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

Proceeding	91178539
Party	Defendant Omnisource DDS, LLC
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Attachments	AQUAJETT - Response to MSJ - FINAL.pdf (10 pages)(140718 bytes)

filed a response opposing such an amendment. Regardless, as of the filing of Opposer's Motion for Summary Judgment, a claim of a lack of a bona fide intent was contained in Applicant's pleadings in the proceeding.

Any documents, interrogatory answers, and discovery testimony regarding the intent of the Applicant at the time of the filing of its mark was irrelevant. Because this issue was not a part of this proceeding to date, any discovery obligations thus far for Applicant did not include any burden or responsibility to respond in regards to the issue of Applicant's intentions and Applicant was under no obligation to produce such documentation.

SUMMARY JUDGMENT STANDARD

A party is entitled to summary judgment when it has demonstrated that there is no genuine issue as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Here, Opposer has not demonstrated that there are no material facts at issue regarding the alleged lack of a bona fide intent to use. Furthermore, Opposer has not demonstrated that, based on the facts, Applicant does not have a bona fide intent to use its mark in commerce or that Opposer is entitled to judgment as a matter of law.

Opposer bears the initial burden of production and proof regarding bona fide intent to use. *Intel Corp. v. Emeny*, Opposition No. 91123312 (May 15, 2007). Even if Opposer meets its burden of production, Applicant may produce evidence of a bona fide intent which counters

Opposer's production. Furthermore, the ultimate burden of proof rests with Opposer, and that burden does not shift. *Id.*

In addition, "[a]s a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment". *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993), quoting *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed.Cir.1991).

UNDISPUTED FACTS

Applicant's principal, Dr. William R. Weissman, DDS, owns patent numbers 5,511,693; 5,556,001; and 5,564,629 for oral hygiene products including oral irrigators. See Weissman Depo. at pp.18, 19.

The goods listed by Applicant in its Application No. 78893144 for the AQUAJETT mark are "oral irrigators."

Dr. William R. Weissman has been a practicing dentist for more than twenty nine years. See attached Declaration.

The fact that Applicant's entity was not formed until 2005 is irrelevant. The main members of Applicant, two brothers who are practicing dentists, have been involved in the field of dentistry and in patenting oral irrigators for many years. See Declaration of William R. Weissman, attached.

Dentistry and oral irrigator products are closely related. Dr. William R. Weissman has used oral irrigators in connection with his dental practice since 1980. See Declaration of William R. Weissman, attached.

Since 2004, Omnisource has filed multiple trademark applications for use in connection with oral irrigators, including: OMNIJET, AQUAJETT, OMNIPIK, SHOWERJET, and AQUAPIK.

Applicant has attended at least four trade shows of the California Dental Association in the field of dental and oral hygiene products.

14 Q. Have you attended any trade shows where oral
15 irrigators are marketed?
16 A. Yes.
17 Q. What trade shows?
18 A. California Dental Association.
19 Q. And what type of trade show is that?
20 A. It's a meeting here in California for new
21 products and for disseminating information about
22 progress in the dental field.

See Weissman Depo. at p.41 and Affidavit of William R. Weissman, DDS. See also Applicant's document production at OMNISOURCE 000027 – 000032, attached to Opposer's Motion for Summary Judgment as Exhibit as part of Exhibit G.

APPLICANT'S BONA FIDE INTENT TO USE THE AQUAJETT MARK IN COMMERCE

Applicant is a small, closely held company. It does not maintain extensive written records, much of its plans and discussions are oral. Applicant intends to market, sell and/or license oral irrigators and intends that AQUAJETT could be a brand name for said oral irrigators.

The Trademark Act requires a bona fide intention to use in commerce. 15 U.S.C. §1051(b). An "intention" is an aim or a target, an expression of one's intent. To require more than a subjective intent is to require objective evidence of preparing to use the mark in

commerce. However, the Trademark Act states that an intention is all that is needed to file a Section 1(b) trademark application.

It is completely reasonable that an Applicant, with a bona fide intent to use a mark in commerce, could file an application and wait for it to be approved by the USPTO and clear the publication period prior to investing further resources and funds in the mark.

“Merely because applicant may not have taken steps to actually launch or introduce a particular product does not mean that applicant otherwise had no intention to develop or market that product.” *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007).

“[A]n applicant could, under certain circumstances, file more than one intent-to-use application covering the same goods and still have the requisite bona fide intention to use each mark.” Senate Judiciary Committee Report on S. 1883, which ultimately became the Trademark Law Revision Act of 1988 (Public Law 100- 667, November 16, 1988); noted in fn 7 of *Commodore Electronics Ltd.*

3 Q. When we started talking earlier this morning, you
4 indicated that Omnisource plans to or is hoping to sell
5 a number of oral care goods, including oral irrigators.
6 Are the oral irrigators that are described in these
7 patents, the products Omnisource -- specifically the
8 oral irrigators that Omnisource is working on or that
9 you intend to sell?
10 A. Yes.
11 Q. Aside from the products that are described in
12 these three patents, does Omnisource intend to sell any
13 other oral irrigators?
14 A. No.
15 Q. What is the target audience or the target market
16 for the oral irrigators that Omnisource intends to sell?
17 A. To the general consuming public who's interested
18 in oral care goods.
19 Q. Ordinary consumers?
20 A. Ordinary consumers.
21 Q. What about dental professionals such as dentists,
22 orthodontists, endodontists?
23 A. They could potentially purchase these.

Weissman Depo. at 22. Here, Applicant has had a bona fide intent to market an oral irrigator product for which its principal owns three patents, and Applicant has filed to register several trademarks with a bona fide intent to test the licensing and marketing potential of the marks and to use one or more of the marks in commerce.

The fact that Applicant has not taken steps to make prototypes, identify a manufacturer, identify manufacturing materials, or license the mark, does not, even collectively, demonstrate a lack of intent to use the mark in commerce.

Similarly, Applicant's failure thus far to determine whether the product would be economically feasible, economically competitive, or technologically competitive, has no bearing on Applicant's *intent*.

Several cases cited as authority by Opposer involve fact patterns wherein an Applicant adopted a mark which was substantially identical to a famous mark owned by the Opposer. See e.g. *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007) (ARDEN BEAUTY and ARDEN B), *L.C. Licensing, Inc. v. Berman*, Opposition No. 91162330 (March 28, 2008) (ENYCE and ENYCE).

Applicant's intent is further differentiated from cases cited by Opposer wherein Applicant failed to demonstrate a bona fide intent, because here Applicant does not have an unreasonably broad listing of goods and services, Applicant's principal is licensed and practices in a field of business related to the use of oral irrigators, and Applicant's principal has many colleagues and contacts who could be potential customers or licensees. See Declaration of William R. Weissman, attached.

It is irrelevant that Applicant has not produced any evidence of its technology being "competitive" or "feasible," or where it would be manufactured, or what materials would be

used. The law requires an intent to use, it does not require a detailed, elaborate business plan indicating specific elements of intent.

CONCLUSION

Even if Opposer's amended notice of opposition were permitted, summary judgment on the issue of a bona fide intent to use Applicant's mark is not appropriate. Opposer has not demonstrated that no material facts are at issue regarding Applicant's bona fide intention to use its mark, and has not demonstrated that it is entitled to judgment as a matter of law, particularly since the issue of a bona fide intent has not been pled. Applicant has demonstrated that it had a bona fide intent, or at the very least that material facts regarding a bona fide intent are in dispute.

Dated: May 13, 2008

Respectfully Submitted,



Erik M. Pelton

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of Applicant's Response to Motion for Summary Judgment was deposited with postage sufficient for first class mail on May 13, 2008, to Counsel for Opposer at the following address:

Glenn A. Gundersen
Dechert LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808

By: _____


Erik M. Pelton, Esq.

I have planned to sell the oral irrigators covered in the Oral Irrigator Patents since at least 1996.

In 1996, I created a prototype of one of the oral irrigator devices referenced in the Oral Irrigator Patents.

In 2005, I formed Omnisource as a vehicle for developing, manufacturing, marketing and selling the oral irrigator devices referenced in the Oral Irrigator Patents.

Since 2004, Omnisource has filed at least five intent to use trademark applications for use in connection with oral irrigators, namely: OMNIJET, AQUAJETT, OMNIPIK, SHOWERJET, and AQUAPIK.

Omnisource filed five applications with intent to use them for the same goods to give potential licensees of the Oral Irrigator Patent devices flexibility in branding those devices, while at the same time giving them a “package deal” wherein rights to a trademark are included in the same transaction as rights to manufacture and distribute the devices. On information and belief, this is consistent with the distribution practice commonly known as “private labeling,” or “private label manufacturing.”

Omnisource has purchased the domain names omnisource.net and aquajett.com, and currently owns those domain names.

In 2005, 2006, 2007, and 2008, I attended the California Dental Association tradeshow as a representative of Omnisource. At those tradeshow, I researched competing oral irrigators and spoke with potential licensees.

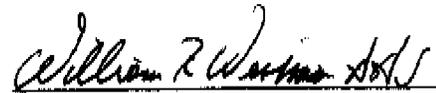
Omnisource has a bona fide intent to use the mark AQUAJETT for oral irrigators in commerce in the United States.

Omnisource has had a bona fide intent to use the mark AQUAJETT for oral irrigators in commerce in the United States since at least May 26, 2006, when Omnisource filed the application to register the trademark AQUAJETT in the United States.

I declare under penalty of perjury that the following is true and correct to the best of my knowledge.

Dated: May 13, 2008

Seen and sworn to,



William R. Weissman, DDS