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

Proceeding	91123312
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

INTEL CORPORATION'S REPLY TRIAL BRIEF

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Opposer, Intel Corporation ("Intel") submits this Reply Memorandum in Support of its Trial Brief. [1]

I. INTRODUCTION

Given the opportunity to identify objective evidence of his bona fide intent to use the IDEAS INSIDE mark, Applicant does not. Instead, Applicant's Trial Brief lacks any factual support or citation to the record, and is nothing more than argument and supposition. The record still is devoid of any evidence that Applicant made any effort to develop the IDEAS INSIDE trademark or that he had a bona fide intent to use the IDEAS INSIDE mark in U.S. commerce.

In view of the lack of any objective evidence to support Applicant's bona fide intent to use – as required by the Lanham Act – the Board should grant Intel's Opposition and refuse registration of the IDEAS INSIDE mark.

II. ARGUMENT

A. Applicant has Failed to Demonstrate an Objective Bona Fide Intent to Use the IDEAS INSIDE Mark in the U.S.

The relevant case law requires Applicant to support his intent-to-use application with an *objective* bona fide intent to use the mark in commerce, not a subjective intent. *See* Intel's Br., Section V.B.1.; *see Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q.2d 1351 (T.T.A.B. 1994) (holding 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."); *Commodore Electronics Ltd. v. CBM*

[1] For the Board's reference, the due date for Intel's Reply Brief is April 7, 2006 because Intel's Trial Brief was due, and filed, on February 21, 2006 (as the calendared date, February 18 fell on a Saturday and Monday, February 20, was a holiday). *See* TBMP 801.02(b). Thus, all subsequent briefing dates are adjusted by three calendar days. *See S Industries, Inc. v. Casablanca Indus., Inc.*, 2002 TTAB LEXIS 644 (TTAB 2002) (adjusting all trial brief deadlines when Plaintiff's Trial Brief was due on a weekend).

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 requisite bona fide intent).

Nothing in the record, and nothing in Applicant's Trial Brief, establishes that he had an objective intent to use the IDEAS INSIDE trademark in the United States. 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. Nor did Applicant counter any of Intel's arguments regarding the lack of such evidence.

Applicant *implies* that he had "business plan information" regarding the IDEAS INSIDE mark, but refused to produce it on "proprietary information considerations." (Appl.'s Br. at 5.) The suggestion that Applicant somehow possessed "business plan information" relating to the IDEAS INSIDE mark is misleading, uncorroborated, and false. No such information or plans were produced in discovery, even though Intel's discovery requests specifically called for them. *See* Opposer's Document Requests at No. 7 and Interrogatories at No. 21 (*See* Exhibit D to Intel's Notice of Reliance). Applicant never sought a protective order for the production of any such "proprietary" information. And, Applicant never mentioned the existence of such plans as part of his testimony. Thus, with no record of such business plans, Applicant cannot now attempt to corroborate an alleged bona fide intent with the obtuse implication that "business plan information" – information that was never discussed, produced, or made part of the record – might exist.[2]

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[2] To allow Applicant to rely on the alleged existence of this information now would be highly prejudicial to Intel. During discovery, Intel sought to ensure that Applicant had produced *all* documents responsive to Intel's requests, specifically any documents that Applicant was withholding on alleged confidentiality grounds. Intel offered to enter into a protective order with Applicant to cover any such information or

B. The Senate Judiciary Committee's Illustrations Support a Finding of Applicant's Lack of Bona Fide Intent

In its Trial 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 Applicant's intent. (Intel's Br. at 13-15.) Applicant's Trial Brief partially addressed the applicability of two of these illustrations, but fails to show why they do not apply to this case.

As to his filing of numerous ITU applications to register marks for the same goods and services (Illustration No. 3, Intel's Br. at 15), Applicant explains "it is clear that the marks filed for, by the Applicant, have no objective basis for being identified as desirable." (Appl.'s Br. at 10.) Applicant's argument misses the point. The Senate illustration suggests that an applicant's filing of numerous ITU applications to be used in conjunction with the same goods may disprove the bona fide nature of applicant's intent. Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988). Here, it is undisputed that Applicant has filed numerous ITU applications for a variety of trademarks to be used on the same services, namely, on-line and off-line retail services for a wide range of goods (*see, e.g.*, Application Serial Nos. 75/825,226; 75/415,374; 75/885,342; 75/263,386; 75/415,363 and 75/263,382). Applicant eventually abandoned all of these U.S. applications, and many others in his home country. This is strong evidence of Applicant's lack of bona fide intent, notwithstanding his current characterization of the objective desirability of the marks.

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documents. In response, Applicant made it clear that it had produced all documents that were responsive to Intel's discovery requests.

Second, in response to Intel's statement that Applicant filed an "excessive number" of ITU applications to register marks that were never used, Applicant argues that he registered three trademarks in Canada and then asserts that "other trademark applications were put on hold pending the settlement of the Intel Opposition." (Appl.'s Br. at 10.) But Intel's opposition against *one* of Applicant's trademarks would not excuse his pattern of filing for various marks without any intent to develop them, nor would it provide Applicant with a valid reason why he has not, or could not, develop these "other trademark applications," including the IDEAS INSIDE mark. Further, Applicant has not submitted any evidence of the three purported Canadian registrations,[3] nor of these "other trademark applications." For all of these reasons, Applicant cannot rely on these assertions to argue that he possessed a bona fide intent to use the IDEAS INSIDE mark. Indeed, even if Applicant had obtained trademark registrations for three marks, that would not undo the inference made by the filing of nearly 30 ITU applications for laundry lists of goods or services, most of which were abandoned for failure to submit evidence of use. *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).

In addition, Applicant cannot, and does not, challenge the applicability of the first Senate illustration – *i.e.* that his IDEAS INSIDE application is unreasonably broad and lacks specificity. *See* discussion in Intel's Br. at 13.

Ultimately, Applicant offers no explanation as to why, over a relatively short period of time, he filed nearly thirty trademark applications, often for identical goods and services, but has not developed or used any of them. He has not produced any evidence

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[3] *See infra* discussion at pp. 7-8.

that he spoke to manufacturers, web developers, or engaged in other activity that would provide him the means to produce or offer any of the myriad goods and services listed in his IDEAS INSIDE trademark application. The nature of Mr. Emeny's conduct is precisely what Congress foresaw as an abuse of the ITU process.

C. Applicant's Arguments Do Not Establish a Bona Fide Intent to Use

Throughout his Trial Brief, Applicant relies on supposition – not any facts or evidence of record – in a failed attempt to prove that he had a bona fide intent to use the IDEAS INSIDE mark.

Section 801.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") required Applicant to support any factual allegations with citations to the evidentiary record. As the Board will note, there is not a single evidentiary citation in Applicant's Trial Brief, and with good reason: no documents or evidence that might support Applicant's bona fide intent are part of the record. Under the Rules, because Applicant failed to comply with Section 801.03, the Board should not give any weight or consideration to Applicant's uncorroborated assertions or arguments.

If anything, Applicant's Trial Brief shows that while Applicant might have had lofty aspirations during the "birth of the internet," he did nothing to develop the many trademarks for which he filed applications during that timeframe. (Appl.'s Br. at 9.) Applicant explains that he conceived the mark during a time when the business community was "racing to get funding to launch a new concept on the internet" and that "anything was possible during that time." (*Id.*) But Applicant never pursued or received any funding for his business, never put together a business plan, and did not produce evidence of either.

Elsewhere, Applicant tries to justify his inactivity when he states that he "was intent on preparing the launch of the IDEAS INSIDE business when it was opposed by the [sic] Intel Corporation" (*Id.*) and he "conceived and developed several businesses and is looking forward to their launch once the INTEL OPPOSITION is settled." (*Id.* at 7.) These arguments are revealing in several respects. First, Applicant indicates that he was "*intent* on preparing the launch" *when* his application was opposed – but that opposition occurred nearly two years *after* Applicant filed for the subject mark. Second, as discussed above, Applicant's subjective "intent" to prepare a launch two years after filing is uncorroborated by a single piece of paper or testimony that would demonstrate what steps he took to further his development of the IDEAS INSIDE trademark. Also, there is no evidence of Applicant's "several businesses," and no explanation why all of them would be put on hold pending an opposition against the IDEAS INSIDE mark.

Applicant further suggests that his conception of and filing for the IDEAS INSIDE mark (as one of his many trademarks) and his defense of this Opposition demonstrate a bona fide intent to use the mark. (*Id.* at 8.) But the existence of bona fide intent is determined at the time an applicant files his ITU application, *not* when he decides to defend an opposition. If an applicant's bona fide intent could be established by simply filing a trademark application and participating in a subsequent proceeding, the bona fide ITU requirement envisioned by Congress would be rendered meaningless: all that an applicant would have to do to overcome an attack on his lack of a bona fide intent would be to file an answer to a notice of opposition.

In the same vein, Applicant alludes to his registration of the "ideasinside.com" domain name, ostensibly to demonstrate his bona fide intent to use the IDEAS INSIDE

mark. This domain name, however, is not a part of the record in this proceeding. Also, Applicant never constructed or launched a website under the domain name and, to date, the website associated with Applicant's domain name is still unused and inactive. In any event, the mere reservation of an internet domain name, which can be done within minutes at a very low cost, is insufficient to demonstrate a bona fide intent.

Applicant also argues that he "registered three trademarks in Canada" (*Id.* at 8, 10, 11) in an attempt to prove his intent to use the IDEAS INSIDE mark. However, the existence of these three Canadian marks was not properly made of record and, equally problematic, Applicant has not provided any registration particulars or details on the alleged trademarks from which Intel or the Board could verify Applicant's claim of ownership. Likewise, there is also no evidence to support Applicant's suggestion that he established business under these three Canadian trademarks.

Even if the Board is inclined to consider these three Canadian registrations, their existence does not affect the analysis. Just because Applicant may have secured three unrelated trademark registrations in Canada does *not* establish his bona fide intent to use the IDEAS INSIDE mark in the United States.[4] The fact remains that that Applicant has applied for nearly thirty trademark applications in the U.S. and Canada (all of them with broad identifications of goods and/or services), which have been abandoned or which have never been used, and *all* of Applicant's U.S. applications (except for the subject application), have been abandoned without use. *See generally* Dep. of Steven Emeny

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[4] Applicant claims that Intel has falsely asserted that Applicant filed twenty Canadian ITU Applications, none of which matured to registrations." (Appl. Tr. Br. at 8). Intel's statement that twenty of Applicant's Canadian ITU applications have failed to register is entirely accurate and supported by the record. *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).

(Aug. 8, 2002) at pp. 27-8, 32-33 and 60-61 and Exhibits thereto (Exhibit F to Intel's Notice of Reliance). To the extent that this pattern of activity is an illustrative example from the Senate Judiciary Committee Report, the facts and implications remain the same. *See* Intel's Br. at 13-15 (discussing applicability of Senate Judiciary Report illustrations).

Finally, in an argument that is totally unrelated and irrelevant to the issue of Applicant's bona fide intent, Applicant asserts that Intel has undergone a re-branding and "no longer uses the INTEL INSIDE mark on it's [sic] microprocessors." (Appl.'s Br. at 8.) This is the second time in recent months that Applicant has made this unfounded argument, and just as Intel argued in response to this exact argument in the context of Intel's Motion to Amend its Opposition, this statement is irrelevant, false, and unsupported by any record in this proceeding.

III. CONCLUSION

For all of these reasons, Intel reiterates its request that the Board sustain the Notice of Opposition and refuse registration of Application Serial No. 75/825,218.

Respectfully Submitted,

Date: April 7, 2006

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Intel's REPLY TRIAL BRIEF was served on Mr. Steven Emeny, 93 Day Avenue, Toronto, Ontario M6E 3W1, Canada, by overnight courier, postage prepaid, this 7th day of April, 2006.

Mike Yaghmai