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

Proceeding	91176744
Party	Plaintiff DC Comics and Marvel Characters, Inc.
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Signature	/Michelle C. Morris/
Date	05/29/2009
Attachments	SUPER HERO SJ Motion.pdf (42 pages)(989134 bytes)

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

DC COMICS and
MARVEL CHARACTERS, INC.,

Opposers,

v.

MICHAEL CRAIG SILVER,

Applicant.

Opposition No. 91/176,744
Application No. 78/823,155
Mark: SUPER HERO

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56(a), Trademark Rule of Practice 2.127(e) and Trademark Board Manual of Procedure § 528, Opposers DC Comics and Marvel Characters, Inc. ("Marvel") (collectively, "Opposer") hereby move for an order granting Opposer's Motion for Summary Judgment. This motion is based on Applicant Michael Silver's ("Applicant") lack of a *bona fide* intent to use the SUPER HERO trademark in United States commerce in connection with the goods identified in Application Serial No. 78/823,155. Such conclusion follows from the discovery in this matter, which reveals that Applicant possessed no marketing plans, business plans or other documents; no marketing or manufacturing contacts; and no knowledge or relevant experience in the industry. In light of the Board's recent decision in *Honda Motor Co., Ltd. v. Winkelmann*, Opp. No. 911770552 (TTAB April 8, 2009) (precedential), summary judgment is appropriate herein.

I. STATEMENT OF THE FACTS.

a. Opposer's Business and Trademark Registrations.

DC Comics and Marvel are among the most famous media companies in the world. DC Comics owns a vast array of character properties, including internationally famous characters such as SUPERMAN® and BATMAN®. Marvel owns an equally large portfolio of world-renowned character properties, including SPIDER-MAN® and X-MEN®. DC Comics and Marvel jointly own the trademarks SUPER HERO® and SUPER HEROES®.

DC Comics and Marvel publish comic books featuring their character properties and trademarks. In addition, a substantial part of Opposer's business involves licensing its marks and characters for use in connection with a myriad of goods and services, including (without limitation) clothing, toys, foods, motion pictures, television programs, home videos, computer games, cosmetics and toiletries. *See* Declaration of Carol G. Pinkus (Pinkus Dec.") at ¶ 5; Declaration of Marilyn Drucker ("Drucker Dec.") at ¶ 5¹. Opposer's merchandise licensing programs are among the largest and most successful in the world, involving hundreds of licensees and generating hundreds of millions of dollars in gross revenues. Pinkus Dec at ¶ 6; Drucker Dec. at ¶ 6.

Beginning at least as early as 1966, Opposer (including its predecessors-in-interest) has used its SUPER HERO® and SUPER HEROES® trademarks in connection with comic books, toys and masquerade costumes. Pinkus Dec at ¶ 7; Drucker Dec. at ¶ 7. Opposer owns the following registrations for its SUPER HERO® and SUPER HEROES® trademarks:

¹ These Declarations were originally submitted in connection with Opposer's Motion for Summary Judgment filed on October 25, 2007, and were uncontested by Applicant.

Mark	Reg. No.	Reg. Date	Goods
SUPER HERO	825, 835	3/14/67	IC 025. Masquerade costumes
SUPER HEROES	1,140,452	10/14/80	IC 028. Toy Figures
SUPER HEROES	1,179,067	11/24/81	IC 016. Publications, particularly comic books and magazines and stories in illustrated form, notebooks and stamp albums.
SUPER HERO	3,022,405	12/06/05	IC. 030. Ice cream

Certified status and title copies of these registrations are attached as Exhibit "A" to this motion.

In addition, Opposer owns several registrations for related marks which cover a variety of cosmetics and body products, including the following:

Mark	Reg. No.	Reg. Date	Goods
KRYPTONITE (owned by DC Comics)	2,936,470	3/29/05	IC 03. Cosmetics, namely lipstick, lip gloss and non-medicated lip balm; mascara; nail enamel; face powder, face cream, skin lotion and skin gel; bath powder and perfumed body powder; bath oil, bath gel and non-medicated bath salts; baby oil, baby powder, baby gel and baby lotion; hand cream and lotion; body cream and lotion; sunscreen preparation, namely cream and lotion; shaving cream and after-shave lotion, skin cleanser and non-medicated body soaks; body deodorant, cologne and perfume; soaps, namely, liquid bath soap, gel soap and bar soap; detergent soap, namely, liquid and powder; fabric softener; deodorant soap, skin soap; shampoo and shampoo conditioner; and hairstyling gel.

X-MEN (owned by Marvel)	3,250,362	11/17/06	IC 028. Cologne; Eau-de-toilette; Fragrances for personal use; Perfume
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Certified status and title copies of these registrations are attached as Exhibit "B" to this motion.

b. Applicant Michael Silver.

Applicant Michael Silver is a California resident and self-employed real estate broker. *See*, Deposition of Michael Silver (February 23, 2009) ("Silver Dep.") at pp. 6-7, attached as Exhibit "A" to the Declaration of Jonathan D. Reichman ("Reichman Dec."). Applicant has also dabbled in the sale of t-shirts. Silver Dep. at 14-15. Applicant possesses a Juris Doctor degree from San Francisco Law School, but never pursued a law career. Silver Dep. at 160, 164-165. He floated between a few business school programs, but never completed the M.B.A. coursework. Silver Dep. at 163-164.

On February 24, 2006, Applicant filed the intent-to-use application which is the subject of this proceeding, namely, Application Serial No. 78/823,155 to register SUPER HERO in International Class 3 for "After sun creams; Beauty creams for body care; Cosmetic products in the form of aerosols for skincare; Non-medicated sun care preparations; Skin moisturizer; Skin toners; Sun block; Sun care lotions; Sun screen; Sun tan oil; Sun-block lotions" (the "Application"). When questioned about his reasons for selecting the mark SUPER HERO, Applicant proffered that he was in a park and heard a dog being called "super hero," and therefore "decided he would name the 'International Class 3' product after the dog." *See*, App. Supp. Interrog. Resp., at 26; Silver Dep. at p. 33.

At the time of filing his Application, Applicant had not created a single business plan; had not researched the basic information on the logistics of creating the proposed products; had

not conducted any marketing study; and had not entered into or pursued a single manufacturing contact. *See*, Opposer's First Request for Production of Documents to Applicant ("Opp.'s Doc. Req.") at Reqs. 3, 5, 6, 16-25; Applicant's Amended/Supplemental Responses to Opposer's Document Request Nos. 1-14 and 35 ("App Supp. Doc. Resp."), at Resps. 3, 5, 6, 16-25, which are attached to the Reichman Dec. as Exhibits B and H, respectively.; Silver Dep. at pp. 56-57, 105, 112-113, 136-139.

Moreover, in the three years since his filing, including the nine month period between filing and Opposer's first request for an extension of time to oppose (on November 13, 2006), Applicant has made no further progress in this regard. *See*, Silver Dep. at pp. 56-57, 85, 105, 112-113, 118, 136-140. He has not even written a "check-list" of things he might need to take this project forward. Silver Dep. at p. 137. As conceded in Applicant's interrogatory responses, "Applicant has not taken any steps towards manufacturing, distributing, selling and or promoting any products under the SUPER HERO Trademark." *See*, Applicant's Amended/Supplemental Responses to Interrogatory Nos. 1-27 ("App. Supp. Interrog. Resp."), at 27, which is attached to the Reichman Dec. as Exhibit I.

Applicant possesses no experience in manufacturing or marketing any of the skin care or sunscreen products identified in the Application, and, subsequent to filing, has not sought to gain any such experience. *See*, Silver Dep. at p. 43, 56-57, 112-113, 136-139. Furthermore, Applicant was not even aware of any Food and Drug Administration ("FDA") regulations regarding skin care and sun screen products (Silver Dep. at pp. 54-59), and did not realize that the term "SPF" stood for "Sun Protection Factor." Silver Dep. at p. 63-64. Applicant has no specific scientific or chemical educational training to equip him with the ability to develop the

proposed products, and has not contacted any third party to explore the process. Silver Dep. at pp. 54-57, 112-113, 136.

c. Discovery History.

On May 5, 2008, Opposer served on Applicant written discovery requests consisting of Opposer's First Request for Production of Documents to Applicant ("Opp.'s Doc. Req."), Opposer's First Set of Interrogatories to Applicant ("Opp.'s Interrogs."), and Opposer's First Set of Requests for Admission to Applicant (collectively, "Opposer's Discovery Requests," which are attached to the Reichman Dec. as Exhibits B, C, and D, respectively).

On June 6, 2008, Applicant served his first set of written responses to Opposer's Discovery Requests, consisting of Applicant's Response to Opposer's First Set of Document Requests, Applicant's Response to Opposer's First Set of Interrogatories, and Applicant's Response to Opposer's First Set of Requests for Admission, which are attached to the Reichman Dec. as Exhibits E, F and G, respectively. Applicant provided virtually no information, objecting to each request on the basis of work product or attorney-client privilege, and provided no documents. Therefore, on July 3, 2008, Opposer filed a Motion to Compel Discovery, which was granted in full by the Board on September 4, 2008 (the "Board's September 4 Order").

In response to the Board's September 4 Order, on October 2 and October 3, 2008 Applicant served the following supplemental discovery responses: Applicant's Amended/Supplemental Responses to Opposer's Document Request Nos. 1-14 and 35 ("App. Supp. Doc. Resp."), Applicant's Amended/Supplemental Responses to Interrogatory Nos. 1-27 ("App. Supp. Interrog. Resp."), and Applicant's Document Production ("Apps. Doc. Prod."), which are attached to the Reichman Dec. as Exhibits H, I and J , respectively.

Although Opposer had served detailed document requests relating to Applicant's intended use of the mark, Applicant did not produce a *single piece* of documentation reflecting that he had a *bona fide* intent to use the SUPER HERO mark in commerce. To the contrary, Applicant's sole production documents consisted of an Office email confirming receipt of the Application, and handwritten notes regarding settlement discussions and Board procedures.

Based upon Applicant's discovery responses—or, more precisely, the absence thereof—it became clear to Opposer that Applicant lacked a *bona fide* intent to use the SUPER HERO mark in commerce at the time of filing. Therefore, on October 31, 2008, Opposer filed a Motion to Amend its Notice of Opposition to include this ground as a basis for opposition. Opposer's motion was granted on December 31, 2008, and the Board re-opened discovery to allow follow-up investigation on this issue. Pursuant to this Order, Opposer took Applicant's deposition on February 23, 2009². Applicant's deposition testimony confirmed that Applicant had no *bona fide* intention to use the mark in commerce. Opposer therefore moves for summary judgment on this basis.

II. APPLICANT LACKED A BONA FIDE INTENT TO USE THE SUPER HERO MARK AT THE TIME HE FILED HIS APPLICATION.

a. **The Standard for Summary Judgment.**

A case should be disposed of on summary judgment when “the pleadings . . . together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. 56(c). *See, e.g. Celotex, Corp. v. Cartrett*, 477 U.S. 317, 322-23 (1986). The initial burden of proof rests with the movant

² Opposer noticed this deposition to take place at the undersigned counsel's branch office in San Jose, California, which is approximately 60 miles from Applicant's residence in Sausalito, California. Although the deposition location was in compliance with 37 CFR 2.120(b) and TBMP 403.03(a), Applicant initially refused to appear at this location, on the ground that it was too far away. Opposer resolved this dispute, and secured Applicant's appearance in San Jose, by paying his transportation costs, even though such payment is not required under the Rules. Reichman Dec. ¶ 4.

to establish that there are no genuine issues of material fact in dispute. *Celotex*, 477 U.S. at 317. However, once the movant has satisfied its initial burden of going forward, the burden shifts to the non-movant to establish a genuine issue of material fact. *Anderson v. Liberty Loddy, Inc.*, 477 U.S. 242, 250 (1986). A factual dispute is considered “genuine” when the evidence put forth by the non-movant is substantial enough to require a trial. *Anderson*, 477 U.S. at 249.

“The purpose of the motion [for summary judgment] is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case.” TBMP § 528.01. The Board does not hesitate to dispose of cases on summary judgment when appropriate. *See, e.g., Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1476-1478 (TTAB 1992); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1568 (Fed. Cir. 1987); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1405 (Fed. Cir. 1984).

6. Lanham Act Section 1(b) Requires That Applicant Have a *Bona Fide* Intent to Use.

Lanham Act Section 1(b) states, in pertinent part, that “a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce,” may apply to register such mark.

The Trademark Law Revision Act of 1988 introduced the intent-to-use process, and it was “the intent of congress in enacting Section 1(b) that the *bona fide* requirement focus on an objective good-faith test to establish that an applicant’s intent is genuine.” *See, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1057 (TTAB 1993) (emphasis added). In addition, according to Professor J. Thomas McCarthy, “[e]vidence is objective. . . 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.” See, *J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition* § 19:14, at p. 19-40 (4th ed. 2004) (emphasis added). Under the foregoing standards, an applicant’s “mere statement of subjective intention, without more, would be insufficient to establish applicant’s *bona fide* intention to use the mark in commerce.” *Lane Ltd. v. Jackson Int’l Trading Co.* 33 USPQ2d 1351, 1355 (TTAB 1994).

As a result, “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).” *Commodore Electronics Ltd. supra*, 26 USPQ2d at 1507; see also, *Boston Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (precedential) (applicant’s lack of *bona fide* intent was established by his failure to provide, in response to opposer’s discovery requests, any documents establishing any plan as to how he would proceed with the relevant business); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1891-1892 (TTAB 2008) (precedential) (applicant’s admission in discovery that he had no documents evidencing his intent to use the mark established his lack of *bona fide* intent); *Intel Corp. v. Steven Emeny*, 2007 LEXIS 101, *18-20 (TTAB May 15, 2007) (applicant’s failure to produce any objective evidence of an intent to use the mark resulted in judgment in favor of opposer on the issue of lack of *bona fide* intent).

While the Board has traditionally regarded issues of intent as unripe for summary judgment, it has recently ruled otherwise in a case remarkably similar to the instant dispute. Specifically, in *Honda Motor Co., Ltd. v. Winkelmann*, Opp. No. 911770552 (TTAB April 8, 2009) (precedential) (Exhibit “C” hereto), the Board granted an opposer’s summary judgment

motion on an applicant's lack of *bona fide* intent to use, based on the applicant's lack of documentary evidence demonstrating otherwise. In this action, *pro se* applicant Winkelmann had filed an application to register "V.I.C." for "vehicles for transportation," which was challenged by Honda Motor Co. Ltd. ("Honda") based on a likelihood of confusion with its "CIVIC" trademarks. Winkelmann admitted in his interrogatory responses that he "ha[d] not had activities in the U.S. and ha[d] not made or employed a business plan, strategy, arrangements or methods there," and "ha[d] not identified channels of trade that will be used in the United States." *Id.* at 7. The only documents he produced were printouts from his website which were written in German; copies of his "German, European and WIPO" trademark registrations; and correspondence with the Office. *Id.* at 9.

Thereafter, Honda filed a motion to amend its Notice of Opposition and a motion for summary judgment on the ground that Winkelmann lacked the requisite *bona fide* intent-to-use. In response, Winkelmann submitted only "statements of subjective intent." *Id.* at 9. The Board granted Honda's motion, stating:

[While] the factual question of intent is particularly unsuited to disposition on summary judgment...the absence of any documentary evidence to support an applicant's lack of bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention..." *Id.* at 4.

As explained below, this ruling is directly on point herein.

c. Applicant Lacked a *Bona Fide* Intent To Use the SUPER HERO Mark.

As in *Honda*, Applicant herein has failed to produce a single document, or provide a single piece of corroborating information, in support of his claimed intent to use the mark, and therefore Applicant is incapable of establishing a *bona fide* intent.

In its discovery requests, Opposer sought "[d]ocuments sufficient to show Applicant's use or intended use of SUPER HERO in connection with any products or services sold. . . or

intended to be sold . . . by Applicant.” See Opp.’s Doc. Req., at Req. 4. In response, Applicant directed Opposer to “Figure 1 detailing USPTO email confirmation of SUPER HERO mark application receipt.” See, App.’s Doc. Resps., at 4; and App.’s Doc. Prod. However, this single document, an email from the Office, is totally insufficient to objectively prove Applicant’s *bona fide* intent to use the mark in commerce.

Similarly, Opposer requested documents relating to Applicant’s intended advertising, marketing plans, pricing, customer information, intended channels of trade, *etc.* In response, Applicant repeatedly stated that he possessed no documents or “no documents exist.” See, Opp. Doc. Req. at Reqs. 16-25; App.’s Supp. Resp. to Doc. Req., at Resps. 16-25. In fact, aside from the Office’s email, Applicant’s only document production consisted of handwritten notes which refer to settlement negotiations and Board procedures. See, Applicant’s Document Production.

Applicant’s interrogatory responses further reflect his lack of a *bona fide* intention to use the mark in commerce. For example, in response to Opposer’s inquiry regarding any steps taken by Applicant toward manufacturing, distributing, selling and/or promoting any products or services under the SUPER HERO trademark, Applicant conceded, “Applicant has not taken any steps towards manufacturing, distributing, selling and or promoting any products or services under the SUPER HERO trademark.” See Opp. Interrogs., at Req. 27; App.’s Supp. Interrog. Resp., at Resp. 27.

Moreover, the remainder of Applicant’s interrogatory responses, as well as Applicant’s deposition statements, plainly reveal that he has not even given so much as a thought as to retail or wholesale prices (“Applicant does not know the retail or wholesale prices which Applicant plans to sell the product.” See App.’s Supp. Interrog. Resp., at Resp. 12), or the trade channels through which he intends to sell the products, or realistic advertising methods; and that he has no

specific target market for the products (“Applicant plans to sell it’s product to all consumers no matter what gender, age group, education level or socioeconomic status they hold. No product has been sold yet.” *See*, App.’s Supp. Interrog. Resp., at Resp. 14.) *See also*, Opp. Interrogs., at Reqs. 7-9, 12-14, 19, 21, 26-27; App.’s Supp. Interrog. Resp. at Resp. 7-9, 12-14, 19, 21, 26-27.

Additionally, it is common sense that the proposed skin care and sun screen products are not easily brought to market without some industry expertise. However, Applicant admitted that he has *zero* experience in this field. *See*, Silver Dep. at p. 43. Thus, similar to the applicant in *Boston Red Sox*, who was “an individual with no relevant experience, training, or business connections of record,” Applicant in this case is also devoid of any relevant industry experience. *Boston Red Sox, supra*, 88 USPQ2d at 1587.

Moreover, sunscreen products are obviously regulated by the FDA. *See* August 23, 2007 FDA news release “*FDA Aims to Upgrade Sunscreen Labeling*,” attached as Exhibit “K” to the Reichman Dec. However, Applicant has absolutely no knowledge of those regulations, and has never even bothered to research any potential regulatory issues. Silver Dep. at pp. 54-59. Not only was Applicant unaware of any FDA regulations concerning sunscreen, Applicant was not even aware that the term “SPF” stands for “Sun Protection Factor.” Silver Dep. at pp. 63-64.

Furthermore, Applicant has no specific scientific or chemical educational training to equip him with the capability to develop the proposed skin care products, and to this day has not contacted or hired any third parties for advice or assistance in the process. Silver Dep. at pp. 56-57. In fact, Applicant has not made a single manufacturing or advertising contact; has not created a business plan; has not conducted any market studies or performed any research concerning the logistics of bringing skin care products to market; has not assembled any financial analysis of the projected costs or revenues; and has not taken any steps toward product

development or packaging. *See e.g.*, Silver Dep. at pp. 54-57, 72-74, 85, 105, 112-113, 136-139; Opp. Doc. Req. at Reqs. 3, 5, 6, 16-25; App's Supp. Resp. to Doc. Req., at Resps. 3, 5, 6, 16-25. Applicant has not even made a simple check-list of things to do to take the project forward. Silver Dep. at p. 137.

In his deposition testimony, Applicant asserted that his defense of the opposition proceeding qualifies as a "very important step in producing the product," and in fact it was the *only* step that he could point to in supporting his *bona fide* intent. *See*, Silver Dep. at pp. 112-113. However, the Board has clearly held that "[a]pplicant's decision to forgo a business model until after the opposition is decided does not explain his failure to have any documents whatsoever at the time the application was filed that showed an intent to use the mark." *L.C. Licensing, Inc., supra*, 86 USPQ2d at 1892.

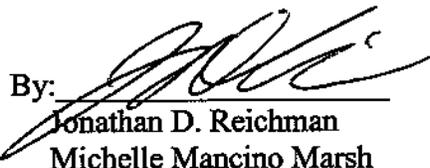
Applicant's main interest in applying to register the SUPER HERO mark was to "name the International Class 3 products" after a cute dog he met in a park. *See*, App. Supp. Interrog. Resp., at 26; Silver Dep. at p. 33. But his desire clearly did not align with any actual *bona fide* intention to bring the products to market, because he has done *absolutely nothing*—either before or after filing his Application—move the process forward. Thus, given Applicant's complete failure to produce a shred of evidence, Applicant has not and cannot objectively demonstrate that he held the requisite *bona fide* intent to commercially use the SUPER HERO mark as of his application filing date. Simply asserting a *bona fide* intent is not sufficient to avoid summary judgment. *See, Honda Motor Co., supra*. As such, no genuine issue of material fact exists for the Board to decide, and accordingly Opposer is entitled to summary judgment.

CONCLUSION

For the reasons hereinabove set forth, Opposer respectfully requests that the Board issue an order granting Opposer's Motion for Summary Judgment, sustaining its Opposition, and refusing registration to U.S. Application Ser. No. 91/176,744.

KENYON & KENYON LLP

Dated: May 29, 2009

By: 

Jonathan D. Reichman
Michelle Mancino Marsh
Michelle C. Morris
One Broadway
New York, New York 10004
(212) 425-7200
Attorneys for Opposer

PROOF OF SERVICE

I hereby certify that true and complete copy of OPPOSER'S MOTION FOR SUMMARY JUDGMENT, the Declarations of Jonathan D. Reichman, Marilyn Drucker and Carol G. Pinkus and accompanying exhibits, including the Deposition of Michael Silver, have been served by mailing said copy on May 29, 2009, via first class mail to:

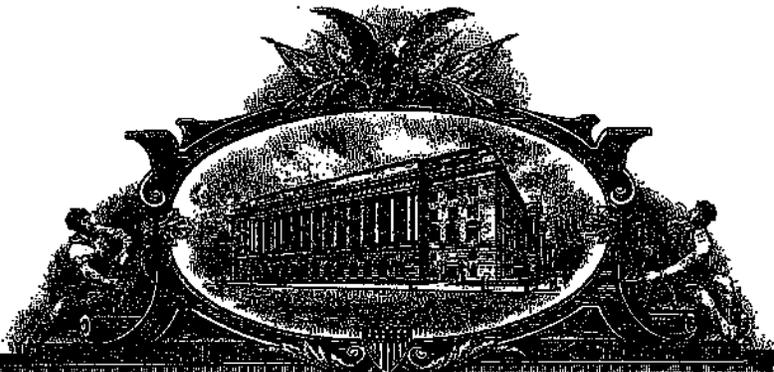
Michael Craig Silver
64 Lincoln Drive
Sausalito, CA 94965



Michelle C. Morris

EXHIBIT A

1750728



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

April 30, 2009

THE ATTACHED U.S. TRADEMARK REGISTRATION 825,835 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

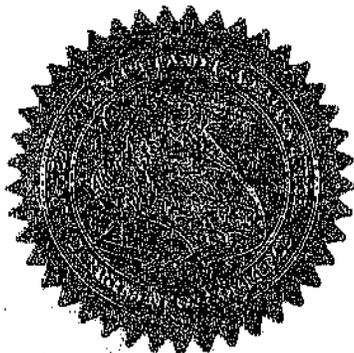
REGISTERED FOR A TERM OF 20 YEARS FROM *March 14, 1967*
2nd RENEWAL FOR A TERM OF 10 YEARS FROM *March 14, 2007*
SECTION 8

SAID RECORDS SHOW TITLE TO BE IN:

MARVEL CHARACTERS, INC.
A DELAWARE CORPORATION

By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

T. Wallace
T. WALLACE
Certifying Officer



Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office
Renewal

Reg. No. 825,835
Registered Mar. 14, 1967
OG Date Oct. 4, 1988

**TRADEMARK
PRINCIPAL REGISTER**

SUPER HERO

MARVEL ENTERTAINMENT GROUP,
INC. (DELAWARE CORPORATION)
387 PARK AVENUE SOUTH
NEW YORK, NY 10016 AND

DC COMICS, INC. (NEW YORK CORPO-
RATION)
666 FIFTH AVENUE
NEW YORK, NY 10103, ASSIGNEE BY
MESNE ASSIGNMENT BEN COOPER,
INC. (NEW YORK CORPORATION)
BROOKLYN, NY

FOR: MASQUERADE COSTUMES, IN
CLASS 39 (INT. CL. 25).

FIRST USE 10-29-1965; IN COMMERCE
3-4-1966.

SER. NO. 243,225, FILED 4-12-1966.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 4, 1988.*

COMMISSIONER OF PATENTS AND TRADEMARKS

1750728

THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE**

United States Patent and Trademark Office

April 28, 2009

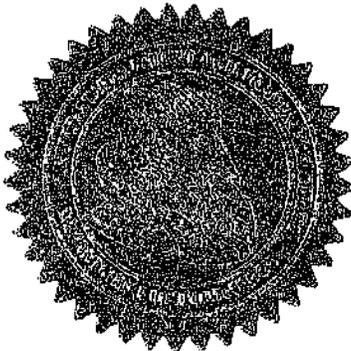
**THE ATTACHED U.S. TRADEMARK REGISTRATION 1,140,452 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.**

**REGISTERED FOR A TERM OF 20 YEARS FROM *October 14, 1980*
1st RENEWAL FOR A TERM OF 10 YEARS FROM *October 14, 2000*
SECTION 8 & 15**

SAID RECORDS SHOW TITLE TO BE IN:

***MARVEL CHARACTERS, INC.
A DELAWARE CORPORATION***

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**



A handwritten signature in black ink, appearing to read "P. Swain".

**P. SWAIN
Certifying Officer**

Int. Cl.: 28

Prior U.S. Cl.: 22

United States Patent and Trademark Office

Reg. No. 1,140,452

Registered Oct. 14, 1980

TRADEMARK
Principal Register

SUPER HEROES

Cadence Industries Corporation (Delaware corporation)
575 Madison Ave.
New York, N.Y. 10022
and
DC Comics Inc. (New York corporation)
75 Rockefeller Plz.
New York, N.Y. 10019, assignees of
Ben Cooper, Inc. (New York corporation)
Brooklyn, N.Y.

For: TOY FIGURES, in CLASS 28 (U.S. Cl. 22).
First use Jul. 2, 1973; in commerce Jul. 2, 1973.
Owner of U.S. Reg. No. 1,080,655.

Ser. No. 11,796, filed Jan. 24, 1974.

M. MERCHANT, Primary Examiner

1751939

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

May 01, 2009

**THE ATTACHED U.S. TRADEMARK REGISTRATION 1,179,067 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.**

REGISTERED FOR A TERM OF 20 YEARS FROM *November 24, 1981*

1st RENEWAL FOR A TERM OF 10 YEARS FROM *November 24, 2001*

SECTION 8 & 15

LESS GOODS

SAID RECORDS SHOW TITLE TO BE IN:

MARVEL CHARACTERS, INC.

A DELAWARE CORPORATION

By Authority of the

Under Secretary of Commerce for Intellectual Property

and Director of the United States Patent and Trademark Office



A handwritten signature in black ink, appearing to read "P. Swain".

P. SWAIN

Certifying Officer

Int. Cl.: 16

Prior U.S. Cls.: 5, 22, 37 and 38

United States Patent and Trademark Office

Reg. No. 1,179,067

Registered Nov. 24, 1981

TRADEMARK

Principal Register

SUPER HEROES

Cadence Industries Corporation (Del. corporation),
a.k.a. Marvel Comics Group and DC Comics Inc.
575 Madison Ave.
New York, N.Y. 10022

For: PUBLICATIONS, PARTICULARLY
COMIC BOOKS AND MAGAZINES AND
STORIES IN ILLUSTRATED FORM; ~~CARD-
BOARD STAND UP FIGURES, PLAYING
CARDS, PAPER IRON ON TRANSFERS, ERAS-
ERS, PENCIL SHARPENERS, PENCILS, GLUE
FOR OFFICE AND HOME USE, SUCH AS IS
SOLD AS STATIONERY SUPPLY, NOTEBOOKS
AND STAMP ALBUMS, in CLASS 16 (U.S. Cls. 5,
22, 37 and 38).~~

First use Oct. 1966; in commerce Oct. 1966.

Ser. No. 222,079, filed Jul. 3, 1979.

HENRY S. ZAK, Primary Examiner

1750728

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

April 28, 2009

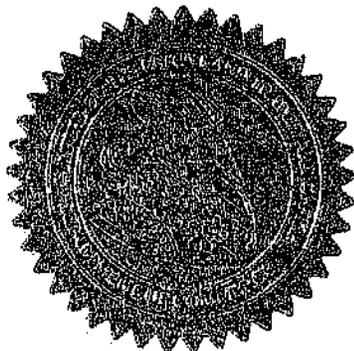
THE ATTACHED U.S. TRADEMARK REGISTRATION 3,022,405 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 10 YEARS FROM *December 06, 2005*

SAID RECORDS SHOW TITLE TO BE IN:

***MARVEL CHARACTERS, INC.
A DELAWARE CORPORATION***

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**



A handwritten signature in black ink, appearing to read "F. Swain".

**F. SWAIN
Certifying Officer**

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 3,022,405

Registered Dec. 6, 2005

**TRADEMARK
PRINCIPAL REGISTER**



**DRIGGS FARMS OF INDIANA, INC. (INDIANA
CORPORATION)
400 SOUTH CHAMBER DRIVE
DECATUR, IN 46733**

**THE MARK CONSISTS OF THE WORDING SU-
PER HERO SUPERIMPOSED OVER A FLASH
FLAME DESIGN.**

FOR: ICE CREAM, IN CLASS 30 (U.S. CL. 46).

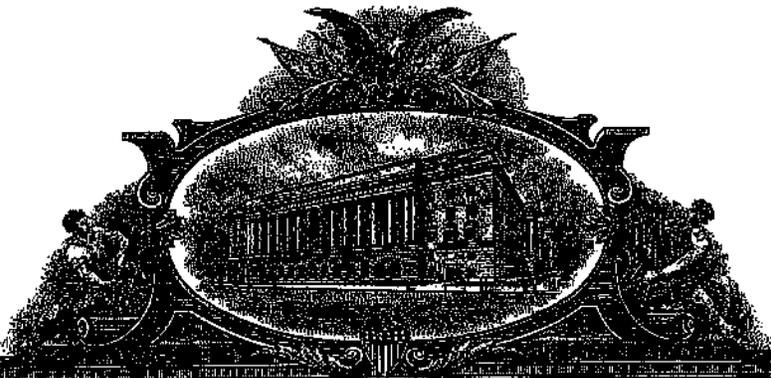
SER. NO. 76-526,513, FILED 6-27-2003.

FIRST USE 6-9-2003; IN COMMERCE 6-9-2003.

BARBARA A. GOLD, EXAMINING ATTORNEY

EXHIBIT B

X750738



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

April 28, 2009

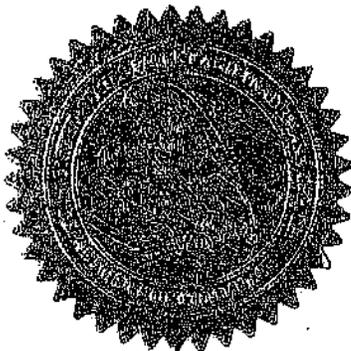
**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,936,470 IS
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH
REGISTRATION IS IN FULL FORCE AND EFFECT.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *March 29, 2005*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant***

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**



**P. SWAIN
Certifying Officer**



Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

Reg. No. 2,936,470

United States Patent and Trademark Office

Registered Mar. 29, 2005

**TRADEMARK
PRINCIPAL REGISTER**

KRYPTONITE

**DC COMICS (PARTNERSHIP)
1700 BROADWAY
NEW YORK, NY 10019**

FOR: COSMETICS, NAMELY LIPSTICK, LIP GLOSS AND NON-MEDICATED LIP BALM; MASCARA; NAIL ENAMEL; FACE POWDER, FACE CREAM, SKIN LOTION AND SKIN GEL; BATH POWDER AND PERFUMED BODY POWDER; BATH OIL, BATH GEL AND NON-MEDICATED BATH SALTS; BABY OIL, BABY POWDER, BABY GEL AND BABY LOTION; HAND CREAM AND LOTION; BODY CREAM AND LOTION; SUNSCREEN PREPARATION, NAMELY CREAM AND LOTION; SHAVING CREAM AND AFTER-SHAVE LOTION, SKIN CLEANSER AND NON-MEDICATED BODY SOAKS; BODY DEODORANT, COLOGNE AND PERFUME; SOAPS, NAMELY,

LIQUID BATH SOAP, GEL SOAP AND BAR SOAP; DETERGENT SOAP, NAMELY, LIQUID AND POWDER; FABRIC SOFTENER; DEODORANT SOAP, SKIN SOAP; SHAMPOO AND SHAMPOO CONDITIONER; AND HAIRSTYLING GEL, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 11-23-2001; IN COMMERCE 11-23-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 78-465,204, FILED 8-10-2004.

CHERYL STEPLIGHT, EXAMINING ATTORNEY

1750728

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

April 28, 2009

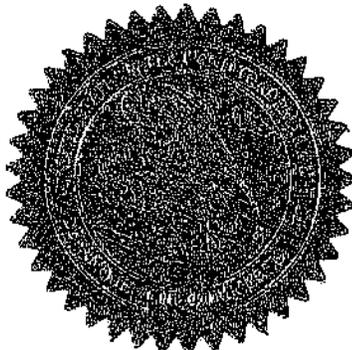
**THE ATTACHED U.S. TRADEMARK REGISTRATION 3,250,362 IS
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH
REGISTRATION IS IN FULL FORCE AND EFFECT.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *June 12, 2007*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant***

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**



**P. SWAIN
Certifying Officer**



Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 3,250,362

Registered June 12, 2007

**TRADEMARK
PRINCIPAL REGISTER**

X-MEN

**MARVEL CHARACTERS, INC. (DELAWARE
CORPORATION)
9242 BEVERLY BOULEVARD, SUITE 350
BEVERLY HILLS, CA 90210**

**FOR: COLOGNE; EAU-DE-TOILETTE; FRA-
GRANCES FOR PERSONAL USE; PERFUME, IN
CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).**

FIRST USE 5-31-2006; IN COMMERCE 5-31-2006.

**THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.**

**OWNER OF U.S. REG. NOS. 1,723,928, 2,052,216
AND OTHERS.**

SER. NO. 77-046,945, FILED 11-17-2006.

WILLIAM VERHOSEK, EXAMINING ATTORNEY

EXHIBIT C

THIS OPINION IS
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Skoro

Mailed: April 8, 2009

Opposition No. 91170552

Honda Motor Co., Ltd.

v.

Friedrich Winkelmann

**Before Quinn, Drost and Mermelstein,
Administrative Trademark Judges.**

By the Board:

On April 21, 2004, Friedrich Winkelmann (hereinafter "applicant") filed an application to register the mark V.I.C. for "vehicles for transportation..." in Class 12.¹ On April 24, 2006, Honda Motor Co., Ltd. (hereinafter "opposer") filed a notice of opposition alleging a likelihood of confusion between opposer's CIVIC registrations² and applicant's applied-for mark. Applicant

¹ Serial No. 76587840 for "Vehicles for transportation on land, air or water, namely, motor propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft; parts used in vehicles for transportation on land, air or water, namely, motor propelled and self-propelled vehicles for use on land and on water and motor propelled and glider aircraft" in Class 12, filed under Section 44(e) based on German Registration No. 30354374, filed October 24, 2003, for, *inter alia*, "vehicles, machines for locomotion by land, air or water parts of air, land or water vehicles"; claiming a bona fide intent to use the mark in commerce.

² Reg. No. 1045160, issued July 27, 1976, for CIVIC, for "automobiles" in Class 12, renewed May 1, 2006; and Reg. No.

Opposition No. 91170552

answered the notice of opposition by denying the salient allegations thereof.

On July 16, 2008, opposer filed a motion for summary judgment and a motion to amend its notice of opposition. On September 19, 2008, applicant answered the amended notice of opposition. We therefore grant opposer's motion to amend as conceded, and the amended notice of opposition is of record.

Opposer's motion for summary judgment is based on the newly added ground that applicant lacked the requisite bona fide intent to use the mark in commerce at the time of filing his application. In support of its motion for summary judgment, opposer has submitted copies of applicant's discovery responses.³ Applicant has responded with a declaration from Jens Schulte, European Counsel for applicant, and James C. Wray, counsel for applicant in the U.S.

In support of its motion, as noted above, opposer has submitted applicant's written responses to opposer's discovery requests. Opposer maintains that applicant's

2573521, issued May 28, 2002, also for the mark CIVIC, claiming dates of first use and first use in commerce of September, 1972; Section 8 & 15 affidavits accepted January 29, 2008, for "automobiles and structural parts therefor" in Class 12. (Ex. D and E to amended notice of opposition).

³ Opposer also submitted proof of the use of its registered mark on cars; copies of its registrations; and a dictionary definition of "automobile."

Opposition No. 91170552

discovery responses demonstrate a *prima facie* case that applicant lacked a bona fide intent to use the mark when it filed its application. Opposer further contends that applicant's mere statements of subjective intention, without more, are insufficient to establish applicant's bona fide intent to use the mark in commerce in the United States. Opposer concludes that the absence of any other documentary evidence prepared, created or produced prior to the filing date of the application or subsequent thereto, demonstrates applicant's lack of the requisite bona fide intent at the time of filing, rendering the application *void ab initio*, and that it is entitled to judgment in its favor as a matter of law.

Applicant contends, on the other hand, that the evidence of his bona fide intent to use the mark V.I.C. in commerce in the U.S. is through his registration and use of the mark V.I.C. in Europe, including Germany; and through the filing of applications for registration in other countries and in the U.S. (Response p. 4). Applicant also states, through counsel, that this opposition has "delayed applicant's realization of its intended use in the United States." (Response p. 2).

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a

matter of law. See Fed. R. Civ. P. 56(c). In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). The Board has held, however, that the absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act,⁴ unless other facts are presented which adequately explain or outweigh applicant's failure to provide such

⁴ Lanham Act § 1(b) states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark.

Opposition No. 91170552

documentary evidence. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

At the outset, we find that there is no genuine issue of material fact concerning opposer's standing to be heard on its claim. Although opposer neither submitted status and title copies of its pleaded registrations of its CIVIC mark nor an affidavit or declaration in support of its allegations of use of its CIVIC mark, there is other evidence establishing opposer's standing. The record includes applicant's statement that "Honda uses CIVIC only on subcompact automobiles" and "applicant's vehicles may compete with Honda vehicles." (Interrogatory No. 54 response). We find applicant's statements sufficient to establish that opposer has a real interest in the outcome of this proceeding; that is, opposer has a direct and personal stake in the outcome of the opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

An applicant who has applied for registration under Section 44(e) of the Lanham Act, claiming priority based on a registration of his mark in a foreign country, must, in his U.S. application, verify, in writing, that he has a bona fide intent to use the mark in U.S. commerce. 15 U.S.C. § 1126(e). In determining whether an applicant under § 44(e)

has the requisite bona fide intent to use the mark in U.S. commerce, the Board uses the same objective, good-faith analysis that it uses in determining whether an applicant under § 1(b) has the required bona fide intent to use the mark in U.S. commerce. See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." *Lane Ltd. v. Jackson International Trading Co.*, *supra* at 1356.⁵

⁵ As stated by the Board in *Lane*, "With respect to the activities of applicant's predecessor, the evidence shows that applicant's principal had succeeded in marketing tobacco in the United States by locating a non-U.S. licensee ... which exported tobacco to the United States under the previous SMUGGLER mark. This evidence is relevant because it establishes that applicant's principal was engaged in the tobacco marketing business, including the export of tobacco to the United States under the previous SMUGGLER mark. When viewed in the context of this prior experience and success in the relevant industry, we find that applicant's efforts to obtain a licensee for the new SMUGGLER mark are consistent with and corroborative of applicant's claimed bona fide intention to use the new mark in commerce." (Id. at 1356).

The situation in *Lane* is to be contrasted with the present case where there is no evidence that applicant is engaged in the manufacture or sale of automobiles under the claimed mark, thereby providing no evidence of a bona fide intention to use the mark in commerce. See also *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (no bona fide intent found because there was no relevant business established).

In this case, opposer has proffered documents that applicant provided to opposer through discovery, which include applicant's interrogatory responses and document production (or lack thereof) which, opposer asserts, demonstrates that applicant has no current business plans, ongoing discussions, promotional activities, or anything else to corroborate his claim of a bona fide intent to use the mark in commerce in the United States. Specifically, opposer points to applicant's responses to interrogatories numbered 15 and 16, by which opposer requested a description of a business plan, strategy or arrangements and methods used by applicant in connection with the use of, or intent to use, the mark for the identified goods (interrogatory 15) and to identify the channels of trade that are or will be used in the U.S. by applicant in connection with the identified goods (interrogatory 16). Both interrogatories were answered with "Applicant has not had activities in the U.S. and has not made or employed a business plan, strategy, arrangements or methods there" and "has not identified channels of trade that will be used in the United States."

Interrogatory 34 asked applicant to state whether he had a bona fide intent to use the mark on or in connection with the goods on the day the application was filed; to which applicant responded "yes" but the follow-up interrogatory 36 asked if the response was affirmative, to

Opposition No. 91170552

identify any and all evidence supporting applicant's claim that it had an intent to use the mark for the identified goods, to which applicant responded "Not Applicable."

(Motion for Summary Judgment, Exhibits B and C).

As for requests for production, opposer notes requests number 9 (documents sufficient to identify all intended uses of applicant's mark on or in connection with the claimed goods); number 10 (documents to identify products of applicant associated with applicant's mark intended to be used...); and number 12 (documents applicant intends to use to promote, advertise, publicize or sell goods and/or services under his mark) - all to which applicant responded: "No such documents exist". (Motion Ex. D). For the documents actually produced in response to request for production number 11 (documents sufficient to identify the types of vehicles applicant intends to promote, advertise, publicize, offer to sell and/or sell in connection with the mark), number 14 (documents that evidence, refer or relate to the advertising and promotional means intended to be used to advertise and promote applicant's goods) and number 16 (documents that reflect, refer to or evidence applicant's intent to use applicant's mark on vehicles in the U.S.), applicant's responses stated "See Documents A, B and C1-10". (Motion Ex. D). Accompanying these documents, applicant provided a list and described them as "Document A printouts

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from Applicant's website, www.MTWGroup.de (enclosed)"⁶;
"Document B Applicant's German, European and WIPO trademark
registrations (enclosed)"⁷; and "C1-C10 are official
correspondence with the United States Patent and Trademark
Office and can be viewed online using the 'View full files'
option from the USPTO homepage."⁸

Applicant has countered the motion⁹ with statements of
subjective intent, not made by applicant himself, but rather
made by declarants on his behalf.¹⁰

⁶ The printouts appear to be from the MTW Motor Group website
with applicant's name underneath the banner; the advertisement is
in German, with use of the mark as "MTW V.I.C.-PAKET" which
appears to be a gift box with a list of items to be used in
connection with an automobile. Without verification and
translation, the connection between the goods claimed in the
application and these documents is unclear. As used in these
materials, the mark does not appear to identify "vehicles for
transportation."

⁷ These are again without translation and submitted with the
application to support a claim of priority.

⁸ Opposer notes that Document A is actually the foreign
registrations and Document B is the website printout and
Documents C1-10 were never produced.

⁹ There is also quite a bit of argument by applicant that opposer
has not objected to applicant's registration of its mark outside
of the United States; and has not objected to the use of "vic" as
used by Ford Motor Company. Exhibits attached to Mr. Wray's
declaration provide extensive Internet results relating to the
use of "vic" to identify Ford Motor Company's "Crown Victoria"
automobile. These arguments are not relevant to the issue before
us, namely, applicant's bona fide intent to use the mark in
commerce in the U.S.

¹⁰ Opposer has moved to strike these declarations as lacking
foundation. We have considered the declarations submitted by
applicant's counsel to the extent they are relevant to the issue
of applicant's bona fide intent to use the mark in the U.S. It
should be pointed out, however, that these declarations do not
include any objective facts in support of applicant's intent. In
that we have considered these declarations as applicant's only

Federal Rule of Civil Procedure 56(c) provides:

The judgment sought should be rendered if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.

Federal Rule of Civil Procedure 56 requires a nonmoving party to go beyond the pleadings and to "set out specific facts showing a genuine issue for trial." Fed. R. Civ. P. 56(e)(2); *Celotex Corp. v. Catrett*, *supra* at 324.

In its response to the motion, applicant has not provided any exhibits that provide any additional, relevant information in support of his declarations nor identified those portions of the record before the Board that demonstrate that he manufactures vehicles in Germany or elsewhere. Rather, applicant has pointed to the same evidence opposer points to, namely, the website printouts showing the mark as used in Europe.

To raise a genuine issue of material fact, applicant must rely on specific facts that establish the existence of an ability and willingness to use the mark in the United States to identify its claimed "vehicles for transportation" at the time of the filing of the application. Applicant's

evidence in support, we have not afforded them much weight. Accordingly, opposer's motion to strike these declarations is hereby denied.

declarations of outside counsel merely state opinions and do not provide specific facts in support of his position.

While the evidence necessary to support a bona fide intent to use may differ depending on the circumstances of each case, the evidence that applicant relies upon through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods. Further, these documents do not show that applicant has an intent to use the mark in the United States. The website printouts are not translated, but judging from the graphics, the mark seems to be used to identify car care packages or promotional material, not the vehicles themselves; and there is no evidence of a bona fide intent to use the mark in the United States as to the goods listed in the application. Any intention to use the mark may go to promotional services for dealerships, but not to "vehicles for transportation." Finally, because the arguments of counsel are not supported by any evidence of record related to applicant's bona fide intent, they are insufficient to raise a genuine issue of material fact. See, e.g., *Hornblower & Weeks Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001).

Therefore, after having considered the evidence and arguments submitted by the parties in connection with the motion, and viewing that evidence in the light most favorable to applicant, we find there is no evidence of

Opposition No. 91170552

applicant's bona fide intent to use the mark in the United States to identify the claimed goods. Because applicant has not established that there is any genuine issue of material fact as to his lack of a bona fide intent to use, opposer's motion for summary judgment is granted.

The opposition is sustained, and registration is refused to applicant.