

Oral Hearing:  
August 25, 2011

Mailed:  
March 8, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Judith Mendez

v.

Dita, Inc.

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Consolidated:  
Opposition Nos. 91167828 and 91170265  
(to application Serial Nos. 78507798 and 78507802)

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Sean M. Novak of Novak & Ben-Cohen LLP for Judith Mendez.

Neil A. Goteiner<sup>1</sup> and Frank J. Riebli of Farella Braun &  
Martel LLP for Dita, Inc.

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Before Kuhlke, Bergsman, and Wellington,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Dita, Inc. (applicant) has filed an intent-to-use  
application to register the standard character mark DITA for  
the following:

Jewelry, namely, bracelets and wrist watches in  
International Class 17.<sup>2</sup>

Applicant has also filed a use-based application to  
register the same mark for the following goods:

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<sup>1</sup> Argued at oral hearing on behalf of applicant.

<sup>2</sup> Serial No. 78507798, filed on October 28, 2004.

Leather goods, namely, hand bags, wallets, luggage, and tote bags in International Class 18; and

Clothing, namely, jeans, t-shirts, tank tops, hats and shoes; leather goods, namely, belts and wristbands in International Class 25.<sup>3</sup>

Registration of the mark with respect to all goods in both applications has been opposed by Judith Mendez (opposer and a/k/a "Dita de Leon") on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act. Specifically, opposer has alleged that she "is the owner of a trademark under the same letters DITA"; that she is "in the business of manufacture and sale of jewelry under the trademark in use DITA"; and that she is "in the business of manufacture and sale of clothing, leather goods, hand bags and other goods..." By way of an earlier Board order, opposer's allegations have been deemed to include an assertion of opposer's priority with respect to her use of the DITA trademark.<sup>4</sup>

Applicant, in its answers, has denied the salient allegations of the notices of opposition. In addition, applicant claimed ownership of Registration No. 2080072 for

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<sup>3</sup> Serial No. 78507802, filed October 28, 2004. For the class 18 goods, the application states the mark was first used anywhere on February 18, 2002 and first used in commerce on May 17, 2002; with respect to the class 25 goods, the application states the mark was first used anywhere (and in commerce) on February 28, 1996.

<sup>4</sup> See June 23, 2008 Board order.

the mark DITA for "eyewear, namely, sun glasses and eye glasses" in International Class 9.<sup>5</sup>

Evidentiary Submissions and Objections

The record consists of the pleadings and files of the involved applications.

Opposer has filed the testimony deposition transcripts with exhibits of Jeff Solorio, applicant's president, and of herself, Judith Mendez.<sup>6</sup> Likewise, during its testimony period, applicant took the testimony of the same two individuals and submitted the deposition transcripts with exhibits.<sup>7</sup> To avoid confusion, references in this decision to the testimony will contain a Roman numeral "I" (signifying the first deposition taken during opposer's testimony period) or "II" (signifying the second deposition taken during applicant's testimony period).

In addition, applicant submitted under notices of reliance a copy of its DITA registration (Registration No. 2080072) and copies of printouts from printed publications in general circulation making reference to applicant's goods.

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<sup>5</sup> Issued on July 15, 1997; renewed.

<sup>6</sup> Mr. Solorio's (first) deposition taken on February 24, 2009, with Exhibits 1-2. Ms. Mendez' (first) deposition taken on March 2, 2009, with Exhibits 1-13.

<sup>7</sup> Mr. Solorio's (second) deposition taken on May 19-20, 2010, with Exhibits 3-31. Ms. Mendez' (second) deposition taken on May 19, 2010, with Exhibits 14-24.

The Board previously granted applicant's motion to strike two declarations (one signed by opposer's sister and the other by a person who purportedly assisted opposer with website design) that were submitted by opposer under a notice of reliance. These same two declarations were also submitted by opposer as exhibits during the first Mendez deposition (Mendez I, Exhibits 12 and 13). At the time of their introduction, applicant objected on the basis that Ms. Mendez' was unable to authenticate the documents themselves and that the content of the declarations constitutes hearsay. Applicant reiterated its objections in its trial brief.

It has long held that absent a stipulation or motion approved by the Board, a party may not submit evidence during its testimony period by way of declaration; rather such evidence must be submitted by testimony deposition. Trademark Rule 2.123(b). See *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007). Accordingly, applicant's objection is sustained and the Mendez I Exhibits 12-13 have not been considered.

In its trial brief, opposer argues that applicant "failed to comply with discovery obligations...rendering its purported evidence inadmissible." Brief, p. 23. In particular, opposer objects to applicant's reliance upon Exhibits 1-30 to the Solorio I and II depositions. In

addition, opposer objects to Mr. Solorio's testimony regarding opposer's website because "there is no basis or foundation for Mr. Solorio's testimony concerning his opinions relating to the creation and maintenance of Opposer's website." Brief, 25. We need not consider the merits of these objections because the testimony and materials that applicant seeks to strike from the record have no bearing on the outcome of our ultimate decision. Simply put, the objected-to testimony and exhibits are not pertinent or outcome determinative and we see no need to address the arguments regarding this evidence in this decision.

The oppositions have been fully briefed and an oral hearing was held before this panel.

Standing

A party has standing to oppose within the meaning of § 13 if that party can demonstrate a "real interest" in the proceeding. *Universal Oil Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 460 (1972). See also *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In her pleadings, opposer has alleged that she "is in the business of manufacture and sale of jewelry under the trademark in use DITA" (Not. of Opposition, 91167828) and that she is "in the business of manufacture and sale of clothing, leather goods,

hand bags and other goods...under the trademark in use DITA" (Not. of Opposition, 91170265). In her testimony, opposer has testified that she is a celebrity entertainer who goes by the name "Dita" and that she also sells (or has sold) clothing, leather goods and hand bags utilizing DITA as a trademark in connection therewith. This testimony is sufficient to establish opposer's standing.

Priority

Priority of use is a necessary element in any likelihood of confusion under Section 2(d).

At the very least, applicant can rely on the filing date of its trademark applications for priority purposes, namely, October 28, 2004. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991)

("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights."). We note applicant argues an earlier priority date for certain goods; however, as explained further below, it is not necessary to look beyond its constructive use or filing date of its applications.

We must now determine whether opposer has used its mark prior to applicant's priority date of October 28, 2004.

**Opposition Nos. 91167828 and 91170265**

Because opposer is not claiming ownership of a federal registration, she must show that she acquired common law rights prior to applicant's priority date. *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (The "decision as to priority is made in accordance with the preponderance of the evidence").

In attempting to prove her priority of use, opposer relies exclusively on her deposition testimony and related exhibits. Oral testimony, even of a single witness, if "sufficiently probative," may be enough to prove priority. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965); and *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972). However, the testimony should carry with it "conviction of its accuracy and applicability." *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232 (CCPA 1945). See also *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge

of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

Under direct examination, opposer testified that she has used DITA as a trademark "as early as the 1980s" on certain goods identified in each class of the opposed applications. However, her responses are vague and indefinite when describing the nature and extent of her initial purported use of the trademark DITA. Under questioning by her own counsel, she testified:

Q. What's your best estimate as to when you first started selling items for more than just casually?

A. I am going to be honest, in the '80s, even if I was 10 years old, I thought I was a serious businesswoman. And I took very - it was very serious for me, you know, charging whatever money, \$4.00, \$5.00, whatever it was I charged at the time. I don't remember. You know, and I was - like I said, I was a child prodigy. I was, you know, at a very young age already considering myself a businesswoman.

[Mendez I 29:6-15].

Q. What is your best estimate, though - let me give a time frame of let's say, 19- between 1985 and the year 2005, could you estimate how much total income you derived from - from sales of jewelry? Just your best estimate.

A. Under 10,000 maybe.



Q. And how about between 1985 and 2005, can you estimate how much income you derived from sales of clothing with the Dita mark on them?

A. They - it has not been a high volume business. So, again, I don't have an exact number for you. But I know it's not more than 10,000.

[Mendez I, 52:8-19].

On cross-examination, opposer offered even less definite testimony regarding her purported use of the term DITA as a trademark on goods similar to those of applicant. At several points in her depositions, opposer became evasive in her responses and combative.<sup>8</sup> Opposer's evasiveness is exemplified at Mendez I 62:24-66:25 (involving lack of documents evidencing actual sales). We further note opposer's counsel objected at one point to this questioning as "vague" and "overbroad"; however, to the contrary, the questioning was clear and could not reasonably be misunderstood by Ms. Mendez.

When asked to estimate how many units or the amount of income she derived from sales of these products, she often responded "I'm not going to guess" or simply that she could not recall. She could not identify any suppliers who actually supplied her with the goods that she purportedly

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<sup>8</sup> We would be remiss if we did not point out the unprofessional dialogue that transpired between counsel for both parties during Ms. Mendez' depositions, as well as Ms. Mendez' interaction with applicant's counsel. Many pages of the deposition transcripts are replete with irrelevant bickering and involve personal attacks. Despite the absence of a Board official at testimonial

sold under the trademark DITA. Ultimately, her testimony in its entirety results in a very unclear picture of what activities, if any, were undertaken prior to October 28, 2004, whereby we can find that she acquired trademark rights in the name DITA for any goods.

As to any documents evidencing actual sales of goods, opposer produced a single Paypal (electronic payment service) printout that references the sale of an item described as "Dita's Autographed Photo," bearing a date of June 8, 2007. Mendez, Exhibit 10. This exhibit clearly does not corroborate opposer's testimony that she was using DITA as trademark for any of the goods at issue prior to October 28, 2004.

Opposer, in her testimony, excuses the lack of documentary evidence and inability to estimate sales figures as being the result of her conducting a "Mom and Pop" business and the number of years that have passed since 2004 (or earlier) and the taking of her testimony (March 2009 and May 2010). However, even for the two year time period immediately preceding her deposition, opposer was evasive on the same issue regarding documentation evidencing actual sales and was unable to provide an estimate of sales:

Q. So in the \$ 200,000 over the past two years you made, approximately, was there any - did any of that revenue come from selling product?

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depositions, parties and counsel are "required to conduct their business with decorum and courtesy." Trademark Rule 2.192.

A. Some of it, yes. It wasn't a lot.

Q. How much?

A. I don't know. I haven't provided that accounting.

Q. Approximately.

A. I haven't calculated, so I'm not going to engage in guessing right now.

Q. Well, I just want an approximate number.

A. I know what you want and I just gave you an answer.

Q. Was it more than \$100,000?

A. No.

Q. Was it more than \$5,000?

A. I don't know.

Q. Was it more than \$50,000?

A. I have—I just said I don't know.

Q. So you don't know more—

A. I'm not going to engage in guessing.

[Mendez II, 83:10-84:9].

...

Q. What have you sold? What products have you sold over the past two years where you generated money?

A. The products have been I have an ongoing T-shirt collection.

Q. And where do you sell them?

A. Those are sold online—

Q. And how much have you made from them?

A. - or in person. I already answered that question.

Q. Approximately.

A. I have not quantified that.

Q. Do you have any evidence that you've sold anything?

A. I don't have any - no receipts.

Q. No receipts, no evidence at all?

A. No. They are available online. You can see the product online.

Q. Do you have - but you have no evidence of receipts?

A. No.

[Mendez II, 85:16-86:10].

Based on the record before us, with particular emphasis on the entirety of opposer's own testimony and all related exhibits, we do not find that opposer has established by the preponderance of the evidence that she was using DITA as a trademark on any goods prior to October 28, 2004. We are not persuaded by opposer's vague and general testimony.

Based on the testimony of Ms. Mendez, we cannot determine with any specificity when she first used the mark DITA and we cannot determine in general whether she used the mark DITA prior to the filing date of applicant's applications. *See Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 92 USPQ 330, 333 (CCPA 1952) ("[T]here is no evidence of any advertising or of sales of any product to any particular customers, nor is there any evidence which would indicate use of the trade mark [sic] 'Mark Twain' on collars prior to October 1, 1921, except the oral testimony of the witnesses

aforementioned. The only specimen produced showing use of the mark was the above-mentioned collar which was manufactured in 1937.") Read in its entirety, her testimony does not carry with it "conviction of its accuracy and applicability." *B.R. Baker Co.*, 66 USPQ 232.

Inasmuch as the oral testimony of opposer regarding her first use of DITA is unsupported by documentary evidence and is not "clear and convincing," opposer has failed to establish by a preponderance of the evidence use of her mark prior to applicant's established first use date of October 28, 2004. For the reasons discussed, priority rests with applicant in the consolidated proceedings.

Conclusion

After careful consideration of the evidence and the parties' briefs, we conclude that opposer has failed to establish her priority, which is a necessary element of any claim under Trademark Act § 2(d).

**Decision:** The consolidated oppositions are dismissed with prejudice.