

ESTTA Tracking number: **ESTTA215037**

Filing date: **06/02/2008**

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

Proceeding	91178539
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Date	06/02/2008
Attachments	AQUAJETT Reply Brief in Support of Motion for Summary Judgment.pdf (10 pages)(960010 bytes)

- Applicant admits that it has not taken steps to create any prototypes for the oral irrigator product that is described in Dr. Weissman’s patents. Likewise, Applicant admits that it has not identified any potential manufacturers for its oral irrigator product, or identified any of the materials that might be used to construct that product. (*Compare App. Br. at 6 with Opp. Br. at 4-5.*)
- Applicant admits that it has not determined if it would be economically feasible to manufacture or commercially market this product. Likewise, Applicant admits that it has not determined if the technology that is described in these 12-year-old patents would be competitive with oral irrigator products that are currently on the market. (*Compare App. Br. at 6-7 with Opp. Br. at 3-4.*)
- Applicant admits that Dr. Weissman is familiar with many brands of oral irrigators that are currently sold in the United States, and the “common methods” that manufacturers and retailers use to market and distribute these products. However, Applicant does not claim to have any specific plans for marketing and distributing its own oral irrigator product (*Compare Weissman Decl. at 1 with Opp. Br. at 8-11.*)
- Applicant claims that it has registered the domain name www.aquajett.com. However, there is no evidence that Applicant has ever launched a website at this address. (*Compare Weissman Decl. at 2 with Opp. Br. at 11.*)
- Applicant admits that it filed intent-to-use applications for five other trademarks, and that these applications cover the exact same product that is described in its application for AQUAJETT. Applicant admits that it intends to offer these marks to third parties who may be interested in selling oral irrigators. However, Applicant does not claim that it has made any effort to put these marks into use. (*Compare App. Br. at 4 and Weissman Decl. at 2 with Opp. Br. at 12.*)

Simply put, Applicant has conceded that there is no genuine issue as to any of the material facts set forth in Opposer’s brief.

B. Applicant’s “Facts” Are Contradicted By Its Own Testimony

Applicant claims that it has a *bona fide* intent to use AQUAJETT for oral irrigators, because the president of Omnisource is a practicing dentist, and because he has used oral irrigators in his dental practice. (App. Br. at 3; Weissman Decl. at 1.) However, the fact that the company president is a dentist who claims to have used oral irrigators does not demonstrate a *bona fide* intent to use a particular trademark in offering such products to the public.

In any event, this claim is directly contradicted by Dr. Weissman’s sworn deposition testimony.

Q: Do you as a dentist use oral irrigators here at your office?

A: No.

Q: You do not?

A: Correct.

Q: The product that's described in these patents, have you installed it here at your office?

A: No.

Q: You don't use it in your practice?

A: Correct.

Dr. Weissman also testified under oath that he does not provide oral irrigators to his patients. *See* Weissman Dep. at 13, 17, 24 (attached as Ex. A to the Declaration of Jacob Bishop, dated June 2, 2008).

Applicant claims that Dr. Weissman attended a trade show sponsored by the California Dental Association where he "researched competing oral irrigators and spoke with potential licensees." (Weissman Decl. at 2.) However, he has not identified these competing oral irrigators or the potential licensees or provided any other specifics.

This claim is also contradicted by Dr. Weissman's sworn deposition testimony. Dr. Weissman testified under oath that Applicant has never shown its oral irrigator product at this trade show (or any other trade show for that matter), and that Omnisource never distributed any advertising, marketing, or promotional materials at this event. (Bishop Decl., Ex. A., Weissman Dep. at 34, 41.) Moreover, Dr. Weissman expressly admitted that he never discussed Applicant's oral irrigator product with any of the companies that attended this trade show. (*Id.* at 42.)

"A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity. Where, as here a party has been examined extensively at deposition and then seeks to create an issue of fact through a later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed." *Sinskey v. Pharmacia Ophthalmics, Inc.*, 25 USPQ2d 1290, 1293 (Fed. Cir. 1992)

Applicant submitted a declaration that directly contradicts the declarant's sworn deposition testimony, but has failed to provide any explanation for this conflicting testimony. Applicant cannot be

allowed to create a dispute of material fact by contradicting its own prior testimony, because that would undermine the entire purpose of Fed. R. Civ. P. 56. *See id.* Accordingly, these factual allegations must be “disregarded” when “assessing the existence of a genuine issue of fact” in this proceeding. *Id.*

C. Applicant’s “Facts” Have No Evidentiary Support

Applicant’s brief contains several assertions of fact that are not supported by any evidence in the record.¹ The lack of citations is particularly inexcusable, because these claims involve the Applicant’s own activities.

Opposer demonstrated that Applicant failed to produce a single document showing that it has a *bona fide* intent to use its mark in commerce.² (Opp. Br. at 5-8.) Applicant tries to explain the lack of documentary evidence by claiming that it “does not maintain extensive written records” and that “much of its plans and discussions are oral.” (App. Br. at 4.) No evidentiary support is provided for this assertion. No such plans or discussions were produced in discovery, even though Opposer specifically asked for this type of information in its discovery requests. (*See, e.g.*, Declaration of Erik Bertin (dated April 8, 2008), Ex. C, Req. 3, 6; Ex. D, Int. 10; Ex. E, Req. 11.) There is no indication when these alleged “plans” were developed, or when these purported “discussions” took place. Nor is there any evidence that these alleged “plans and discussions” relate in any way to the AQUAJETT mark or the oral irrigator product that is described in the Application.

Applicant claims that it intends to offer its oral irrigator product to dental professionals, but has not offered any evidence to support this claim. (App. Br. at 5) In fact, the evidence in the record

¹ The paucity of Applicant’s evidentiary citations stands in stark contrast to the detailed citations in Opposer’s brief. At the end of every sentence containing a factual statement, Opposer has provided the Board with a specific reference to the record.

² Applicant claims that a *bona fide* intent can be gleaned from Dr. Weissman’s patents and from the invoices for four trade shows that Dr. Weissman has attended. (App. Br. at 4, 6.) Opposer demonstrated that these documents do not create a genuine dispute of material fact, because they do not prove that Applicant had a *bona fide* intent to use its mark at the time the application was filed. (Opp. Br. at 14-17.) Applicant did not address any of these arguments in its brief.

demonstrates that this is nothing more than a pipe dream. When asked if the Applicant intends to sell oral irrigators to members of the dental profession, Dr. Weissman admitted that “I haven’t really thought about exactly who or when these would be sold or to whom.” (Bishop Decl., Ex. A, Weissman Dep. at 23.) Applicant claims that Dr. Weissman “has many colleagues and contacts who could be potential customers or licensees” for this product.³ (App. Br. at 6.) However, Dr. Weissman is not aware of any other dentists who use oral irrigators in their dental practice, nor is he aware of any dentists who provide oral irrigators to their patients. (Bishop Decl., Ex. A, Weissman Dep. at 14, 17.) In fact, when asked to admit that it intends to offer this product to dentists, dental hygienists, orthodontists, and endodontists for use in the practice of dental medicine, Applicant refused to answer the request on that grounds that it called for “conjecture or speculation.” (Bishop Decl., Exs. B & C, Req. 47-50.)

Applicant claims that it is familiar with “the most common methods by which manufacturers and retailers market, distribute, and deliver oral irrigators to dentists.” (Weissman Decl. at 1.) However, there is no evidence that Applicant has any plans to offer its own oral irrigator product through these channels of trade. Dr. Weissman testified that Applicant could “potentially” offer its product to dental offices, but admitted that he has not given any thought to how Applicant would go about doing that. (Bishop Decl., Ex. A, Weissman Dep. at 37.) Dr. Weissman obtains supplies for his own practice from dental supply houses that specialize in providing supplies to dental practitioners. However, he admitted that Applicant has not discussed its oral irrigator product with any of these suppliers, and in fact, it has not even identified any specific dental supply houses to whom this product might be offered. (*See id.*)

Finally, Applicant claims that it has a *bona fide* intent to use its mark in commerce because its principals are practicing dentists, and because dentistry is closely related to oral irrigators. (App. Br. at 3, 6.) Applicant does not explain why this demonstrates a *bona fide* intent to use AQUAJETT on or in connection with oral irrigators, or how this proves that Applicant had the requisite intent at the time that it

³ Applicant cites Dr. Weissman’s declaration in support of this claim, but the declaration itself does not mention any of these alleged “colleagues and contacts.”

filed its application. Moreover, Applicant has not offered any evidence to suggest that a dentist would be likely to expand his or her business from the practice of ordinary dental medicine to the manufacture, distribution, marketing, and sale of a complex dental instrument, such as an oral irrigator. Dr. Weissman testified that he developed his oral irrigator along with several engineers. (Bishop Decl., Weissman Dep. at 20.) Although he was in private practice at the time, Dr. Weissman admitted that he did not develop this product as part of his dental practice. (*See id.* at 21.) Dr. Weissman does not use oral irrigators in his private practice, and he is not aware of any other dentists who do so. (*See id.* at 13, 14.) In fact, Applicant admitted that this type of product cannot be used to treat or prevent dental diseases. (*Id.* at 11; Bishop Decl., Exs. B & C, Req. 24, 27.)

Under Rule 56, a party opposing summary judgment “shall set forth such facts as would be admissible in evidence” to show a “genuine issue of material fact.” Fed. R. Civ. P. 56(c), (e). In this case, Applicant has not cited any objective evidence in the record that supports its factual assertions. Instead, Applicant relies on a self-serving declaration from its executive or on unsupported arguments from its attorneys. A lawyer’s arguments “are not evidence and cannot by themselves create a factual dispute sufficient to defeat a summary judgment motion.” *Siegel Transfer, Inc. v. Carrier Express, Inc.*, 54 F.3d 1125, 1138 (3d Cir. 1995). As for Dr. Weissman’s allegations, the Board has held – in a precedential decision – that “[t]he mere assertion of an intent to use the mark without corroboration of any sort, whether documentary or otherwise, is not likely to provide credible evidence to establish a bona fide intention to use the mark.” *L.C. Licensing, Inc. v. Berman*, Opp. 91/162,330 at 23 (TTAB Mar. 28, 2008) (precedential decision).⁴ Because Applicant failed to offer any credible or admissible evidence to support these factual assertions, they do not create a genuine dispute of material fact.

D. Applicant Failed To Produce Any Objective Evidence Demonstrating A *Bona Fide* Intent To Use Its Mark In Commerce

Applicant claims that it should not be required to produce objective evidence demonstrating that

it intends to use AQUAJETT in commerce, because a statement of intent is all that is needed for filing an intent-to-use application. (App. Br. at 4-5.) But the Board has made it clear that “an applicant’s mere statement of subjective intention, without more, would be insufficient to establish [the] applicant’s *bona fide* intention to use the mark in commerce.” *Intel Corporation v. Emeny*, Opp. No. 91/123,312, at 11 n.7 (TTAB May 15, 2007).⁵ Instead, an applicant’s *bona fide* intent must be “shown by objective evidence” “in the form of real life facts measured by the actions of the applicant, not by the applicant’s later arguments about his subjective state of mind.” *Id.* at 10, 11.

Applicant claims that it does not need to produce “a detailed, elaborate business plan indicating specific elements of intent” in order to satisfy this requirement. (App. Br. at 7.) However, the Board has held that the failure to produce any documentary evidence – such as business plans, media plans, or other planning documents – is sufficient to prove that the applicant lacks the requisite *bona fide* intent. *Commodore Electronics v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). Applicant does not address or attempt to distinguish this case.

Applicant claims that it is reasonable to file an application and wait for it to clear the publication period before investing resources and funds in its mark. (App. Br. at 5.) However, the Board rejected this argument in *L.C. Licensing*. The Board found that an applicant’s decision to forgo developing a business model until after an opposition has been decided did not excuse the applicant’s failure to produce documentary evidence demonstrating its intent, because it not explain why the applicant’s failed “to have any documents whatsoever at the time the application was filed that showed an intent to use the mark.” *L.C. Licensing*, Opp. 91/162,330 at 22.

Applicant attempts to distinguish *L.C. Licensing* by noting that the applicant adopted a mark that was virtually identical to the opposer’s mark. (App. Br. at 6.) Although the Board addressed the

⁴ Available at <http://des.uspto.gov/Foia/ReterivePdf?system=TTABIS&fINm=91162330-03-28-2008>.

⁵ Available at <http://ttabvue.uspto.gov/ttabvue/ttabvue-91123312-OPP-47.pdf>

applicant's bad faith in the context of the opposer's confusion claim, it never mentioned this issue in its discussion of the applicant's *bona fide* intent. See *L.C. Licensing*, Opp. 91/162,330 at 17-19, 20-23.

Applicant also claims that an applicant may have "an intention to develop or market [a] product," even if it has not "taken steps to actually launch or introduce [that] product" (App. Br. at 5), quoting *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007). *Wet Seal* is distinguishable, because in that case the applicant previously produced the products that were listed in the application, which tended to suggest that it had the capacity to reintroduce those products under a different mark. See *id.* at 1643. By contrast, Applicant admitted that it has never produced an oral irrigator product and has never taken any steps to manufacture or market such products. (Opp. Br. at 4-5.)

Applicant claims that "[a]s a general rule, the factual question of intent is particularly unsuited for disposition based on summary judgment." (App. Br. at 3.) If an applicant could establish its *bona fide* intent based solely on its own self-serving testimony, it could create a dispute of material fact simply by submitting a declaration claiming that "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future." *Intel*, Opp. No. 91/123,312, at 10 n.5. But the Board has made it clear that an applicant's subjective intent is essentially irrelevant. Instead, *bona fide* intent must be shown with objective evidence demonstrating that the applicant genuinely intends to use its mark in commerce. *L.C. Licensing*, Opp. 91/162,330 at 20, 23; *Intel*, Opp. No. 91/123,312, at 11. Where – as here – the Applicant fails to offer any objective evidence demonstrating that it has a *bona fide* intent to use its mark in commerce, it is appropriate to decide that issue on a motion for summary judgment. "In such a situation, there can be 'no genuine issue as to any material fact,' since a complete failure of proof concerning an essential element of the [applicant's] case necessarily renders all other facts immaterial." *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

Applicant argues that it did not offer any objective evidence demonstrating its *bona fide* intent, because Opposer did not assert that claim in the Notice of Opposition. Therefore, Applicant claims that it "was under no obligation to produce such documentation" and that its failure to produce this type of

evidence is “irrelevant.”⁶ Applicant is grasping at straws. During the discovery period, Opposer specifically asked Applicant to produce evidence demonstrating that it has a *bona fide* intent to use its mark in commerce.⁷ Opposer asked for similar information when it deposed Dr. Weissman.⁸

Applicant provided a substantive response to Opposer’s discovery requests, and in fact, readily admitted that “a claim of a lack of a bona fide intent was contained in Applicant’s pleadings [served] in the proceeding.” (App. Br. at 2.) Therefore, Opposer is entitled to move for summary judgment based upon those responses. *See* Rule 2.127(e)(2) (explaining that discovery responses and discovery deposition testimony will be considered by the Board when they are offered in support of a motion for summary judgment). If Applicant believed that it had “no obligation to produce such documentation”(App. Br. at 2), it could have objected to Opposer’s discovery requests, and if necessary, should have asked the Board to issue an order stating that Applicant’s *bona fide* intent is off-limits in this proceeding. Applicant waived its right to raise these objections by refusing to assert them when the requests were served and by providing a substantive response to each and every request.

Finally, Applicant admits that it filed multiple intent-to-use applications covering the exact same product that is described in its application for AQUAJETT. Applicant claims that these filings were justified by the legislative history for the Trademark Revision Act of 1988. (App. Br. at 5.) According to the Senate Report, “[a]n applicant’s bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing). Thus, an applicant could, under certain circumstances, file more than one intent-to-use application covering the exact same goods and still have the requisite bona fide intention to use each mark.” Senate

⁶ App. Br. at 2. Applicant made a similar argument in its response to Opposer’s second motion to amend the notice of opposition. *See* Applicant’s Response to Opposer’s Second Motion to Amend the Notice of Opposition at 2.

⁷ *See, e.g.*, Declaration of Erik Bertin (dated April 8, 2008), Ex. C, Req. 3, 6; Ex. D, Int. 10; Ex. E., Req. 11; Ex. F, Int. 17; Ex. G, Req. 2-5, 7, 9, 10; Exs. H & I, Req. 71-76, 87, 97.

⁸ *See, e.g.*, Bertin Decl., Ex. A, Weissman Dep. at 34, 39-41, 43-49.

Rep. No. 100-515, at 24 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577.

Applicant purportedly intends to offer its marks to third parties who are interested in selling the oral irrigator product that is described in the patents that Dr. Weissman owns or co-owns. However, there is no evidence that Applicant has obtained any right from Dr. Weissman or his co-inventors to use the inventions described in those patents, or that those inventions are marketable. (Opp. Br. at 3-4.) There is no evidence that Applicant has made any effort to put these marks into use or to bring this product to market, either before or after the applications were filed. (*Id.* at 4-5, 8-11.) There is no evidence that Applicant has attempted to license this product to third parties, no evidence that it has developed any marketing materials for this product, and no evidence that Applicant has identified the manufacturers, distributors, and sales agents needed to deliver this product to potential licensees. (*Id.* at 4-5, 7-10.) Thus, Applicant's purported plans for licensing its marks to third parties do not explain why it failed to produce any documents confirming that it has a *bona fide* intent to use these marks in commerce, nor does it explain why Applicant has not or could not put these marks into use since the applications were filed.

CONCLUSION

For the foregoing reasons, Opposer is entitled to summary judgment as a matter of law.

Dated: June 2, 2008

Respectfully submitted,

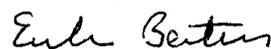


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Certificate of Service

I hereby certify that a true and correct copy of Opposer's Reply Brief in Support of Its Motion for Summary Judgment Based on the Issue of Applicant's *Bona Fide* Intent has been served by mailing such copy first class, postage prepaid, to Erik Pelton, P.O. Box 100637, Arlington, VA 22210 on June 2, 2008.



Erik Bertin