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

Proceeding	91178539
Party	Plaintiff SmithKline Beecham Corporation
Correspondence Address	Glenn A. Gundersen Dechert LLP Cira Centre, 2929 Arch Street Philadelphia, PA 19104-2808 UNITED STATES glenn.gundersen@dechert.com
Submission	Motion for Summary Judgment
Filer's Name	Erik Bertin
Filer's e-mail	glenn.gundersen@dechert.com, erik.bertin@dechert.com
Signature	/Erik Bertin/
Date	04/08/2008
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of Omnisource DDS, LLC
Application Serial No.: 78/893,144
Filed; May 25, 2006
Mark: AQUAJETT

SMITHKLINE BEECHAM CORPORATION	:	
Opposer,	:	
v.	:	Opposition No. 91/178,539
OMNISOURCE DDS, LLC	:	
Applicant.	:	

OPPOSER'S MOTION FOR SUMMARY JUDGMENT
ON THE ISSUE OF APPLICANT'S *BONA FIDE* INTENT

Opposer, SmithKline Beecham Corporation, moves for summary judgment pursuant to Fed. R. Civ. P. 56 and Trademark Rule § 2.127(e). In addition, Opposer respectfully requests that the Board suspend all matters that are not germane to this motion pursuant to Rule 2.127(d).

Applicant, Omnisource DDS, LLC, has filed an intent-to-use application to register AQUAJETT for "dental instruments, namely, oral irrigators" (the "Application"). However, Applicant has failed to produce any objective evidence demonstrating that it has a *bona fide* intent to use the mark in commerce for the goods that are described in this Application.

- Applicant does not have any objective evidence – documentary or otherwise – that demonstrates a *bona fide* intent to use AQUAJETT in commerce.
- Applicant has not taken any steps to put this mark into use, either before or after the filing date of the Application.
- Applicant has filed numerous intent-to-use applications covering the same product that is described in its application for AQUAJETT, but has not taken steps to put these marks into use.

Based on this lack of evidence, Opposer has moved to amend the Notice of Opposition by adding a new basis for opposing the Application, namely, that Applicant lacked a *bona fide* intent to use its mark in

commerce at the time that the Application was filed.[1] Opposer now moves for summary judgment on this claim. Discovery closed February 9th and Opposer's testimony period is scheduled to begin on April 9th.

STATEMENT OF UNDISPUTED FACTS

Opposer does not dispute the factual allegations set forth in Applicant's interrogatory responses, to the extent that they are material to the issue of Applicant's *bona fide* intent. Similarly, Opposer does not dispute the factual allegations set forth in Applicant's responses to Opposer's document requests and requests for admission, or in the documents that Applicant produced in response to those requests, to the extent that they are material to the issue of Applicant's *bona fide* intent. Likewise, Opposer does not dispute the factual allegations set forth in the discovery deposition testimony of Applicant's president, Dr. William R. Weissman, DDS or the exhibits thereto, to the extent that they are material to the issue of Applicant's *bona fide* intent.

All of this evidence has been submitted as exhibits to the Declaration of Erik Bertin, dated April 8, 2008. Applicant's discovery responses are referred to herein as "Ex. ___, [Int. / Req.] [number]." Excerpts from the deposition of Applicant's president and the exhibits thereto are referred to herein as "Weissman Dep. at [page(s)]" or "Weissman Dep. Ex. [number]."

A. The Applicant

Omnisource DDS, LLC is a California corporation incorporated in 2005. (Weissman Dep. at 52; Ex. M.) Applicant does not have any subsidiaries, parent companies, or related companies. (Ex. D, Int. 1.) Applicant's president is Dr. William R. Weissman, DDS. (Weissman Dep. at 7.) Dr. Weissman is a practicing dentist, and he is the most knowledgeable person concerning Applicant's business and its plans for using the AQUAJETT mark. (Weissman Dep. at 7, 8, 9; Ex. B, Int. 3.)

B. The Application

On May 25, 2006 Applicant filed an intent-to-use application to register AQUAJETT for "dental

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1 *See* Opposer's Second Motion to Amend the Notice of Opposition, filed April 8, 2008.

instruments, namely, oral irrigators." (Weissman Dep. Ex. 5.) An "oral irrigator" is an oral hygiene device used for cleaning teeth, cleaning spaces between teeth, and cleaning gums. (Exs. H & I, Req. 17, 18, 19.)

In its Application, Omnisource "declare[d] that it has a *bona fide* intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services." Applicant purportedly intends to use AQUAJETT for "oral irrigators," but does not intend to use this mark for any other type of "dental instrument." (Ex. F, Int. 7.)

C. Applicant's Lack Of Technology

Applicant purports to have an intent to use AQUAJETT in connection with the oral irrigator product that is described in U.S. patent numbers 5,511,693; 5,556,001; and 5,564,629 (collectively referred to herein as the "Patents"). (Weissman Dep. at 22, 26-27; Weissman Dep. Exs. 2, 3, 4.) However, these Patents are not owned by Applicant or licensed to Applicant, and there is no evidence or testimony to indicate that the inventions described in the Patents could be used to produce a commercially marketable product.

The Patents were issued to Dr. Weissman and other co-inventors more than 10 years ago, in 1996. (Exs. H & I, Req. 165-66; Weissman Dep. at 18, 19; Weissman Dep. Exs. 2, 3, 4.) Dr. Weissman owns two of these Patents outright; the third patent is jointly owned by Dr. Weissman and his co-inventors. (Weissman Dep. Exs. 2, 3, 4.)

Applicant was not incorporated until 2005. (Weissman Dep. at 52; Ex. M.) Dr. Weissman has not assigned these Patents to Applicant, has not licensed these Patents to Applicant, and has not assigned or licensed these Patents to any third parties. (Exs. H & I, Req. 171-73; Ex. F, Int. 20; Ex. G, Req. 12; Weissman Dep. at 19.) Thus, Applicant does not have a license to use the inventions shown in these Patents, nor did it have such a license at the time the Application was filed.

Opposer asked Applicant to produce "[a]ll documents referring or relating to any product or technology described in [the Patents]." Applicant admitted that it does not have any documents responsive to this request. (Ex. G, Req. 13.) In particular, Applicant did not produce any documents or testimony suggesting that it would be feasible to manufacture or commercially market the devices shown

in the Patents, and no documents or testimony indicating that the technology shown in the Patents would be competitive with current-day oral irrigator products. Likewise, Applicant did not produce any documents or testimony demonstrating that it has considered these issues.

Dr. Weissman asserted that, at some point between 1990 and 1997, he sent letters to companies that produce oral care products concerning his oral irrigator product. However, he could not identify any of these companies, he does not have copies of these letters, and he has not attempted to contact any of these companies since the 1990s. (Weissman Dep. at 32-33.) Applicant was not involved in these efforts, since Applicant was not incorporated until 2005. (Weissman Dep. at 52; Ex. M.)

D. Applicant's Non-Use Of The AQUAJETT Mark

Applicant has never used AQUAJETT on or in connection with an oral irrigator product or any other product or service. (Exs. H & I, Req. 86; Ex. C, Req. 7.) Likewise, Applicant has never licensed or attempted to license this mark for use on or in connection with oral irrigators or any other product or service. (Exs. H & I, Req. 90; Ex. F, Int. 19.) In fact, Dr. Weissman admitted that Applicant "hasn't really thought about exactly . . . when these [products] would be sold or to whom." (Weissman Dep. at 23.)

E. Applicant's Lack Of A Product

Applicant has never sold or attempted to sell any oral irrigator product, and has never had any inventory of the product that it purportedly intends to sell under the AQUAJETT mark. (Exs. H & I, Req. 91, 94; Weissman Dep. at 29.) Dr. Weissman asserted that Applicant has a single prototype which was developed sometime in the 1990s, but he does not know where this prototype is currently located. (Weissman Dep. at 29-30.) Needless to say, Applicant was not involved in the development of this prototype, because Applicant did not exist until 2005. (Weissman Dep. at 52; Ex. M.)

Applicant has not given any thought as to where its product would be manufactured. (Weissman Dep. at 30.) Applicant has never contracted with any third parties or attempted to identify any third parties who might be able to manufacture this product on Applicant's behalf. (Ex. E, Req. 12; Weissman Dep. at 30-31.) Applicant has not identified the types of materials that would be used to construct its oral

irrigator, has not prepared any schematics that would be used to assemble this product, and has not prepared any instruction manuals or user manuals that would explain how the products works. (Weissman Dep. at 30, 39.)

F. Applicant's Lack Of Documentary Evidence

Applicant has not produced a single document showing that it has a *bona fide* intent to use its mark in commerce, except for its assertion that the Application and the Patents evidence such intent.

1. No Documents Demonstrating Applicant's Intent to Use AQUAJETT

Opposer asked Applicant to produce "[a]ll documents and things supporting Applicant's claim of a bona fide intent to use AQUAJETT in commerce in connection with the goods described Applicant's application," and to produce "[a]ll documents and things which evidence the manner in which Applicant intends to use" this mark. (Ex. C, Req. 3; Ex. E, Req. 11.) Opposer also asked Applicant to "[s]tate all facts and identify all documents supporting Applicant's assertion in [the Application] that it had, as of the application filing date, a bona fide intention to use [AQUAJETT] in commerce in connection with the goods identified in the application." (Ex. D, Int. 10.)

In response to these requests, Applicant stated that its "bona fide intent to use the AQUAJETT mark in commerce is evidence [sic] in Applicant's patent filings and other documents indicating an intention to manufacture dental instruments," and that "[o]ther than the documents previously produced and the patents referenced herein, Applicant is not in possession of any responsive documents regarding the manner in which [it] intends to use the mark." (Ex. C, Req. 3; Ex. D, Int. 10; Ex. E, Req. 11.) As discussed above, these "patent filings" were made by Dr. Weissman and his co-inventors long before Applicant even existed. (Weissman Dep. Exs. 2, 3, 4; Weissman Dep. at 52.) Moreover, Applicant does not own the issued patents that resulted from these filings, and there is no evidence that these patents have been licensed or assigned to the Applicant or any other third parties. (Weissman Dep. at 19; Weissman Dep. Exs. 2, 3, 4; Exs. H & I, Req. 171-73; Ex. F, Int. 20; Ex. G, Req. 12.)

Opposer then asked Applicant to identify the "other documents" that are referenced in these responses. Under cross-examination, Dr. Weissman admitted that Applicant does not have *any* other

documents demonstrating a *bona fide* intent to use AQUAJETT:

Q: The reference there to "patent filings," am I correct in assuming that Omnisource is referring to [the Patents]?

A: Right.

Q: There's a reference here to "other documents." . . . [W]hat other documents is Omnisource referring to here?

A: Off the top of my head, I can't place which other documents that would be referring to. The filings for the patents seem like the main reference as to the use of the potential trademark names.

Q: Sitting here today and aside from the patent filings that you just mentioned, can you think of any other documents that Omnisource has that relate in any way to the oral irrigator products that are described in those patents?

A: The only other documents might be the other applications for the different trademarks.

Q: The filings that were made at the trademark office?

A: Correct.

Q: And again, those would include Opposer's 5 through 9?

A: Correct.

Q: Aside from those exhibits that I just mentioned and the patents that we were discussing, are there any other documents that Omnisource has that would relate in any way to your intention to use the mark AQUAJETT?

A: Not that I can recall at this moment.

(Weissman Dep. at 45-47; Weissman Dep. Exs. 2-4, 5-9, 10.)

2. No Planning Documents

Applicant has never prepared any business plans or marketing plans for its oral irrigator product or its AQUAJETT mark. Opposer asked Applicant to produce all documents that refer or relate to "Applicant's business or marketing plans for each product that Applicant intends to offer, sell, or distribute in the United States bearing, displaying, or using Applicant's AQUAJETT mark" and "Applicant's business or marketing plans for any product or technology described in [the Patents]." Applicant admitted that it does not have any documents responsive to these requests. (Ex. G, Req. 2, 3.) Under cross examination, Dr. Weissman confirmed that Applicant has not prepared a business plan for its

oral irrigator products or its AQUAJETT mark, it has not hired anyone to prepare a business plan on its behalf, and it has not attempted to contact any third parties who might be able to provide this type of service. (Weissman Dep. at 48-49.) Dr. Weissman testified that Applicant might prepare a business plan for its oral irrigator products or the AQUAJETT mark "[w]hen the time is ready," but he does not know when that might be. (Weissman Dep. at 49.)

3. No Labels, Tags, Logos, or Packaging Materials

Applicant has never created any labels, tags, logos, or packaging materials for the oral irrigator product that it purportedly intends to sell under the AQUAJETT mark. (Weissman Dep. at 39-40.) Opposer asked Applicant to produce a representative sampling of labels, tags, and other packaging materials "showing, bearing, or displaying Applicant's AQUAJETT Mark," but Applicant admitted that no such documents exist. (Ex. G, Req. 4; Exs. H & I, Req. 87.) Dr. Weissman confirmed that Applicant has not hired any third parties to create these materials on its behalf, and it has not contacted any third parties who might be able to provide these types of services. (Weissman Dep. at 40.) He also confirmed that Applicant has never given any thought to how it might go about creating a label, logo, or other packaging material for its oral irrigator product or the AQUAJETT mark. (Weissman Dep. at 40-41.)

4. No Advertising, Marketing, or Promotional Materials

Applicant has never created any advertising, marketing, or promotional materials for the oral irrigator product that it purportedly intends to sell under the AQUAJETT mark. (Exs. H & I, Req. 97; Weissman Dep. at 34, 43-45.) Opposer asked Applicant to produce "a representative sampling of brochures, flyers, displays, advertising, and other promotional materials" that depict or describe "any product that Applicant intends to offer, sell, or distribute in the United States using Applicant's AQUAJETT Mark," including any "advertising, marketing, or promotional materials" that Applicant intends to distribute at any trade show. Applicant does not have any documents responsive to these requests. (Ex. G, Req. 5, 7.) Dr. Weissman confirmed that Applicant has not hired any third parties to create any advertising, marketing, or promotional materials on its behalf, and it has not contacted any third parties who might be able to provide these types of services. (Weissman Dep. at 44.) In fact, he

admitted that Applicant has not given any thought to the types of material that might be developed for this product. (Weissman Dep. at 34, 44.)

5. No Media Plans

Applicant has not identified any of the media outlets where it might advertise, market, or promote the oral irrigator product that it purportedly intends to sell under the AQUAJETT mark. (Ex. F, Int. 17; Ex. C, Req. 6.) Opposer asked Applicant to produce "marketing plans, media plans, or other marketing or sales documents sufficient to identify the periodicals, newspapers, and other publications the websites, the television and radio networks and stations, the cable television networks, and other media outlets where Applicant intends to advertise, market, or promote any product that Applicant intends to offer, sell, or distribute in the United States using Applicant's AQUAJETT Mark." Applicant's response to this request was "None." (Ex. G, Req. 9.) When asked to admit that it intends to market its products in general circulation magazines, newspapers, television and radio commercials, point-of-sale advertisements, or online advertisements, Applicant refused to answer the request on the grounds that it called for "conjecture or speculation." (Exs. H & I, Req. 71-76.)

Dr. Weissman confirmed that Applicant has not created any media plans, has not hired any third parties to create a media plan on its behalf, and has not contacted any third parties who might be able to provide this type of service. (Weissman Dep. at 47-48.) He also testified that Applicant might prepare a media plan for its oral irrigator products or the AQUAJETT mark "at the point that I'm ready to market these items," but he does not know when that might be. (Weissman Dep. at 48.)

6. No Press Coverage

Given that Applicant has never sold an oral irrigator product in the United States, and has made no effort to advertise, market, or promote its product, Applicant's product and its AQUAJETT mark have not received any coverage in the press. (Ex. G, Req. 10; Weissman Dep. at 48.)

G. Applicant's Lack Of Effort To Put Its Mark Into Use

Applicant has not taken any steps to put its mark into use for oral irrigators, either before or after the filing date of its application. In fact, Dr. Weissman openly admitted that "nothing" has been done to

bring these products to market. (Weissman Dep. at 29.)

1. No Marketing Plans

Applicant has considered selling its oral irrigator product on its own (as opposed to selling this product through a licensee). (Weissman Dep. at 31.) However, Applicant has not given any thought as to how it would go about doing this. (Weissman Dep. at 35, 36.)

2. No Licensees

In the alternative, Applicant has considered licensing its products to companies "in the oral care industry who are in the preventative oral care field." (Weissman Dep. at 31-32.) However, Applicant has not made a firm decision one way or the other. (Weissman Dep. at 31.) As a practicing dentist, Dr. Weissman is aware of various companies that produce oral care products, but he has not attempted to contact any of these companies within the past eleven years. (Weissman Dep. at 32-33.)

3. No Customers

Applicant purportedly intends to offer its oral irrigator product to ordinary consumers and possibly dental professionals. (Weissman Dep. at 22.) However, Applicant has not "really thought about exactly who or when these [products] would be sold or to whom." (Weissman Dep. at 23.) Applicant does not have any documents concerning the potential classes of customers for the product that will be offered under the AQUAJETT mark. (Ex. E, Req. 5.) When asked to admit that it intends to offer this product to ordinary consumers and dental professionals, Applicant refused to answer the request on the grounds that it called for "conjecture or speculation." (Exs. H & I, Req. 45-50.)

4. No Channels of Trade

Applicant purportedly intends to offer its oral irrigator product through retail stores, but it has not done anything to pursue that idea. (Weissman Dep. at 36.) Dr. Weissman was able to identify three other companies that sell oral irrigators, and he testified that these products are sold in pharmacies and general retail stores, such as Target. (Weissman Dep. at 15-16.) However, he could not identify the types of retail stores where Applicant's oral irrigator might be sold. (Weissman Dep. at 38.)

Applicant could "potentially" offer its product "to dental offices," but Applicant has not given

any thought as to how it would go about doing this. (Weissman Dep. at 37.) When asked to identify any other "potential avenues" where Applicant intends to offer its oral irrigator product Applicant admitted that "[i]t hasn't been thought about yet." (Weissman Dep. at 36.)

Applicant does not have any documents concerning the potential channels of trade for its oral irrigator product. (Ex. E, Req. 4.) When asked to admit that it intends to offer this product through pharmacies, dental health clinics, retail stores, online retail stores, discount retail stores, department stores, or other retail outlets, Applicant refused to answer the request on the grounds that it called for "conjecture or speculation." (Exs. H & I, Req. 29-34, 37-40.)

5. No Marketing Activities

Applicant has not done anything to market the oral irrigator product that it purportedly intends to sell under the AQUAJETT mark. Applicant has never placed any advertisements for this product, or hired any salespeople to market this product on its behalf. (Weissman Dep. at 38, 43.) Applicant has never distributed any brochures, fliers, hand-outs or other advertising, marketing, or promotional materials for this product. (Weissman Dep. at 34; Ex. G, Req. 7.) Likewise, Applicant has never shown its product at any trade shows. (Weissman Dep. at 41.)

Opposer asked Applicant to "[p]rovide a list of all trade shows, conferences, and other public meetings where Applicant intends to advertise, market, or promote the products that are described in [the Application.]" In response to this request, Applicant stated that it "has not yet identified the specific details of how and where it will advertise." (Ex. F, Int. 18.) Opposer also asked Applicant to produce "[d]ocuments sufficient to show any trade shows where Applicant has advertised, marketed, or promoted or intends to advertise, market or promote any product under Applicant's AQUAJETT Mark." In response to this request, Applicant produced six invoices for a trade show that is sponsored by the California Dental Association. (Ex. G, Req. 6.) However, Applicant has not claimed that these documents are evidence of its *bona fide* intent. (*Compare* Ex. G, Req. 6 *with* Ex. D, Int. 10; Ex. E, Req. 11; and Weissman Dep. at 45-47.)

Dr. Weissman usually attends this trade show once a year. (Weissman Dep. at 42.) He explained

that it is for "dentists" and "oral care companies," and it features "new products" and "information about progress in the dental field." (Weissman Dep. at 41-42.) However, Applicant has never shown its oral irrigator product at this trade show, and it has never distributed any advertising, marketing, or promotional material at these events. (Weissman Dep. at 41; Ex. G, Req. 7.) Likewise, Applicant has never discussed its oral irrigator product with any of the oral care companies who attend this trade show, and it has never taken any contact information from any of these companies. (Weissman Dep. at 42.) In fact, three of the six invoices that Applicant produced are for events which were held before Applicant even existed. (*Compare* Ex. M. *with* Ex. G, Req. 6 at OMNISOURCE 000027-000029.)

6. No Websites

Applicant asserts that it has registered several domain names, but Dr. Weissman admitted that there are no active websites at any of these addresses. (Weissman Dep. at 27-28.)

7. No Pricing Information

Dr. Weissman was able to identify three other companies that sell oral irrigator products, and he testified that their products cost between $29 to $65. (Weissman Dep. at 18.) However, he admitted that Applicant has not set any prices for its own oral irrigator. (Weissman Dep. at 39.) When Opposer asked Applicant to produce documents "sufficient to show the prices that it intends to quote to prospective customers for each product that Applicant intends to offer, sell, or distribute" under the AQUAJETT mark, Applicant responded that no such documents exist. (Ex. G, Req. 11.)

8. No Financial Information

Opposer asked Applicant to produce documents "sufficient to identify Applicant's advertising and promotional expenditures" for the products that it purportedly intends to sell under the AQUAJETT mark. Applicant admitted that no such documents exist. (Ex. C, Req. 8.) In fact, Applicant has never even prepared a budget for the production, marketing, or sales of its oral irrigator product. (Weissman Dep. at 49-50.)

9. No Insurance

Applicant has not purchased any product liability insurance for injuries that might be caused by

its oral irrigator product, and has not contacted any insurance brokers who might be able to underwrite this type of policy. (Weissman Dep. at 35.)

H. Applicant's Applications for Other Trademarks for the Same Goods

Applicant has filed intent-to-use applications for five other trademarks, namely, AQUAPIK, OMNIFRESH, OMNIJET, OMNIPIK, and SHOWERJET (collectively referred to herein as Applicant's "Other Marks"). These applications cover the exact same product that is described in the Application for AQUAJETT, namely, "oral irrigators." The Trademark Office has issued a Notice of Allowance for four of these applications, but Applicant has not filed a Statement of Use for any of them. (Ex. L; Weissman Dep. Exs. 6-9.) Dr. Weissman admitted that he plans to offer these marks to third parties who may be interested in selling oral irrigators, and that he filed multiple applications because different marks might appeal to different companies. (Weissman Dep. at 26.)

Applicant has never used these Other Marks on or in connection with oral irrigators. (Exs. H & I, Req. 109, 111, 113, 115, 141, 143, 145, 147, 149, 151, 153, 155, 157, 159, 161, 163.) It does not have any documents demonstrating its intent to use these Other Marks, other than the Patents mentioned above. (Weissman Dep. at 47.) Applicant has never used these Other Marks on any marketing materials, and it does not have any plans for using these Other Marks on any labels, logos, or packaging materials for its oral irrigator products. (Weissman Dep. at 40-41, 44.)

ARGUMENT

A. The Standard For Summary Judgment Favors Opposer

Summary judgment is appropriate when the pleadings, deposition testimony, answers to interrogatories, document requests, and requests for admissions "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); Trademark Rule 2.127(d).

As the moving party, the Opposer bears the initial burden of demonstrating that there are no genuine issues of material fact and that it is entitled to judgment as a matter of law. Opposer may satisfy this requirement by establishing that the Applicant lacks "the requisite *bona fide* intention to use its mark

on or in connection with the [goods] recited in the involved application." *Intel Corporation v. Emeny*, Opp. No. 91/123,312, at 8-9 (TTAB May 15, 2007).[2] The Board must "look at the evidence relied upon by the opposer and then determine whether or not opposer has made a persuasive argument on behalf of its position herein." *Id.* at 9.

If the Board determines that the Opposer "has established a prima facie case that applicant's application is invalid for lack of the requisite bona fide intention to use its mark, the burden then shifts to applicant to come forward with evidence to refute such case." *Id.* In doing so, the Applicant must show that there is a genuine fact dispute for trial. Fed. R. Civ. P. 56(e); TBMP § 528.01. A factual dispute is not "material" if it would not affect the outcome of this proceeding. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248-49 (1986); *Opryland USA, Inc. v. Great American Music Show, Inc.*, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). Likewise, a fact dispute is not "genuine" unless there is enough evidence in the record such that the Board could reasonably find in favor of the Applicant on that issue. *See Anderson,* 477 U.S. at 248-49; *Sweats Fashions v. Pannill Knitting Co.,* 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). In responding to a summary judgment motion, Applicant may not rely on mere denials or conclusory allegations, but rather, "must set forth specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e).

Based on these standards, Opposer is entitled to summary judgment on the issue of Applicant's *bona fide* intent.

B. Applicant Does Not Have A *Bona Fide* Intent To Use AQUAJETT

Section 1(b) of the Trademark Act requires an applicant filing a Section 1(b) application to verify that it has "a *bona fide* intention, under circumstances showing the good faith of such person" to use its mark in commerce for the goods or services specified in the application. 15 U.S.C. § 1051(b). If the applicant does not have a *bona fide* intent to use the mark as of the filing date of the application, the application is invalid. *See* TBMP § 309.03(c)(5) (applicant's lack of *bona fide* intent to use a mark in

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2 Available at http://ttabvue.uspto.gov/ttabvue/ttabvue-91123312-OPP-47.pdf

commerce is an appropriate ground for an opposition).

Whether an applicant has the requisite *bona fide* intent requires "a fair objective determination based on all of the circumstances" using "an objective good-faith test to establish that [the] applicant's intent is genuine." *L.C. Licensing, Inc. v. Berman*, Opp. 91/162,330 at 20 (TTAB Mar. 28, 2008) (precedential decision)[3]; *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha,* 26 USPQ2d 1503, 1506 (TTAB 1993) (precedential decision). In other words, an applicant's *bona fide* intent must be shown with objective "evidence in the form of real life facts measured by the actions of the applicant," rather than applicant's self-serving testimony concerning its "subjective state of mind." *Intel Corp.,* Opp. No. 91/123,312 at 11. Thus, "an applicant's mere statement of subjective intention, without more," is not enough to establish a *bona fide* intent. *Id.* at 11 n.7.

The Board has held that the applicant's failure to produce any evidence – documentary or otherwise – demonstrating that it plans to use its mark for the goods or services specified in the application "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*, 26 USPQ2d 1503, 1507; *L.C. Licensing*, Opp. 91/162,330 at 20-21. Other circumstances may also "cast doubt on the bona fide nature of the [applicant's] intent or even disprove it entirely," such as (i) failing to take concrete steps to put a mark into use since the application was filed; (ii) filing multiple applications that cover the same product; (iii) filing applications simply to reserve rights in a mark; and (iv) filing multiple applications for marks that have not been used. *See Intel Corp.,* Opp. No. 91/123,312 at 13-15; *see also* Senate Rep. No. 100-515, at 23-24, 26 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577. All of these circumstances are present in this case.

1. Applicant Has Not Produced a Single Document that Demonstrates a *Bona Fide* Intent to Use AQUAJETT

Applicant does not have a single document that demonstrates its intent to use AQUAJETT in

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[3] Available at http://des.uspto.gov/Foia/ReterivePdf?system=TTABIS&flNm=91162330-03-28-2008

commerce. Opposer asked Applicant to identify and produce all documents demonstrating that it intends to use its mark in connection with the oral irrigator that is described in the Application. Applicant admitted that it does not have *any* documents that are responsive to these requests, other than the Application and the Patents which it does not own.[4] (*See* Statement of Undisputed Facts ("Facts") § F.1.)

The statements made in the Application do not prove that the Applicant has a *bona fide* intent to use its mark in commerce, because Applicant has failed to produce any documents or other objective evidence to corroborate those statements. Instead, these statements simply reflect the Applicant's subjective state of mind as of the date that the Application was filed. *See L.C. Licensing,* Opp. No. 91/162,330 at 22-23.

Likewise, the Patents do not establish that the Applicant has a *bona fide* intent to use AQUAJETT in commerce. A patent is a form of intellectual property that gives the patentee the exclusive right to make, use, or sell the product or technology that is described therein. It also gives the patentee the exclusive right to prevent others from making, using, or selling products that infringe upon the claims that are asserted in the patent.

As discussed above, Applicant does not own any of these Patents, and in fact, Applicant did not even exist when the Patents were issued. Two of the Patents were issued to Dr. William Weissman in 1996; the third Patent was issued to Dr. Weissman and his co-inventors that same year. As such, these individuals have a legal right to make, use, or sell the oral irrigator product that is described in these Patents. Dr. Weissman and his co-inventors have never assigned or licensed these Patents to Applicant.

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[4] As discussed above, Applicant does not have any business plans, marketing plans, or other planning documents for its oral irrigator product or the AQUAJETT mark, and it does not know when it might prepare these types of documents. (Facts § F.2.) Applicant does not have any labels, tags, logos, or packaging materials for the product that it purportedly intends to sell under the AQUAJETT mark, and it has not given any thought as to how it might go about creating these materials. (Facts § F.3.) Applicant does not have any advertising, marketing, or promotional materials for its product, and it has not given any thought as to what types of materials that might be developed. (Facts § F.4.) Likewise, Applicant does not have any media plans identifying the types of outlets where it might advertise, market, or promote its oral irrigator product, and it does not have any specific plans for creating this type of document. (Facts § F.5)

Thus, Applicant does not have a license to use the inventions shown in these Patents, nor did it have such a license at the time the Application was filed. (*See* Facts § C.)

If Dr. Weissman or his co-inventors licensed or assigned their Patents to Omnisource, then Applicant would be entitled to the same legal rights as the current patent owners. However, the Patents – in and of themselves – do not prove that it would be feasible to manufacture or commercially market the devices shown in the Patents, or that the technology shown in these Patents would be competitive with current-day oral irrigator products. Likewise, the Patents do not prove that the Applicant has any concrete plans to make, use, or sell an oral irrigator product in the United States, or that Applicant has any firm plans to use AQUAJETT on or in connection with that product. In fact, Dr. Weissman admitted that "nothing" has been done to bring this product to market, and that Applicant has not given any thought as to when – or if – the AQUAJETT mark will be used in connection with that product. (Weissman Dep. at 29.)

Finally, Applicant produced six invoices for an annual trade show that is sponsored by the California Dental Association. Although these invoices are dated between 2003 and 2008, they were not sent to Dr. Weissman until March 4, 2008 – less than a week after he was deposed, and roughly a week before Applicant responded to Opposer's second set of document requests. (Ex. G, Req. 6.) The timing of this transaction suggests that the Applicant obtained these documents from the California Dental Association solely for use as evidence in this proceeding.

In any event, the invoices do not prove that the Applicant has a *bona fide* intent to use AQUAJETT in commerce. Dr. Weissman admitted that Applicant has never shown its oral irrigator product at *any* of these events. Applicant has never distributed any advertising, marketing, or promotional material for any trade show, and it has never created any brochures, fliers, hand-outs or other advertising, marketing or promotional materials for use at this show or any other trade show. Likewise, Applicant has never discussed its oral irrigator product with any of the oral care companies who attended these trade shows, and it has never taken any contact information from any of these companies. In fact, three of these invoices are for events which were held before Applicant even existed. (*See* Facts §§ F.4,

G.5.) As such, these invoices are not credible evidence that the Applicant had a *bona fide* intention to use AQUAJETT as of the Application filing date, and are irrelevant.

Under *L.C. Licensing* and *Commodore Electronics*, Applicant's failure to produce any credible documentary evidence evidencing an intent to use AQUAJETT is a sufficient basis for ruling in Opposer's favor on the issue of *bona fide* intent. *L.C. Licensing,* Opp. No. 91/162,330 at 20-21; *Commodore Electronics,* 26 USPQ2d at 1507.

2. Applicant Has Not Taken any Concrete Steps to Put Its Mark into Use

Opposer has demonstrated that Applicant has not done *anything* to bring its oral irrigator product to market or to put its AQUAJETT mark into use. Applicant has never used AQUAJETT in commerce for oral irrigators or any other type of dental instrument. It has never licensed or attempted to license this mark for use in the United States or anywhere else. Applicant has never manufactured an oral irrigator, and it has never contacted any third parties to manufacture this product on its behalf. Applicant has not given any thought as to *how* or *where* this product might be sold, or given any thought as to *when* this product might be sold or to *whom*. Applicant has not prepared any budgets for the production, marketing, or sales of its oral irrigator product, and it has not hired any sales people to sell this product. Applicant has not placed any advertisements, distributed any marketing materials, created any websites, purchased any insurance, or set any prices for this product. Simply put, *nothing* has been done to bring this product to market, and *nothing* has been done to put the AQUAJETT mark into use since the Application was filed. These evidentiary omissions confirm that the Applicant did not have a *bona fide* intention to use AQUAJETT on or in connection with oral irrigators as of the date that the Application was filed. (*See* Facts §§ D, E, G1-9.)

3. Applicant's Trademark Filings Cast Doubt upon Its *Bona Fide* Intent

When Congress enacted § 1(b) of the Trademark Act, it anticipated that some applicants would abuse the intent-to-use filing system. As a safeguard, Congress required applicants to verify that they have a *bona fide* intent to use their marks "under circumstances showing the good faith of such person." 15 U.S.C. § 1051(b). The legislative history provides an illustrative list of "circumstances" that may cast

doubt on the *bona fide* nature of the applicant's intent, or "even disprove it entirely." Senate Rep. No. 100-515, at 23. Many of these circumstances are present in this case, and together they confirm that Applicant lacks the requisite *bona fide* intent to use AQUAJETT in commerce.

a. Filing multiple applications covering the same product

Filing numerous intent-to-use applications for a variety of trademarks covering the same goods or services may cast doubt on the applicant's *bona fide* intention to use any one of those marks. *Intel Corp.*, Opp. No. 91/123,312 at 14-15; *see also* Senate Rep. No. 100-515, at 23-24. As discussed above, Applicant filed six intent-to-use applications for various trademarks, namely AQUAJETT, OMNIJET, OMNIFRESH, OMNIPIK, AQUAPIK, and SHOWERJET. These applications were filed within a span of less than two years, and they all cover the exact same product that is described in the Application for AQUAJETT, namely, "oral irrigators." (Ex. L; Weissman Dep. Exs. 5-9.) When asked if it actually intends to use all of these marks, Applicant admitted that "that hasn't been determined yet." (Weissman Dep. at 24-25.)

b. Filing applications simply to reserve rights in a mark

Filing an intent-to-use application merely to reserve a right in a mark may undermine an applicant's claim that it intends to use that mark in commerce. *Intel Corp.*, Opp. No. 91/123,312 at 14; *see also* Senate Rep. No. 100-515, at 25. In this case, Applicant admitted that it plans to offer its various marks to third parties who may be interested in selling oral irrigators, and that it filed multiple applications because different marks might appeal to different companies. (Weissman Dep. at 26.) Applicant has considered licensing its product to companies in the oral care industry. (Facts § G.2.) But as discussed above, Applicant has never licensed or attempted to license any of its marks for use in the United States, and since these applications were filed, Applicant has not attempted to contact any companies within the oral care industry to discuss its oral irrigator product. (Facts § D.)

c. Filing multiple applications for marks that have not been used

Applicant's lack of *bona fide* intent is also demonstrated by the fact that it has filed multiple intent-to-use applications for marks that have never been used. *Intel Corp.*, Opp. No. 91/123,312 at 14-

15. As discussed above, Applicant has received a Notice of Allowance for four of the six applications that are currently active, but it has not filed a statement of use for any of them. (Ex. L; Weissman Dep. Exs. 5-9.) In fact, Applicant does not have concrete plans to use any of these marks:

> Q: When are you planning on making your final decision as to what the name of this product will be?
>
> A: That hasn't been thought about yet.
>
> Q: You said . . . you would make the decision when you were able to make the choice as to which name was available to you. Is it your understanding that these names are not available to you right now?
>
> A: No. These names are available to me right now.
>
> Q: That being the case, why is it that you can't decide on which one of the names is the one that you want to use?
>
> A: Because I haven't at this point specifically focused on which name to use.

(Weissman Dep. at 25-26.) It is unlikely that these marks will be put into use in the foreseeable future. Applicant has never used these marks on any marketing materials, and it does not have any plans for using them on any labels, logos, or packaging materials for its oral irrigator products. (Weissman Dep. at 40-41, 44.) Likewise, Applicant does not have any documents demonstrating its intent to use these marks, other than the Patents mentioned above. (Weissman Dep. at 47.)

C. Opposer Has Standing To Oppose This Application

Any person who believes that it will be damaged by the registration of a mark has standing to oppose. 15 U.S.C. § 1063. All that is required is that Opposer must have a "real interest" in the proceeding, and a "reasonable basis" to believe that it will be damaged by the registration of the Applicant's mark. *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999). Opposer may satisfy this requirement by submitting copies of its pleaded registrations, and by demonstrating that its registrations are valid and subsisting. *See L.C. Licensing*, Opp. No. 91/162,330 at 6 (ownership of valid and subsisting registrations establishes standing with respect to claims for likelihood of confusion and lack of *bona fide* intent).

Applicant is seeking to register AQUAJETT for "oral irrigators." Opposer has opposed based on

its prior registrations for AQUAFRESH and various formatives, as well as its registrations for the marks AQUA and AQUA FLOSS. These registrations cover a broad range of oral hygiene products, including toothpastes, toothbrushes, and a water jet oral hygiene device for cleaning and irrigating gums and spaces between teeth. All of these registrations were issued, or the underlying applications were filed, prior to the filing date of Applicant's application.

Opposer has submitted certified status and title copies of its registration for AQUA FLOSS and one of its registrations for the mark AQUAFRESH. (Exs. J, K.) Moreover, Applicant admits that Opposer was using AQUAFRESH for toothbrushes and toothpastes before Applicant filed its application for AQUAJETT. (Exs. H & I, Req. 1, 5.)

Applicant is seeking to register AQUAJETT for the exact same product that is described in Opposer's pleaded registration for AQUA FLOSS, namely, a water jet oral hygiene device for cleaning teeth and gums. Applicant has admitted that oral irrigators are likely to be sold to the same classes of consumers and through the same channels of trade as the toothpaste that is described in Opposer's pleaded registration for AQUAFRESH. (Weissman Dep. at 11-12, 14-17.)

Based on this evidence, there are no genuine issues of material fact concerning Opposer's standing to oppose the Application.

CONCLUSION

Based on the relevant evidence in the record, it is clear that there are no genuine disputes of material fact and that Opposer is entitled to judgment as a matter of law. Applicant cannot demonstrate that it has a *bona fide* intent to use its mark, because there is no objective evidence to support that claim. Accordingly, Opposer respectfully requests that the Board sustain the opposition and deny registration to Application Serial No. 78/893,144.

Dated: April 8, 2008

Respectfully submitted,

Glenn A. Gundersen
Erik Bertin
Jacob R. Bishop
DECHERT LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808
(215) 994-2183

Attorneys for Opposer
SMITHKLINE BEECHAM CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Motion for Summary Judgment Based on the Issue of Applicant's *Bona Fide* Intent has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, P.O. Box 100637, Arlington, VA 22210 on April 8, 2008.

Erik Bertin