

THIS OPINION IS NOT
PRECEDENT OF THE
TTAB

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

Skoro

Mailed: September 10, 2008

Opposition No. 91178539

SmithKline Beecham Corporation

v.

Omnisource DDS, LLC

**Before Rogers, Taylor, and Ritchie de Larena
Administrative Trademark Judges.**

By the Board:

An application has been filed by Omnisource DDS, LLC to register the mark AQUAJETT for "Dental instruments, namely, oral irrigators" in Class 10.¹

Registration has been opposed by SmithKline Beecham Corp. on the grounds of a likelihood of confusion and dilution.² By a motion to amend its notice of opposition,³

¹ Application No. 78893144, filed on May 25, 2006, claiming a bona fide intent to use the mark in commerce.

² In support of these grounds opposer has claimed ownership of numerous registrations containing the mark AQUAFRESH and states that "since at least as early as 1972 and since long prior to any date of first use upon which Applicant can rely, [it] has manufactured, distributed, marketed and sold various oral care products under the mark AQUAFRESH, both alone and together with another word or words and/or design." (Notice ¶ 1).

³ This is opposer's second motion to amend its notice of opposition. By Board order dated March 26, 2008 opposer's first motion to amend to add another registration to its already long list of claimed registrations was deferred until final hearing,

filed April 8, 2008, opposer seeks to add an allegation that applicant is not entitled to registration of its mark for the goods identified in its application because applicant lacked the requisite bona fide intention to use the applied-for mark in commerce as of the application filing date. On the same date, opposer filed a motion for summary judgment based on the proposed additional ground of a lack of bona fide intent. Applicant has opposed both motions.

Motion to Amend

Opposer's motion to amend its notice of opposition to add a count of no bona fide intent to use the mark is granted. Rule 15(a) of the Federal Rules of Civil Procedure encourages courts to look favorably on motions to amend when justice so requires. In deciding such a motion, the Board must consider any undue prejudice to the non-moving party. By this motion opposer seeks to add a ground based on information it obtained during discovery and, more specifically, through the deposition of applicant's president, Dr. Weissman. Applicant responds and states that the motion is untimely, having been filed after discovery has closed; that its discovery responses thus far did not include information directed to the issue of applicant's

so as not to unduly delay these proceedings. That amendment is now accepted, see fn 4, *infra*.

intent; and applicant will be prejudiced in that this request is made five weeks after the deposition.⁴

The Board finds that allowing the amended pleading provides an opportunity for a more efficient adjudication of the merits of this dispute. Further, applicant will not be prejudiced by the amendment in that any evidence necessary to contest the added claim and support its bona fide intent to use the mark is within applicant's control and further discovery is not necessary.⁵ Accordingly, the amended notice of opposition filed with opposer's April 8, 2008 motion is accepted and is now opposer's pleading of record.⁶

Motion for Summary Judgment

This case now comes up on opposer's motion for summary judgment solely on the ground that applicant lacks a bona fide intent to use its mark in commerce. The motion has been fully briefed.

Opposer argues that no objective evidence exists which demonstrates a bona fide intent by applicant to use its

⁴ Applicant also notes that in its proposed amended notice opposer has included the claimed registration that was the subject of the Board's March 26, 2008 order deferring consideration of such proposed amendment. Because there is cause to amend the notice of opposition at this point, opposer's inclusion of the additional claimed registration is accepted.

⁵ It is noted that opposer has not asked for additional discovery on this issue.

⁶ For purposes of deciding the motion for summary judgment, the Board assumes that applicant denies newly added paragraphs 8 through 18 and the allegations contained therein.

proposed mark in commerce. Because of this alleged absence of sufficient objective evidence, opposer contends that it is entitled to judgment in its favor as a matter of law.

In support of its motion, opposer has submitted excerpts from the discovery deposition of applicant's president as well as copies of written discovery responses. Opposer maintains that applicant's president's responses to deposition questions reveal that applicant lacks evidence sufficient to establish that it had a bona fide intention to use its proposed mark in commerce.⁷ In particular, opposer contends that the discovery deposition responses indicate that from the time the mark was first conceived by applicant until the filing date of the application and beyond, the only documents that applicant has that tend to show any objective intention to use the mark in commerce are Dr. Weissman's patent filings, which are neither owned by nor licensed to applicant. Opposer concludes therefore that the absence of any other documentary evidence prepared, created or produced prior to the filing date of the application or subsequent thereto, together with applicant's filing of numerous intent to use applications for the same goods under

⁷ Opposer points to Dr. Weissman's statements that no thought has been given as to where the goods would be manufactured (Weissman dep. 31); he has never contacted third parties who might be able to manufacture the goods (dep. 30-31; Request for Production No. 12); there are no business plans or marketing plans for the product (dep. 48-49; production requests 2 and 3) and Dr.

various marks, demonstrates applicant's lack of the requisite bona fide intent at the time of filing.

Applicant contends, on the other hand, that it does have objective evidence of its bona fide intent in the filing of the trademark applications and Dr. Weissman's patent filings. Applicant also provides a declaration from Dr. Weissman⁸ stating, inter alia,⁹ that applicant had a bona fide intent to use the mark since May 26, 2006 when the application was filed.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See

Weissman's statement that he might prepare a business plan "when time is ready", but doesn't know when that would be (dep. 49).

⁸ Dr. Weissman's declaration was submitted with its response to the motion for summary judgment.

⁹ Dr. Weissman further states in his declaration that he created a prototype of the goods in 1996; that in 2004 he filed five ITU applications; that in 2005 he formed applicant as a vehicle to sell the goods; that applicant purchased domain names "omnisource.net and aquajett.com" and that in 2005-2008 he has attended tradeshow as a representative of applicant and researched the competition.

Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). The Board has held, however, that the absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act,¹⁰ unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). In this case there is some objective, documentary evidence, namely, the declaration and supporting documentation of applicant's president, Dr. Weissman, who owns patents for the goods and could license their use to applicant; the filing of numerous trademark applications to test the licensing and marketing

¹⁰ Lanham Act § 1(b) states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark.

potential of the various marks; and Dr. Weissman's declaration as to his intent to use the mark when the application was filed.

In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the record." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994).¹¹

Opposer has proffered evidence including applicant's interrogatory responses, document production (or lack thereof) or deposition responses which demonstrate that applicant has no current plans, ongoing discussions or ability to sell the identified items in commerce. However, these "admissions" do not disprove applicant's assertion of its bona fide intent to use the mark in commerce at the time of filing its application. (See Weissman declaration). Prior to the time of filing the application, Dr. Weissman had filed patent applications, several trademark

¹¹ In *Lane Ltd., supra*, the Board found that correspondence drafted by applicant in which it sought to license its mark and which was dated **ten months** after the filing of applicant's application served to corroborate applicant's bona fide intention to use its mark. *Id.* (emphasis added).

applications for various marks for the same goods,¹² purchased domain names and attended tradeshows. Although the websites have not been built, it does not mean that at some point he will not make the decision to build them. See *Lane Ltd., supra*. Also of record is Dr. Weissman's declaration that he is a majority owner of applicant, a closely held corporation; a dentist since 1976 and has used this type of product in his practice since 1980.¹³

After careful review of the record before us, we find that there is a genuine issue of material fact as to whether applicant, at the time of filing the application, had a bona fide intention to use the mark in commerce. Accordingly, opposer's motion for summary judgment is hereby denied.

Proceedings are resumed. Applicant is allowed **thirty days** from the mailing date of this order to file an answer to the second amended notice of opposition.

Trial dates are hereby reset as follows:

DISCOVERY PERIOD TO CLOSE:

CLOSED

30-day testimony period for party in position of plaintiff to close:

October 20, 2008

¹² Dr. Weissman states that it is his intent to provide potential licensees of the goods a flexibility in branding the devices (Weissman dec.). This is sufficient to withstand a motion for summary judgment as to a bona fide intent to use the mark.

¹³ While an applicant's statement of subjective intention, without more is not enough to establish a bona fide intent, there is sufficient objective evidence here to raise a genuine issue of material fact. See generally *Lane Ltd., supra*.

30-day testimony period for party in
position of defendant to close:

December 19, 2008

15-day rebuttal testimony period for
plaintiff to close:

February 2, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdnagmnt.htm>