cannot be said, as a matter of law for purposes of summary judgment, that Ms. Ellis could not have been, was not, or is not, any or all of those things with respect to these marks. In fact, it is obvious from the parties’ course of conduct, based on the facts of record, that a license back was, to the extent of any inconsistency of use or claims of ownership, what was intended by TSDC and Ms. Ellis – technical points of pleading and draftsmanship notwithstanding. Certainly there is no lack of triable issues on the question, and for this reason as well summary judgment is inappropriate.

VI. TSDC’s Application is Not Void Ab Initio

Sigler states that TSDC’s claim of trademark rights is is “premised entirely on a purported retroactive assignment from Sandra Ellis,” which, Sigler claims – incorrectly, as shown above – is “invalid,” but which is any case ineffective because it was not actually made until September 27, 2011, while the application for the FIGHT LIKE A

GIRL CLUB CLAIM YOUR POSER mark was filed on April 23rd of 2010. “Thus,” says Sigler, “TSDC was not entitled to use the FIGHT LIKE A GIRL CLAIM YOUR POWER mark” when it filed the application. Sigler’s formulation, however, attempts to elide the difference between ownership and **entitlement** to use. An application under §1(b) or §44 of the Act, 15 U.S.C. 1051(b) or §1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§1051(b)(3), 1126(d)(2) and 1126(e); 37 C.F.R. 2.33(b)(2).

In light of all the foregoing, as well as the evidence – certainly sufficient to raise a triable issue of fact – submitting the accompanying Declaration of Sandy Ellis, Sigler is incorrect in claiming that, as a matter of law, this application must be deemed void ab initio. Sigler acknowledges, in its Statement of Undisputed Facts, that TSDC was formed on April 1, 2010 (¶1), three weeks before it filed its 1(b) application for FIGHT LIKE A GIRL CLAIM YOUR POWER and months before it filed, on July 8, 2010, an amendment to allege us in support of conversion of the application to 1(a) status. There is no dispute, then, that the applicant existed, nor that its principal was Sandy Ellis, who – prior to the effectuation of the assignment – had complete power over the granting of licenses for its use.

Sigler, however, cites to two interrogatory answers as “proof” that the use in question, i.e., prior to the formalization of the assignment, could not have been by way of license. It claims, in ¶8, that TSDC “admits that it has never granted or been granted any license for use of the” mark, citing TSDC’s answer to Interrogatory 5, to wit:

INTERROGATORY NO. 5

Fully identify any license which has been granted to or by Applicant for use of the Mark (include parties to the license, date, duration, substance of license, and goods for which license was granted).

RESPONSE TO INTERROGATORY 5

There are no such licenses.

This might be very compelling, except for several points. One is that, based on the previous section, the doctrine of unity of control militates against reliance on such formalities. If, however, formalities are to be determinative, Sigler would do well to pay attention to its own. For in paragraph E of the Introduction and Definitions of its Interrogatories, attached as Exhibit D to the Declaration in Support of Sigler’s Motion for Summary Judgment, Sigler describes it as

not only Applicant TSDC, LLC . . . but also its predecessors, if any, persons controlling or controlled by Applicant, and its and their officers, directors, employees, agents, representatives and attorneys, to the fullest extent the context permits.

The same definition is used in Exhibit E with respect to the answer by TSDC to Interrogatory 45 concerning FIGHT LIKE A GIRL. And pursuant to that “full extent,” it was and is accurate to say that no licenses were granted “to or by Applicant” for use of the mark, because the Applicant is defined in a multiplicity of ways by Sigler to include both Ms. Ellis and TSDC.

Thus it would have made no sense to answer the interrogatory by referring to a license “from the Applicant [Ms. Ellis] to the Applicant [TSDC]” for the period prior to the memorialization of a formal assignment. And it would be preposterous to do so, under the general principles of the unity of control doctrine, and in light of the law’s recognition that the assignment was, indeed, effective because it was a mere memorialization of “what actually occurred at that time.” In any event, such considerations are so rife with factual

questions that their determination on a motion for summary judgment would be inappropriate.

VII. Sigler’s Argument against Tacking is Irrelevant Here, and is not Supported by the Law

Sigler states that TSDC may not benefit from tacking – the determination that earlier and later versions of a mark are legal equivalents, thus extending a date of first use to the original version – based on I FIGHT LIKE A GIRL. WANNA SEE? because it did not plead the same based on its earlier use of FIGHT LIKE A GIRL and FIGHT LIKE A GIRL CLUB CLAIM YOUR POWER, and that in any event tacking is not appropriate here as a matter of law. Sigler’s premise here is puzzling, to say the least, but its legal assertions regarding tacking in the

circumstances are incorrect.



The supposed basis of Sigler’s argument is that TSDC’s production, in discovery, of a catalog image of t-shirt bearing the trademark FIGHT LIKE A GIRL (Figure 1 at left), TSDC is actually seeking the benefit of what Sigler claims to believe is a different trademark altogether called I FIGHT LIKE A GIRL. WANNA SEE?

Figure 1

There is, however, nowhere in the record any indication that TSDC has ever asserted the existence of such a trademark. Figure 1 is merely a depiction of an image produced in response Sigler’s requests for documents constituting evidence of TSDC’s earliest uses of the FIGHT LIKE A GIRL trademark – it was part of the “Fight Like a Girl Collection” – and of nothing else.

Because Sigler has not explained the basis, legal or factual, on which it asserts that TSDC would treat this use as anything other than a use of FIGHT LIKE A GIRL, TSDC is at a considerable disadvantage in responding. If Sigler is suggesting that the use of other words in association with a trademark phrase empty such use of trademark significance for that phrase, and in fact constitute a different trademark, it has not cited any authority for the proposition. Nor does the law support it. For example, in *Application of E. Kahn's Sons Co.*, 343 F.2d 475, 476 (C.C.P.A. 1965), the United States Court of Customs and Patent Appeals, considering a different issue, nonetheless did not hesitate to find trademark use of the phrase THE WIENER THE WORLD AWAITED upon consideration of specimen consisting of a product package showing the phrase THE WIENER THE WORLD AWAITED “on a representation of a pennant, which is **preceded by the phrase, in much smaller type, ‘Your family will also enjoy’**” (emphasis added). There was no suggestion that the specimen could not function for the mark because of the continuity or existence of other words, i.e., that the actual mark used as THE WIENER THE WORLD AWAITED. YOUR FAMILY WILL ALSO ENJOY. For that matter, Sigler states in a footnote that it “does not concede that Ellis’ use of I FIGHT LIKE A GIRL. WANNA SEE? constitutes trademark use” – raising the question of what Sigler’s point is on this score in the first place.

In any event, even if Sigler were to be taken at its own word, however inconsistently, that the use demonstrated by Figure 1 were of the phrase described, its tacking argument would be incorrect. Certainly the distinction suggested by Sigler between use by Ms. Ellis and use by TSDC is of no effect. “It has long been the rule, codified by the Lanham Act, that after a valid assignment the assignee . . . inherits the assignor’s . . . date of first use” of a trademark. *Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 15 (D.D.C. 1998), *citing* 15 U.S.C. § 1127. As to the substance of the use, “[m]inor changes in a mark which do not change the basic, overall commercial impression created on buyers will not constitute any abandonment and will not interrupt the user’s chain of ownership back to adoption and use of the original form.” Thomas McCarthy, *McCarthy*

on Trademarks & Unfair Competition § 17:27 (4th ed.1998), quoted in *D & J Master Clean, Inc. v. Servicemaster Co.*, 181 F. Supp. 2d 821, 825 (S.D. Ohio 2002). Regarding which marks should or should not be deemed eligible for tacking, the Federal Circuit explained as follows in *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156 (Fed. Cir. 1991):

The previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark. However, for the purposes of “tacking,” even if the two marks are confusingly similar, they still may not be legal equivalents. *Id.* Instead, the marks must create the same, continuing commercial impression, and the later mark should not materially differ from or alter the character of the mark attempted to be “tacked.”

Id. at 1159 (internal quotations and citations omitted). Sigler claims that tacking is inapplicable here on various grounds, none of which is compelling. One is that the respective marks in these consolidated proceedings create commercially different impressions. Sigler cites various cases where there was no tacking permitted, but none of them is useful as a comparison here.

Sigler’s citation to *Van Dyne-Crotty* on this score is not illuminating. In denying tacking of CLOTHES THAT WORK. FOR THE WORK YOU DO to use of CLOTHES THAT WORK in *Van Dyne-Crotty*, the Court did little to explain its rationale, essentially merely concluding that the two marks differed in their commercial impressions. As Judge Newman noted in her dissent, “The appended clause does not change the commercial impression of CLOTHES THAT WORK; it is simply an explanation, a reinforcement-as is often seen in commercial usage. The appended clause does not convert CLOTHES THAT WORK into a different mark, as the panel majority holds.” *Id.* at 1161 (Newman, J., dissenting); *see also*, 3 McCarthy on Trademarks and Unfair Competition § 17:26 (4th ed.), questioning the rationale of the decision.

Sigler cites the TTAB’s refusal to permit tacking of TANTRA to TANTRA’S INDIAN OVEN in *Tantra One v. Tita’s*, *supra*. The comparison is not apt, considering the vast difference between the two TANTRA marks. The Board made this determination on the ground that, “[i]n part, the addition of the words ‘India’s Oven’ gives the mark TANTRA’S INDIA’S OVEN a connotation of cooking that is wholly absent from the mark TANTRA, *per se.*” *Id.* at *3. Sigler,

however, does not explain the differing **connotations** here that would be a bar to tacking. Tacking is permitted “where the two marks, though differing slightly in their literal meaning or grammatical presentation, nevertheless possess the same connotation in context.” *Laura Scudder's v. Pacific Gamble Robinson Co.*, 136 USPQ 418, 419-20 (TTAB 1962) (permitting tacking of t “BLUE BIRD” to use of “BLUE ROBIN”), *cited by Van Dyne-Crotty, supra*. Here, unlike the descriptive portion of the TANTRA’S INDIAN OVEN mark that is missing from the arbitrary TANTRA mark, all three marks here are relatively trivial variations on the FIGHT LIKE A GIRL core an identical message to the public: That of a defiant, even pugnacious, female spirit asserting itself in the battle against cancer, and fighting – evoking the uniquely militant and passionate concept of “fighting like a girl.” In the case of each mark, it is the FIGHT LIKE A GIRL “trope” or concept that predominates. Even under the standard of *Van Dyne-Crotty*, the commercial impression here is not altered by the addition of these additional words.

Sigler’s “tacking” argument is a true straw man, and by all indications nothing more than an attempt to utilize a preposterous theory – a claim that TSDC is seeking to tack onto trademark rights in mark it never claimed existed – as a way of eliminating damaging evidence regarding its earliest use of the FIGHT LIKE A GIRL mark. The Board should pay it no heed.

VIII. Conclusion

For all the foregoing reasons, the Board should deny Sigler’s motion for summary judgment in whole or in part.

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Dated: December 27, 2012

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Applicant' Brief in Opposition to Motion for Summary Judgment was served on this 27th day of December, 2012 by email, per stipulation of counsel, on the following attorneys for Opposer:

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