

ESTTA Tracking number: **ESTTA27523**

Filing date: **03/05/2005**

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

<b>Proceeding</b>	91123312
<b>Party</b>	Plaintiff INTEL CORPORATION ,
<b>Correspondence Address</b>	BOBBY A. GHAJAR HOWREY SIMON ARNOLD & WHITEK LLP 750 BERING DRIVE HOUSTON, TX 77057
<b>Submission</b>	Reply in Support of Motion
<b>Filer's Name</b>	Bobby A. Ghajar
<b>Filer's e-mail</b>	ghajarb@howrey.com, ramosm@howrey.com, yaghmair@howrey.com
<b>Signature</b>	/bobbyaghajar/
<b>Date</b>	03/05/2005
<b>Attachments</b>	IDEAS INSIDE Reply Brief.pdf ( 9 pages )

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

<b>INTEL CORPORATION,</b>	)	
	)	
<b>Opposer,</b>	)	Opposition No. 123,312
	)	
<b>v.</b>	)	Serial No.: 75/825,218
	)	
<b>STEVEN EMENY,</b>	)	Published: April 24, 2001
	)	
<b>Applicant.</b>	)	Opposed Mark: IDEAS INSIDE
	)	
	)	Classes: 35, 38 and 42
	)	

---

**OPPOSER’S REPLY MEMORANDUM IN SUPPORT OF ITS  
MOTION FOR SUMMARY JUDGMENT ON THE ISSUE OF  
APPLICANT’S BONA FIDE INTENT TO USE, AND  
SUSPENSION PENDING DISPOSITION OF SUMMARY JUDGMENT**

Opposer, Intel Corporation (“Intel”) respectfully submits its Reply Memorandum in Support of its Motion for Summary Judgment on the Issue of Applicant’s Bona Fide Intent to Use, and Suspension Pending Disposition of Summary Judgment. As the evidence has established, and Mr. Steven Emeny’s (“Applicant”) response brief further confirms, Applicant truly lacked a bona fide intent to use the mark IDEAS INSIDE when he filed his intent-to-use (“ITU”)-based application. Intel’s motion for summary judgment should be granted.

**INTRODUCTION**

Intel, owner of the internationally famous INTEL INSIDE trademark, moved for summary judgment on the issue that Applicant did not have at the time of filing, and could not produce any evidence to show, a bona-fide intent to use the IDEAS INSIDE trademark in United States commerce. In his response brief (cited herein as “Resp. Br.”), Applicant had an opportunity to provide the Board with evidence as to his objective bona

fide intent to use the IDEAS INSIDE mark. Applicant failed to do so. If anything, Applicant's response supports Intel's motion, and, overall, fails to raise any genuine issues of material fact.

The record remains devoid of any evidence that Mr. Emeny made *any* effort to develop the IDEAS INSIDE trademark, including prior to the filing of his ITU application, or between the time he filed his application and the time the application was opposed by Intel (roughly one and one-half years). He admits that he did nothing from his date of filing through the date of publication for opposition, and blames his current inactivity on the opposition process. The uncontested facts, however, are that Mr. Emeny did nothing at any time to promote, develop, market, or use the IDEAS INSIDE trademark in the United States.

On these facts, the Board should grant Intel's motion for summary judgment.

## **ARGUMENT**

### **I. Applicant has Failed to Demonstrate an Objective Bona Fide Intent to Use.**

As Intel explained in detail in its opening brief, the bona fide intent necessary to support an ITU application is an *objective* bona fide intent to use the ITU mark in commerce, not a subjective intent. *See* Intel Summary Judgment Brief ("SJ Br.") at pp. 7-9; *see also Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q.2d 1351 (T.T.A.B. 1994) ("an applicant's *mere statement of subjective intention*, without more, *would be insufficient* to establish [the] applicant's bona fide intention to use the mark in commerce.") (emphasis added); *Commodore Electronics, Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1508 (T.T.A.B. 1993) (finding that the absence of documentary support for the applicant's ITU application was sufficient to establish lack

of the requisite bona fide intent). An applicant must have a bona fide intent to use the proposed mark at the time of filing. *See* 15 U.S.C. § 1051.

Nothing in the record, and nothing in Applicant's response brief, establishes that he had an objective intent to use the IDEAS INSIDE trademark in U.S. commerce as required by the Lanham Act. *Id.* There are no documents, interrogatory responses, or affidavits to support such a contention. Applicant has not produced a shred of evidence to suggest he has taken any steps to develop, pursue, or use the IDEAS INSIDE trademark in the United States before or after he filed his application. In fact, Applicant has conceded that he has not done anything in support of the mark. *See* Applicant's Responses to Opposer's Second Set of Requests for Admissions, at Responses 34-36, and Applicant's Responses to Opposer's First Set of Interrogatories, at Responses 7-10 and 12, all attached as Exs. 4 and 5 to the Ghajar Decl. respectively

## **II. The Senate Report's Illustrations Apply to These Facts and Support a Finding of Applicant's Lack of *Bona Fide* Intent.**

In its opening brief, Intel argued that the illustrations set forth in the Senate Report on the implementation of ITU procedures cast doubt on, and disprove, the bona fide nature of Mr. Emeny's intent. *See* Intel SJ Br. at pp. 11-12. The fact that Mr. Emeny has filed: 1) numerous intent-to-use applications for a variety of trademarks to be used on the same services; 2) nearly thirty U.S. and Canadian ITU applications for marks which he ultimately has never used; and 3) applications with an overly broad list of goods and services<sup>1</sup>; all undermine his claim of bona fide intent. *Id.*; *see* Ex. 6 to Ghajar Decl (TARR Records); *see also* Ex. 7 to Ghajar Decl. (Emeny Dep. at pp. 27-28 and 60-61).

---

<sup>1</sup> In his deposition, Mr. Emeny essentially admitted that his "intent" was one of exclusion, not an objective intent to use the mark himself. Emeny Dep. at p. 33 (Ex. 7 to Ghajar Decl.).

In response, Mr. Emeny does nothing to refute these facts. He has no justification as to why he has, over a relatively short period of time, filed nearly thirty applications, often for identical goods and services, but has failed to use any of them. He does not address why he has not produced any documentary evidence to show that he possessed a bona fide intent to use his various ITU marks in conjunction with the broad list of goods and services that are the subject of the these applications. The nature of Mr. Emeny's conduct is precisely what Congress foresaw as an abuse of the ITU process.

**III. None of Applicant's Arguments Raise Any Genuine Issues of Fact in Dispute.**

Applicant's response brief resorts to irrelevant and inadmissible *argument*, without any support from the record. These arguments, at best, demonstrate a *subjective* intent on Applicant's part to use the IDEAS INSIDE mark. But the wishful, subjective belief that Applicant would perhaps one day use the IDEAS INSIDE mark, in some capacity, in connection with some of the vast list of services that are the subject of his ITU application is not enough under the law to support his ITU application or defeat Intel's present motion. *See* Sect. I, *supra*.

Applicant argues that his defense of this Opposition justifies his inactivity, stating that it was "evident at the time [May 25, 2001, when opposed] that should a business be launched using the term IDEAS INSIDE there would be an immediate law suit." Resp. Br. at 2. Yet Applicant admits that from November 5, 1999 (the date he filed his application) to May 25, 2001 (when Intel opposed the application) he took no action in relation to the mark. What has happened *post-opposition* does not negate the lack of a bona fide intent to use the IDEAS INSIDE mark at the time of filing.

Applicant's "entrepreneur" argument is similarly misguided. In his brief, Applicant tries to excuse his inability to demonstrate a bona fide intent to use the IDEAS INSIDE mark because he is an alleged entrepreneur. He states: "[an entrepreneur's] vision may be much grander at the outset than it's [sic] eventual implementation." Resp. Br. at p. 3. However, Applicant does not cite to any evidence that he took any objective steps in support of his "vision" with respect to the mark. In essence, Applicant argues that entrepreneurs are exempted from having to form an objective bona fide intent to use an ITU mark on an identification of goods and services. But the record is clear that Applicant's goal, as he himself previously admitted, was to use a broad list of goods and services in conjunction with the marks he applied for to "make sure that nobody else [can] take advantage of those marks. [Therefore] there [is] a long list of wares implemented into the trade-mark applications at the time of submission." Emeny Dep. at p. 33 (Ex. 8 to Ghajar Decl.). He essentially concedes that his identification of services was speculative at best and for defensive purposes only and had nothing to do with what actual services he intended to eventually offer; therefore, he could not have possessed the level of objective bona fide intent necessary to support his application. *See e.g.*, Report of the Trademark Review Commission, 77 Trademark Rep. 375, 397 (1987), USTA, "The Trademark Law Rev. Act of 1988," P. 37 (1989) ("By 'bona fide,' we mean no mere hope, but an intention that is firm....").

Mr. Emeny also argues that "[t]he time, effort and cost of creating the trademark, filing the trademark and supporting it's [sic] defense ... display a bona fide attempt to use the mark in commerce." *See* Resp. Br. at pp. 4-5. The mere selection of a mark, and the

filing and defense of an application does not, on its own, prove an applicant's bona fide intent. Such logic would render the bona fide intent requirement meaningless.

Further, Applicant argues that three of his Canadian applications – for marks other than IDEAS INSIDE – have matured to registration. As noted below, *see* Sect. IV, *infra*, the record of these three marks was not properly made of record and should be stricken. Even if the Board is inclined to consider these three Canadian registrations, their existence does not affect the analysis. The fact remains that Applicant has applied for nearly thirty applications that have been abandoned without use, all using laundry lists of goods and services. All of Applicant's U.S. applications, except for the IDEAS INSIDE application, have been abandoned. To the extent that this pattern is an illustrative example from Senate Judiciary Committee Report, the facts and implications remain the same. Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988).

Finally, Applicant suggests that the registration of a domain name is evidence of his bona fide intent. As an initial matter, there is no evidence of record that Applicant owns any such domain name registration or that it has ever been developed or used. Nonetheless, the mere reservation of an internet domain name, without more, cannot demonstrate an objective bona fide intent to use the corresponding trademark. If this act alone could prove the requisite objective bona fide intent, any ITU applicant could circumvent the bona fide intent requirement by paying a few dollars to reserve a corresponding domain name. If anything, Applicant's dormant, undeveloped, and untouched domain name corroborates his lack of an objective bona fide intent to use the IDEAS INSIDE trademark.

In sum, none of Applicant's arguments demonstrate his bona fide intent at the time of his ITU application's filing, as required under the Lanham Act. These arguments fail to raise any genuine issue of material fact that justifies denial of Intel's motion.

**IV. Exhibits 2 and 3 of Mr. Emeny's Response Brief Should be Stricken.**

The Board should strike Exhibits 2 and 3 of the Emeny response brief from the record. The Canadian Intellectual Property Office ("CIPO") report and the Trademark Electronic Search System ("TESS") report that that Mr. Emeny has submitted as exhibits are not a part of Mr. Emeny's two Notices of Reliance or Intel's evidence. *See* Exs. 2 and 3 to Ghajar Decl. (Applicant's Notices of Reliance). Furthermore, this evidence is not of the type that the Board generally allows to be introduced by a party for purposes of summary judgment only. *See Trademark Trial and Appeal Board Manual of Procedure* § 528.05(a), at p. 500-108 (stating that a party may, for summary judgment purposes, rely on "copies of other registrations, documents or things produced in response to a request for production, official records...printed publications... and testimony from other proceedings..."). In addition, Exhibits 2 and 3 are not properly authenticated and, moreover, are irrelevant to the subject matter of this dispute – Intel's trademark filings are not at issue in this Opposition. Accordingly, this evidence should not be considered as part of Mr. Emeny's Opposition, or in later stages of this proceeding.

**V. Applicant's Request for "Summary Judgment" is Inappropriate and Must be Denied.**

In his response brief, Applicant suggests that he is entitled to summary judgment because Intel has used false information against the Applicant. Procedurally, this request lacks foundation since the Applicant has never moved for summary judgment against Intel and, therefore, it cannot be granted the relief it seeks. *See* Fed. R. Civ. P. 56.

Nevertheless, to be clear, Intel's opening brief cited to the USPTO records and Applicant's own deposition testimony, which demonstrate that Applicant had filed nearly thirty U.S. and Canadian ITU applications which have ultimately not matured to registrations for various reasons. *See* Ex. 6 to Ghajar Decl. (TARR Records); *see also* Exh. 7 to Ghajar Decl. (Emeny Dep. at pp. 27-28 and 60-61). *See* Ex. 6 to Ghajar Decl. (TARR Records); *see also* Exh. 7 to Ghajar Decl. (Emeny Dep. at pp. 27-28 and 60-61). Applicant's request must be denied.

**VI. Intel's Request for a Resetting of its Testimony Period in this Matter is Warranted in the Event Intel's Summary Judgment Motion is Denied.**

In the event that the Board denies Intel's summary judgment motion, it would be reasonable for it to grant Intel an additional requested thirty (30) days from the date of the Board's ruling to supplement its testimony. Intel's testimony period was open at the time of filing of the instant motion, and it made sense to wait for the Board's ruling before investing additional time and expense to collect and submit evidence. Applicant has articulated no prejudice for the Board to reject Intel's good faith request. Consequently, the requested extension should be granted if necessary.

**CONCLUSION**

For the foregoing reasons, Intel's motion and request to reset the schedule should be granted. No genuine issue of fact is in dispute as to Applicant's lack of bona fide intent to use the IDEAS INSIDE trademark in the United States. Further, the Board should strike Exhibits 2 and 3 attached to Applicant's Opposition as lacking foundation, unauthenticated, improper, and irrelevant. Finally, the Board should deny Applicant's

request for summary judgment as improper and unsupported, and should reset the schedule.

Respectfully Submitted,

Date: March 5, 2005

/s/ Bobby A. Ghajar

Bobby A. Ghajar  
Katherine M. Basile  
Mike M. Yaghmai  
Howrey Simon Arnold & White, LLP  
550 South Hope Street, Suite 1400  
Los Angeles, California 90071  
(213) 892-1800

Attorneys for Opposer,  
Intel Corporation