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

Proceeding	91178539
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Attachments	AQUAJETT Opposer's Trial Brief.pdf (61 pages)(3306304 bytes)

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.	:	

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INTRODUCTION

Opposer, SmithKline Beecham Corporation, respectfully submits this Trial Brief pursuant to Trademark Rule of Practice § 2.128.

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.

This lack of evidence confirms that Applicant lacked a *bona fide* intent to use its mark in commerce at the time the Application was filed.

Opposer owns 14 registrations for AQUAFRESH and various forms of the term AQUAFRESH. Opposer's registrations cover a broad range of oral care products, including toothpaste, toothbrushes, toothbrush and oral appliance cleaners, dental gels, dentifrices. All these registrations predate the filing of Applicant's Application. Applicant's AQUAJETT mark is similar in appearance and sound to Opposer's marks, Applicant is seeking to register this mark for an oral care product that is complementary to the oral care products that Opposer provides under its marks, and it must be presumed that these products will be sold to identical consumers through identical channels of trade. Therefore, Opposer opposes this application on the grounds that Applicant's mark is likely to cause confusion or mistake or to deceive consumers as to the source of Applicant's goods in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

STATEMENT OF ISSUES

I. Whether registration should be refused because Applicant did not have a *bona fide* intent to use the mark AQUAJETT for the goods described in the Application when the Application was filed.

II. Whether Applicant's AQUAJETT mark so resembles Opposer's registered AQUAFRESH and

related AQUAFRESH-formative marks for complementary goods as to be likely to cause confusion, mistake, or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

DESCRIPTION OF THE RECORD

I. OPPOSER'S EVIDENCE

Opposer has made the following evidence of record:

A. Opposer's First Notice of Reliance, containing certified status and title copies of 14 of Opposer's valid and subsisting U.S. Trademark Registrations for the following marks, which were made of record pursuant to Trademark Rule of Practice 2.122(d): AQUAFRESH, AQUAFRESH ALL, AQUAFRESH AQUABLAST, AQUAFRESH SENSITIVE, AQUAFRESH XTENSIVE, AQUAFRESH EXTREME CLEAN, AQUAFRESH FLEX, AQUAFRESH FLEX TIP MAX-ACTIVE, AQUAFRESH WHITE & SHINE, AQUAFRESH DIRECT, AQUAFRESH IMPACT, AQUAFRESH & cat toothbrush design, and AQUAFRESH & elephant toothbrush design. A complete description of Opposer's registrations is set forth below in Section II of Opposer's Statement of Facts.

B. Opposer's Second Notice of Reliance, containing a list of all articles in the NEXIS "All News" database published between April 1, 2006 and May 25, 2006 (the filing date of Applicant's Application) that mention Opposer's AQUAFRESH marks. In addition, Opposer's Second Notice of Reliance contains a sampling of ten of these articles from U.S. publications, which were made of record pursuant to Trademark Rule of Practice 122(e).

C. Opposer's Third Notice of Reliance, containing a list of all articles in the NEXIS "Major Newspapers" database published in the first month of every year from 1995 through 2009 that mention Opposer's AQUAFRESH marks. In addition, Opposer's Third Notice of Reliance contains a sampling of thirteen of these articles, which were made of record pursuant to Trademark Rule of Practice 122(e).

D. Opposer's Fourth Notice of Reliance, containing a list of all articles in the NEXIS "U.S. Newspapers" database published between May 25, 2006 (the filing date of Applicant's Application) and February 10, 2009 (the filing date of Opposer's Fourth Notice of Reliance) that mention Opposer's

AQUAFRESH marks. In addition, Opposer's Fourth Notice of Reliance contains a sampling of thirteen of these articles from U.S. publications, which were made of record pursuant to Trademark Rule of Practice 122(e).

E. Opposer's Fifth and Eleventh Notices of Reliance, containing excerpts and selected exhibits from the deposition testimony of William Weissman, President of Applicant, Omnisource DDS, LLC, taken February 27, 2008, and made of record pursuant to Trademark Rule of Practice 123 (referred to herein as "Weissman Dep. at [page(s)]" or "Weissman Dep. Ex. [letter] at [page(s)]").

F. Opposer's Sixth Notice of Reliance, containing answers that Applicant provided in response to Opposer's First and Second Set of Interrogatories, which were made of record pursuant to Trademark Rule of Practice 2.120(j).

G. Opposer's Seventh Notice of Reliance, containing admissions that Applicant provided in response to Opposer's Requests for Admission, which were made of record pursuant to Trademark Rule of Practice 2.120(j).

II. APPLICANT'S EVIDENCE

The Board excluded much of the "evidence" that Applicant submitted during its testimony period in its Order granting Opposer's motion to strike that evidence.[1] For the reasons set forth in Opposer's Statement of Objections (filed contemporaneously with this Trial Brief), much of the remaining "evidence" that Applicant submitted during its testimony period is also inadmissible under the Rules of Evidence and should be given no consideration. Applicant's purported evidence includes the following:

A. Exhibit 1 to Applicant's Notice of Reliance, containing a copy of the Board's decision in *SmithKline Beecham Corporation v. Tocad Co., Ltd.*, Cancellation No. 92023622 (TTAB 1997).

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[1] In its Order dated June 10, 2009, the Board excluded the following Exhibits to Applicant's Notice of Reliance: Exhibit 2 (containing a complete copy of the discovery deposition testimony of Applicant's President, William Weissman, taken February 27, 2008, together with all of the exhibits thereto), Exhibit 7 (containing a sworn declaration from Applicant's President), Exhibit 8 (containing Applicant's response to Opposer's Requests for Admission Nos. 110, 112, 114, and 116), Exhibits 11, 12 and 13 (containing unauthenticated documents purportedly produced from Applicant's own files). (*See* Order dated June 10, 2009 at 4, 5 & n.5, 6-7.)

B. Exhibit 2 to Applicant's Notice of Reliance, containing extracts from dictionaries that provide definitions for the words "aqua," "fresh," and "jet."

C. Exhibit 3 to Applicant's Notice of Reliance, containing copies of various third party trademark registrations. Opposer has moved to exclude these registrations for the reasons set forth in section I of its Statement of Objections.

D. Exhibits 4 and 6 to Applicant's Notice of Reliance, containing print-outs from the Trademark Office's database relating to Applicant's abandoned application for the mark OMNIFRESH, and its pending intent to use applications for the marks OMNIPIK, OXY+, and LIFES A BLEACH.

E. Exhibit 8 to Applicant's Notice of Reliance, containing Applicant's responses to Opposer's First and Second Set of Interrogatories, and Applicant's response to Opposer's Request for Admission No. 174. Opposer has moved to exclude Applicant's response to Request for Admission No. 174 and Interrogatories Nos. 6, 7, 8, 9, and 10 for the reasons set forth in section II of its Statement of Objections.

F. Exhibit 9 to Applicant's Notice of Reliance, containing print-outs from the Trademark Office's database relating to U.S. Patent Nos. 5,564,629; 5,511,693, and 5,556,001.

G. Exhibit 10 to Applicant's Notice of Reliance, containing copies of Applicant's articles of organization.

H. Exhibit 2 to Applicant's Supplemental Notice of Reliance, containing citations to the discovery deposition transcript of Applicant's President, William Weissman. When Applicant filed its Supplemental Notice of Reliance it did not submit a copy of the specific portions of the transcript that it intends to rely upon in this proceeding. Instead, Applicant attached this evidence as an exhibit to a brief which was filed after the close of its testimony period. Opposer has moved to exclude this testimony for the reasons set forth in section II of its Statement of Objections.

STATEMENT OF RELEVANT FACTS

I. APPLICANT LACKS A *BONA FIDE* INTENT TO USE ITS MARK

A. The Applicant

Omnisource DDS, LLC is a California limited liability company formed in 2005. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 52.) Applicant does not have any subsidiaries, parent companies, or related companies. (Opposer's Sixth Notice of Reliance, Ex. B, Int. 1.) Applicant's president is William R. Weissman, and Applicant admits that he is the most knowledgeable person concerning its business and its purported plans for using the AQUAJETT mark. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 6-7, 8-9.)

B. The Application

On May 25, 2006 Applicant filed an intent-to-use application to register AQUAJETT for "dental instruments, namely, oral irrigators." An "oral irrigator" is an oral hygiene device used for cleaning teeth, cleaning spaces between teeth, and cleaning gums. (Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 17, 18, 19.) Applicant admits that it does not intend to use AQUAJETT for any other type of "dental instrument." (Opposer's Sixth Notice of Reliance, Ex. C, Int. 7; Opposer's Fifth Notice of Reliance, Weissman Dep. at 22.)

C. Applicant's Lack Of Technology

Applicant purports to have an intent to use AQUAJETT in connection with an 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"). (Opposer's Fifth Notice of Reliance, Weissman Dep. at 18, 22, 26-27; Opposer's Eleventh Notice of Reliance, 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 William Weissman and other co-inventors more than 10 years ago, in 1996. (Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 165, 166; Opposer's Fifth Notice of Reliance, Weissman Dep. at 18-20; Opposer's Eleventh Notice of Reliance, Weissman Dep. Exs. 2, 3, 4.)

Weissman owns two of these Patents outright; the third patent is jointly owned by Weissman and his co-inventors. (Opposer's Eleventh Notice of Reliance, Weissman Dep. Exs. 2, 3, 4.) Weissman realizes that the Patents will expire at some point, but he admitted that he does not know when that will be, and that for all he knows, the Patents may expire this year. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 20.)

Applicant was not formed until 2005. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 52.) 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. (Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 171, 173; Opposer's Sixth Notice of Reliance, Ex. C, Int. 20; Opposer's Fifth Notice of Reliance, 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.

Applicant did not produce any documents referring or relating to any product or technology described in the Patents. 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 these 13-year-old Patents would be competitive with current-day oral irrigator products. Likewise, Applicant did not produce any documents or testimony demonstrating that it considered these issues either before or after the Application was filed.

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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 28, 29; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 86.) 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, either before or after the Application was filed. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 32, 34; Opposer's Sixth Notice of Reliance, Ex. C, Int. 19; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 90.) In fact, Weissman admitted that Applicant "hasn't really thought about exactly . . . when these [products] would be sold or to whom." (Opposer's Fifth Notice of Reliance, 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, either before or after the Application was filed. (Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 91, 94; Opposer's Fifth Notice of Reliance, Weissman Dep. at 28, 29.) Weissman claims that he prepared a single prototype for the patent applications that he filed in 1994, but he is not certain where this prototype is currently located. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 19-20; Applicant's Notice of Reliance, Ex. 2, Weissman Dep. at 29.) Needless to say, Applicant was not involved in the development of this prototype, because Applicant did not exist until 2005. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 52.)

Applicant has not given any thought as to where its product would be manufactured. (Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 30, 39.) Moreover, there is no evidence that Applicant ever engaged in any of these activities either before or after the Application was filed.

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." (Opposer's Eleventh Notice of Reliance, Weissman Dep. Ex. 11, Req. 3.) 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." (Opposer's Sixth Notice of Reliance, Ex. B, 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." (Opposer's Sixth Notice of Reliance, Ex. B, Int. 10; Opposer's Eleventh Notice of Reliance, Weissman Dep. Ex. 11, Req. 3.) As discussed above, these "patent filings" were made by Weissman and his co-inventors long before Applicant even existed. (Opposer's Eleventh Notice of Reliance, Weissman Dep. Exs. 2, 3, 4; Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 19; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 171, 173; Opposer's Sixth Notice of Reliance, Ex. C, Int. 20.)

Opposer asked Applicant to identify the "other documents" that are referenced in these responses. Under cross-examination, 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.

(Opposer's Fifth Notice of Reliance, Weissman Dep. at 45-47; Opposer's Eleventh Notice of Reliance, Weissman Dep. Exs. 2-10.)

2. No Planning Documents

Opposer asked Applicant to identify "all documents in the possession, custody or control of or otherwise known to Applicant or its counsel which are relevant to Applicant's selection, adoption and use of Applicant's [AQUAJETT] Mark." (Opposer's Sixth Notice of Reliance, Ex. A, Int. 4.) Applicant admitted that it does not have any documents responsive to this request. (Opposer's Sixth Notice of Reliance, Ex. A, Int. 4.) Applicant has never prepared any business plans or marketing plans for its oral irrigator product or its AQUAJETT mark – either before or after the Application was filed. Applicant has not hired anyone to prepare a business plan on its behalf, and it has not identified any third parties who might be able to provide this type of service. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 48-49.) 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. (Opposer's Fifth Notice of Reliance, 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, either before or after the Application was filed. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 39, 41; Opposer's Seventh

Notice of Reliance, Exs. A & B, Req. 87.) Weissman confirmed that Applicant has not hired any third parties to create these materials on its behalf, and it has not identified any third parties who might be able to provide these types of services. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 40.) He also admitted that Applicant has not made any plans for how it might go about creating a label, logo, or packaging material for its oral irrigator product or the AQUAJETT mark, either before of after the Application was filed. (Opposer's Fifth Notice of Reliance, 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, either before or after the Application was filed. (Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 97; Opposer's Fifth Notice of Reliance, Weissman Dep. at 34, 43-45, 47.) Applicant has never used the AQUAJETT mark on any marketing materials, and has never created or placed any advertisements, any point-of-sale materials or displays, any brochures, handouts, or flyers, any internet ads, or any television or radio commercials for its oral irrigator product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 43-44.) 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 identified any third parties who might be able to provide these types of services. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 44.) In fact, he admitted that Applicant has not given any thought to the types of marketing materials that might be developed for this product or the AQUAJETT mark. (Opposer's Fifth Notice of Reliance, 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, either before or after the Application was filed. Opposer asked Applicant to identify "all forms of media where Applicant intends to advertise, market, or promote the products that are described in Application Serial No. 78/893,144." (Opposer's Sixth Notice of Reliance, Ex. C, Int. 17.) In response to this request, Applicant

admitted that it has not yet determined "how and where it will advertise." (Opposer's Sixth Notice of Reliance, Ex. C, Int. 17.) 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. (Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, 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, Weissman openly admitted that "nothing" has been done to bring this product to market. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 29.)

1. No Use of the Mark

Applicant has never sold an oral irrigator product, either before or after it filed its Application for the mark AQUAJETT, and has never used this mark on or in connection with an oral irrigator product or any other product or service. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 28, 29; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 86, 87.)

2. No Marketing Plans

Applicant has considered selling its oral irrigator product on its own (as opposed to selling this product through a licensee). (Opposer's Fifth Notice of Reliance, Weissman Dep. at 31.) However, Applicant has not made a decision one way or the other, and in fact, has not given any thought as to how it would go about doing this, either before or after the Application was filed. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 31, 35, 36.)

3. No Licensees

Applicant has never licensed or attempted to license the AQUAJETT mark to any third parties. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 32, 33; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 171, 173; Opposer's Sixth Notice of Reliance, Ex. C, Int. 20.) Applicant has considered licensing its oral irrigator to companies "in the oral care industry who are in the preventative oral care field." (Opposer's Fifth Notice of Reliance, Weissman Dep. at 31-32.) However, Applicant has not made a decision about this one way or the other. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 31.) Weissman is aware of various companies that produce oral care products, but Applicant has not identified any specific companies to license its oral irrigator and it has not attempted to identify the specific segments within these companies that might be interested in such a product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 33, 34.)

4. No Customers

Applicant purportedly intends to offer its oral irrigator product to ordinary consumers and possibly dental professionals. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 22; Opposer's Sixth Notice of Reliance, Ex. C, Int. 14.) However, Applicant has not "really thought about exactly who or when these [products] would be sold or to whom." (Opposer's Fifth Notice of Reliance, Weissman Dep. at 23.)

5. No Channels of Trade

At the time Applicant filed its Application, it had not identified the potential sales outlets for its oral irrigator product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 38.) Applicant now claims that it intends to offer its product through retail stores, but it has not done anything to pursue that idea. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 36.) 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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 15-16.) However, he could not identify the types of retail stores where Applicant's oral irrigator might be sold. (Opposer's Fifth Notice of Reliance, 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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 37.) When asked to identify any other "potential avenues" where Applicant might offer its oral irrigator product Applicant admitted that "[i]t hasn't been thought about yet." (Opposer's Fifth Notice of Reliance, Weissman Dep. at 36, 38.)

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

At the time Applicant filed its Application, it did not have any plans for creating any labels, logos, or packaging materials for the oral irrigator that it purportedly intends to sell under the AQUAJETT mark. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 40-41; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 87.) Likewise, Applicant does not have any current plans to create any labels, tags, logos, or packaging for its product, and has not attempted to identify any third parties who might be able to prepare these materials on its behalf. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 40-41.)

7. 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 developed any marketing materials for its oral irrigator product, either before or after the Application was filed, and it has never created or distributed any advertisements, point-of-sale materials, brochures, handouts, flyers, internet ads, or television or radio commercials for this product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 34, 43-45.) Applicant has never hired any salespeople to market this product on its behalf, it has never hired anyone to prepare any advertising, marketing, or promotional materials for its product, and it has not identified any third parties who might be able to provide these types of services. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 38, 44.) In fact, Applicant has never given any thought to the types of marketing materials that might be developed for this product or the AQUAJETT mark. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 34, 44.)

8. No Pricing Information

Weissman admitted that Applicant has not set any prices for its oral irrigator products. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 39.)

9. No Financial Information

Applicant has never prepared a budget for the production, marketing, or sales of its oral irrigator product, or the use of the mark shown in its Application. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 49-50.)

10. 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. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 35.)

III. OPPOSER'S RIGHTS IN ITS AQUAFRESH AND AQUAFRESH-FORMATIVE MARKS

Opposer is the record owner of 14 valid and subsisting U.S. trademark registrations for AQUAFRESH and various AQUAFRESH formative marks. These registrations include:

Trademark	Reg. No.	Reg. Date	Goods
AQUAFRESH SENSITIVE	1,805,051	November 16, 1993	Toothpaste
AQUAFRESH FLEX	1,662,981	October 29, 1991	Toothbrushes
AQUAFRESH	1,006,821	March 18, 1975	Toothpaste
AQUAFRESH & cat toothbrush design	2,706,176	April 15, 2003	Toothbrushes
AQUAFRESH & elephant toothbrush design	2,706,175	April 15, 2003	Toothbrushes

AQUAFRESH FLEX TIP MAX-ACTIVE	2,759,361	September 2, 2003	Toothbrushes
AQUAFRESH & toothbrush design	2,754,841	August 26, 2003	Toothbrushes
AQUAFRESH ALL	2,314,839	February 1, 2000	Toothpaste
AQUAFRESH EXTREME CLEAN	2,615,649	September 3, 2002	Toothpaste
AQUAFRESH AQUABLAST	2,811,892	February 3, 2004	Toothbrush cleaners and oral appliance cleaners
AQUAFRESH XTENSIVE	3,058,216	February 7, 2006	Toothbrushes
AQUAFRESH WHITE & SHINE	3,218,965	March 13, 2007	Oral care preparations, namely dental gels, dentifrices
AQUAFRESH IMPACT	3,110,249	June 27, 2006	Toothpaste
AQUAFRESH DIRECT	2,985,548	August 16, 2005	Toothbrushes

The applications for all of these registrations were filed well before Applicant filed its Application for AQUAJETT on May 25, 2006. All of these registrations are valid and subsisting on the Principal Register without a showing of acquired distinctiveness. Five of these registrations are incontestable, namely, AQUAFRESH, AQUAFRESH ALL, AQUAFRESH SENSITIVE, and AQUAFRESH EXTREME CLEAN for toothpaste, and AQUAFRESH FLEX for toothbrushes. (*See* Opposer's First Notice of Reliance.)

Applicant admits that Opposer has used its AQUAFRESH mark in connection with toothpastes, and Applicant admits that it was aware of Opposer's use of this mark before it filed its Application for the mark AQUAJETT. (Opposer's Seventh Notice of Reliance, Exs. A&B, Req. 1; Opposer's Sixth Notice of Reliance, Ex. A, Int. 8.) As the Applicant's president explained, toothpaste and toothbrushes are oral hygiene devices used for cleaning teeth, cleaning spaces between teeth, and cleaning gums, these products are used by ordinary consumers, and they are sold through pharmacies and general retail stores, such as Target. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 11, 12, 15, 17, 51.)

Opposer's products have received extensive media coverage, which has contributed to the widespread public recognition of its AQUAFRESH trademarks. AQUAFRESH products have been mentioned on national television and radio broadcasts, such as *CNN, CNNfn, CBS News Marketwatch, CBS News Early Show,* and *National Public Radio*. (Opposer's Third Notice of Reliance, Article No. 84, 126, 162, 172, 190, 192, 193, 317, 318) Opposer's AQUAFRESH products have been mentioned in the most prestigious newspapers in the nation, such as *The New York Times, The Washington Post, The Boston Globe, Chicago Tribune, Philadelphia Inquirer,* and *USA Today*. (*See* Opposer's Second Notice of Reliance, Article No. 218; Opposer's Third Notice of Reliance, Article Nos. 78, 109, 153, 155, 188, 256; Opposer's Fourth Notice of Reliance, Article No. 29; Opposer's Fourth Notice of Reliance, Article No. 40.) In addition, they have been discussed in numerous regional newspapers, such as the *Alabama Mobile Register, Allentown Morning Call, Deseret Morning News, Detroit Free Press, Pittsburgh Tribune Review, Pittsburgh Post Gazette, Pittsburgh Business Times, Cleveland Plain Dealer, Knoxville News Sentinel, Lancaster Intelligencer Journal,* the *Michigan Muskegan Chronicle*, the *Seattle Post Intelligencer,* among others. (*See* Opposer's Second Notice of Reliance, Article Nos. 6, 198, 200, 206, 207, 211, 212; Opposers Third Notice of Reliance, Article Nos. 15, 34, 68, 70, 71, 112, 142, 144, 217, 332, 336; Opposer's Fourth Notice of Reliance, Article No. 32, 34, 39, 42, 45, 55, 79.) All of these articles use the AQUAFRESH trademarks when referring to Opposer's products – as in "Aquafresh toothpaste," and when Opposer introduces a new toothpaste or toothbrush under its AQUAFRESH mark or launches a new marketing campaign for its products, these developments are often mentioned in the

national and regional press. (*See, e.g.,* Opposer's Second Notice of Reliance, Article Nos. 7, 8, 11, 200, 203, 204, 207, 211, 212; Opposer's Third Notice of Reliance, Article No. 44, 217, 232, 357; Opposer's Fourth Notice of Reliance, Article No. 28, 29, 30, 55, 67, 79.) The interest in AQUAFRESH products is consistent from year to year. To establish this point, Opposer has provided a random sampling of articles from the NEXIS database which were published in the month of January between 1995 and 2009. (*See* Opposer's Third Notice of Reliance.) This extensive media attention has contributed to the widespread public recognition of the AQUAFRESH marks.

The fact that Opposer's products are routinely mentioned in the press is not surprising. AQUAFRESH was ranked among the top 10 toothpaste brands from 2001 to 2003 and from 2005 to 2008 by a commercial publication that compiles market quotations for the drug store industry. Unit sales of AQUAFRESH toothpaste remained relatively stable during this period, with 63,976,000 units sales reported in 2001 and 63.4 million unit sales reported in 2008. Likewise, dollar sales of AQUAFRESH remained relatively stable, with $148,396,000 dollar sales reported in 2001 and $147,000,000 dollar sales reported in 2008. (*See* Opposer's Second Notice of Reliance, Article No. 5; Opposer's Third Notice of Reliance, Article Nos. 20, 28, 40, 104, 136, 250, 337, 338, 350.)

ARGUMENT

I. REGISTRATION OF APPLICANT'S MARK SHOULD BE REFUSED BECAUSE 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 commerce is an appropriate ground for an opposition).

Whether an applicant has the requisite *bona fide* intent requires "an objective determination based on all of the circumstances" using "an objective good-faith test to establish that [the] applicant's intent is genuine." *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1930 (TTAB 2009) (precedential decision); *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 and by the actions of the applicant," rather than applicant's self-serving testimony concerning its "subjective state of mind." *Research In Motion Ltd.*, 92 USPQ2d at 1931. Thus, an "applicant's mere statement that it intends to use the mark, and its denial that it lacked a bona fide intent" do not prove that the applicant had a *bona fide* intent to use its mark when it filed its application. *Id.*

The absence of any documentary evidence demonstrating that the applicant plans to use its mark for the goods or services specified in the application "constitutes objective proof that is sufficient to prove that the applicant lacks a *bona fide* intention to use its mark in commerce." *Research In Motion Ltd.*, 92 USPQ2d at 1930; *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1891 (TTAB 2008) (precedential decision); *Commodore Electronics*, 26 USPQ2d at 1507. Other circumstances may also "cast doubt on the bona fide nature of the [applicant's] intent or even disprove it entirely," such as failing to take concrete steps to put a mark into use since the application was filed. *See Intel Corp. v. Emeny,* 2007 TTAB LEXIS 101, at *14-15 (TTAB May 15, 2007) (attached as Exhibit A to Opposer's Trial Brief).

The Board has routinely held that registration should be refused where – as here – the applicant fails to offer any documents, any testimony, or any other objective proof demonstrating that it had a *bona fide* intent to use its mark in commerce. For example, in *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009) (precedential decision), the applicant never offered any products or services under its mark. The applicant did not have any plans concerning how its mark might be used or when the mark might be put into use. The applicant did not have any documents concerning the classes of customers or the channels of trade for its products. The applicant did not produce any market studies, surveys, or focus group studies, and did not produce any documents concerning its plans for the

expansion or growth of its business. Likewise, the record was "devoid of any evidence concerning product design efforts, manufacturing efforts, graphic design efforts, test marketing, correspondence with prospective licensees, preparation of marketing plans or business plans, creation of labels, marketing or promotional materials, or the like." *Id.* at 1930-31.

In *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (precedential decision), the applicant failed to produce any labels, tags, or packaging for its products, failed to produce any documents concerning the advertising, marketing or promotion of its products. Likewise, there was no evidence to suggest that the applicant had the capacity to launch a genuine commercial enterprise involving the manufacturing and distribution of the products described in his application, and the applicant failed to produce any other documents suggesting that he had a plan for how he might proceed with such a business. *See id.* at 1587.

In *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (precedential decision), the applicant admitted that it did not have any business plans for its product and admitted that it had not identified the channels of trade for that product. The applicant also admitted that it did not have any documents concerning the intended use of its mark, the products that it intended to offer under its mark, or any documents for promoting, advertising, or publicizing that product. *See id.* at 1662-63.

In *DC Comics v. Silver*, 2009 TTAB LEXIS 566 (TTAB Aug. 21, 2009), the applicant did not take any steps toward manufacturing, distributing, selling, or promoting any products or services under his mark. He did not identify the retail or wholesale prices that he intended to charge for his products or services. He did not produce any documents concerning his actual or planned promotional expenditures. The applicant never conducted any market studies or surveys concerning his mark, he never produced any advertisements, advertising scripts, or other promotional materials, and he never produced any documents concerning the trade channels for his product. The applicant had no experience in manufacturing or marketing those products, he did not have a business "geared toward manufacturing, marketing, and selling the identified goods," and he never hired any engineering firms or marketing firms to handle these issues. *See id.* at * 12-15 (attached as Exhibit B to Opposer's Trial Brief).

Likewise, in *Montblanc-Simplo GmbH v. United Brands International, Inc.*, 2009 TTAB LEXIS 633 (TTAB Sept. 29, 2009), the applicant did not produce any marketing plans for the products that it purportedly intended to sell under its marks. The applicant did not produce any documents concerning the projected sales for its product, nor did it produce any correspondence with advertising agencies or public relations firms regarding the promotion of its product. The applicant claimed that it had attempted to identify potential suppliers for its product, but did not have any documents to substantiate that claim. *Id.* at *17-21 (attached as Exhibit C to Opposer's Trial Brief).

In each of these cases, the Board refused registration because the lack of evidence in the record confirmed that the applicant did not have a *bona fide* intent to use its mark at the time that its application was filed. Three of these cases are precedential decisions that are binding upon the panel assigned to this case. The deciding factors which were cited in these decisions are also present in this case. Therefore, Opposer respectfully submits that the Application for AQUAJETT should be refused and judgment should be entered in Opposer's favor.

A. 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 commerce. Applicant has never created 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. (*See* Statement of Facts § F.2.) Applicant has never created 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. (*See* Statement of Facts §§ F.3, G.6.) Applicant has never created 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. (*See* Statement of Facts §§ F.4, G.7.) Applicant has never created 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. (*See* Statement of Facts § F.5.)

Applicant does not have any documents discussing the manufacture, distribution, or sale of its product. (*See* Statement of Facts §§ C, E, F.1.) Applicant has not produced any market research studies, surveys, focus group studies, or other test marketing documents. (*See* Statement of Facts § F.4.) Applicant has not prepared any budgets for the production, marketing, or sale of its product, or any documents discussing the wholesale or retail prices for this product. (*See* Statement of Facts §§ G.8, G.9.) Applicant does not have any documents discussing the classes of customers or channels of trade for its products. (*See* Statement of Facts §§ G.4, G.5.) Applicant does not have any instruction manuals or user manuals explaining the intended use for its product or any documents explaining how the products works. (*See* Statement of Facts § E.)

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. However, 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. (*See* Statement of 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 failed to produce any documents or other objective evidence to corroborate those statements. The Board has made it clear that an "applicant's mere statement that it intends to use the mark" – without "evidence in the form of real life facts" – does not establish "a bona fide intent to use the mark in commerce when [the applicant] filed the involved application." Indeed, "[i]f the filing and prosecution of a trademark application constituted a bona fide intent to use a mark, then in effect, lack of a bona fide intent would never be a ground for opposition or cancellation, since an inter partes proceeding can only be brought if the defendant has filed an application." *Research In Motion*, 92 USPQ2d at 1931.

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 William Weissman in 1996; the third Patent was issued to 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. Weissman and his co-inventors have never assigned or licensed these Patents to Applicant. 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* Statement of Facts § C.)

If Weissman or his co-inventors licensed or assigned their Patents to Applicant, 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, that the products described in these Patents actually work, or that the technology shown in Patents issued in 1996 would be competitive with current-day oral irrigator products. 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 had any firm plans to use AQUAJETT on or in connection with that product, either before or after the Application was filed. Moreover, the Patents do not prove that Applicant has the capacity to launch a genuine commercial enterprise involving the manufacture, distribution, marketing, or sale of an oral irrigator, or that Applicant has any plans for how it might proceed with such a business. Weissman acknowledged that these Patents will expire, but he admitted that he does not know when that will be, and that for all he knows, the Patents may expire this year. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 20.) He also admitted that "nothing" has been done to bring this product to market since the Patents were issued, and that Applicant has not given any thought as to when – or if – the AQUAJETT mark will be used in connection with that product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 29.)

Applicant's reliance on these Patents is very similar to an argument which was considered – and rejected – in *DC Comics v. Silver*, 2009 TTAB LEXIS 566 (Aug. 21, 2009). In that case the applicant submitted a description of a formula for "Maiden Waves Sunscreen" as evidence of his intent to use the mark SUPERHERO for sunscreens. However, the formula did not establish the applicant's *bona fide* intent, because he admitted that the formula was never put into use. *See id.* at *16-17. Likewise, the Applicant in this case claims that it intends to use AQUAJETT for an oral irrigator that is described in the Patents. However, Applicant admits that it has never actually produced the product that is described in these Patents. In fact, Applicant has never given any thought as to where this product would be manufactured, and it has never contracted with any third parties or attempted to identify any third parties who might be able to manufacture this product on its behalf. Applicant has not identified the types of materials that would be used to construct its oral irrigator, it has not prepared any schematics that would be used to assemble this product, and it has not prepared any instruction manuals or user manuals that would explain how the products works. Weissman claims that he produced a single prototype when he filed his applications for these Patents in the 1990s, but he is not certain where this prototype is currently located. Because Applicant has never produced or attempted to produce an actual irrigator based on the Patents and has not produced any evidence to suggest that the irrigator described in those Patents would actually work, the Patents are not evidence of Applicant's *bona fide* intent to use the mark AQUAJETT as of the date that the Application was filed. (*See* Statement of Facts § E.)

Applicant's failure to produce any credible documentary evidence demonstrating an intent to use AQUAJETT confirms that Applicant did not have a *bona fide* intent to use this mark at the time that its Application was filed, and is a sufficient basis for ruling in Opposer's favor on this issue. *Research in Motion*, 92 USPQ 2d at 1930-31; *Boston Red Sox*, 88 USPQ2d at 1587; *DC Comics*, 2009 TTAB LEXIS at *12-15, 18; *Honda Motors*, 90 USPQ2d at 1663; *L.C. Licensing*, 86 USPQ2d at 1891-92 ; *Commodore Electronics*, 26 USPQ2d at 1507.

B. 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, either before or after the Application was filed. Applicant has never used AQUAJETT in commerce for oral irrigators or any other type of dental instrument. (*See* Statement of Facts §§ D, G.1.) Applicant has never prepared any business plans, any marketing plans, or any media plans concerning the AQUAJETT mark. (*See* Statement of Facts § F.2.) In fact, Applicant has not made *any* plans as to *how* its mark might be used or *when* the mark might be put into use.

Applicant has never manufactured an oral irrigator, it has never contracted with any third parties to manufacture this product, and it has not attempted to identify any third parties who might be able to manufacture the product on its behalf. (*See* Statement of Facts § E.) Applicant has never licensed or attempted to license the AQUAJETT mark for use in the United States or anywhere else. (*See* Statement of Facts §§ D, G.3.) Applicant has never drafted any budgets for the production, marketing, or sale of its oral irrigator product, or set any wholesale or retail prices for this product. (*See* Statement of Facts §§ G.8, G.9.) Applicant has never hired any sales people to sell its product, or identified the specific retail outlets where the product might be sold. (*See* Statement of Facts §§ G.5, G.7.) In fact, 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 never prepared any labels, tags, or packaging for its products, it has never prepared or placed any advertising, marketing, or promotional materials for its products, and it has not identified any third parties who might be able to produce these materials on its behalf. (*See* Statement of Facts §§ F.3, F.4, G.6, G.7.) Applicant has never purchased any product liability insurance for its oral irrigator, and has never contacted any insurance brokers to discuss this issue. (*See* Statement of Facts § G.10.) Simply put, *nothing* has been done to bring this product to market, and *nothing* has been done to put the AQUAJETT mark into use, either before or after 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 its filing date. *Research in Motion*, 92 USPQ2d at 1930-31; *Boston Red Sox*, 88 USPQ2d at 1587; *DC Comics*, 2009 TTAB LEXIS at *12-15, 18; *Montblanc-Simplo*, 2009 TTAB LEXIS at *17-21; *L.C. Licensing*, 86 USPQ2d at 1891-92. If the Board enters judgment against Applicant on this issue, then it need not consider Section II of Opposer's Trial Brief (Likelihood of Confusion), and instead may proceed directly to Section III (Opposer's Standing).

II. REGISTRATION OF APPLICANT'S MARK SHOULD BE REFUSED UNDER SECTION 2(d)

To prevail in this opposition under section 2(d), Opposer must show by a preponderance of the evidence that it has priority in a valid mark and that Applicant's mark, when used on or in connection with the goods and services specified in application Serial Number 78/241,931, is likely to cause confusion or to cause mistake or to deceive. *See, e.g., Baroid Drilling Fluids, Inc. v. Sun Drilling Prods.*, 24 USPQ2d 1048, 1052 (TTAB 1992).

A. Opposer Has Clear Priority

Opposer has made of record 14 registrations for its AQUAFRESH marks. All of these registrations are valid and subsisting and they all have filing dates that precede the filing date of the Application for Applicant's mark (i.e. before May 25, 2006). (*See* Opposer's First Notice of Reliance.) Applicant also admits that Opposer began using its AQUAFRESH mark for toothpaste before it filed its application for AQUAJETT. (Opposer's Seventh Notice of Reliance, Exs. A&B, Req. 1; Opposer's Sixth Notice of Reliance, Ex. A, Int. 8.) Thus, there is no question that Opposer has priority in this case. *See King Candy Co. v. Eunice Kinds Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. There Is A Likelihood Of Confusion Between Opposer's AQUAFRESH And Related Marks And Applicant's AQUAJETT Mark

When applying the test for likelihood of confusion under Section 2(d), the Board must consider the factors set forth in *In re E.I. DuPont deNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973), that are relevant to the opposition and that are supported by evidence in the record. *See*

Cunningham v. Laser Golf Corp., 222 F.3d 943, 946, 55 USPQ2d 1842 (Fed. Cir. 2000); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202, 22 USPQ2d 1542 (Fed. Cir. 1992) (factors must be considered "when relevant evidence is of record"). In this case, the relevant factors include (1) the similarity of the marks; (2) the related nature of the goods; (3) the identical channels of trade and classes of consumers; and (4) the strength of Opposer's marks.

In analyzing the relevant *DuPont* factors, the Board must also apply the following principles. As the newcomer, Applicant has a duty to avoid selecting a mark that is confusingly similar to Opposer's previously registered marks. This is especially so where, as here, Opposer's marks are strong and distinctive. *See Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("A strong mark . . . casts a long shadow which competitors must avoid."). If the Board has any doubts as to whether there is a likelihood of confusion, they must be resolved in Opposer's favor. *See, e.g., In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985). Based on the *DuPont* factors and given these standards, it is clear that Applicant's AQUAJETT mark is likely to cause confusion, or to cause mistake, or to deceive.

1. The Marks are Similar

The first factor that the Board must consider under the likelihood of confusion analysis is the similarities between the Applicant's mark and the Opposer's mark, in terms of their overall appearance, sound, meaning, and commercial impression. *See, e.g., In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Similarity in any one of the elements of sound, sight or meaning may be sufficient to prove a likelihood of confusion. *See, e.g. Interstate Brands Corp. and Interstate Brands West Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (TTAB 2000) ("it is not necessary that marks be similar in all three of the elements of sight, sound and meaning to support a finding of likelihood of confusion.")

Likelihood of confusion has been found where, as here, the marks have identical prefix elements but different endings. *See, e.g., NutraSweet Co. v. K & S Foods Inc.*, 4 U.S.P.Q.2d 1964 (TTAB 1987) (NUTRA-SWEET for chemical compound used as a sweetening ingredient in the manufacture of food products and beverages and NUTRA SALT for salt with trace minerals); *Colgate-Palmolive Co. v.*

Warner-Lambert Co., 184 U.S.P.Q. 380 (TTAB 1974) (ULTRA BRITE for dentifrices and ULTRA-DENT for denture cleanser tablets); *National Service Industries Inc. v. Sherwin-Williams Co.,* 6 U.S.P.Q.2d 1655 (TTAB 1988) (ZIP and ZIP WAX for car cleaning and polishing preparations and ZIP-SHEEN for mechanical wheel compound used in polishing exterior vehicle painted surfaces in automotive refinishing industry). Moreover, when marks are used in connection with closely related goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *See Century 21 Real Estate Corp. v. Century Life of America,* 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). That is exactly the case here. Applicant has sought to register its mark for an oral care product that is likely to be offered to ordinary consumers through the same channels of trade where Opposer offers its oral care products. Therefore, any similarity between Applicant's mark and Opposer's mark would be enough to create a likelihood of confusion or mistake. *See, e.g., In re Mack,* 197 USPQ 755 (TTAB 1977).

The similarities between the marks are self-evident. Both AQUAFRESH and AQUAJETT consist of two words that have a similar appearance and nearly identical cadence. They both begin with the identical word AQUA and they both contain nearly the same number of letters. Each mark contains three syllables and begins with the same two syllable word. Both marks end with a one syllable word that contains the same vowel sound. Indeed, Applicant's mark incorporates all of the vowel sounds that appear in Opposer's AQUAFRESH mark. (*See* Applicant's Notice of Reliance, Ex. 2, noting that "fresh" and "jet" are both pronounced with an " ĕ " sound.)

The Applicant's mark and the Opposer's marks will be used on oral care products, and as discussed below, these products are likely to be sold to ordinary consumers. Some consumers may overlook the differences in these marks, since ordinary consumers retain a general, rather than a specific, impression of the trademarks that they encounter. Others may perceive these differences, but may assume that the Applicant's mark is a variation on Opposer's line of oral care products, or they may wonder if it is an extension of Opposer's AQUAFRESH product line.

2. The Goods Described in the Application are Closely Related to the Goods Described in Opposer's Registrations

Another factor that the Board must consider is the similarity of the Applicant's goods and the Opposer's goods and services. It is axiomatic that in making this comparison, it is solely the goods and services as listed in Applicant's application and Opposer's registrations that should be considered. *See Cunningham,* 222 F.3d at 948. The Board may not place any limitations on the parties' identification of goods and services unless that limitation is set forth in the identification itself. *See Squirtco v. Tomy Corp.,* 216 USPQ 937, 940 (Fed. Cir. 1983).

Applicant is seeking to register AQUAJETT for "oral irrigators." As discussed above, Opposer owns 14 registrations for AQUAFRESH and various AQUAFRESH formative marks for toothpaste, toothbrushes, and other oral care products. (*See* Opposer's First Notice of Reliance.) Thus, Opposer's registrations cover goods that are closely related to the oral irrigators described in Applicant's Application.

Opposer's oral care products and Applicant's oral irrigator would presumably be sold through the same retail outlets and would presumably be offered to the same classes of customers. Applicant admitted that oral irrigators are sold through the same retail outlets as toothpaste and toothbrushes, although it has not identified the specific outlets where its own product would be sold. Applicant also admitted that oral irrigators, toothbrushes, and toothpaste would be used for the same purpose and in the same place (e.g. the bathroom). (*See* Opposer's Fifth Notice of Reliance, Weissman Dep. at 11, 12, 15, 17, 51.) Thus, a consumer could conceivably brush his or her teeth with AQUAFRESH toothpaste on an AQUAFRESH FLEX toothbrush and then use the AQUAJETT oral irrigator product to clean his or her gums. Given the prominent position of AQUAFRESH toothpaste in the oral care market, it is inevitable that a significant percentage of the people who are exposed to Applicant's AQUAJETT oral irrigator will have used at least one of Opposer's oral care products.

3. The Parties' Goods Will Be Offered to the Same Consumers and through the Same Channels of Trade

As discussed above, Applicant's application for AQUAJETT covers oral irrigators. Applicant's identification is not restricted to any particular class of consumers, channels of trade, or nature of use. Likewise, Opposer owns unrestricted registrations for AQUAFRESH and other AQUAFRESH-formative marks for toothbrushes, toothpaste, and other oral care products. Because Applicant did not specify the customers or channels of trade for its oral irrigator, the Board must assume that Applicant's goods will be sold to all of the potential purchasers and through all of the appropriate channels of trade for those goods. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *Kangol Ltd. v. KangaRoos U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992). This broad category necessarily includes *all* the same customary purchasers and channels of trade for the oral care products listed in Opposer's registrations, because Opposer's registrations are similarly not limited to specific customers or channels of trade.

Moreover, the evidence in the record establishes that the channels of trade and classes of consumers for these products are likely to be identical. Applicant claims that it intends to market its oral irrigator to ordinary consumers who use oral care goods, including "interdental brushes." (Opposer's Fifth Notice of Reliance, Weissman Dep. at 14-15; Opposer's Sixth Notice of Reliance, Ex. C, Int. 14, 15.) Although Applicant has not identified the specific retail outlets where its oral irrigator would be sold, it admits that other oral irrigator manufacturers sell their products through pharmacies and general retail stores, such as Target. Applicant admits that these same retail outlets also carry toothpaste, toothbrushes, and other oral care products. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 11, 12, 15, 17, 51.)

4. Opposer's marks are strong and distinctive

An important factor to be considered in a likelihood of confusion analysis is the strength of the Opposer's marks. Where – as here – the opposer's mark is "strong" it is accorded a broader scope of

protection and the applicant's mark may be found confusingly similar even if the mark and the goods are not identical.

a. AQUA FRESH is inherently distinctive as applied to toothpaste and toothbrush products.

Opposer's AQUAFRESH marks do not directly describe the nature, characteristics or qualities of toothpaste and toothbrush products. They are arbitrary or suggestive. All of these marks are registered on the Principal Register in the United States Patent and Trademark Office without a claim of acquired distinctiveness. (*See* Opposer's First Notice of Reliance.) These registrations confirm the distinctive nature of Opposer's marks. 15 U.S.C. § 1057.

b. Opposer's marks are well-known.

Commercial publications that compile market quotations for the drug store industry confirm that AQUAFRESH is one of the leading toothpaste brands in the United States and that AQUAFRESH has held this position for more than 13 years. These publications also confirm that sales of AQUAFRESH toothpaste have remained relatively stable, with roughly $148 million in sales reported in 2001 and roughly $147 million in sales reported in 2008. (*See* Statement of Facts § III.)

Over the past 13 years Opposer's products have received extensive media coverage, which has contributed to the widespread public recognition of its AQUAFRESH marks. AQUAFRESH products have been mentioned on national television and radio broadcasts, and in articles published in national and regional newspapers. All of these articles use the AQUAFRESH trademarks when referring to Opposer's products, and when Opposer introduces a new toothpaste or toothbrush product under its AQUAFRESH mark or launches a new marketing campaign, the announcement is often mentioned in the press. Moreover, the interest in AQUAFRESH products is consistent from year to year, as demonstrated by the steady stream of references which were added to the NEXIS database between 1995 and 2009. (*See* Statement of Facts § III.)

c. No third party use dilutes the strength of Opposer's marks.

Applicant has made of record a handful of third-party registrations for marks containing the term "AQUA" for goods in the fields of dentistry and veterinary sciences. (*See* Applicant's Notice of Reliance, Ex. 3). However, Applicant has offered no evidence showing that any of these third party marks are in use. Moreover, most of the registrations that Applicant has submitted cover products which would be used by dental professionals or products which would be used on animals, rather than oral care products which would be used by ordinary consumers. As such, Applicant's third party registrations are immaterial and have no impact on the strength of Opposer's marks.[2]

III. 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 Research in Motion,* 92 USPQ2d at 1930; *Boston Red Sox,* 88 USPQ2d at 1586 (ownership of valid and subsisting registrations establishes standing with respect to claim for lack of *bona fide* intent or any other statutory ground for opposition).

Applicant is seeking to register AQUAJETT for "oral irrigators." Opposer has opposed based on its prior registrations for AQUAFRESH and various formatives. These registrations cover oral hygiene products, including toothpastes and toothbrushes. Opposer has submitted certified status and title copies of these registrations, which demonstrate that Opposer's registrations were issued, or the underlying applications were filed, prior to the filing date of Applicant's Application. (*See* Opposer's First Notice of Reliance.)

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[2] Applicant also submitted a third party registration for the Spanish term "Aquis." Opposer's objections to this "evidence" are set forth in Section I of its Statement of Objections.

Applicant is seeking to register AQUAJETT for an oral hygiene device that is closely related to the oral care products described in Opposer's pleaded registrations. Applicant admits that Opposer was using AQUAFRESH for toothpastes before it filed its application for AQUAJETT, and admits that oral irrigators are likely to be sold to the same classes of consumers and through the same channels of trade as the toothpaste and toothbrushes that are described in Opposer's pleaded registrations. (Opposer's Seventh Notice of Reliance, Exs. A&B, Req. 1; Opposer's Fifth Notice of Reliance, Weissman Dep. at 11-12, 14-17.) Together, this evidence confirms that Opposer has standing to oppose the Application.

CONCLUSION

Applicant has failed to demonstrate that it has a *bona fide* intent to use its mark, because there is no objective evidence to support that claim. By contrast, the relevant evidence in the record confirms that Applicant's use of the mark AQUAJETT is likely to cause confusion with Opposer's AQUAFRESH mark and related formatives. All of the relevant *DuPont* factors weigh decidedly in Opposer's favor: the goods are closely related, the customers are the same, the channels of trade are the same, and the marks are similar. Accordingly, Opposer respectfully requests that the Board sustain the opposition and deny registration to Application Serial No. 78/893,144.

Dated: December 24, 2009

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Trial Brief has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, P.O. Box 100637, Arlington, VA 22210 on December 24, 2009.

Erik Bertin

Erik Bertin

Exhibit A

Intel Corp. v. Emeny, 2007 TTAB LEXIS 101 (TTAB May 15, 2007)

LEXSEE 2007 TTAB LEXIS 101

Intel Corporation v. Steven Emeny

Opposition No. 91123312 against Serial No. 75825218

Trademark Trial and Appeal Board

2007 TTAB LEXIS 101

May 15, 2007, Decided

DISPOSITION:
[*1]

Decision: The opposition is sustained and registration to applicant is hereby refused.

COUNSEL:

Bobby A. Ghajar, Katherine M. Basile and Mike Yaghmai of Howrey LLP for Intel Corporation.

Steven Emeny, Pro se.

JUDGES: Before Hairston, Bucher and Wellington, Administrative Trademark Judges.

OPINION BY: BUCHER

OPINION:

THIS OPINION IS NOT PRECEDENT OF THE TTAB

Opinion by Bucher, Administrative Trademark Judge: Steven Emeny, a Canadian citizen, seeks registration on the Principal Register of the mark IDEAS INSIDE for services recited in the application, as amended, as follows:

> "computerized on line ordering service featuring the wholesale and retail distribution of books, music, motion pictures, multimedia products and computer software in the form of printed books, audiocassettes, videocassettes, compact disks, floppy disks, CD ROM's; clothing items, namely, anoraks; aprons; ascots, baby bibs; badminton pants; badminton shirts; bandannas; baseball shirts; baseball stockings; baseball uniforms; baseball caps; basketball uniforms; basketball singlets; basketball jerseys; basketball socks; basketball shorts; basketball pants; basketball shirts; bath wraps; bathrobes; beach [*2] coats; beach cover ups; bed jackets; belts; berets; bib ties; bibs; bikinis; blazers; blouses, body suits; booties; boots; bowling shirts; boxing trunks; brassieres; briefs; camisoles; capes; cardigans; coats; collars; costumes; coveralls; cravats; cummerbunds; diaper covers; diaper liners; dickies; dress skirts; dresses; dressing gowns, fencing uniforms; fencing jackets; football shirts; football pants; football jackets; footwear; foundation garments; fur coats; garter belts; garters; gloves; golf pants, golf shirts; golf

vests; golf jackets; golf socks; golf hats; golf shorts; golf caps; gym shirts; gym shorts; gym pants; halters, handball shirts; handball pants; hosiery, housecoats; jackets; jeans; jerseys; jodhpurs; jogging suits; judo uniforms; jumpers; jumpsuits; karate uniforms; kimonos; knickers; knit shirts; ladies' panties; leg warmers; leggings; leotards; lingerie; lounge wear robes; mantles; masquerade costumes; mittens; muffs; neckties; neck warmers; negligees; night shirts; night gowns; one-piece jumpsuits; overalls; pants; panty hose; parkas; play suits; polo shirts; polo pajamas; rain ponchos; raincoats; rain suits; rainwear; robes; rugby pants; rugby shirts; running [*3] suits; sandals; sashes; scarves; scrub pants; shawls; shells; shirts; shorts; skirts; slacks; sleep wear; slips; smocks; snow suits; snowmobile suits; soccer pants; soccer shirts; socks; sport caps; sport shirts; stockings; storm suits; storm coats; straw hats; suits; sun suits; suspenders; sweat shirts; sweatband wristlets; sweaters; sweat jackets; sweatpants; sweat shorts; sweat suits; swim pants; swim wear; T-shirts; tank tops; tennis caps; tennis pants; tennis shirts; tennis jackets; tennis shorts; thermal underwear; ties; tights; topcoats; tops; track and field shirts; track and field pants; trousers; tunics; turtlenecks; tuxedos; underwear, uniforms; vestees; vests; volleyball pants; volleyball jackets; volleyball shirts; waistcoats; warm-up tops; warm-up suits; warm-up pants; wash suits; wind protection jackets; wraparounds; wraps; wrestling uniforms; footwear, footwear accessories, namely, basketball shoes; boots, court shoes; football shoes; jogging shoes; overshoes; pumps; rain boots; running shoes; sandals; shoes; slip-ons; slippers; thongs; toe rubbers; headwear, namely, beanie caps; bonnets; caps; ear muffs; fur hats; hats; head bands; sun visors; swim caps; toques; visors" [*4] in International Class 35;

"electronic direct digital transmission of messages and data via computer terminals" in International Class 38; and

"computer services, namely, providing on line search engines for obtaining data on a global computer network" in International Class 42. n1

n1 Application Serial No. 75825218 was filed on November 5, 1999 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

In 2001, Intel Corporation opposed this application on the basis that it resulted in a likelihood of confusion and that it diluted Intel's rights in INTEL INSIDE (*in standard character format*) and [SEE ILLUSTRATION IN ORIGINAL], and also alleged confusion with its family of marks incorporating therein the word "Inside," including INTEL INSIDE, THE COMPUTER INSIDE and THE JOURNEY INSIDE.

After taking discovery, opposer amended its original notice of opposition to assert that applicant lacked a *bona fide* intention to use the mark in commerce at [*5] the time he filed this application. Shortly before the due date for final briefs, opposer sought to delete the claims of likelihood of confusion and dilution. In its decision of September 25, 2006, the Board dismissed the notice of opposition with prejudice as to the claims of likelihood of confusion and dilution. Accordingly, the sole remaining issue before the Board in this opposition proceeding is whether opposer has demonstrated that applicant lacked a bona fide intention to use the mark **IDEAS INSIDE** as required by *Section 1(b)* of the Lanham Act.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. In support of its case, opposer made of record, via its Notice of Reliance filed November 29, 2002, *inter alia*, the Affidavit of Leslie Skinner, dated November 29, 2002; applicant's deposition transcript and attachments; and applicant's responses to

opposer's Interrogatories and opposer's Requests for Admissions.

Factual Findings

Opposer

Intel is the leading developer and manufacturer in the world of computer microprocessors. Its products and services span the fields of computers, [*6] communications, networking, consumer electronics and the Internet. Intel is the owner of the **INTEL INSIDE** trademark seen the world-over by many millions of consumers.

With regard to Intel's standing in this opposition proceeding, opposer has alleged and proven at trial a real commercial interest, as well as a reasonable basis for the belief that opposer would be damaged by the registration of applicant's **IDEAS INSIDE** mark. *Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).* Intel has presented evidence of its ownership and validity of its pleaded registration for the mark **INTEL INSIDE**, and that it has spent millions of dollars advertising and promoting these marks. Accordingly, opposer's earlier allegation of likelihood of confusion is accepted as a proper allegation of opposer's standing with respect to the pleaded ground that applicant lacked a *bona fide* intention to use his mark at the time he filed this application. n2

n2 See *Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)*; *Metromedia Steakhouses, Inc. v. Pondco II Inc., 28 USPQ2d 1205, 1209 (TTAB 1993)*; *Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 1326, 217 USPQ 641, 648 (Fed. Cir. 1983)*; *Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1657 (TTAB 2002)*; *The Nestle Company Inc. v. Nash-Finch Co., 4 USPQ2d 1085, 1087 (TTAB 1987)*; and *Liberty Trouser Co. v. Liberty & Co., 222 USPQ 357, 358 (TTAB 1983)* (allegation of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

[*7]

Applicant

Steven Emeny, a resident of Toronto, Canada, alleges that for the past decade he has been pursuing a home business, Baced Communications. In addition to the instant applicant, Mr. Emeny filed eight other trademark applications with the United States Patent and Trademark Office during a three-year period (1997 - 2000) surrounding this filing:

Serial No.	Mark	Comments
75885374	INTERNET SURF SUIT	225 items of clothing, listed alphabetically
75885342	MULTIMEDIA POCKET	same 225 items of clothing, listed alphabetically
75825226	CYBERSPACE ESSENTIALS	on-line wholesale and retail store services featuring computers, software, books, etc.
75815571	BYTE SIZE CLOTHING	24 items of children's clothing
75415374	WHEN YOU'RE GOING PLACES!	225 items of clothing, listed alphabetically; and promoting the goods and services of others
75415363	[SEE ILLUSTRATION IN ORIGINAL]	182 items listed in Int. Cl. 25, including duplicate items and products not in Int. Cl. 25; as well as a broad array of online services
75263386	ROOKIESAURUS	30 disparate items in Int. Cl. 9; 225 items of clothing, listed alphabetically; and promoting the goods and services of others

75263382	INTERNET SURFWEAR	225 items of clothing, listed alphabetically; and promoting the goods and services of others

[*8]

As noted by opposer, all eight of these other applications have now gone abandoned.

Preliminary matters

Before analyzing the merits of this case, we turn to applicant's contention that Intel has embraced a new "brand architecture" as part of a recent "makeover," and no longer uses the **INTEL INSIDE** mark on its microprocessors.

We cannot entertain a defense in which applicant attacks the validity of opposer's pleaded registrations where applicant has failed to file in a timely manner a counterclaim or a separate petition to cancel those registrations. n3 Applicant has not done so, and hence, we have given no further consideration to applicant's contention in this regard.

n3 *See 37 CFR §§ 2.106(b)* and *2.114(b)*; *Food Specialty Co. v. Standard Products Co., 406 F.2d 1397, 56 C.C.P.A. 1005, 161 USPQ 46, 46 (CCPA 1969)*; *Gillette Co. v. "42" Products Ltd., Inc., 396 F.2d 1001, 55 C.C.P.A. 1347, 158 USPQ 101, 104 (CCPA 1968)* [allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration]; and TBMP § 311.02(b) (2d ed. rev. 2004).

[*9]

Applicant's bona fide intent to use this mark

We turn then to the sole remaining issue of whether applicant lacks the required *bona fide* intention to use his mark on or in connection with the services recited in his application. Opposer argues in its initial brief that:

> ... [T]he evidence in this case unequivocally shows that Applicant's behavior - concurrently filing for multiple ITU-based applications without ever developing or using them; filing unrealistically broad identification of goods and/or services; abandoning all but one of his U.S. trademark applications after requesting multiple extensions of time; and lacking any objective proof of his *bona fide* intent to use the IDEAS INSIDE mark -- is exactly what the legislature intended to prevent when it required that ITU applicants attest to a *bona fide* intent to use marks. Given the complete absence of evidence to corroborate Applicant's declaration that he possessed a *bona fide* intent to use the IDEAS INSIDE mark at the time of its filing, the Board should sustain Intel's opposition and refuse registration of Applicant's IDEAS INSIDE mark.

Opposer's burden

In order to prevail [*10] on this allegation, opposer has the burden of proof of establishing, by a preponderance of the evidence, its claim of a lack by applicant of the requisite *bona fide* intention to use its mark on or in connection with the services recited in the involved application. We look at the evidence relied upon by opposer and then determine whether or not opposer has made a persuasive argument on behalf of its position herein. If we determine that 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. While the burden to produce evidence shifts, the burden of persuasion by a preponderance of the evidence remains with the party asserting a lack of a *bona fide* intention to use.

The Trademark Law Revision Act: *bona fide* intent to use

Opposer is correct in noting that *Section 1(b)* of the Trademark Act requires that an applicant filing an intent-to-use (ITU) application verify that it has a "*bona fide* intention" to use the mark in commerce. *15 U.S.C. § 1051(b)(1)*. If [*11] an applicant lacks a *bona fide* intent to use an ITU-based mark in commerce at the time of its filing, the application is invalid. n4 While it is practically impossible for an Trademark Examining Attorney to explore this in the *ex parte* context, an alleged trademark owner's *bona fide* intentions can be fully tested in the context of an *inter partes* proceeding.

n4 *See* TBMP § 309.03(c)(5) (2d ed. rev. 2004) [defendant's lack of *a bona* fide intent to use a mark in commerce is an appropriate ground for an opposition or cancellation].

Although the term "*bona fide*" is not defined within the Act itself, the legislative history of the Trademark Law Revision Act of 1988 ("TLRA") reveals that Congress intended the test of "*bona fide*" intent to be shown by "objective" n5 evidence of "circumstances" showing "good faith." Building on the recommendations of the Trademark Review Commission, n6 Congress chose this new statutory language very carefully:

> Despite its numerous virtues, [*12] a registration system based on intent also carries some potential for abuse. A single business or individual might, for instance, attempt to monopolize a vast number of potential marks on the basis of a mere statement of intent to use the marks in the future. To minimize such risks, S.1883 requires the specified intent to be *bona fide*. This *bona fide* requirement focuses on an *objective good-faith test* to establish that the intent is genuine.

Senate Judiciary Committee Report on S.1883 ("Senate Report"), S. Rep. No. 100-515, p. 6 (Sept. 15, 1988).

n5 The evidence is "objective" in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of the applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."

See J. Thomas McCarthy, 3 *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 19:14, at p. 19-40. (4th ed. 2004)

[*13]

n6 *See* Report of the Trademark Review Commission. *77 Trademark Rep. 375, 397 (1987)*, USTA, "The Trademark Law Rev. Act of 1988." P. 37 (1989) ("By '*bona fide*,' we mean no mere hope, but an intention that is firm ... The term '*bona fide*' should be expressly stated in the statute to make clear such intent must be genuine.").

From this history, we agree with opposer that applicant's showing should be "objective" in the sense that it is 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. n7

n7 An ITU applicant must be prepared to support his *bona fide* intention to use the mark by objective means inasmuch as "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," *Lane Ltd. v. Jackson International Trading Co., 33 USPQ2d 1351 (TTAB 1994)* [applicant's evidence of its business plan and licensing program constitutes credible, objective corroboration of application claim that it had a *bona fide* intention to use the mark in commerce on tobacco].

[*14]

Hence, where an applicant has no documentation evidencing his plans to use the mark on the goods or services claimed, such an absence of clear, objective evidence is sufficient for an opposer to prove that the applicant lacked the requisite *bona fide* intention, unless the applicant can outweigh that absence with an adequate explanation of why no such documentation exists. In *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993)*, the Board concluded that the opposer therein would be entitled to prevail on its claim that the applicant lacked the *bona fide* intention to use its mark in commerce required by *Section 1(b)* of the Act if the opposer were to plead and prove that the applicant is unable to present any evidence, documentary or otherwise, supportive of or bearing on the applicant's claimed *bona fide* intention to use the mark in commerce. In *Commodore Electronics,* the Board also dismissed the applicant's contention that defending an opposition proceeding, in itself, demonstrates applicant's *bona fide* intent - an argument also advanced by applicant herein.

The Senate Report in the legislative history of the TLRA [*15] provides an illustrative list of circumstances that may cast doubt on the *bona fide* nature of an applicant's stated intention, or even disprove it entirely. n8

n8 "Senate Judiciary Committee Report on S.1883," *S. Rep. No. 100-515*, pp. 23-24 (Sept. 15. 1988).

Accordingly, we find that a number of these circumstances apply in the instant case, supporting the conclusion that applicant lacks the requisite *bona fide* intention to use the **IDEAS INSIDE** mark in commerce.

Lists of hundreds of items

For example, opposer argues that Congress recognized that filing an ITU application for many products raises serious doubt as to the applicant's intention to use the mark for each of the products.

In the instant application, as in most of applicant's other now-abandoned ITU applications, the recitation of services reveals an unreasonably broad listing of goods and services, *supra*, pp. 1 - 3. In this case, applicant's recitation of services covers the online sale of nearly every type of article [*16] of clothing - more than two-hundred items of apparel, listed alphabetically (and drawn from the Office's listing of acceptable identifications of goods in International Class 25) from "anoraks, aprons, ascots" to "lingerie" and "wrestling uniforms"; book distribution services; search engine services; and digital transmission services.

Yet in spite of the breadth of applicant's recitation of services, there is no evidence of record that applicant has advanced any business plans. Nor would we be able to discern from this record that he has initiated a single contact, in the United States or in his home country of Canada, with any of the companies with whom he likely would have to partner in order to offer the services covered in his trademark application (e.g., apparel makers, publishers, and Internet service providers, etc.).

In fact, the record shows that applicant's strategy may well fit the type of potential abuses that Congress anticipated with concern almost twenty years ago. On cross-examination, applicant conceded that he wanted to "make sure that

nobody else [can] take advantage of those marks. [Therefore] there [is] a long list of wares implemented into the trade-mark [*17] applications at the time of submission." [Emeny Dep. at pp. 33, 38-39, attached as Exhibit F to Intel's Notice of Reliance].

We view this as an admission by applicant that he wanted more to preclude the acquisition of rights by others than to use the mark himself in connection with these services and goods. We find this defensive motivation to be totally inconsistent with applicant's claim in his application concerning his intentions to use the mark in commerce.

Applicant's filing history in the United States Patent and Trademark Office

The Senate report also suggests that the filing of numerous ITU trademark applications with the United States Patent and Trademark Office for a variety of marks covering the same goods and services might well cast doubt on applicant's *bona fide* intention to use any one of those marks.

As shown above, within a three-year period, applicant filed nine ITU applications for various marks for use in connection with the sale of a wide range of apparel and other services. The pattern reveals enumerations of quite similar listings of more than two-hundred items of clothing, a broad array of online store services including the sale of computers, [*18] software, books, etc., as well as applicant's promoting the goods and services of others.

Applicant eventually abandoned all of his U.S. applications, except for the **IDEAS INSIDE** application, and he has never proven use of any of the marks involved in these applications. n9

n9 Opposer argues that many of these same marks were the subject of approximately twenty applications in applicant's home country of Canada that have similarly failed to mature into registrations, while applicant counters that at least three have matured into registrations in the Canadian Intellectual Property Office. However, even if this latter contention were properly of record, it would not change the outcome of this proceeding in the United States Patent and Trademark Office.

Applicant has failed to rebut opposer's *prima facie* case

As seen above, opposer has satisfied its initial burden with respect to applicant's absence of a *bona fide* intention to use his mark in commerce. As seen in *Commodore Electronics, supra,* [*19] the absence of documentary support for the applicant's ITU application was sufficient to establish that the applicant lacked the requisite bona fide intent. Just as the applicant in *Commodore Electronics* could not point to any specific documents demonstrating its intent to use the mark, applicant herein has failed to produce any documents that objectively prove his *bona fide* intent to use the **IDEAS INSIDE** mark in commerce. In spite of several discovery requests that called for applicant's marketing plans, discussions, or business plans for the **IDEAS INSIDE** mark, none were divulged. [*See* applicant's response to interrogatories 7, 9, 10, 12 and 18 (Exhibit D to Intel's Notice of Reliance)]. Applicant further admitted that he has never conducted any specific planning for the use of the **IDEAS INSIDE** mark and has not promoted or sold any goods or services using this mark. [*Id.; see also* applicant's responses to opposer's second set of requests for admissions, at Responses 34 and 36]. Applicant conceded that "the term **IDEAS INSIDE** has not been developed in the United States since the filing of the []trademark...." Even after Intel moved for [*20] summary judgment on the specific issue of applicant's *bona fide* intent to use his mark in commerce, he failed to cite to any evidence or testimony in support of his *bona fide* intent to use the **IDEAS INSIDE** mark on the recited services including the sale of an extensive listing of clothing items.

Hence, the record remains void of any evidence in support of applicant's alleged *bona fide* intent. Under *Commodore Electronics*, applicant's failure to produce any objective evidence of an intent to use the **IDEAS INSIDE** mark is sufficient basis for ruling in Intel's favor on the bona fide intent issue. *See Commodore Electronics, supra at*

1508.

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

GRAPHIC:

Logo, no caption; Illustration, no caption

Exhibit B

DC Comics v. Silver, 2009 TTAB LEXIS 566 (TTAB Aug. 21, 2009)

LEXSEE 2009 TTAB LEXIS 566

DC Comics and Marvel Characters, Inc. v. Michael Craig Silver

Opposition No. 91176744

Trademark Trial and Appeal Board

2009 TTAB LEXIS 566

August 21, 2009, Decided

JUDGES: [*1]

Before Grendel, Holtzman, and Mermelstein, Administrative Trademark Judges

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

By the Board:

Michael Craig Silver ("applicant") seeks to register the mark SUPER HERO in standard character form for "after sun creams; beauty creams for body care; cosmetic products in the form of aerosols for skincare; non-medicated sun care preparations; skin moisturizer; skin toners; sun block; sun care lotions; sun screen; sun tan oil; sun-block lotions" in International Class 3. n1

n1 Application Serial No. 78823155, filed February 24, 2006, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), *15 U.S.C. Section 1051(b)*.

DC Comics ("DC") and Marvel Characters, Inc. ("Marvel") (together "opposers") oppose registration of applicant's mark. In a second amended notice of opposition, opposers set forth the following grounds of opposition: 1) likelihood of confusion with their previously registered [*2] SUPER HERO and SUPER HEROES marks under Trademark Act Section 2(d), *15 U.S.C. Section 1052(d)*; 2) dilution of their allegedly famous SUPER HERO and SUPER HEROES marks under Trademark Act Section 43(c), *15 U.S.C. Section 1125(c)*; and 3) lack of a bona fide intent to use the involved mark in commerce under Trademark Act Section 1(b), *15 U.S.C. Section 1051(b)*, when applicant filed the involved intent to use application. Applicant, in his answer, denied the salient allegations of the second amended petition to cancel.

This case now comes up for consideration of opposers' motion (filed May 29, 2009) for summary judgment on their pleaded claim that applicant lacked a bona fide intent to use his involved mark in commerce when he filed the involved intent-to-use application. The motion has been fully briefed. n2

n2 Opposers' motion is the second motion for summary judgment that they have filed in this proceeding. On October 25, 2007, opposers filed a motion for summary judgment on their pleaded claim under Trademark Act Section 2(d), *15 U.S.C. Section 1052(d)*. The Board denied opposers' first motion for summary judgment in an April 21, 2008 order.

[*3]

In support of their motion for summary judgment, opposers have submitted copies of applicant's written discovery responses and a copy of opposers' discovery deposition of applicant. Opposers maintain that applicant has failed to produce any documents or corroborating evidence in support of his claimed intent to use the mark and that applicant has done "*absolutely nothing*" toward bringing the identified goods to market. Opposers' brief at 13 (emphasis in original). Accordingly, opposers contend that there is no genuine issue of material fact that applicant had no bona fide intent to use the SUPER HERO mark on the identified goods when he filed his application and that entry of summary judgment is warranted under the circumstances.

Applicant has responded with notes from his personal records. Applicant maintains that he is a professional entrepreneur who owns "several business entities with complementing licenses for each one;" that his educational background, including completion of all college pre-medical course requirements and various graduate business courses, "establishes [his] ability and willingness ... to execute and follow through with an intent to use application for [*4] a business endeavor." Applicant's brief at 3-4. Applicant further contends that, because he is licensed by the American Petroleum Institute to sell "automobile, heavy duty, and industrial lubricant products" under his TEXASTEA mark, he has established that he "can achieve licenses from a governing body of an industry, such as the FDA, without having had direct prior business experience in an industry, such as the sunscreen industry." Applicant's brief at 6-7. Applicant further contends that his bona fide intent to use the SUPER HERO mark in commerce is evidenced by the "Maiden Waves formula" description previously submitted [as an exhibit to his brief in opposition to opposers' motion for leave to file their first amended notice of opposition] and the newly submitted checklist and notes concerning the [SUPER HERO] mark and that his involved mark "can be recognized as a viable brand name product that could be sold" through his Waveworks/Maiden Waves apparel company. Applicant's brief at 8. Applicant further contends that his bona fide intent to use the SUPER HERO mark in connection with the identified goods is further established by his "creation of a Maiden Waves sunscreen formula [*5] that can be used to help create a formula for the [SUPER HERO] product." Applicant's brief at 9. Accordingly, applicant asks that the Board deny opposers' motion for summary judgment and instead enter summary judgment in his favor.

In reply, opposers contend that arguments in applicant's brief are not supported by documentary evidence and contradict his earlier discovery responses; that the documents that applicant includes as exhibits with his brief in opposition to opposers' motion were not previously produced in discovery; and that these documents and the Maiden Waves formula description that applicant previously submitted as an exhibit to his brief in opposition to opposers' motion for leave to file their first amended notice of opposition fail to establish a bona fide intent to use the involved mark on the identified goods.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Fed. R. Civ. P. 56(c)*. The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial [*6] and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56(c)*; *Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1987)*.

In a motion for summary judgment, the moving party, in this case opposer, has the burden of establishing the absence of any genuine issues of material fact for trial and that it is entitled to judgment as a matter of law. In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, in

this case applicant, 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 *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).*

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, [*7] the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).*

At the outset, we note that applicant has not contended that opposers do not have standing to maintain this proceeding. In any event, we find that there is no genuine issue of material fact that each of the opposers has standing to maintain this proceeding. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987)*; *Stuart Spector Designs Ltd. v. Fender* [*8] *Musical Instruments Corp., USPQ2d , 2009 TTAB LEXIS 132 (TTAB, Opposition No. 91161403, March 25, 2009)*; TBMP Section 303.06 (2d ed. rev. 2004).

Regarding DC's standing, opposers submitted a declaration of DC's executive director for brand management, Marilyn Drucker, who avers that, "beginning in 1966, [opposers and their predecessors-in-interest] have exploited their SUPER HERO and SUPER HEROES trademarks in connection with comic books, toys, and masquerade costumes;" that "a substantial part of [DC's] business originates from licensing its marks ... for use in connection with a variety of goods and services, including ... cosmetics, personal care and health products such as bubble baths, toothbrushes, foam soaps, facial tissues and bandages;" "that [DC's] merchandise licensing agreements bundle groups of comic book characters and generally include licenses to use the SUPER HERO and SUPER HEROES marks." n3 Drucker declaration at paragraphs 5 and 7-8.

n3 In the second amended notice of opposition, opposers allege that DC filed application Serial No. 78946654 for the mark MY FIRST SUPER HERO for goods in International Class 3 including "sunscreen preparation" and that the examining attorney cited applicant's involved application against DC's application. However, opposers did not submit any evidence on this point. A copy of the Office Action in which the examining attorney cited applicant's involved application would have, by itself, been sufficient to establish DC's standing to maintain this proceeding. See *Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990).*

[*9]

Regarding Marvel's standing, opposers have submitted a declaration of Carol G. Pinkus, the director of intellectual property for Marvel Entertainment, Inc., Marvel's parent company and status and title copies of Marvel's Registration Nos. 825835 n4 and 3022405 n5 for the mark SUPER HERO and Registration Nos. 1140452 n6 and 1179067 n7 for the mark SUPER HEROES. The Pinkus declaration is highly similar to the Drucker declaration, except that Ms. Pinkus avers that "a substantial part of [Marvel's] business originates from licensing its marks ... for use in connection with a variety of goods and services, including ... cosmetics and toiletries." Pinkus declaration at paragraph 5. In view of evidence opposers' activities in connection with the SUPER HERO and SUPER HEROES marks, we find that DC and Marvel have each established that they have a real interest in the outcome of this proceeding; that is, each opposer has a direct and personal stake in the outcome of this opposition. See *Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023*

(Fed. Cir. 1999); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp., supra.*

n4 Issued March 14, 1967 for "masquerade costumes" in International Class 25; renewed twice.
[*10]

n5 Issued December 6, 2005 for "ice cream" in International Class 30.
n6 Issued October 14, 1980 for "toy figures" in International Class 28; renewed.
n7 Issued November 24, 1981 for publications, particularly comic books and magazines and stories in illustrated form; notebooks and stamp albums" in International Class 16; renewed.

We turn next to whether opposers have established that there is no genuine issue of material fact for trial on their claim that applicant lacked a bona fide intent to use the mark in commerce when he filed his involved application. Trademark Act Section 1(b), *15 U.S.C. Section 1051(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. An applicant's bona fide intent 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) and must reflect an intention to use the mark "'in the ordinary course of [*11] trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993)* (quoting Trademark Act Section 45, *15 U.S.C. Section 1127*, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988).

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)*. Nonetheless, the absence of any documentary evidence on the part of an applicant regarding its bona fide intent to use a mark in commerce constitutes objective proof sufficient to prove that applicant lacks a bona fide intention to use its mark in commerce. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d at 1507*. Indeed, the Board has held, that where there is no evidence of an applicant's bona fide intent to use the mark at issue on the claimed goods or services, entry of summary judgment on a claim that the applicant had no bona fide intent to use the mark in commerce when he filed his involved [*12] application may be warranted. See *Honda Motor Co. v. Winkelmann, 90 USPQ2d 1660 (TTAB 2009)*.

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 circumstances, as revealed by the evidence of record." See *Lane Ltd. v. Jackson International Trading Co., 33 USPQ2d 1351, 1355 (TTAB 1994)*.

In this case, opposers have proffered applicant's statements made during discovery, which opposers assert demonstrate that applicant has no current business plans, ongoing discussions, promotional activities, or anything else to corroborate his claim of a bona fide intent to use the mark in commerce in the United States. Specifically, opposers point to applicant's supplemental responses to opposers' interrogatories, in which applicant conceded that he has not taken any steps toward manufacturing, distributing, selling, or promoting any products or services under the SUPER HERO trademark [*13] and that he does not know the retail or wholesale prices that he plans to charge for the identified goods. Applicant's supplemental responses to interrogatory nos. 12 and 27. In addition, opposers have proffered applicant's statements that he has conducted no market studies or surveys concerning his involved mark. See applicant's supplemental response to interrogatory no. 19; Silver deposition at 105.

Further, opposers have proffered applicant's statements from his February 23, 2009, discovery deposition. In that deposition, applicant states, among other things that, when he filed the application, he had not formed a business that

was geared toward manufacturing, marketing and selling the identified goods; that applicant has no experience in manufacturing or marketing any of the identified goods; that applicant was not aware of any Food and Drug Administration regulations regarding skin care and sunscreen products; that applicant has no specific educational training to equip him with the ability to develop the identified goods; and that that has engaged neither a chemical engineer nor a marketing firm since filing his application on February 24, 2006. See Silver deposition at 40, [*14] 43, 54-57, 63-64, 85, 105, 112-13, 118, and 136-40.

As for document requests, opposers note requests nos. 16 (representative samples of advertisements and promotional materials in which the mark has appeared), 17 (copies of advertising scripts), 18 (documents sufficient to show actual or planned promotional expenditures under the mark), 19 (documents concerning trade channels), 20 (documents concerning trade shows, conventions, seminars and other events open to the public at which goods sold or offered for sale under the SUPER HERO mark were or are planned to be displayed), 21 (documents concerning investigations, market studies and surveys concerning any matter related to this proceeding), 22 (documents concerning "any investigation of the marketplace with respect to applicant's involved mark or opposers' pleaded marks) and 23 (documents concerning surveys, studies and opinion polls with respect to applicant's involved mark or opposers' pleaded marks), to which applicant produced no responsive documents. In addition, opposers proffer applicant's response to document request no. 12, in which applicant states that he "has no documents concerning any effort to exploit or commercialize [*15] any product under SUPER HERO."

Taken together, the evidence that opposers submitted in support of their motion for summary judgment is sufficient to indicate that applicant had taken no actual steps toward preparing to use the SUPER HERO mark on the identified goods and that applicant merely had a subjective intent to use the SUPER HERO mark on the identified goods when he filed his involved application. Based on the foregoing, we find that opposers have met their initial burden of establishing that there is no genuine issue of material fact remaining for trial on their claim that applicant did not have a bona fide intent to use the SUPER HERO mark in commerce when he filed his involved application.

Federal Rule of Civil Procedure 56 requires a nonmoving party to go beyond the pleadings and to "set out specific facts showing a genuine issue for trial." *Fed. R. Civ. P. 56(e)(2); Celotex Corp. v. Catrett, supra at 324.* To raise a genuine issue of material fact, applicant must rely on specific facts that establish that he possessed an ability and willingness to use the SUPER HERO mark as a mark for his identified goods when he filed the application.

Applicant's arguments [*16] in his brief do not provide specific facts in support of his position. See, e.g., *Hornblower & Weeks Inc. v. Hornblower & Weeks, Inc., 60 USPQ2d 1733, 1736 (TTAB 2001).* Further, applicant's evidence consists of four documents: 1) applicant's undated typed checklist of activities that he claims to undertake when he starts a business in which the wording "SuperH." is handwritten in the upper left-hand corner; n8 2) an undated handwritten note which consists solely of the wording "Maiden Waves Sunscreen formula" and an arrow pointing to the wording "SuperHero Name"; 3) an undated description of a formula for "Maiden Waves Sunscreen"; and 4) a photograph of a drum of synthetic motor oil that includes the TEXASTEA mark. Applicant did not submit any declaration or affidavit as an exhibit to his brief. Although applicant did not produce a copy of the checklist, the handwritten note, or the photograph of the drum showing the TEXASTEA mark prior to filing his brief in opposition to opposer's motion for summary judgment, we have, in an abundance of caution, considered those documents in our decision.

n8 The checklist otherwise states as follows:

[Illegible wording] DBA
Publish DBA
Business License
Separate Tel. #
Industry Licenses

Business Cards
Logos
Co. Office inspection

[*17]

Regarding the undated checklist, applicant admits in his brief that he only recently recognized the checklist as being "substantial enough to serve as a credible business plan and checklist for the Super Hero product." Applicant's brief at 6. As such, the checklist does not corroborate his assertion of an intent to use at the time the application was filed. Here, the checklist, which is undated and unsupported by a declaration or affidavit, is, at best, a recitation of general tasks to be performed in setting up a business, none of which relate specifically to the SUPER HERO mark or the goods at issue. Further, applicant does not indicate that he actually performed any of the tasks listed thereon to prepare for using the SUPER HERO mark on the identified goods. Regarding the handwritten note, nothing in the record indicates that the handwritten note was prepared contemporaneously with the filing of the application. In addition, regarding applicant's alleged possible use of the SUPER HERO mark to market sunscreen prepared under the Maiden Waves formula, applicant states in his discovery deposition that such formula was never actually prepared. n9 See Silver deposition at 73-74.

n9 Any alleged use of the TEXASTEA mark on petroleum products has no bearing upon applicant's intent to use SUPER HERO, a completely different mark, on "after sun creams; beauty creams for body care; cosmetic products in the form of aerosols for skincare; non-medicated sun care preparations; skin moisturizer; skin toners; sun block; sun care lotions; sun screen; sun tan oil; [and] sun-block lotions."

[*18]

Thus, applicant's evidence indicates, at most, that applicant has considered use of the involved mark for the identified goods and has confidence in his ability to bring such goods to market at some point in the future; however, these documents do not rebut opposers' showing that there is no genuine issue of material fact that applicant did not possess the requisite intent to use the mark on the identified goods when he filed his application. n10 See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, supra*; see also *L.C. Licensing Inc. v. Berman, 86 USPQ2d 1883, 1887 (TTAB 2008)*, and *Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581, 1587 (TTAB 2008)* (no bona fide intent found because there was no relevant business established). Moreover, applicant's arguments in his brief regarding his ability to bring the goods to market are directly contradicted by statements that applicant made in his discovery deposition that he had no experience or training in the relevant field. Therefore, after having considered the evidence and arguments submitted by the parties in connection with the motion, and viewing that evidence in the light [*19] most favorable to applicant, we find there is no evidence of applicant's bona fide intent to use the mark on the identified goods when he filed his application.

n10 Although applicant indicated in his discovery deposition that he does not intend to move forward with preparing to use his mark until after the resolution of this proceeding, opposers' claim relates to applicant's intent when he filed the involved the application on February 24, 2006, and not his intent during the pendency of this proceeding.

Because applicant has not established that there is any genuine issue of material fact as to his a bona fide intent to use the mark on the identified goods, opposers' motion for summary judgment is granted. The opposition is sustained,

and registration is refused to applicant.

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

Exhibit C

Montblanc-Simplo GmbH v. United Brands International, Inc.,
2009 TTAB LEXIS 633 (TTAB Sept. 29, 2009)

LEXSEE 2009 TTAB LEXIS 633

Montblanc-Simplo GmbH v. United Brands International, Inc.

Opposition No. 91185637

Trademark Trial and Appeal Board

2009 TTAB LEXIS 633

September 29, 2009, Decided

JUDGES: [*1]

Before Bucher, Kuhlke, and Taylor, Administrative Trademark Judges

OPINION:

THIS DISPOSITION IS NOT A PRECEDENT OF THE TTAB

By the Board:

United Brands International, Inc. (hereafter "applicant") seeks to register the mark MONT BLANC for one hundred thirty-two goods classified in International Class 9, encompassing a broad range of items, including blank discs for computers, micro computers, personal computers, carrying cases for cell phones, and video phones. n1

n1 Application Serial No. 77306457, filed October 17, 2007, based on applicant's alleged *bona fide* intent to use the mark in commerce. The application includes the following translation of the mark: "The foreign wording in the mark translates into English as white mountain."

Montblanc-Simplo GmbH (hereafter "opposer") opposes registration of the applied-for mark on the grounds of likelihood of confusion and dilution. In support of its claims, opposer (i) alleges priority based on common law rights accruing from use of the mark [*2] MONTBLANC in connection with writing instruments since at least 1913; (ii) pleads ownership of eight trademark registrations n2 for the marks MONTBLANC and MONTBLANC and design for, respectively, various goods and services including, *inter alia*, fountain pens, ball point cartridges, sunglasses, jewelry, luggage, toiletries, clothing accessories, stationery, design and retail services for luxury items, business consulting and management, and education and training services in the fields of arts, education, literacy, musicianship and related activities; and (iii) alleges that the mark MONTBLANC is both famous and distinctive and has been so since prior to the filing date of the involved application.

n2 Opposer's pleaded registrations for the marks MONTBLANC and MONTBLANC and design are: Reg. No. 777208, issued September 1, 1964; Reg. No. 1825001, issued March 8, 1994; Reg. No. 1884842, issued March 21, 1995; Reg. No. 2202465 issued November 10, 1998; Reg. No. 2415189, issued December 26, 2000; Reg. No. 2820561, issued March 9, 2004; Reg. No. 2515092, issued December 4, 2001; and Reg. No. 3021081, issued November 29, 2005.

[*3]

In its answer, applicant denies the salient allegations set forth in the notice of opposition.

This case now comes up on opposer's fully-briefed combined motion (filed on May 21, 2009) for leave to amend the notice of opposition to add an additional ground for opposition, *viz.* that applicant lacked a *bona fide* intent to use the mark MONT BLANC in commerce for the described goods at the time the application was filed, and for summary judgment on the newly-asserted ground. n3

n3 Opposer also requests that this proceeding be suspended and that testimony periods be extended, if necessary. This proceeding was suspended on May 28, 2009; therefore, the motion to suspend is moot. In view of our decision regarding the subject motion for summary judgment, the motion for an extension to the testimony periods is also moot. Opposer's motion (filed April 13, 2009) to extend the discovery period and remaining dates in the trial schedule is granted as conceded. See Trademark Rule 2.127(a), *37 C.F.R. § 2.127(a)*.

[*4]

Motion to Amend Notice of Opposition

Opposer seeks to amend the notice of opposition to include a claim that applicant did not have a *bona fide* intent to use the MONT BLANC mark in commerce in connection with the recited goods as of the filing date of the application. The new, additional paragraph in the proposed pleading reads as follows:

> 10. As for a separate and additional ground, Applicant lacked a bona fide intention to use Applicant's mark in commerce for the goods specified in the Application at the time of filing as shown by the fact that he [*sic*] has no documents that evidence such intent either at or around the time of filing the Application or to date.

In support of its motion, opposer has provided a proposed amended notice of opposition and the declaration of counsel for opposer, Shadaia M. Gooden of Kalow & Springut LLP, to support opposer's submission of its exhibits, which include, *inter alia*, a copy of applicant's responses (including documents produced) to opposer's first request for the production of documents and things, and a copy of the transcript of the discovery deposition of applicant's CEO and President, Seirous Ghalati, [*5] which occurred on May 1, 2009.

Opposer argues that the Board should grant its motion for leave to amend because opposer learned the information to support the new claim during recent discovery and because the proposed amendment will not prejudice applicant inasmuch as no new discovery is required. Opposer specifically contends that "all relevant information to support Applicant's intent to use the mark rests solely in the possession of Applicant" (motion, p. 4).

In opposition, applicant essentially argues the merits of the claim, *viz.* that it has had and continues to have an uninterrupted *bona fide* intent to use the MONT BLANC mark in commerce, but that opposer's opposition has interfered with applicant's business plans and that it has been unwilling to bring products to market until this proceeding

is resolved (response, p. 2). Applicant also contends that opposer's motion "provides no basis for why Opposer's request should be granted and would unfairly prejudice Applicant" (response, p. 5).

The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would be prejudicial to the rights of [*6] the adverse party or parties, would violate settled law, or would serve no useful purpose. *Fed. R. Civ. P. 15(a). See, e.g., Polaris Industries v. DC Comics, 59 USPQ2d 1798 (TTAB 2001)*; *Boral Ltd. v. FMC Corp., 59 USPQ2d 1701 (TTAB 2000)*; and *Institut National des Appellations d'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2d (BNA) 1875, 1896 (TTAB 1998)*; TBMP § 507.02 (2d ed. rev. 2004). This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993)* (allowing opposer to add the claim that applicant did not have a bona fide intention to use the mark in commerce on the specified goods and services when it filed several applications); and *Marmark, Ltd. v. Nutrexpa, S.A., 12 USPQ2d 1843 (TTAB 1989)*.

We find that opposer's motion for leave to amend to add the additional claim was timely inasmuch as the proposed new claim is based primarily on information discovered during the deposition of applicant's representative on May 1, 2009 and opposer's motion to amend was filed [*7] less than three weeks later. As to whether applicant will be prejudiced by the amendment, applicant does not indicate how it will be prejudiced; it only asserts that it will be prejudiced. Inasmuch as the motion herein was filed prior to the close of discovery and we have granted as conceded opposer's motion to extend the close of discovery, we find that allowance of the proposed amendment would not be prejudicial to applicant.

As to whether opposer's proposed claim is sufficient, opposer need only allege in its amended pleading a further statutory ground for opposition to the application. We find that the allegation set forth in paragraph 10 of the amended notice of opposition constitutes adequate notice pleading of a claim that applicant had no *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b), *15 U.S.C. Section 1051(b)*, on the filing date of the application. *See, e.g., Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536 (TTAB 2007)*; and *Commodore Electronics Ltd. V. CMB Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993)*. Finally, entry of the new claim would not violate settled law. *See Id.* [*8]

In view of the foregoing, opposer's motion for leave to amend its pleading is granted. Accordingly, opposer's Amended Notice of Opposition filed on May 21, 2009 (as an exhibit to the subject combined motion) is considered opposer's operative pleading in this proceeding.

Motion for Summary Judgment

Opposer has moved for summary judgment on the newly-asserted ground that applicant had no *bona fide* intent to use the mark in commerce under Trademark Act *Section 1(b)* on the filing date of the involved application.

In support of its motion, opposer has submitted exhibits comprising a copy of opposer's first request for production of documents and things, a copy of applicant's responses thereto, a copy of the deposition transcript of Mr. Ghalati, and the declaration of Ms. Gooden, which states that the attached exhibits are true and correct copies of the documents referenced therein.

Opposer essentially argues the merits of its claim that applicant had no *bona fide* intent to use the mark MONT BLANC in commerce on the filing date of the involved application. Specifically, opposer argues that applicant has produced no documents during the course of discovery demonstrating [*9] any preparation for using the mark in commerce (motion, pp. 7-9); that applicant lacks experience with the various "high-tech" computer-related and technical goods described in the involved application (motion, p. 9); and that applicant has filed multiple applications for famous marks which share many of the same goods (motion, pp. 9-10). Opposer asserts that despite its written requests for documents such as business and marketing plans, documents "referring ... to Applicant's business,"

documents with market projections of applicant's future sales of applicant's goods with the mark MONT BLANC, correspondence with advertising agencies or public relations firms regarding the promotion of applicant's products bearing the mark MONT BLANC, exemplars for advertising or packaging materials created by or for applicant for use with the mark MONT BLANC, and the like, applicant has not provided any such documents or materials. Further, opposer points out that opposer's representative, Mr. Seirous Ghalati, testified during his deposition that applicant's only preparation to date to use the MONT BLANC mark in commerce was to create mock-up web pages for a website, but that applicant had not yet [*10] even secured a web address and that such mock-up web pages had been destroyed and proof thereof was not available (Gooden declaration, Exh. D; motion, p. 8). Opposer mentions that Mr. Ghalati also testified that he has no experience working with the goods identified in the involved application (*Id.* at p. 9). We also note opposer's Exhibit E, which is comprised of copies of applicant's applications for other marks previously filed by applicant for largely the same goods classified in International Class 9 that are described in the involved application. n4

n4 Opposer's Exhibit E is comprised of copies of the applications for the marks BOSS (application Serial No. 77303107); CATERPILLAR (application Serial No. 77383896); DIESEL (application Serial No. 77303519); and PUMA (application Serial No. 77303544).

In response to the motion, applicant contends that its *bona fide* intent to use the mark is a material fact in dispute (response, p. 3); yet, applicant also argues the merits of opposer's claim. Applicant [*11] specifically asserts, *inter alia*, that opposer's motion "is based solely on the unsupported allegation that Applicant did not have the *bona fide* intent to use the mark MONT BLANC in commerce at the time the application was filed" (response, p. 1); that applicant had at the time of filing the involved application, "which intent continues uninterrupted," a *bona fide* intent to use the mark MONT BLANC in connection with the "electronics based items" identified in the involved application (response, p. 1); that applicant has been unwilling to bring products to market pending resolution of these proceedings (response, p. 2); that applicant continues to take steps, including the building of a website that contains the MONT BLANC mark; that Mr. Ghalati does have experience with marketing and manufacturing; that applicant will hire technical individuals as needed; that opposer has failed to ask applicant "why no such documentation exists" (response, p. 3; Ghalati declaration, P9); and that opposer's motion for summary judgment is filed for the purpose of delaying "Applicant's marketing plan, and stop Applicant from using the mark" (response, p. 4). In support of its opposition to [*12] the motion, applicant has submitted the declaration of Mr. Ghaliti.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See Fed. R. Civ. P. 56(c)*. The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984)*.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *Fed. R. Civ. P. 56(c)*; and *Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986)*. Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve issues of material fact; it [*13] may only ascertain whether such issues are present. *See 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. 1993)*; *Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992)*.

Further, when a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine issue of material fact and the moving party is entitled to judgment, the burden shifts to the

nonmoving party to demonstrate the existence of at least one genuine issue of material facts that requires resolution at trial. The nonmoving party, however, may not rest on the mere allegations of its pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. Consequently, factual assertions, without evidentiary support, are insufficient to defend against a motion for summary judgment. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 USPQ2d 1733, 1739 (TTAB 2001)* [*14] ("applicant has produced no evidence, or raised any expectation that at trial it could produce evidence"); and *S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221, 1225 n.9 (TTAB 1987).*

In regard to opposer's claim that applicant lacks the *bona fide* intent to use the mark MONT BLANC in commerce with the identified goods, 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).* However, the Board has held 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, 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), cited in Honda Motor Co., Ltd. v. Friedrich Winkelmann, 90 USPQ2d 1660, 1662 (TTAB 2009). See also Boston Red Sox Baseball Club LP v. Sherman, 88 U.S.P.Q.2d (BNA) 1581, 1586 (TTAB 2008).* [*15] The determination of whether an applicant has a *bona fide* intention to use the mark in commerce is an objective determination based on all the circumstances as revealed by the evidence of record. *See Lane Ltd. v. Jackson International Trading Co., 33 USPQ2d 1351, 1355-1356 (TTAB 1994)* ("Applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's *bona fide* intention to use the mark in commerce").

Before we consider the merits of the motion for summary judgment, we must first consider the question of whether opposer has the proper standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999)* and *Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).* The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Industries, 213 USPQ at 189.*

We note that opposer [*16] attached to the notice of opposition a current printout of information from the TARR electronic database records of the USPTO showing the current status and title of its pleaded registration for the mark MONTBLANC (see footnote 2, supra)). *See* Trademark Rule 2.122(d)(1), *37 C.F.R. § 2.122(d)(1).* We find this evidence of opposer's long-standing registration sufficient to establish that opposer has a real interest in the outcome of this proceeding; that is, opposer has a direct and personal stake in preventing the registration of applicant's mark for the identified goods. n5 Thus, there is no genuine issue of material fact regarding opposer's standing. *See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987);* and *Lipton Industries, Inc. v. Ralston Purina Co., supra. See also L.C. Licensing Inc. v. Berman, 86 USPQ2d 1883, 1887 (TTAB 2008)* (standing established; opposition sustained on grounds of lack of a bona fide intention to use the mark in commerce and likelihood of confusion).

n5 We also note that applicant has not challenged opposer's standing to oppose the involved application.

[*17]

Turning to the merits of opposer's motion for summary judgment, based on the submissions of the parties, we find that opposer has satisfied its initial burden of showing the absence of any documentary evidence regarding applicant's *bona fide* intention to use the mark, and that applicant has failed to come forward with evidence that would adequately explain or outweigh its failure to provide such documentary evidence.

The documentary evidence submitted by opposer shows that applicant has no documents or other objective proof that it had a *bona fide* intent to use the mark MONT BLANC in commerce when the involved application was filed. We note, in particular, that only corporate formation documents n6 were produced by applicant during discovery; that during Mr. Ghalati's discovery deposition, in response to the query of opposer's counsel as to whether applicant would produce the web pages that Mr. Ghalati "tried to create for Mont Blanc," Mr. Ghalati responded "I destroyed it" (motion, Exh. D; discovery deposition of Mr. Ghalati, p. 47, lines 8-21); and that Mr. Ghalati affirmed repeatedly during his discovery deposition that he had no documents, "nothing in writing," and/or [*18] no documents responsive to opposer's numerous discovery requests. For instance, Mr. Ghalati answered some of the deposition questions of opposer's counsel as follows:

"Q: So you told us you did two things in preparation for using these trademarks; you have tried to create a website and you gathered information about the products you wanted to use the mark in connection with. Right?
A: Yes, sort of, yes.
Q: Anything else that you've done in preparation for using the Mont Blanc name ...?
A: No, not - not more than that.
Q: Nothing else?
A: No.
Q: Have you prepared any type of marketing plan?
A: I thought of something, but I have not put it in writing.
Q: Nothing in writing?
A: No."

(*Id.* at p. 50, lines 9 through 25, and p. 51, line 1).

...

"Q: Do you have any documents responsive to request No. 18 [*i.e.* evidencing or referring to market projections of applicant's future sales of any products or services under applicant's mark]?
A: No."

(*Id.* at p. 58, lines 18 through 20).

...

"Q: How about document request 20, do you have any documents responsive to that request [*i.e.* correspondence with advertising or public relations firms regarding [*19] promotion of applicant's products or services bearing the word MONT BLANC]?
A: Not yet.

(*Id.* at p. 59, lines 3 through 5)."

...
"Q: What activities have you completed since you filed this application?
A: I started, as as I said, producing the website for marketing the product, and which is not - was not successful and took me time, and also I did some search to see how can I market it with - concerning the suppliers.
Q: Nothing else?
A: Yes, nothing else."

(*Id.* at p. 62, lines 24 through 25, and p. 63, lines 1 through 5).

...

"Q: Have you created any paperwork that reflects your attempt to identify any suppliers for the goods that are identified Opposer's Exhibit 3?
A: What do you mean?
Q: Is there any documentation that reflects your efforts in that regard??
A: What sort of documentation?
Q: Any document that reflects your efforts in trying to identify suppliers of the goods?
A: As I said, I made a search to identify the product and, of course, that included the suppliers, too.
Q: Do you have any papers that show that?
A: I don't have with me.
Q: Do you have it anywhere else?
A: Maybe I should check my computer."

(*Id.* at p. 51, lines [*20] 4 through 23).

n6 Applicant has produced only a copy of its articles of incorporation, a copy of its "Statement of Information" for the State of California Secretary of State, which states that the type of business of the corporation is "import and export," a copy of applicant's "Application for Employer Identification Number" [Form SS-4], which indicates that applicant's principal line of merchandise is "communication accessories," and a copy of the minutes of applicant's first meeting of its Board of Directors.

Applicant has countered the motion and the documentary evidence produced by opposer with statements of subjective intent and unsupported statements that applicant "has taken steps and continues to take steps ... pending resolution of this proceeding" (see PP 3-5, 7, Ghalati declaration). This is not sufficient to raise a genuine issue of material fact. *See Sinskey v. Pharmacia Ophthalmics Inc., 982 F.2d 494, 25 USPQ2d 1290, 1293 (Fed. Cir. 1992)* ("A party cannot create an issue [*21] of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity"). Further, applicant has not demonstrated that it has any experience in the field of electronics manufacturing or sales, despite the listing of 132 goods in that field. *See, e.g., Honda Motor Co., 90 USPQ2d at 1664.*

Having considered the evidence and arguments submitted by the parties, and viewing that evidence in the light most favorable to applicant, we find that there is no evidence of applicant's *bona fide* intent to use the mark MONT BLANC in commerce with the goods identified in the involved application. That is, there is no genuine issue that applicant did not at the time it filed its application, nor does it now, have a *bona fide* intention to use the mark MONT BLANC.

We therefore conclude that opposer has demonstrated, as a matter of law, that it is entitled to summary judgment on the ground that applicant did not have at the time the application was filed (nor does it continue to have), the required *bona fide* intent to use the mark in commerce with the goods described in the involved application. [*22]

Accordingly, opposer's motion for summary judgment is **GRANTED** on its claim that applicant lacked a *bona fide* intent to use the mark MONT BLANC in commerce on the application filing date. Opposer is allowed until **TWENTY DAYS** from the mailing date of this order to inform the Board whether it wishes to go forward on its likelihood of confusion and dilution claims. If opposer fails to so advise the Board, or advises the Board that it does not wish to go forward with either of those claims, the opposition will be sustained as to the claim that applicant lacked a *bona fide* intent to use its mark in commerce and will be dismissed as to the *Section 2(d)* and dilution claims.

This proceeding remains otherwise SUSPENDED.