

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Hearing Date: February 16, 2011

Mailed: May 31, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nintendo of America, Inc.
v.
Adar Golad

Opposition No. 91178130
To Application Serial No. 78817267

John W. Crittenden of Cooley LLP, for Nintendo of America, Inc.

Erik M. Pelton of Erik M. Pelton & Associates PLLC, for Adar Golad.

Before Bergsman, Ritchie, and Wolfson, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On February 17, 2006, applicant, Adar Golad, applied to register the mark FLASHBOY in standard character form on the Principal Register for "plug and play interactive video games of virtual reality comprised of computer hardware and software," in International Class 9 and "hand-held units for playing video games and electronic games, namely, stand alone video game machines," in

International Class 28. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce.

On June 29, 2007, opposer, Nintendo of America, Inc., opposed the registration of applicant's mark on the ground that applicant's mark is likely to cause confusion with opposer's Registration No. 1622675 for the mark GAMEBOY for "game equipment, namely, electronic game equipment for playing video games and video game programs; toys, namely, electronic memory device toys," in Class 28,¹ among others. In its notice and amended notice of opposition, opposer alleges that it "owns numerous U.S. trademark registrations in International Class 28" which include the term "BOY," *i.e.*, GAME BOY ADVANCE, GAME BOY POCKET, GAME BOY ADVANCE VIDEO, and LIGHT BOY, among others. (Am'd Notice at 4).

Opposer maintains that applicant's mark is "substantially similar" to opposer's previously registered marks and is likely to cause confusion in violation of Section 2(d) of the Trademark Act. (Am'd Notice at 17-24). Opposer further alleges that the marks are "identical in their dominant components" and therefore applicant's mark is "likely to cause dilution" of opposer's pleaded marks. (Am'd Notice at 25-33). However, since opposer did not

¹ Registered November 13, 1990, based on first use and first use in commerce on June 2, 1989. Sections 8 and 15 accepted and acknowledged. Renewed.

pursue the dilution ground on brief, we consider it to be waived.

Finally, opposer added a cause of action via amended notice, filed after discovery was taken, asserting that applicant did not have a bona fide intent to use the mark in commerce when he filed the application "as shown by the fact that he has no documents that evidence such intent either at or around the time of filing the Application or to date." (Am'd Notice at 36).

Applicant denied the salient allegations of the amended notice of opposition. Both parties filed briefs, and opposer filed a reply brief. Applicant requested an oral hearing, which was presided over by this panel.

We consider the pleaded and tried grounds of (i) priority and likelihood of confusion, and (ii) lack of bona fide intent to use the applied-for mark.

The Record

The record consists of the pleadings; the file of the involved application; and the following:

1. The testimonial deposition of George S. Harrison, opposer's former Senior Vice-President of Marketing and Corporate Communications, taken during opposer's trial period on June 23, 2009, together with extensive exhibits thereto, some of which have been labeled confidential;

2. Opposer's four notices of reliance on
 - a. Applicant's responses to opposer's first set of interrogatories.
 - b. Copies of opposer's GAME BOY and other trademark registrations, specifically, GAME BOY ADVANCE, GAME BOY ADVANCE VIDEO, GAME BOY POCKET, and LIGHT BOY prepared by the USPTO showing both the current status of and title to the registrations.²
 - c. A copy of a nonprecedential TTAB decision rendered in Opposition No. 91163873.³
 - d. Applicant's responses to opposer's second set of interrogatories.
 - e. Applicant's responses to opposer's second set of requests for production of documents.
3. Applicant's two notices of reliance on
 - a. Third-party registrations containing the term "BOY."
 - b. Applicant's responses to opposer's discovery requests, pursuant to Rule 2.120(j)(5); 37 CFR

² We note that the registrations submitted with opposer's June 26, 2008 notice of reliance do not match exactly the registrations pleaded in the notice or the amended notice of opposition. However, we have considered them because applicant has not objected to the inconsistency. Therefore, the notice of opposition is deemed amended to conform to the evidence under FRCP 15(b). Furthermore, as will be discussed herein, the applicable registration that we will consider for likelihood of confusion, Registration No. 1622675 for GAMEBOY, was both pleaded and introduced into evidence.

§ 2.120(j)(5), which provides that "Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party."

- c. Dictionary definitions for "game," "boy," and "flash."
- d. Printouts from the USPTO and World Intellectual Property Organization databases showing other trademark registrations owned by applicant.
- e. Internet printouts from the toy company run by applicant.

³ While both parties relied on nonprecedential cases in making their respective arguments, we note that nonprecedential cases are by their nature not binding on the Board.

Priority and Standing

As a result of opposer's submission of status and title copies of its GAME BOY registration (No. 1622675), among others, opposer has established its priority as well as its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) and *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As mentioned *supra*, for purposes of our likelihood of confusion analysis, we will consider the applicable *du Pont* factors as to pleaded Registration No. 1622675, for GAME BOY, which has the most relevant goods and most similar mark. If we find a likelihood of confusion as to this mark, then our analysis with regard to the others would be moot.

Similarly if we do not, then we would not find it as to the others either. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Fame

We turn first to the factor of fame because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider relevant factors such as sales and revenue. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2s 1811, 1817 (TTAB 2005). In his deposition, Mr. George S. Harrison, opposer's former Senior VP of Marketing and Corporate Communications, testified to various sales and advertising figures for GAME BOY hardware and software over the years. Some of the figures were submitted under the designation "Confidential," and we are

not able to disclose them publicly, although we note that they are large under any standard. Other numbers we can set forth as follows. Game Boy was first introduced as a "handheld electronic gaming device" in 1989. (Harrison depo. at 11 and 28). Mr. Harrison estimated based on worldwide sales reports that approximately 185.48 million Game Boy units were sold in the United States in the time period 1989 through 2005. (Harrison depo. at 54 and Ex. N). Advertising for Game Boy products in the time period 2000 to 2005 alone totaled in the hundreds of millions of dollars. *Id.*, and Ex. S. Opposer presented evidence of advertisements in major national publications, such as Rolling Stone, Nickelodeon, Marvel Comics Jr., Boys' Life, Junior Scholastic, Vibe, and Disney Adventures, throughout the period 1989 to the present. *Id.* at 39 and Ex. F. Mr. Harrison also testified that opposer has, over the years, touted the GAME BOY mark and associated products widely, in opposer's own publication, Nintendo Power magazine, which is sold at newsstands and by subscription, to about 400,000 people annually. *Id.* at 32-33 and Ex. D.

Furthermore, opposer submitted dozens of news articles via the Harrison deposition, discussing the reputation and fame of its Game Boy device and software cartridges, from periodicals and newspapers such as The New York Times, The

Chicago Sun Times, and others mentioned below.⁴ Excerpts include the following:

"Essentially an upgraded version of the Super Game Boy accessory for the Super Nintendo of the early '90s, the Game Boy Player is an adapter that allows three generations of Game Boy games to be played on the GameCube. The player easily attaches to the bottom of the GameCube through an expansion port and plays through a regular controller." *Orange County Register* July 24, 2003.

"A new video game for Nintendo's Game Boy Advance may bring meaning to the parental command, 'Go play outside.'" *The Associated Press State and Local Wire/Business News* August 13, 2003.

"A new version of Nintendo's handheld Game Boy, which has sold 150 million units since 1989 to Pokemon-crazed kids and bored travelers, is being updated to reflect consumers' increased expectations as well as stay ahead of new competition from games played on cellphones." *USA Today* January 7, 2003.

"Nintendo of America announced three new seizures of counterfeit Game Boy games in China, bringing the number of anti-piracy raids against illegal manufacturers and retailers to 135 in that country alone in 2002." *CBSMarketWatch* February 11, 2003.

"Nintendo's new portable video game system, the DS, hits stores today with the unenviable task of replacing the company's ubiquitous Game Boy." *Tampa Tribune* November 21, 2004.

We conclude that opposer has shown significant market exposure, revenue, and overall fame amongst the relevant public. The evidence clearly establishes that GAME BOY is a

⁴ These articles are relevant and admissible to show what others are writing about opposer, and that opposer and its mark have been the subject of unsolicited publicity as well as extensive advertising.

famous mark in connection with video game hardware and software. This fifth *du Pont* factor strongly favors opposer.

The Goods and Channels of Trade

The goods listed in the application are "plug and play interactive video games of virtual reality comprised of computer hardware and software," in Class 9 and "hand-held units for playing video games and electronic games, namely, stand alone video game machines," in Class 28. The goods listed in opposer's Registration No. 1622675 are "game equipment, namely, electronic game equipment for playing video game programs; toys, namely, electronic memory device toys" in Class 28. We find that there is substantial overlap between the goods in Class 28, and they are legally identical. We also find, based on the testimony of Mr. Harrison, and the exhibits thereto, as well as exhibits contained in applicant's second notice of reliance, that there is a substantial relationship between the video games included in applicant's class 9 identification of goods, and the equipment used to play those games. *See Harrison depo.* at 11 ("The Game Boy is a handheld electronic gaming device that takes individual software cartridges and displays the games for play on a self-contained screen on the hardware itself.") *See also Id. at Ex. A and B; and Appl's second*

Notice of Reliance. Accordingly, the goods are in-part legally identical and otherwise substantially related.

Because the goods described in the application and the opposer's registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). In other words, we conclude that the channels of trade and classes of purchasers of the parties' goods are the same. These second and third *du Pont* factors heavily favor finding a likelihood of consumer confusion.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Preliminarily, we note that

the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

This is especially true in the case of a famous mark, which enjoys a "wide berth" of protection. See *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, *supra*, 22 USPQ2d 1453, 1456.

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is an ordinary consumer who plays hand-held video games.

Opposer, in its brief, claims a family of marks based on the common term "BOY." (Opposer's Brief at 8). A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Recognition of a family of marks is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. *Id.*

In the present case, opposer has not provided sufficient evidence that opposer promotes a group of marks for which the common characteristic is the term "BOY." Neither the Harrison deposition, the exhibits thereto, nor the notices of reliance establish a pattern of promotion or recognition among the purchasing public that opposer has, in

fact, established a family of marks based on the term "BOY." Several articles and advertisements refer to the marks "GAME BOY" and "GAME BOY ADVANCE" together. However, we accept that, if anything, opposer's evidence has pointed to a "family" of marks based on the term "GAME BOY" not just the term "BOY," a point that was not argued by opposer (and which is in any event the same as the mark we analyze, herein). (Harrison depo. at Ex. E and F).⁵ Accordingly, we will not undertake our analysis of likelihood of confusion as to a family of marks, but rather solely as to the mark GAME BOY, as discussed *supra*.

Both opposer's mark and applicant's consist of two words, of which the second is "BOY." The first word in opposer's mark is "GAME," which is descriptive of the "electronic game equipment for playing video games" for which it is registered. The first word in applicant's mark is "FLASH." Applicant has submitted a definition of "flash" as meaning "of sudden origin and short duration."⁶ Applicant has also admitted to other definitions of the term "flash." In Interrogatory No. 5, opposer asked, "What about your product does the word FLASH describe or signify?" Applicant responded "In addition to the general objections above, Applicant objects to this Interrogatory as requesting

⁵ Mr. Harrison testified that he doesn't even believe the LIGHT BOY product is "for sale" anymore, as it would be "obsolete." (Harrison depo. at 88).

materials which are publicly available, namely common dictionary and reference materials. Notwithstanding and without waiving these objections, Applicant provides the following response: The product and its features are quick, fast, or speedy."

We note that another definition included in applicant's second notice of reliance defines "flash memory" as "a computer memory chip that retains its data even without a connection to a power source."⁷ Mr. Harrison also gave a definition of the term "flash memory" at his deposition, in response to a question, answering, "flash memory is a form of short-term memory that can be used in video game products." (Harrison depo. at 74). Used in the context of video games, we find the definition of "flash memory" to be applicable here. Consumers are likely to see the mark FLASH BOY, and believe that it is a version of GAME BOY intended to be used on or in connection with flash memory. Alternatively, they may believe that FLASH BOY is a "speedier" version of GAME BOY. In any event, we find that consumers are likely to find the commercial impressions of the marks are similar. This is particularly true since the goods overlap, and since GAME BOY enjoys the "wide berth" of fame. *Kenner Parker Toys, Inc. v. Rose Art. Ins., Inc.*, *supra*, 22 USPQ2d 1453, 1456

⁶ Merriam-Webster (2010).

⁷ *Id.*

(Fed. Cir. 1992).

Applicant argues that the term "BOY" is suggestive, however, in that it has been incorporated by numerous third-parties in their trademark registrations in Class 28. In this regard, applicant submitted approximately 19 use-based third-party registrations in Class 28 that incorporate the term "BOY." The list includes: TOUCH BOY, ASTRO BOY, LOST BOYS, COWBOY UP, COWBOY, BATTERY BOYZ, WHITEBOY, RED BOY RECORDS, HELLBOY, PIN BOY and design, JIMMY NEUTRON BOY GENIUS, GOD'S BOY, SHARK BOY, CITY BOY, BOYNQ, WILDBOYZ, HARDYBOYZ, PAPERBOYZ, and STEAM BOY. Some of the registrations, although in Class 28, do not include video-game-related products. Others, although incorporating the term "BOY," are for dissimilar marks, using the term as part of a phrase, or with a "Z." Finally, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). See also *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing

about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

In re Hub Distributing, Inc., 218 USPQ at 286.

Applicant did not submit any supporting evidence of third-party use of the term "BOY" in connection with video-game products. We do not find the term to be descriptive when used in connection with opposer's or applicant's goods. Rather, as stated above, since we find the mark GAME BOY to be famous, applicant's use of the mark FLASH BOY on the same goods is likely to be viewed by consumers as another version of the famous GAME BOY electronic game.

The terms "GAME" and "FLASH" do not look or sound alike. However, we find that the dissimilarities in sight and sound between opposer's and applicant's marks are outweighed by the similarities in commercial impression, especially in light of fame of the GAME BOY mark, and considering the overlap in the goods. Accordingly, this first *du Pont* factor weighs in favor of finding a likelihood of confusion.

Consumer Sophistication

Opposer urges us to consider consumer sophistication. In this regard, as with the other *du Pont* factors, we are bound by the parties' respective identifications of goods. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("[t]he

authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." [citations omitted]).

We have no doubt that applicant's "plug and play interactive video games of virtual reality comprised of computer hardware and software," and its "hand-held units for playing video games and electronic games, namely, stand alone video game machines," could be sold to unsophisticated consumers. Presumably opposer's identical goods would be as well. As indicated above, the average customer is an ordinary consumer who plays hand-held video games. Indeed Mr. Harrison testified in his deposition that 60-65% of those who use opposer's GAME BOY goods are "under age 18." (Harrison depo. at 75). We deem this fourth *du Pont* factor to favor opposer.

Balancing the Factors

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that the goods overlap and are otherwise substantially related, and are likely to be marketed through the same channels of trade to generally unsophisticated consumers. Opposer's

GAME BOY mark is famous, such that the mark is strong despite the suggestive nature of GAME, and the marks have a similar commercial impression. Accordingly, we find a likelihood of consumer confusion between opposer's mark GAME BOY and applicant's mark, FLASH BOY for the applied-for goods.

Lack of Bona Fide Intent to Use

Next, we consider opposer's claim that applicant lacked a bona fide intent to use the mark FLASH BOY for the applied-for goods in commerce at the time he applied to register it. "A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances." *Boston Red Sox v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008), citing *Lane Ltd. v. Jackson Intl. Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). "Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof sufficient to prove that the applicant lacks a bona fide intention to its use its mark in commerce." *Id.* at 1587, citing to *Commodore Electronics Ltd. V. CBM Kabushiki Kaisha Opp.*, 26 USPQ2d 1503, 1507 (TTAB 1993). In response to document requests, applicant in

that case asserted he had no documents concerning trademark searches and investigations nor any advertising or promotional materials that he intended to use. The Board found this evidence, as presented by opposer, satisfied opposer's *prima facie* burden, which applicant did not rebut.

In its responses to interrogatories and document requests, applicant here made clear that he did not, at the time of filing his application, have a business plan or other documents to reflect plans to advertise, manufacture or otherwise use the mark FLASHBOY in commerce on the goods for which applicant seeks registration. Examples include the following. In response to Interrogatory No. 1:

"Describe with particularity any searches or investigations performed by you or on your behalf in connection with your decision to use the FLASHBOY Mark," applicant responded, after his objections, "None." In response to Interrogatory No. 14: "Identify all persons whom you have permitted and/or licensed to use the FLASHBOY Mark," applicant responded, "None." In response to Interrogatory No. 16: "Identify all documents that refer to, reflect, constitute, mention, or discuss any business plans for your business," applicant responded, "None."

Similarly, applicant was unable to identify, locate, or produce documents evidencing his plans to use the mark FLASHBOY in commerce for the applied-for goods. Asked in

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Document Request #2 for "All documents that refer to, relate to, or constitute communications with others regarding your plans to use the FLASHBOY Mark," applicant responded that he was "not in possession of any responsive documents." Asked in Document Request #3 for "All documents that refer or relate to your efforts to start or build a business to manufacture, market, advertise, distribute, or sell products bearing the FLASHBOY Mark," applicant responded that he was "not in possession of any responsive documents." Asked in Document Request #4 for "All documents that refer to, relate to, or constitute communications with others regarding your efforts to start or build a business to manufacture, market, advertise, or sell products bearing the FLASHBOY Mark," applicant responded that he was "not in possession of any responsive documents." Asked in document Request #5 for "All documents that refer to, relate to, or constitute communications with others regarding your efforts to obtain funding for design, development, manufacture, marketing, advertising, or distribution of products bearing the FLASHBOY Mark," applicant responded that he was "not in possession of any responsive documents." Asked in Document Request #9 for "All documents that refer to, relate to, or constitute agreements with anyone with regard to the distribution of goods to be sold bearing the FLASHBOY Mark," applicant responded that he was "not in possession of any

responsive documents." Asked in Document Request #11 for "All documents that refer to, relate to, or constitute efforts to obtain governmental or regulatory approval with regard to goods to be sold bearing the FLASHBOY mark," applicant responded that he was "not in possession of any responsive documents." Asked in Document Request #12 for "All documents that refer to, relate to, or constitute specifications for goods to be sold bearing the FLASHBOY Mark," applicant responded he was "not in possession of any responsive documents."

We find that by showing that applicant had no business plan, no agreements to manufacture, distribute, create, or market any product under the mark, and no other indications of intention to use it in commerce, opposer has made a sufficient *prima facie* case that applicant lacked a bona fide intention to use the mark FLASHBOY in commerce on the applied-for goods at the time he filed his application.

We then examine the evidence presented by applicant to see whether applicant has rebutted the *prima facie* case. Applicant asserts that he has the ability to market and sell the video-game products for which he seeks the FLASH BOY mark. See appl's brief. As evidence of this, applicant points to his own responses to interrogatories. In response to Interrogatory #35, inquiring regarding any prior experience "in the video game hardware or software

industry," applicant responded: "Applicant was educated from 1975-1980 at Technion school in Haifa Israel in engineering. From 1980 to the present, Applicant founded and managed Goliath BV toy company. See Applicant's patent from the European Patent Certificate produced as Applicant 0033-0039." Asked in Interrogatory #40: "State whether you have ever made, had made, sold offered for sale, distributed, advertised, and/or marketed any of the following goods in the United States: plug and play interactive video game hardware or software, ritual reality video games, hand-held units for playing video games or electronic games, or stand alone video game machines," applicant responded, after objections, "yes." Asked to elaborate in response to Interrogatory No. 41, however, applicant referred to the opening of a U.S. subsidiary after the filing of his application, which is not relevant to this claim. Likewise, applicant's European patent does not show any intent to use this mark in the U.S., nor do his other trademark registrations.

To show a bona fide intent to use, there must be "objective evidence," that is evidence in the form of "real life facts and by the actions of the applicant." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §19:14 (4th ed. 2009). There should be some "definite" (if not necessarily "concrete") plan by applicant. For example,

"written plan of action for a new product or service," or a "re-branding of an existing line of goods or services." *Id.* Applicant here noted his various existing trademarks and a European patent, but showed no nexus as to how these would be used to launch FLASH BOY for the presently applied-for goods. *See Boston Red Sox v. Sherman, supra*, 88 USPQ2d 1581, 1586; (opposer's showing of applicant's failure to produce documents sufficient to establish prima facie case which must then be rebutted by applicant); *see also Honda Motor Co., Ltd. V. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009). In the latter case, the Board granted summary judgment in favor of opposer where applicant admitted in its discovery responses seeking information about its business plans and other activities that it had 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." Applicant's mere self-serving assertion that he had a bona fide intent to use the mark in connection with the identified goods in the U.S. was held insufficient to establish a genuine issue of material fact since he produced no documents to support the assertion. That the mark was used elsewhere was not relevant. In short, the Board is not concerned with the mere capability of an applicant to

produce goods under the mark, but also with whether applicant has displayed an objective intent to do so.

Applicant argues that three prior Board cases weigh in his favor. We note that they are nonprecedential. We also note that each is distinguishable from the present case. In *Kellogg Co. v. The Earthgrains Co.*, Opposition No. 91110121 (TTAB 2003), the first nonprecedential case cited by applicant, for the proposition that opposer has the burden to investigate leads or else has not proven its case for lack of bona fide intent, applicant therein stated in response to interrogatories that it had "prepared labels for use during test marketing for the product" and that it had "used the mark . . . in conjunction with [other mark] on packaging for test marketing the product." This is clearly distinguishable from the present case where applicant indicated no use of its mark in any test marketing or other manner.

In *The Wet Seal, Inc. v. FD Management, Inc.*, Opposition No. 91157022 (TTAB 2007), the second nonprecedential case cited by applicant, the Board held that opposer didn't carry its burden, because it had only deposed one person, and it didn't show that he would be the sole person in the company that would be responsible for launching products. Rather, the Board stated: "In fact [his] testimony shows with regard to at least certain

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products, that he clearly was not the only person involved in the decision-making process." Accordingly, it simply could not be determined from the evidence whether applicant had a bona fide intent or not. The Board also noted that it found the witness's testimony "ambiguous," which we, in the present case, do not.

In the third nonprecedential case cited by applicant, *Collagenex Pharma, Inc. v. Four Star Partners*, Opposition No. 91150890 (TTAB 2003), opposer "presented only argument" but submitted no evidence. Clearly, that is distinguishable from the case at hand, where opposer has presented evidence that we have found to constitute a *prima facie* case. The three cases, besides being nonprecedential, are distinguishable.

Opposer has made a *prima facie* case that applicant lacked a bona fide intent to use the FLASH BOY mark on the applied-for goods at the time he filed the application. Applicant has not rebutted the presumption. Accordingly, on this ground, too, we find for opposer.

DECISION: The opposition is sustained.