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Date January 2, 2004 Signature *Steve ML*

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

EXXON MOBIL CORPORATION,

Opposer,

v.

DATAWORX B.V.,

Applicant.

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Opposition No. 120,519



01-05-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**OPPOSER'S REPLY BRIEF  
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

Opposer, Exxon Mobil Corporation ("Opposer") submits this reply brief in support of its Motion for Summary Judgment to address the issues raised in Applicant's Response.

**INTRODUCTION**

In its motion for summary judgment, Opposer pointed out that Applicant in its discovery responses had provided no support for its claimed bona fide intent to use DEXXON as a trademark in the United States. This motion specifically addressed two separate grounds for granting summary judgment: (1) that Applicant has shown no bona fide intent to use the mark *in the United States*; and (2) that Applicant has shown no bona fide intent to use the mark *as a trademark* on the goods listed in the application (as opposed to a service mark or trade name for distribution services). In its response, Applicant provides no evidence to support its alleged

intent, and cites no cases other than those relied on by Opposer. Applicant also fails to even address the trademark/service mark distinction, essentially conceding that issue. Finally, Applicant improperly attempts to exclude its own damaging discovery responses. This reply addresses each of these issues in turn.

**1. Applicant Has Provided No Evidence to Support Its Alleged Intent**

Opposer's Motion for Summary Judgment pointed out the absence of documentary or other support for Applicant's claim of a bona fide intent to use DEXXON as a trademark. A proper response to that motion would have been for Applicant to "set forth specific facts showing that there is a genuine issue for trial," *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986) (quoting Fed. R. Civ. P. 56(e)), and to present "concrete evidence" supporting these facts. *Celotex v. Catrett*, 477 U.S. 317, 324 (1986). Applicant has done neither.

Applicant's Response makes the curious assertion that "[t]he DEXXON *bona fide* use is well documented and obviously not in dispute" (page 5) and that it is "undisputed that the Applicant, like many companies, would have a *bona fide* intent to use its mark in the largest free-market economy in the world" (pages 2-3). Applicant's bona fide intent, and the lack of evidence to support that intent, is precisely what *is* in dispute in Opposer's motion. Applicant claims that its "*bona fide* intent has been exhibited through various means, and various documents," Applicant's Response at 2, and that "[d]ocuments indicate that DEXXON [*sic*] is sold to resellers." *Id.* at 5. These vague and incomplete references to unspecified documents are typical of Applicant's arguments. Even if such documents did in fact exist, which Opposer strongly doubts, Applicant has failed to place them, or any other evidence, in the record in connection with this motion.

Applicant is thus left to argue, without any evidence, that its filing of its application alone should be sufficient to raise a factual issue concerning its intent. As the cases cited in Opposer's motion make clear, this is not enough. *See Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q. 2d 1351, 1355 (T.T.A.B. 1994) (“[A]pplicant’s mere statement of subjective intention, without more, would be insufficient to establish applicant’s bona fide intention to use the mark in commerce.”); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q. 2d 1503, 1507 (T.T.A.B. 1993) (holding that “absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b).”). Applicant’s arguments regarding Congressional intent and what the law should be ignore these standards.<sup>1</sup>

Applicant also attempts to portray itself as an “international” company, and that it should be obvious that it intends to do business in the United States. *E.g.*, Applicant’s Response at 7, 9. However, as noted in Opposer’s motion, Applicant’s own web site identifies Applicant as a “Pan European distributor of storage media, devices and accessories and solutions.” Opposer’s motion at 2 and Exhibit 1-A. Unlike the applicant in *Lane*, Applicant here has provided no declaration nor any documentary evidence supporting its alleged intent to expand to the United States. Rather, Applicant argues that its intention to “exploit the American market” is “obvious if nothing else by its filing of this trademark application in 1998.” Applicant’s Response at 7. This

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<sup>1</sup> In addition, Applicant’s statement at page 3 of its brief that “the time period from filing to proof of use under almost any circumstances will well exceed four years” is simply incorrect. Many ITU applications proceed to registration in far less than four years. *E.g.*, Registration No. 2,275,041 for the mark EXXON DRIVER CASH, which was filed as an ITU application on May 13, 1998 and registered on August 31, 1999.

is precisely the “mere statement of subjective intention” that the Board in *Lane* described as “insufficient to establish applicant’s bona fide intention to use the mark in commerce.” *Lane Ltd.*, 33 U.S.P.Q. 2d at 1355.

Finally, Applicant attempts to find support for its position in the *Lane* and *Commodore* cases that Opposer relied upon in its motion. Applicant notes that the Board denied summary judgment in both cases, but erroneously claims that it did so “upon facts exactly like those alleged by the Opposer here.” Applicant’s Response at 4. In *Lane*, the Board considered extensive evidence submitted by the applicant in support of its bona fide intent to use the mark, including the declaration of its principal detailing a license agreement and a business plan with an international licensing program, as well as letters detailing the applicant’s offers to license the mark to companies in the United States and elsewhere. In *Commodore*, there is no indication that the opposer moved for summary judgment. Rather, it was applicant’s motion for summary judgment on the intent issue that was denied, based in part on applicant’s complete lack of documentary evidence. It was in this context that the Board commented that the factual question of intent is, as a general rule, unsuited to disposition on summary judgment (as noted in Applicant’s Response at 4). This is far different from the present situation, where Applicant has been given every opportunity to come forward with evidence to support its alleged intent and has failed to do so.

## **2. Applicant Has Shown No Intent to Use DEXXON as a Trademark for Goods**

Opposer’s motion explained in detail that Applicant’s use of the mark DEXXON in Europe has always been in connection with distributorship services, rather than as a trademark on goods, and that no evidence suggests that Applicant’s allegedly planned use in the United

States would be different. Opposer's motion at 2, 5, 9-10. In its response, Applicant completely ignores the trademark/service mark distinction, never attempting to explain why or how it would make a transition to selling DEXXON branded goods in the United States. In fact, Applicant explains that it "is involved in sales and services in Europe; the company wishes to extend its activities to the American market." Applicant's Response at 8. Applicant has thus essentially conceded that if it does ever enter the U.S. market, it will do so as a distributor of products bearing the trademarks of others, as it has done in Europe. Such use would not constitute use of DEXXON as a *trademark* for the goods listed in the application.<sup>2</sup>

### **3. Opposer's Submission of Applicant's Discovery Responses Was Proper**

Applicant, apparently realizing the damaging admissions in its discovery responses, seeks to have them excluded by claiming that Opposer failed to include Applicant's objections when quoting the responses in its motion. Applicant's Response at 9-10. However, Opposer submitted complete versions of Applicant's general objections, as well as its full response (including objections) to each cited discovery response. Opposer's motion at Exhibits C through G. Applicant's argument for exclusion of the responses is specious and should be ignored. *See* Trademark Rule 2.127(e).

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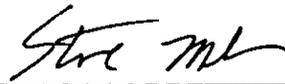
<sup>2</sup> These goods, all in Class 9, are "computers and computer peripherals; optical appliances and instruments, namely, optical disk readers; computer storage devices and media, namely, blank optical disks; blank audio disks; blank audio cassette tapes; blank re-writable CD-ROM disks; head cleaning cartridges for computer storage devices and data storage equipment; blank computer hard disks; removable disks and tape backup drives for computers; blank digital linear tape cartridges; blank 4 mm and 8 mm computer storage tapes; blank removable three and half inch and five and quarter inch floppy disks."

## CONCLUSION

In the face of Opposer's motion, Applicant has come forward with no evidence supporting its claim of a bona fide intent to use DEXXON as a trademark for goods in the United States. Therefore, the Board should grant summary judgment in Opposer's favor and deny registration of Applicant's Trademark Application Serial No. 75/511,805.

DATED: January 2, 2004

Respectfully submitted,

By: 

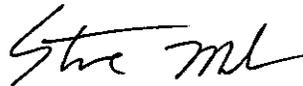
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT has been served via First Class Mail, postage prepaid to counsel for Applicant at the address below, on January 2, 2004:

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