

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

CME

Mailed: June 24, 2015

Opposition No. 91212540

Glory Yau-Huai Tsai

v.

BJK Glory House Catering Co., LLC

**Before Kuczma, Gorowitz, and Hightower,  
Administrative Trademark Judges.**

**By the Board:**

Applicant seeks registration of the mark GLORY HOUSE, in standard characters for “restaurant and catering services.”<sup>1</sup> In his notice of opposition, Opposer alleges prior use of the trademark and trade name GLORY HOUSE in connection with his publishing, printing, and printing product business and prior registration of the mark depicted below for “printed matter; namely, childrens['] books, religious books, music books, newspapers for the oriental community, leaflets, business cards, menus, greeting cards, Christmas cards, letterheads and envelopes”<sup>2</sup>:

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<sup>1</sup> Application Serial No. 85789420, filed November 28, 2012, based on an allegation of use since January 1, 2000.

<sup>2</sup> Registration No. 1879695; issued on February 21, 1995; Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed.



As grounds for opposition, Opposer alleges that Applicant's applied-for mark is likely to cause confusion with both of Opposer's prior used and registered marks. In its answer, Applicant denies the salient allegations in the notice of opposition.

This case now comes up on: (1) Applicant's motion, filed November 12, 2014, for summary judgment in its favor "on the basis that there is no genuine issue of material fact that Applicant's GLORY HOUSE mark is not confusingly similar to Opposer's registered mark,"<sup>3</sup> Motion for Summary Judgment, p. 1; (2) Applicant's motion to strike Opposer's summary judgment evidence, filed February 3, 2015 as part of its reply brief in support of its motion for summary judgment; and (3) Opposer's response to the Board's order of May 6, 2015 (the "Prior Order") deeming

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<sup>3</sup> It appears from Applicant's motion for summary judgment and briefs in support thereof that Applicant may believe this proceeding concerns only whether there is a likelihood of confusion between Applicant's applied-for mark and Opposer's registered mark. Opposer's amended notice of opposition, however, broadly pleads rights and a likelihood of confusion with the mark and trade name GLORY HOUSE, without a design element, for Opposer's publishing, printing, and printing product business. See Amended Notice of Opposition, ¶¶ 6-7, 9, 13-15, 47, 50-51, 55 and 56.

In its reply brief, Applicant asserts that "Opposer offered no evidence that any of Opposer's printing jobs pre-date Applicant's filing date or Applicant's date of first use." Reply, p. 9. Priority, however, is not an issue with respect to Opposer's registered mark as Applicant has not asserted a counterclaim to cancel the pleaded registration. To the extent Applicant may be challenging Opposer's prior common law rights for publishing and printing, Applicant's motion was clear that it seeks summary judgment only on the issue of likelihood of confusion. For these reasons, Applicant's brief argument regarding priority in its reply brief will be given no consideration. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.").

certain of Opposer's responses to Applicant's requests for admission as withdrawn. The motion for summary judgment is fully briefed. Opposer has not responded to Applicant's motion to strike, but because of the potentially dispositive nature of Applicant's motion for summary judgment, we exercise our discretion to consider Applicant's motion to strike on its merits. *See* Trademark Rule 2.127(a).

***Opposer's Response to the Prior Order***

Because Applicant's motion for summary judgment is based, in part, on Opposer's deemed admissions to Applicant's requests for admission, we address first Opposer's response to the Prior Order.

On January 14, 2015, Opposer filed a motion to withdraw his effective admissions to Applicant's requests for admission nos. 9, 10, 11, 18 and 25. In the Prior Order, the Board: (1) deemed Opposer's admissions to requests for admission nos. 9, 10, 11, 18 and 25 as withdrawn; and (2) allowed Opposer fifteen days "to serve on Applicant and file with the Board a formal response to requests for admission nos. 9, 10, 11, 18 and 25, which sets forth each request for admission followed by Opposer's denials thereto." Prior Order, pp. 3-4.

On May 18, 2015, Opposer filed a response to the Prior Order denying request for admission nos. 9, 10, 11, 18, and 25.<sup>4</sup> Accordingly, we treat Applicant's requests

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<sup>4</sup> As set forth in the Prior Order, the Board prefers that a party responding to requests for admission reproduce each request immediately preceding the answer or objection thereto. *See* TBMP § 407.03(b) (2014). Opposer did not follow this format, but rather incorporated each request for admission in his denial (*e.g.* "Opposer ... denies applicant's request for admission number 9, which states that [O]pposer only uses the term GLORY HOUSE as it appears in the registration."). Opposer's denials "fairly respond to the substance of the matter" of the requests for admission as required by Fed. R. Civ. P. 36(a)(4), and therefore, Opposer's responses are sufficient.

for admission nos. 9, 10, 11, 18, and 25 as denied. The remainder of Applicant's requests for admission (nos. 1-8, 12-17, 19-24 and 26-28) stand as admitted.

***Motion to Strike***

We next address Applicant's motion to strike Opposer's summary judgment evidence in its entirety. Opposer's summary judgment evidence consists of Opposer's own declaration as well as the following documents:

- a "senior directory printed in 1978" for the Chinese-American Golden Age Association in Monterey Park, California, which bears the pleaded mark, *see* Response to Motion for Summary Judgment, Tsai Declaration and Exhibit 1;
- a page from "the volunteermatch.org website" describing the "Chinese-American Golden Age Association," *see id.* at Tsai Declaration and Exhibit 2;
- "a concert program for a 1993 musical recital" in Whittier, California, which bears the pleaded mark, *see id.* at Exhibit 3;

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On May 20, 2015, Opposer filed a duplicate copy of his response to the Prior Order through ESTTA, the Board's electronic filing system. Opposer is advised that duplicate filings should not be made as they unnecessarily increase the size of the record and cause needless work and expense for the parties and the Board.

Opposer also included in his response to the Prior Order additional arguments and a CD-ROM with supplemental evidence in opposition to Applicant's motion for summary judgment. Opposer's additional arguments and evidence in opposition to Applicant's motion for summary judgment are in the nature of a surreply, and as such, will be given no consideration. *See* Trademark Rule 2.127(e); *see also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); TBMP § 502.02(b). Moreover, with one exception that is not applicable here, submissions to the Board by CD-ROM are not permitted. *See* Trademark Rule 2.126 (a) and (b); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42247, and 42256 (August 1, 2007) (revoking the option to file materials on CD-ROM for all cases); *see also* TBMP §§ 106.03 and 801.03 n.1 (providing that the only time a party may file a CD-ROM with the Board is as an exhibit to a deposition, where the proffering party authenticates and introduces audio and/or video evidence).

- “a concert program for a 1994 musical recital” in Los Angeles, California, which bears the pleaded mark, *see id.* at Exhibit 4;
- an undated wedding card bearing the pleaded mark, *see id.* at Exhibit 5;
- an undated “table card commonly used at banquets” bearing the pleaded mark, *see id.* at Exhibit 6; and
- pages from Applicant’s website “showing that [A]pplicant provides special events services to its customers,” *see id.* at Exhibit 7.

Applicant argues that Opposer “deliberately and intentionally made a decision not to respond to Applicant’s discovery requests and therefore ... must not be allowed to introduce any new evidence that was not submitted during the [d]iscovery phase ... as that would unduly prejudice Applicant by further delaying this matter and prolonging the inevitable, which is a finding that there is no likelihood of confusion and that Applicant is entitled to registration of its mark.”<sup>5</sup> Combined Reply and Cross-Motion to Strike, pp. 5-6.

A party who fails to provide information requested during discovery may, upon motion or objection by his adversary, be precluded from using that information upon a motion for summary judgment, unless the failure was substantially justified or is

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<sup>5</sup> To the extent Applicant argues that Opposer should not be allowed to withdraw certain of his deemed admissions to Applicant’s requests for admission, such arguments will be given no consideration as the Board has previously decided this issue. *See* the Prior Order, and *supra*, pp. 3-4. Applicant further implies that the Board erred in exercising its discretion in resetting Opposer’s deadline to respond to Applicant’s motion for summary judgment. *See* Reply, p. 6. If Applicant was dissatisfied with the Board’s order of December 16, 2014 resetting Opposer’s response deadline, its recourse was to seek reconsideration, but it did not do so. *See* Trademark Rule 2.127(b) (“Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof.”). As such, this argument too will be given no further consideration.

harmless. Fed. R. Civ. P. 37(c)(1); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005). In addition to serving requests for admission, during discovery Applicant served document requests. Opposer's Exhibits 1, 3, and 4 are responsive to Applicant's Document Request Nos. 6 and 7, which seek documents regarding the geographic areas and length of time in each geographic area that Opposer has marketed, sold or promoted products of services in connection with his registered mark. See Motion for Summary Judgment, Exhibit B. Opposer's Exhibit 2 is responsive to Applicant's Document Request No. 8 seeking documents related to "the typical customers to whom Opposer advertises markets, sells or promotes products or services with Opposer's [registered] Mark." *Id.* Because Exhibits 1-4 are responsive to Applicant's document requests, there is no evidence that Opposer produced such documents to Applicant, and Opposer has not established that his failure to produce these documents was substantially justified or harmless, Applicant's motion to strike Exhibits 1-4 is **GRANTED**.

Exhibits 5, 6 and 7, however, do not appear to be responsive to any properly propounded document request,<sup>6</sup> and as such, Applicant's motion to strike Exhibits 5-7 is **DENIED**. Similarly, Opposer's declaration is not a document that would be

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<sup>6</sup> Applicant's Document Request No. 15 seeks "all documents or other tangible evidence that Opposer intends to introduce into evidence during [his] testimony period." Applicant's Document Request Nos. 17 and 18 are similarly broad seeking "all documents ... or other evidence" that Opposer has to support or show confusion between the parties' marks. Because the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial to support his claims, such document requests are improper. See Trademark Rule 2.121(e); see also TBMP §§ 414 and 702.01 (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007)).

responsive to Applicant's document requests, but rather is testimony, and there is no evidence that Opposer failed to attend his noticed deposition or that Applicant even noticed the discovery deposition of Opposer. Accordingly, Applicant's motion to strike Opposer's declaration is **DENIED**.<sup>7</sup>

***Applicant's Motion for Summary Judgment***

We now turn to the merits of Applicant's motion for summary judgment. Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment 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. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993);

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<sup>7</sup> Applicant does not argue, and therefore we do not consider, whether Opposer's declaration should be excluded based on Opposer's failure to identify himself as a witness in his pretrial disclosures.

*Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Upon careful consideration of the arguments and admissible evidence presented by the parties, and drawing all inferences with respect to each motion in favor of Opposer as the non-moving party, we find that there are genuine disputes of material fact that preclude dismissal of the opposition on summary judgment. Specifically, there are genuine disputes of material fact regarding the similarities between Opposer's registered mark and Applicant's mark in appearance, sound, meaning and commercial impression,<sup>8</sup> and the similarities between the parties' trade channels.<sup>9</sup> Accordingly, Applicant's motion for summary judgment is **DENIED**.<sup>10</sup>

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<sup>8</sup> Opposer has admitted that his registered mark is not identical to Applicant's mark, but marks do not have to be identical for there to be a finding of likelihood of confusion. *See* Motion for Summary Judgment, Exhibit A, Request for Admission No. 8.

<sup>9</sup> With respect to the parties' trade channels, Opposer's Exhibit 7 demonstrates that Applicant promotes its GLORY HOUSE restaurant and catering services for receptions and other events and Opposer attests that "many of [his] customers are in the special events industry and organize banquets. ... Both customers of the opposer and applicant are event coordinators...." *See* Response to Motion for Summary Judgment at Tsai Declaration, ¶ 6 and Exhibit 7 thereto.

<sup>10</sup> The parties should note that the evidence submitted in connection with Applicant's motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

Proceedings herein are resumed and dates are reset as follows:<sup>11</sup>

Plaintiff's 30-day Trial Period Ends	<b>8/3/2015</b>
Defendant's Pretrial Disclosures Due	<b>8/18/2015</b>
Defendant's 30-day Trial Period Ends	<b>10/2/2015</b>
Plaintiff's Rebuttal Disclosures Due	<b>10/17/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>11/16/2015</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>11</sup> At this late stage in the proceeding, the Board will not consider any further motions for summary judgment.