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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91123312
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TABLE OF CONTENTS

<u>PAGE</u>		<u>PAGE NO.</u>
I.	INTRODUCTION .....	1
II.	DESCRIPTION OF THE RECORD .....	2
III.	STATEMENT OF THE ISSUES .....	3
IV.	RECITATION OF FACTS.....	3
A.	Intel Corporation.....	3
B.	Mr. Steven Emeny .....	4
C.	History of This Proceeding .....	8
V.	ARGUMENT .....	9
A.	Opposer Has Standing to Oppose the Issuance of this Application.....	9
B.	Applicant Lacks a Bona Fide Intent to Use the Mark IDEAS INSIDE.....	10
1.	Section 1(b) of the Lanham Act Requires a <i>Bona Fide</i> Intent to Use. ....	10
2.	Applicant’s Failure to Produce Objective Evidence is Sufficient to Establish a Lack of Bona Fide Intent to Use. ....	12
3.	The Legislative History of Section 1(b) of the Act Specifically Supports a Finding that Applicant Lacks a Bona Fide Intent. ....	13
a.	Filing for applications unreasonably lacking in specificity in describing the proposed goods casts further doubt on, or disproves, Applicant’s bona fide intent. ....	13
b.	Filing for an excessive number of intent-to-use applications to register marks that ultimately were not used casts a doubt on, or disproves, Applicant’s bona fide intent. ....	14
c.	The filing of numerous ITU applications for a variety of marks covering the same goods and services casts doubt on or disproves Applicant’s bona fide intent. ....	15
VI.	CONCLUSION .....	16

**TABLE OF AUTHORITIES**

**CASES**

*American Paging Inc. v. American Mobilphone Inc.*,  
17 U.S.P.Q.2d 1726 (Fed. Cir. 1990) .....8

*Commodore Electronics, Ltd. v. CBM Kabushiki Kaisha*,  
26 U.S.P.Q.2d 1503 (T.T.A.B. 1993).....12, 13

*Lane Ltd. v. Jackson Int'l Trading Co.*,  
33 U.S.P.Q.2d 1351 (T.T.A.B. 1994).....11

**STATUTES**

15 U.S.C. § 1051 .....10

15 U.S.C. § 1065 .....3

**OTHER AUTHORITIES**

Report of the Trademark Review Commission, 77 Trademark Rep. 375 (1987),  
USTA, “The Trademark Law Rev. Act of 1988,” (1989) .....11

Senate Judiciary Committee Report on S. 1883 (“Senate Report”),  
S. Rep. No. 100-515 (Sept. 15, 1988) .....10, 11, 13

**RULES**

Trademark Trial and Appeal Board Manual of Procedure §704.12 .....5

Trademark Trial and Appeal Board Manual of Procedure § 309.03 .....9, 10

**TREATISES**

J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*  
§ 19:14 (4th ed. 2004).....11

## I. INTRODUCTION

Intel Corporation (“Intel”) opposed Application Serial No. 75/825,218 for the mark IDEAS INSIDE in 2001 on the basis that it infringed and diluted Intel’s rights in its famous INTEL INSIDE and INTEL INSIDE & Design trademarks. As discovery progressed, Intel realized that Applicant, a Canadian citizen without business ties to the United States, had no evidence or documents, and could provide no testimony, to demonstrate that he had a bona fide intent to use the IDEAS INSIDE mark in U.S. commerce, as required by Section 1(b) of the Lanham Act (the “Act”). In response to Intel’s discovery requests for evidence of Applicant’s efforts to develop the IDEAS INSIDE trademark – indicia that he possessed a bona fide intent to use the mark – Applicant submitted nothing: no marketing or business plans, no customer contacts, no web site development efforts, or other relevant information. Instead, the evidence revealed that Applicant had engaged in a pattern of filing various intent-to-use (“ITU”)-based trademarks and allowing them to go abandoned, without proving use of a single one.

Intel later amended its notice of opposition to add lack of bona fide intent as an additional basis for opposition. Then, even after Intel moved for summary judgment on this ground, and Applicant was provided with another opportunity to demonstrate his bona fide intent to use the IDEAS INSIDE mark, Applicant submitted nothing. In view of the overwhelming evidence to support the lack of bona fide intent basis of Intel’s opposition, Intel filed a motion to amend its notice of opposition to focus solely on that ground. The Board has yet to rule on Intel’s motion.

As discussed below, the evidence in this case unequivocally shows that Applicant’s behavior – concurrently filing for multiple ITU- based applications without ever developing or using them; filing unrealistically broad identification of goods and/or services; abandoning all

but one of his U.S. trademark applications after requesting multiple extensions of time; and lacking any objective proof of his bona fide intent to use the IDEAS INSIDE mark – is exactly what the legislature intended to prevent when it required that ITU applicants attest to a *bona fide* intent to use marks. Given the complete absence of evidence to corroborate Applicant’s declaration that he possessed a bona fide intent to use the IDEAS INSIDE mark at the time of its filing, the Board should sustain Intel’s opposition and refuse registration of Applicant’s IDEAS INSIDE mark.

## **II. DESCRIPTION OF THE RECORD**

Intel’s record in this case consists of the following:

- (1) The pleadings;
- (2) The file of the opposed application, Application Serial No. 75/825,218 for IDEAS INSIDE, filed November 5, 1999;
- (3) Intel’s Notice of Reliance, filed November 29, 2002. Filed with this document were:
  - (a) The Affidavit of Leslie Skinner, dated November 29, 2002 (Exhibit B-2);
  - (b) Copies of registration certificates for the marks INTEL INSIDE and INTEL INSIDE & Design owned by Opposer (Exhibits A1- A17);
  - (c) Applicant’s deposition transcript and its attachments, which consist of the particulars of Applicant’s various U.S. and Canadian trademark applications (Exhibit F);

- (d) Third-party articles and reports relating to Intel and its INTEL INSIDE brand (Exhibits C1- C101); and
- (e) Applicant's Responses to Opposer's Interrogatories and Opposer's Requests for Admissions (collectively Exhibit D).

### **III. STATEMENT OF THE ISSUES**

The sole issue before the Board in this opposition proceeding is whether Applicant had a bona fide intent to use the mark IDEAS INSIDE as required by Section 1(b) of the Lanham Act.

As discussed above, because Intel has filed a pending motion to amend its notice of opposition to withdraw its likelihood of confusion and dilution causes of action, Intel has not addressed facts and arguments relating to these grounds in this trial brief. In the event that the Board denies Intel's motion to amend, Intel hereby requests that the Board provide Intel with a brief period of time to file a revised trial brief to address the infringement and dilution grounds.

### **IV. RECITATION OF FACTS**

#### **A. Intel Corporation**

Founded in 1968, Intel is the world's leading developer and manufacturer of microprocessors and other building blocks for the computing and Internet industries worldwide. *See* Affid. of Leslie Skinner (Exh. B-2 to Intel's Notice of Reliance) at ¶ 2. Intel promotes and sells a variety of products and services spanning the fields of computers, communications, networking, consumer electronics, and the Internet. *Id.* at ¶¶ 4-7.

Intel is the owner of the world famous INTEL INSIDE trademark. Today, Intel owns numerous U.S. trademark registrations for the INTEL INSIDE and INTEL INSIDE & Swirl Design trademarks, several of which are incontestable under 15 U.S.C. § 1065. *See generally* Exh. A1-17 to Intel's Notice of Reliance (copies of U.S. Registration Certificates); Skinner Affid. at ¶ 9 (Exh. B-2 to Intel's Notice of Reliance). In 1991, Intel launched a revolutionary

marketing campaign under the INTEL INSIDE brand. *Id.* at ¶¶ 8, 13-16. Using nearly every form of marketing medium and through cooperative advertising, Intel has reached many millions of consumers with the INTEL INSIDE trademark. *Id.* at ¶¶ 13-16. Since 1991, Intel has invested hundreds of millions of dollars on advertising and promoting its goods under the INTEL INSIDE mark. *See* Affid. of Leslie Skinner at ¶ 17 (Exh. B-2 to Intel’s Notice of Reliance). Due to the extensive use and promotion of the INTEL INSIDE mark, it has become a famous cultural icon. *See generally*, Exhibits C1-C101 of Intel’s Notice of Reliance (third-party articles and reports relating to Intel and its INTEL INSIDE brand); Affid. of Leslie Skinner at ¶ 16 (Exh. B-2 to Intel’s Notice of Reliance). Intel’s products and services are used by various consumers, including individuals, online retailers, telecommunications companies, small businesses, and consulting companies. *See* Skinner Affid. at ¶ 12 (Exh. B-2 to Intel’s Notice of Reliance).

**B. Mr. Steven Emeny**

Applicant, a Canadian resident, proclaims to be an “entrepreneur and develop[er] of new businesses for the Internet, e-commerce.” Dep. of Steven Emeny (Aug. 8, 2002) at p. 10, (Exhibit F to Intel’s Notice of Reliance). He works from his home office in Toronto, Canada. *Id.* at p. 12. As an individual formerly involved in the computer industry, Applicant admitted knowing Intel Corporation, and stated that he considers Intel to be a well-known, well-respected company. *Id.* at pp. 20-21.

During his deposition in August 2002, Mr. Emeny stated that he had pursued a home business since he left his position at American Express in 1997. *Id.* at p. 18. He also stated that his business, Baced Communications, was ready to be launched at the time of the deposition. *Id.* However, in this entire proceeding, Applicant submitted no evidence to show that he has ever operated a business, even though nearly nine years have passed since Mr. Emeny allegedly began

to plan for his business (i.e., from the date he left American Express). *Id.*

Since 1997, Mr. Emeny has filed nine U.S. and twenty Canadian ITU applications which have not matured into registrations. The U.S. applications filed by Mr. Emeny include: INTERNET SURF SUIT (Serial No. 75/885,374); MULTIMEDIA POCKET (Serial No. 75/885,342); CYBERSPACE ESSENTIALS (Serial No. 75/825,226); BYTE SIZE CLOTHING (Serial No. 75/815,571); WHEN YOU'RE GOING PLACES! (Serial No. 75/415,374); I S (Serial No. 75/415,363); ROOKIESAURUS (Serial No. 75/263,386); and INTERNET SURFWEAR (Serial No. 75/263,382). *See generally* Dep. of Steven Emeny (Aug. 8, 2002) at pp. 27-8, 32-33 and 60-61 and Exhibits thereto (Exhibit F to Intel's Notice of Reliance)<sup>1</sup>. Six of the Applicant's U.S. ITU applications were abandoned for failure to file a Statement of Use. *Id.* Two others were abandoned due to failure to respond to Office Actions. *Id.* Many of Applicant's past trademark applications covered identifications of goods and services that were identical or highly similar to one another. *Id.* For example, many of the applications covered a very wide range of clothing items in Class 25. Others covered virtually identical services in Class 35 such as "retail store, wholesale store, mail order, and online retail store services." Today, the Applicant's only "live" U.S. trademark application is application Serial No. 75/825,218 for the mark IDEAS INSIDE – the subject of this Opposition. *Id.*

Like several of Applicant's other now-abandoned applications in the U.S., the IDEAS INSIDE application covers a wide range of online retail and computer-related services, including:

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<sup>1</sup> Independently, the Board may take judicial notice of the particulars of Applicant's various U.S. and Canadian trademark applications. These particulars may be viewed through publicly available government websites maintained and operated by the USPTO and Canadian Intellectual Property Office. The particulars of Applicant's trademark applications are proper for judicial notice since they are not subject to dispute and the evidence is "capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." TBMP §704.12 (A). In addition, Mr. Emeny has himself relied upon these applications. *See, e.g.*, Exhs. 1 and 2 attached to Applicant's Opposition to Intel's Motion for Summary Judgment dated February 14, 2005.

computerized on line ordering service featuring the wholesale and retail distribution of books, music, motion pictures, multimedia products and computer software in the form of printed books, audiocassettes, videocassettes, compact disks, floppy disks, CD ROM's; clothing items, namely, anoraks; aprons; ascots, baby bibs; badminton pants; badminton pants; badminton shirts; bandannas; baseball shirts; baseball stockings; baseball uniforms; baseball caps; basketball uniforms; basketball singlets; basketball jerseys; basketball socks; basketball shorts; basketball pants; basketball shirts; bath wraps; bathrobes; beach coats; beach cover ups; bed jackets; belts; berets; bib ties; bibs; bikinis; blazers; blouses, body suits; booties; boots; bowling shirts; boxing trunks; brassieres; briefs; camisoles; capes; cardigans; coats; collars; costumes; coveralls; cravats; cummerbunds; diaper covers; diaper liners; dickies; dress skirts; dresses; dressing gowns, fencing uniforms; fencing jackets; football shirts; football pants; football jackets; footwear; foundation garments; fur coats; garter belts; garters; gloves; golf pants, golf shirts; golf vests; golf jackets; golf socks; golf hats; golf shorts; golf caps; gym shirts; gym shorts; gym pants; halters, handball shirts; handball pants; hosiery, housecoats; jackets; jeans; jerseys; jodhpurs; jogging suits; judo uniforms; jumpers; jumpsuits; karate uniforms; kimonos; knickers; knit shirts; ladies' panties; leg warmers; leggings; leotards; lingerie; lounge wear robes; mantles; masquerade costumes; mittens; muffs; neckties; neck warmers; negligees; night shirts; night gowns; one-piece jumpsuits; overall; pants; panty hose; parkas; play suits; polo shirts; polo pajamas; rain ponchos; raincoats; rain suits; rainwear; robes; rugby pants; rugby shirts; running suits; sandals; sashes; scarves; scrub pants; shawls; shells; shirts; shorts; skirts; slacks; sleep wear; slips; smocks; snow suits; snowmobile suits; soccer pants; soccer shirts; socks; sport caps; sport shirts; stockings; storm suits; storm coats; straw hats; suits; sun suits; suspenders; sweat shirts; sweatband wristlets; sweaters; sweat jackets; sweatpants; sweat shorts; sweat suits; swim pants; swim wear; T-shirts; tank tops; tennis caps; tennis pants; tennis shirts; tennis jackets; tennis shorts; thermal underwear; ties; tights; topcoats; tops; track and field shirts; track and field pants; trousers; tunics; turtlenecks; tuxedos; underwear, uniforms; vestees; vests; volleyball pants; volleyball jackets; volleyball shirts; waistcoats; warm-up tops; warm-up suits; warm-up pants; wash suits; wind protection jackets; wraparounds; wraps; wrestling uniforms; footwear, footwear accessories, namely, basketball shoes; boots, court shoes; football shoes; jogging shoes; overshoes; pumps; rain boots; running shoes; sandals; shoes; slip-ons; slippers; thongs; toe rubbers; headwear, namely, beanie caps; bonnets; caps; ear muffs; fur hats; hats; head bands; sun visors; swim caps; toques; visors, in International Class 35;

electronic direct digital transmission of messages and data via computer terminals, in International Class 38; and

computer services, namely, providing on line search engines for obtaining data on a global computer network, in International Class 42.

*Id.*

In his deposition, Applicant admitted that the primary intent of the long list of items covered by his application was to prevent other people from using that trademark on those items. Dep. of Steven Emeny (Aug. 8, 2002) at pp. 38-39, 52 (Exhibit F to Intel's Notice of Reliance). Throughout his deposition and in his written discovery responses, Applicant essentially conceded that he had taken no steps to develop the IDEAS INSIDE mark in the United States and admitted that he was not manufacturing any of the clothing items listed under the IDEAS INSIDE mark and was not in discussions with any manufacturers to do so. *Id.* at pp. 39, 70; *see also* Applicant's Resps. to Opposer's Second Set of Req. for Admissions (Exhibit D to Intel's Notice of Reliance), at Resp. 34 (Applicant admitted that "the term IDEAS INSIDE has not been developed in the United States since the filing of the IDEAS INSIDE trademark."); Resp. 36 (Applicant admitted that "the term IDEAS INSIDE has not been promoted in the United States since the filing of the IDEAS INSIDE trademark."); Applicant's Responses to Opposer's Interrogatories at Nos. 7, 9, 10, 12, 18 (Applicant confirmed no sales under the IDEAS INSIDE mark; no hiring of consultants or advertising or marketing agencies to create and advertise the mark; no dissemination of promotional materials that reference the mark; and that "to date, no documents were sent to Applicant's customers, prospective customers, trade organizations, or members of the press relating to the Applicant's use of the term IDEAS INSIDE.") (*See* Exhibit D to Intel's Notice of Reliance).

Further, even though Intel directed written discovery towards Applicant's marketing efforts and business plans for the IDEAS INSIDE mark, Applicant did not produce any such documents or responses. *See id.* (Exhibit D to Intel's Notice of Reliance).

**C. History of This Proceeding**

Applicant filed his ITU-based Application Serial No. 75/825,218 for the mark IDEAS INSIDE in November of 1999. Approximately two years later, Intel Corporation (“Intel”) opposed the IDEAS INSIDE application, initially based on likelihood of confusion and dilution with Intel’s famous INTEL INSIDE mark. Consequently, in November of 2002, Intel amended its Notice of Opposition to include Applicant’s lack of a bona fide intent to use the IDEAS INSIDE mark. The Board granted Intel’s motion.

Intel conducted various written discovery relating to the Applicant’s intent to use the alleged mark, but Applicant did not conduct any discovery, submit testimony or introduce other evidence in this matter.<sup>2</sup> In 2004, the parties filed their respective notices of reliance.

In May 2005, after the close of the discovery period, Intel sought to have Applicant’s lack of bona-fide intent adjudicated on summary judgment. Intel’s motion detailed the evidence that supported Applicant’s lack of bona-fide intent to use the mark in commerce, as required by Section 1(b) of the Lanham Act. The Board denied Intel’s motion as untimely, and did not reach the merits of Intel’s motion.

The evidence overwhelmingly demonstrates Applicant’s lack of any bona fide intent to use the IDEAS INSIDE mark. The issue of Applicant’s bona-fide intent to use is dispositive. If Applicant lacks a bona-fide intent to use the IDEAS INSIDE mark, no need exists for the parties or the Board to expend resources and effort on Intel’s infringement and dilution causes of action. *Cf. American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff’d*

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<sup>2</sup> The Board expressly recognized this fact in the Order it issued on January 24, 2006, in which it stated “[I]t is also noted that applicant did not take any testimony or introduce any other evidence during its testimony period.”

*without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990) (ruling on one dispositive ground renders other grounds for granting cancellation moot).

For this reason, on February 2, 2006, Intel moved to focus the opposition on the bona fide intent to use claim and to drop its likelihood of confusion and dilution claims without prejudice, or in the alternative, with prejudice. Intel also sought to have this proceeding suspended pending the Board's ruling on Intel's motion to amend. Because the Board has yet to rule on either motion, Intel submits its trial brief on the issue of Applicant's lack of bona fide intent to use the IDEAS INSIDE mark. *See also supra* Section II.

## V. ARGUMENT

### A. Opposer Has Standing to Oppose the Issuance of this Application.

Intel has standing to oppose the issuance of Application Serial No. 75/825,218. "Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint." Trademark Trial and Appeal Board Manual of Procedure § 309.03(b). At the pleading stage, all that is required is that plaintiff allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis for its belief of damage." *Id.* To plead a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. *Id.* Here, Intel is the owner of numerous INTEL INSIDE and INTEL INSIDE & Design U.S. registrations, and has spent millions of dollars advertising and promoting these marks. The registration of Applicant's IDEAS INSIDE mark on the Principal Register would be inconsistent with Intel's rights in its INTEL INSIDE registrations and under common law, and would be damaging to Intel.

**B. Applicant Lacks a Bona Fide Intent to Use the Mark IDEAS INSIDE.**

Applicant did not have a bona fide intent to use the IDEAS INSIDE mark when he filed an application for that mark in 1999. Instead, he applied for the mark for a wide variety of services simply in order to preclude others from registering and rightfully using the mark.

1. Section 1(b) of the Lanham Act Requires a *Bona Fide* Intent to Use.

Section 1(b) of the Lanham Act (the “Act”) requires that an applicant filing an ITU application verify that it has a “bona fide intent[]” to use the mark in commerce. 15 U.S.C. § 1051(b)(1). If an applicant lacks a bona fide intent to use an ITU-based mark in commerce at the time of its filing, its application is invalid. See, e.g., T.B.M.P. § 309.03(c)(5) (enumerating Defendant’s lack of a bona fide intent to use a mark in commerce as an appropriate ground for an opposition or cancellation). Although the term “bona fide” is not defined within the Act itself, the legislative history of the Act clarifies that the “intent” required is an *objective* one. Indeed, Congress chose the Act’s ITU language very carefully:

Despite its numerous virtues, a registration system based on intent also carries some potential for abuse. A single business or individual might, for instance, attempt to monopolize a vast number of potential marks on the basis of a mere statement of intent to use the marks in the future. To minimize such risks, S. 1883 requires the specified intent to be bona fide. This bona fide requirement focuses on an *objective good-faith test* to establish that the intent is genuine.

Senate Judiciary Committee Report on S. 1883 (“Senate Report”), S. Rep. No. 100-515 (Sept. 15, 1988) (emphasis added).

Reputed trademark commentator J. Thomas McCarthy explains:

‘The evidence is “objective” in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant’s testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of the applicant later testifying, ‘Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future.’

See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* § 19:14, at p. 19-40. (4th ed. 2004); see also *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q.2d 1351 (T.T.A.B. 1994) (stating that "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" and explaining that an ITU applicant must be prepared to support its bona fide intent to use by objective means) (emphasis added).

While an ITU applicant's bona fide intent to use may be subject to contingencies, those contingencies must themselves be objective, not merely the subjective state of mind of the applicant regarding some possible future use of the mark in question. See *McCarthy on Trademarks and Unfair Competition* § 19:17, at p. 19-46 ("the language of §1(b) itself supports the view that the contingency must be objective, for §1(b) refers to 'circumstances' showing 'good faith.' The word circumstances points to objective, external contingencies, not to subjective, internal indecision."). While these "contingencies" may include product testing or market research, it does not include mere "hope," by itself. See 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....").

The Senate Report also includes an illustrative, though non-exclusive, series of circumstances that "may cast doubt on the bona fide nature of the intent or even disprove it entirely." Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988). These circumstances include, amongst others, where applicant has filed: 1) numerous intent-to-use applications for a variety of desirable trademarks to be used on a single new product; 2) an excessive number of intent-to-use applications to register marks which

ultimately were not actually used; or 3) applications unreasonably lacking in specificity in describing the proposed goods. *Id.*

As discussed below, all of these circumstances and indicia manifest themselves in this case.

2. Applicant's Failure to Produce Objective Evidence is Sufficient to Establish a Lack of Bona Fide Intent to Use.

An applicant's failure to produce clear, objective evidence of a bona fide intent to use a proposed mark demonstrates a lack thereof. *See Commodore Electronics, Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1508 (T.T.A.B. 1993). In *Commodore Electronics*, an Opposition proceeding, the Trademark Trial and Appeal Board found that the absence of documentary support for the applicant's ITU application was sufficient to establish that the applicant lacked the requisite bona fide intent. *Id.* It also dismissed applicant's contention that defending an opposition proceeding in itself demonstrates applicant's bona fide intent. *Id.*

Just as the applicant in *Commodore* could not point to any specific documents demonstrating its intent to use the mark, Applicant has failed to produce any documents that objectively prove his bona fide intent to use the IDEAS INSIDE mark in commerce. In spite of several discovery requests that called for Applicant's marketing plans, discussions, or business plans for the IDEAS INSIDE mark, none were divulged. *See, e.g.*, Applicant's Resp. to Interrogs. 7, 9, 10, 12, and 18 (Exhibit D to Intel's Notice of Reliance), *supra* at p. 7. Applicant further admitted that he has never promoted or advertised, sold any goods or services under, or conducted any specific planning for the use of, the IDEAS INSIDE mark. *Id.*; *see also* Applicant's Resps. to Opposer's Second Set of Req. for Admissions, at Resps. 34 and 36.

Applicant also conceded that “the term IDEAS INSIDE has not been developed in the United States since the filing of the [ ] trademark,” unjustifiably relying on this Opposition as an excuse for his inaction – even though Intel did not oppose the subject application until nearly two years after the filing date. *Id.* Even after Intel moved for Summary Judgment on the specific bona fide intent to use issue, Applicant failed to cite to any evidence or testimony in support of his bona fide intent to use the IDEAS INSIDE mark. *See supra* footnote 2. The record remains void of any evidence in support of Applicant’s alleged bona fide intent. Under *Commodore Electronics*, Applicant’s failure to produce any objective evidence of an intent to use the IDEAS INSIDE mark, alone, is sufficient basis for ruling in Intel’s favor on the bona fide intent issue. *Commodore Electronics*, 26 U.S.P.Q.2d at 1508.

3. The Legislative History of Section 1(b) of the Act Specifically Supports a Finding that Applicant Lacks a Bona Fide Intent.

As discussed above, the Senate Report specifically lays out an illustrative list of circumstances that may cast doubt on the bona fide nature of an applicant’s intent, or “even disprove it entirely.” Senate Judiciary Committee Report on S. 1883, at p. 23. A number of these circumstances apply in the instant matter. Together, they strongly support the conclusion that Applicant lacks a cognizable intent to use the IDEAS INSIDE trademark.

- a. Filing for applications unreasonably lacking in specificity in describing the proposed goods casts further doubt on, or disproves, Applicant’s bona fide intent.

The unreasonably broad nature of the goods and services listed in most of Applicant’s ITU applications, including the IDEAS INSIDE application, provides further proof of the Applicant’s lack of bona fide intent.

Here, Applicant's identification of services purports to cover the online sale of nearly every type of article of clothing (over 200 types of apparel, from "anoraks" and "cummerbunds" to "lingerie" and "wrestling uniforms"); book distribution services; search engine services; and digital transmission services. Yet in spite of the breadth and specificity of Applicant's identification of services, there is no evidence of record that Applicant made contacts or business plans with apparel makers, publishers, or ISPs – any of the companies that he likely would have partnered with to offer the services covered in his trademark application.

Applicant conceded that his strategy in applying for a delimited list of goods and services under his ITU applications was 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 pp. 33, 38-39, attached as Exhibit F to Intel's Notice of Reliance. In so doing, Mr. Emeny essentially admitted that his "intent" was one of exclusion, not an objective intent to use the marks.

- b. Filing for an excessive number of intent-to-use applications to register marks that ultimately were not used casts a doubt on, or disproves, Applicant's bona fide intent.

Applicant's lack of bona fide intent is also demonstrated by the fact that he has filed many ITU applications for marks that he ultimately has never used (*e.g.*, Application Serial Nos. 75/263,386; 75/263,382; 75/415,374; 75/415,363; 75/815,571; 75/885374; 75/885,342; and 75/825,226). *See generally* Exhibits to Dep. of Steven Emeny (Aug. 8, 2002), (Exhibit F to Notice of Reliance); *supra* footnote 1. All of these applications – now abandoned – were filed around the same time period (1998-2000) that Applicant filed the IDEAS INSIDE application. Significantly, Applicant has never proven use of any of the trademarks that he has filed in the

United States.

The fact that approximately twenty of Applicant's ITU applications in his home country have failed to mature to registration, many of which were for the same marks that were the subject of his now-abandoned U.S. ITU applications, further corroborates his lack of bona fide intent. *See generally* Emeny Dep. and Exhibits thereto (Exhibit F to Intel's Notice of Reliance) (outlining the various abandoned trademark applications owned by Mr. Emeny in the United States and Canada).

- c. The filing of numerous ITU applications for a variety of marks covering the same goods and services casts doubt on or disproves Applicant's bona fide intent.

Within a three year period, Applicant filed nine ITU applications for various trademarks for use with a wide range of apparel and/or retail sales and advertising of apparel and other services.<sup>3</sup> *See supra* at Sect. IV (B), pp. 5-6 (listing Applicant's US trademark applications, all of which cover a wide range of apparel in Class 25 and/or sales and advertising services in Class 35). Applicant eventually abandoned all of his US applications, except for the IDEAS INSIDE application. *See generally* Exhibits to Dep. of Steven Emeny (Aug. 8, 2002), (Exhibit F to Intel's Notice of Reliance); *see also supra* footnote 1.

In summary, each of these factors further disprove Mr. Emeny's bona fide intent.

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<sup>3</sup> For example, the Class 35 services covered by Applicant's Application Serial Nos. 75/415,374 (WHEN YOU'RE GOING PLACES); 75/263,386 (ROOKIESAURUS); and 75/263,382 (INTERNET SURFWEAR) all cover advertising and promoting the goods and services of others; arranging and conducting trade shows; and "retail store, wholesale store, mail order, and online retail store services" featuring clothes, computer hardware, software, and other goods; and "public relations services for others." Two of Applicant's other US Applications, 75/825,226 (CYBERSPACE ESSENTIALS) and 75/415,363 (IS & Design), cover the same retail, wholesale, and online store services.

## VI. CONCLUSION

When the Lanham Act was amended to allow applicants to file ITU applications, it was anticipated that certain applicants would attempt to abuse the process. As one safeguard, Congress added specific language to the Act that required ITU applicants to declare, under penalty of perjury, their bona fide intent to use the mark in commerce.

As clearly evidenced by the legislative history of the Act, and the specific illustrations provided in the Senate Report, Applicant's conduct is exactly what Congress foresaw as abuse of the system. Applicant should not be allowed to stockpile trademarks that he has no objective intent to use. Respectfully, the Board should not condone such abuse.

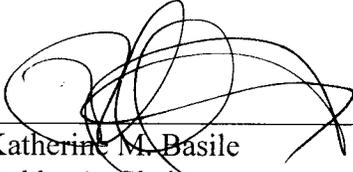
For these reasons, Intel respectfully requests that the Board sustain the Notice of Opposition, and refuse registration of Applicant's IDEAS INSIDE mark.

Respectfully Submitted,

INTEL CORPORATION

Date: \_\_\_\_\_

2/21/06

  
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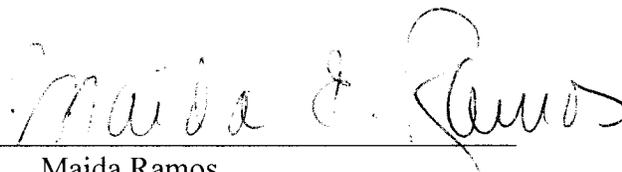
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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Intel's "Trial Brief" was served on Mr. Steven Emeny, 93 Day Avenue, Toronto, Ontario M6E 3WA, Canada, by First Class mail, postage prepaid, this 21st day of February, 2006.

  
Maida Ramos