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

Proceeding	91178539
Party	Defendant Omnisource DDS, LLC
Correspondence Address	ERIK M. PELTON ERIK M. PELTON & ASSOCIATES, PLLC P. O. BOX 100637 ARLINGTON, VA 22210 UNITED STATES emp@tm4smallbiz.com
Submission	Brief on Merits for Defendant
Filer's Name	Mark L. Donahey
Filer's e-mail	uspto@tm4smallbiz.com
Signature	/markldonahey/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SmithKline Beecham Corporation
Opposer,

v.

Omnisource DDS, LLC,
Applicant.

Opposition No. 91178539

Application Serial No. 78893144

Mark:

AQUAJETT

APPLICANT'S TRIAL BRIEF

ERIK M. PELTON
ERIK M. PELTON & ASSOCIATES, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089
EMAIL: emp@tm4smallbiz.com

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Section 2(d) of the Trademark Act, 15. U.S.C. § 1052(d)

37 CFR §2.122(b)

37 CFR §2.122(e)

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Trademark Trial and Appeal Board Manual of Procedure 704.03(b)(2)

Trademark Trial and Appeal Board Manual of Procedure § 704.03(b)(1)(B)

INTRODUCTION

Applicant's AQUAJETT mark and Opposer's AQUAFRESH and AQUAFRESH-formative marks are not confusingly similar when the appropriate factors are considered, particularly given the differences between the marks and between the goods of the respective parties. Furthermore, Opposer has not met its burden to demonstrate a lack of *bona fide* intent by Applicant. Applicant has provided testimony supporting its *bona fide* intent to use the AQUAJETT mark, and any lack of additional production is justified and tempered by other facts including, but not limited to, Applicant's principal's experience in the industry as a professional, relevant patents owned by Applicant's principal, Applicant's other trademark filings, and no evidence of any bad faith. As a result, dismissal of the Opposition is appropriate.

STATEMENT OF THE ISSUES

The issues before the Trademark Trial and Appeal Board in this proceeding are:

I. Whether Application Serial No. 78893144 for use of AQUAJETT in connection with "Dental instruments, namely, oral irrigators" is likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15. U.S.C. § 1052(d), with Opposer's AQUAFRESH and AQUAFRESH-formative marks for use with toothpaste, toothbrushes, and other goods;

II. Whether Opposer claim under 15 U.S.C. § 1051(b) that Applicant did not have a *bona fide* intent to use the AQUAJETT mark in connection with the identified goods should be denied because Opposer has not met its burdens of proof and persuasion, and Applicant has produced evidence corroborating its *bona fide* intent; and

III. Whether, in the alternative, Opposer's claim that Applicant did not have a *bona fide* intent to use the AQUAJETT mark in connection with the identified goods should be denied

because Opposer's claim is necessarily an allegation of fraud that has neither been sufficiently pled nor proven by clear and convincing evidence.

DESCRIPTION OF THE RECORD

I. Opposer's Evidence

Opposer's description of its trial testimony in its Brief at ¶¶ 2-3 is accurate, notwithstanding Applicant's outstanding Motion to Strike Exhibit A to Opposer's Second, Third and Fourth Notices of Reliance. Per the Board's Order of June 10, 2009, a decision to strike this evidence as hearsay was deferred until the final hearing. *See* Docket Doc. 38. These Exhibits each contain small excerpts articles found in the NEXIS database. These are not complete copies of printed publications, nor are they complete electronic copies of printed publications, and they are contrary to TBMP § 704.08. As a result, the full context, meaning and relevance of the excerpted materials cannot be determined. The articles do not necessarily relate to Opposer; do not necessarily relate to goods or services relevant to the current proceeding; do not necessarily relate to channels of trade relevant to the current proceeding; may not be from sources of general circulation; may not be available to the general public in libraries or of general circulation among members; and may not be from sources in the United States. As a result, Applicant has moved the Board to strike them from the record, and has fully briefed the issues previously. *See* Docket Docs. 30, 32.

II. Applicant's Evidence

Applicant's trial testimony consists of the following Exhibits:

Exhibit 1:

- Final decision from *SmithKline Beecham Corporation v. Tocad Co., Ltd.*, Cancellation No. 23,622 (TTAB 1997).

Exhibit 2 from Applicant's Supplemental Notice of Reliance (June 30, 2009):

- Pages 22-24, 29-32, 36 -39, 41-42, 45-46, 51-52, and 58-59 from the February 27, 2008, Deposition Transcript of William R. Weissman, President of Applicant Omnisource DDS, LLC.
- Note that the excerpts were submitted as testimony attached to Applicant's Response to Opposer's Motion to Strike Applicant's Supplemental Notice of Reliance on August 14, 2009. Docket Doc 41.
- *See below for discussion of Opposer's Statement of Objections regarding this testimony evidence.*

Exhibit 3:

- Dictionary definitions from Dictionary.com Random House Dictionary "AQUA," "FRESH," and "JET."

Exhibit 4:

- Third Party Registrations on the U.S.P.T.O. Principal Register pursuant to TBMP § 704.03(b)(1)(B) and 37 CFR § 2.122(e), namely Registration Nos. 3139793, 3133049, 3113171, 3134655, 2983556, 2811171, 2667735, 1168165, and 1122734.
- These records are relevant because they contain information regarding the strength of Opposer's mark, likelihood of confusion, and other *DuPont* factors.

Exhibit 5:

- February 27, 2009, Board order dismissing with prejudice Opposition No. 91175031 regarding Applicant's OMNIPIK mark; USPTO TARR record for OMNIPIK (Serial No. 78811971) accessed and printed on April 8, 2009; and Notice of Publication for Serial No. 78811971.

Exhibit 6:

- Records from Applicant's other USPTO applications pursuant to TBMP 704.03(b)(2) and 37 CFR § 2.122(e).
 - OMNIFRESH (Serial No. 78797498): USPTO TARR record (Accessed and printed on 04/08/2009) and Notice of Allowance
 - OXY+ (Serial No. 78/797491): USPTO TARR record (Accessed and printed on 04/08/2009) and Notice of Allowance
 - LIFES A BLEACH (Serial No. 76678665): USPTO TARR record (Accessed and printed on 04/08/2009) and Notice of Allowance

Exhibit 7: Stricken by Board's order of June 10, 2009.

Exhibit 8 from Applicant's Supplemental Notice of Reliance (June 30, 2009):

- Opposer's First Set of Interrogatories to Applicant: Interrogatory No. 7 and Applicant's response thereto.
- Opposer's Second Set of Interrogatories: Interrogatory Nos. 1, 2, 4, 6, 7, 8, 9, and 10 and Applicant's responses thereto.
- Opposer's Requests for Admissions: Request No. 174 and Applicant's response thereto, which includes Exhibit A to the requests consisting of Applicant's annual meeting minutes from June 1, 2006, and June 14, 2007.¹
- *See below for discussion of Opposer's Statement of Objections regarding this testimony evidence.*

Exhibits 9:

- U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001.
- Each patent names Applicant's principal William R. Weissman among its inventors.

Exhibit 10:

- California Secretary of State records for Articles of Organization of Applicant Omnisource DDS, LLC.
- These records show that William Weissman is the organizer and registered agent of Applicant Omnisource DDS, LLC

Exhibits 11 -13: Stricken by Board's order dated June 10, 2009.

By rule, the record includes Applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

APPLICANT'S RESPONSE TO OPPOSER'S STATEMENT OF OBJECTIONS

Opposer has renewed its objections to the evidence of Opposer's Supplemental Notice of Reliance of June 30, 2009, namely Exhibit 8 consisting of (A) an admission and certain interrogatory responses by Applicant introduced to rebut and provide a more complete picture regarding testimony produced by Opposer, and (B) Exhibit 2 consisting of discovery deposition

¹ Applicant response to Opposer's Requests for Admissions: Request Nos. 110, 112, 114, and 116, were stricken by Board's order dated June 10, 2009.

excerpts. Docket Doc. 48. Opposer again maintains the same procedural objections which were denied in the Board's Order of October 5, 2009. Docket Doc. 45. Opposer has failed to argue or demonstrate that the properly introduced testimony is not relevant to the issues put forth by Opposer. In addition, any continuing argument by Opposer regarding this issue fails to indicate a source of prejudice; clearly Opposer has been in possession of the entire deposition transcript throughout the testimony periods.

While Opposer continues to reiterate arguments from its motions to strike regarding the deposition portions cited by Applicant, the Board has already determined that the excerpts of Dr. Weissman's deposition submitted in Applicant's Supplemental Notice of Reliance on June 30, 2009, were timely and were submitted with sufficient explanation. In the Order of October 5, 2009, the Board stated:

Applicant's "explanation of its need to rely on the identified evidence is sufficient for purposes of a notice of reliance. Further, as to providing a copy of the specific pages to be relied upon, while Opposer is correct in saying the entire deposition had been stricken, Applicant would have been allowed time to isolate the identified testimony to aid the Board in its consideration of the evidence, and having now provided it together with its response to the motion to strike, it is deemed timely." Docket Doc. 45 [emphasis added].

As a result, in accordance with the Board's order of October 5, 2009, Applicant's Testimony Exhibits 2 and 8 should not be stricken.

STATEMENT OF RELEVANT FACTS

Opposer claims ownership of numerous trademarks containing AQUAFRESH and provides evidence, primarily in the form of articles, publications, and press releases, of using

AQUAFRESH and other marks beginning with AQUAFRESH in connection with toothbrushes and toothpaste. *Table 1* shows the marks Opposer relied upon in its Brief.²

Table 1: Opposer's Marks

Opposer		
Mark	Reg. No.	Goods/Services
AQUAFRESH SENSITIVE	1,805,051	Toothpaste
AQUAFRESH FLEX	1,662,981	Toothbrushes
AQUAFRESH	1,006,821	Toothpaste
AQUAFRESH FLEX TIP MAX-ACTIVE	2,759,361	Toothbrushes
AQUAFRESH AQUABLAST	2,811,892	Toothbrush cleaners and oral appliance cleaners
AQUAFRESH XTENSIVE	3,058,216	Toothbrushes
AQUAFRESH WHITE & SHINE	3,218,965	Oral care preparations, namely dental gels, dentifrices
AQUAFRESH IMPACT	3,110,249	Toothpaste
AQUAFRESH DIRECT	2,985,548	Toothbrushes
AQUAFRESH EXTREME CLEAN	2,615,649	Toothpaste
	2,706,175 ³	Toothbrushes
	2,754,841 ³	Toothbrushes
	2,706,176 ³	Toothbrushes

² While Opposer pleaded ownership of registrations for AQUA and AQUA FLOSS, Opposer has not included them in its description of the testimony, its statement of facts, or referenced them in its main brief. Furthermore, Opposer has explicitly referenced only its “registered AQUAFRESH and related AQUAFRESH-formative marks” in its Statement of Issues without referencing any other alleged marks. Opposer’s Brief at pp. 1-2. As a result, any claim in the Opposition based on any rights in the AQUA and AQUAFLOSS marks has been waived by Opposer. *Unique Motorcars v. Carroll Hall Shelby Trust*, Oppositions No. 91150352 and 91155242 (March 4, 2009) [not precedential]; see also *Sharp Kabushiki Kaisha v. ThinkSharp, Inc.*, Opposition No. 91118745, n.2 (March 31, 2004) [not precedential]. Also note that Registration No. 2699482, which was also submitted with Opposer’s First Notice of Reliance, was cancelled by the USPTO on November 1, 2009.

³ While Opposer refers to these as AQUAFRESH logo marks without providing images, the USPTO records and registration certificates indicate that the marks consist of toothbrush designs.

On May 25, 2006, Applicant filed an intent to use application Serial No. 78893144 under Trademark Act §1(b), 15 U.S.C. §1051(b) for use of the mark AQUAJETT in connection with oral irrigators. See Table 2.

Table 2: Applicant's Mark

Applicant	
Mark	Goods/Services
AQUAJETT	Dental instruments, namely, oral irrigators

Upon filing its application to register AQUAJETT in connection with oral irrigators under Trademark Act § 1(b), 15.U.S.C. 1051(b), Applicant's president William R. Weissman signed the application filing electronically which contained the express declaration made under penalty of perjury that all statements in the application, including the following statement, were true and correct:

"The applicant has a *bona fide* intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b))."

The declaration, included with all USPTO filings, including the following warnings to Applicant's signatory:

"The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true."

See TEAS Plus Application for Serial No. 78893144 filed electronically on May 25, 2006.

Applicant therefore declared a *bona fide* intent to use the mark on the filing date.

Opposer now seeks cancellation of the Application based on a claim that Applicant did not possess a “*bona fide* intent” to use AQUAJETT in commerce in connection with oral irrigators. However, the record corroborates Applicant’s declared *bona fide* intent to use its mark, and Applicant has provided evidence of objective manifestations of that intent.

Furthermore, there is no evidence that Applicant had any malicious intent or any intent which was not *bona fide*. Opposer’s testimony is devoid of any evidence showing:

- any false or misleading information provided by Applicant to the USPTO in prosecution of Applicant’s AQUAJETT mark;
- any malicious intent by Applicant in its filing and prosecution of Applicant’s AQUAJETT mark at the USPTO;
- any false or misleading information provided by Applicant to the USPTO in prosecution of any other marks filed by Applicant;
- any malicious intent by Applicant in its filing and prosecution of any other marks filed at the USPTO by Applicant;
- an unrealistically broad list of goods and services in Applicant’s AQUAJETT application;
- any defensive actions by Applicant to prevent others from using a mark
- a lack of experience by Applicant in the dental industry;
- a misrepresentation of Applicant’s goods or services in its AQUAJETT application; or
- that Applicant traffics in trademarks for profit or business purposes.

Furthermore, the record contains a substantial amount of evidence demonstrating that Applicant’s *bona fide* intent was not lacking. The record shows that Applicant’s principal is experienced in the dental profession, owns patents for oral irrigator devices, has contemplated how and to whom its products could be sold and/or licensed, and has attended industry trade shows. The testimony record also shows that Applicant has developed other products for use in the field of oral care, has discussed related products at its annual meetings, and that Applicant retained counsel and performed a search of the USPTO records prior to filing of the trademark application.

Applicant has produced testimony regarding the following types of activities:

- Applicant’s experience in the dental profession:
 - Applicant’s experience as a dental professional operating a dental practice (Weissman Dep. 23-24, 32)
 - Applicant’s attendance at trade shows where oral irrigators are marketed (Weissman Dep. 41-24)
- Applicant’s due diligence prior to filing of its trademark:
 - Applicant conducted a search of USPTO records prior to filing its application (Applicant’s Response to Interrog. No. 7; see Applicant’s Testimony Ex. 8)
 - Applicant retained counsel for filing of the application (see TEAS Plus Application for Serial No. 78893144 filed electronically on May 25, 2006)
- Applicant’s consideration of potential consumers and potential channels of trade, including:
 - an intention to market goods to users of oral care goods (Weissman Dep. 51)
 - an intention to market to ordinary consumers (Weissman Dep. 51)
 - a description of the target audience for the oral irrigators that Applicant intends to sell, namely the general consuming public who is interested in oral care goods and potentially dental professionals (Weissman Dep. 22)
 - Applicant’s statement that at the time the trademark applications were filed it was planning to sell the product to ordinary consumers and potentially to dental care professionals (Weissman Dep. 38)
 - Applicant’s consideration of retail stores and dental offices as potential channels of trade (Weissman Dep. 36-37)
- Applicant’s considerations about manufacturing and licensing of its products:
 - Applicant’s determination that manufacturing the product would likely be contracted with a third-party (Weissman Dep. 30)
 - Applicant’s consideration that that direct sales by Applicant as well as the possibility of licensing the mark and product to third-parties to sell its products, and that thought had been given as to the type of companies that could potentially license the product (Weissman Dep. 31-32)
 - Applicant’s consideration of potential licensing parties for its mouthwash and toothpaste products (Weissman Dep. 58)
 - Applicant contacted several potential licensees for his patented product in writing in the 1990’s (Weissman Dep.32-33)
- Written summaries of Applicant’s annual meetings:
 - Applicant’s principal’s discussion of annual meetings minutes summarizing some of its activities or devices (Weissman Dep. 22)
 - June 14, 2006 annual meeting minutes noting “Events of significance of the past year include the following: 1. The continued research and development of new and novel products for the dental marketplace for both the consumer and the dental profession.” See Ex. A to Opposer’s Requests for Admission incorporated by reference to Applicant’s Response to Request for Admission No. 174 (Applicant’s Notice of Reliance Ex. 8)⁴

⁴ While Opposer appears not to include this evidence in its description of the record, the Board’s Orders of June 10, 2009, and October 5, 2009, indicate that Request for Admission No. 174 and the admission thereto are of record subject to a showing of relevance.

- June 1, 2007, annual meeting minutes noting “We have, over the past year, successfully submitted and received some Trademark names that will be used for future commercial ventures once all research has been completed and business practices begin. We are currently contacting companies that have an interest in commercializing our researched products. We will be signing NDA’s with interested parties and then determining if potential sale or licensing agreements can be made. We anticipate that the next 6 months will be spent furthering our business plans as most of our research has been completed.” (Weissman Dep.52), see also Ex. A to Opposer’s Requests for Admission incorporated by reference to Applicant’s Response to Request for Admission No. 174 (Applicant’s Notice of Reliance Ex. 8).³
- Applicant’s Patents (Testimony Ex. 9) and prototype:
 - Applicant’s Articles of Organization in Applicant’s Testimony Ex. 10
 - Applicant’s Patent filings referenced in Applicant’s Supplemental Response to Interrog. No. 10 (Applicant’s Testimony Ex. 8)
 - Applicant’s construction of a prototype product and consideration of use and installation of its products (Weissman Dep. 29)
 - Applicant’s description of how the product would need a source of water, such as a sink or shower, to operate Applicant’s goods, and that installation without use of plumber was intended (Weissman Dep. 23)
- Applicant’s other products:
 - Description of Applicant’s business “engaged in research and development of dental and oral care products.” See Applicant’s Supplemental Response to Interrog. 1 (Applicant’s Testimony Ex. 8)
 - Applicant’s entrance into a non-disclosure agreement with Discus Dental regarding potential licensing of its products (Weissman Dep. 59)
 - Applicant’s indication of the potential to offer its oral irrigator product to companies with which it has engaged in discussion regarding its other oral care products (Weissman Dep. 59)

ARGUMENT

II. APPLICANT’S AQUAJETT MARK IS NOT LIKELY TO BE CONFUSED WITH OPPOSER’S AQUAFRESH MARKS BECAUSE THE EVIDENCE OF RECORD AND PAST BOARD DECISIONS CONCLUSIVELY SHOW THAT THE MARKS ARE SUFFICIENTLY DISSIMILAR TO PREVENT ANY LIKELIHOOD OF CONFUSION

In order to prevail in its claim under 15 U.S.C. §1052(d), Opposer must show that there exists a likelihood of confusion between Opposer’s AQUAFRESH marks used primarily for toothpaste and toothbrushes, and Applicant’s AQUAJETT mark for use in connection with oral irrigators.⁵ The Opposer bears the burden of proof in claims of likelihood of confusion. *Hoover*

⁵ Applicant does not dispute Opposer’s priority.

Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 1359 (Fed. Cir. 2001). “The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098 (CCPA 1976). Marks containing common elements are not likely to be confused if: “(1) the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).

Applicant’s AQUAJETT mark and Opposer’s AQUAFRESH marks have significant differences in sound, appearance and meaning. The shared matter in each of the marks, AQUA-, is weak and diluted and contained in multiple third-party registrations for related goods.⁶

A determination of whether a likelihood of confusion exists must be made by applying the factors set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997). Here, the relevant *du Pont* factors are (1) the dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; and (3) the alleged fame of Opposer’s AQUAFRESH marks. *See, In re E.I. DuPont*, 476 F.2d at 1361. Here, there is no likelihood of confusion between AQUAFLOSS and AQUAJETT based on an application of the *DuPont* factors.

A. Prior Board Decisions Finding No Confusion Between Marks Beginning With the Prefix “AQUA” Support a Finding that the Marks are Not Likely to Be Confused

⁶ As noted in footnote 2 herein, Opposer has waived any claims based on marks other than the AQUAFRESH and AQUAFRESH-formative marks.

At least three previous decisions by this Board found no confusion likely between marks beginning with AQUA-. See *Marcal Paper Mills, Inc. v. American Can Company*, 212 U.S.P.Q. 852 (T.T.A.B. 1981) (no likelihood of confusion between "AQUA-QUILT" and "AQUA-GARD," both for paper towels); *American Standard Inc. v. Scott & Fetzer Company*, 200 U.S.P.Q. 457 (T.T.A.B. 1978) (AQUA STREAM for faucets and AQUAMIX, AQUAMETER, and AQUARIAN II, all for faucets, as well as AQUASEAL for valves, et al., held not confusingly similar); and *SmithKline Beecham Corporation v. Tocad Co., Ltd.*, Cancellation 23,622 (TTAB 1998), *aff'd* 215 F.3d 1350 (Fed. Cir. 1999) (hereinafter "*Tocad*").

In *Marcal Paper Mills*, the Board dismissed an opposition to the registration of "AQUA-QUILT" based on prior use and registration of "AQUA GARD", both for paper towels. The Board based its decision, in part, on adoption by third-parties of the term "AQUA" to suggest water-related qualities and held that the "AQUA" prefix was "an insufficient basis upon which to predicate a holding that the marks as a whole are likely to conflict." *Marcal Paper Mills*, 212 U.S.P.Q. at 863.

Likewise in *American Standard*, the Board dismissed an opposition to the registration of AQUA STREAM for faucets based on the prior use by the opposer of AQUASEAL for valves and AQUAMIX for faucets, and other AQUA marks. "AQUA' possesses an obvious meaning or connotation of 'water' which would be known to the average purchaser" and the "AQUA" prefix "is an insufficient basis, *per se*, on which to hold the marks to be in conflict." *American Standard*, 200 U.S.P.Q. at 461-462.

The facts in the present case are most similar to those in *Tocad*, in which the Board dismissed a cancellation claim brought by the present Opposer, SmithKline Beecham, against a registration for AQUA FLOSS in connection with a "water jet oral hygiene device for cleaning

and irrigating gums and spaces between teeth.” *Tocad*, Cancellation No. 9,223,622. The Board found no confusion likely despite finding that the goods were related and Opposer’s AQUAFRESH marks were famous and entitled to “a substantial degree of protection against similar marks.” *Id.* The Board’s opinion in *Tocad* expressly states that the differences between the AQUA FLOSS and AQUAFRESH marks were sufficient to preclude a finding of confusion regardless of any fame, actual confusion, or similarity of the goods:

[I]n this case, the mark AQUA FRESH and the related marks AQUA-FRESH and AQUAFRESH on the one hand, and mark AQUA FLOSS, on the other, engender such different overall commercial impressions that there is no likelihood of confusion. We recognize that each of the marks includes word AQUA followed by a short one-syllable word beginning with the letter “f”, i.e., FRESH and FLOSS. However, “fresh” and “floss” have very different meanings. That is, “fresh” indicates an attribute as in “freshens breath” and “floss” indicates a function as in the action of defendant’s oral irrigator. Plaintiff’s AQUA FRESH, AQUA-FRESH and AQUAFRESH marks, on the one hand, connote freshness and defendant’s AQUA FLOSS mark, on the other, connotes flossing with water. Thus, the marks in their entireties engender very different connotations and commercial impressions. Under such circumstances, the mere inclusion of the word “aqua” in the parties’ marks is an insufficient basis on which to hold that the marks are in conflict.

We should emphasize that, in arriving at our conclusion that confusion as to source is not likely, we are not relying on defendant’s argument concerning the absence of evidence of instances of actual confusion. **Our conclusion that confusion is not likely is based, quite simply, on the overall differences in the connotations and commercial impression of these marks. This fact is more important to the resolution of the issue of likelihood of confusion here than the strength of the AQUA FRESH mark as applied to toothpaste and the fact that the parties’ marks are applied to goods which fall into the category of oral care products.** *Id.* (citations omitted)(emphasis added).

The Court of Appeals for the Federal Circuit, in affirming *Tocad*, unambiguously acknowledged and confirmed the findings of the Board, stating:

We agree with the Board that in this case the most important *DuPont* factor is the dissimilarities between the two marks. We have repeatedly held that findings based on a single *DuPont* factor may, in some cases, be so important as to be dispositive of the likelihood of confusion analysis. *See Champagne Louis Roeder, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 USPQ2d 1459,

1460-61 (Fed.Cir.1998); *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 31 USPO2d 1142 (Fed.Cir.1991). **We agree with the Board that this is such a case; the differences between the marks simply outweigh all other relevant *DuPont* factors.** *Tocad*, 215 F.3d 1350 (Fed. Cir. 1999) (emphasis added).

While the determinations in prior cases are not binding upon this Board and the Board's decision will be based only on the evidence of record,⁷ a similar analysis is appropriate here. In this case the AQUAJETT and AQUAFRESH marks are even more dissimilar than Opposer's marks were vis-à-vis AQUAFLOSS. Likewise, the marks here, as a whole, are different in sound and appearance and convey different meanings and commercial impressions.

B. There is No Likelihood of Confusion Because Applicant's AQUAJETT Mark is Not Similar to Opposer's AQUAFRESH Marks in Appearance, Sound, Meaning, or Commercial Impression

The dissimilarity of the marks under the first *DuPont* factor may be sufficient to outweigh the evidence as to other factors which favor Opposer's case. *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005), *see also Kellogg Co. v. Pack-Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1889), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Here, the differences between the marks of Opposer and Applicant are significant, and the common elements are diluted and do not dominate the commercial impression. Applicant's AQUAJETT mark and Opposer's AQUAFRESH marks sound different, look different, have different meanings, and create different commercial impressions. As a result of these differences, no confusion is likely between the marks of Opposer and the mark of Applicant.

Marks tend to be perceived in their entirety, and all of their components must be given appropriate weight. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847

⁷ *See, e.g., Hasbro, Inc. v. Braintrust Games, Inc.*, Opposition No. 91169603, N. 8 (T.T.A.B. Aug. 24, 2009)(finding CLUE not famous with respect to board games on the record before the Board even though CLUE had been found famous in two prior TTAB decisions).

(Fed. Cir. 2003). Opposer's marks each contain AQUAFRESH as a singular unitary term without any spacing or hyphen. *See Table 2.* Opposer has produced no evidence of its use of the prefix AQUA- on any goods without the term -FRESH, nor has it produced any evidence of using AQUA by itself. The suffixes -JETT and -FRESH are quite different and AQUAJETT and AQUAFRESH as a whole are quite different as they have different sounds and appearances, and convey different meanings and commercial impressions.

The AQUAJETT and AQUAFRESH appearances are different. JETT is not a word in the English language and provides a distinctive "TT" at the end of the AQUAJETT mark.

The AQUAJETT and AQUAFRESH sounds are different. AQUAJETT's sound evokes and reinforces its meaning of a fast stream of liquid. Its ending is a hard "ETT" sound. Opposer's mark contains an "FR" sound and ends in a soft "ESH" sound, each of which is considerably different from the sound of Applicant's AQUAJETT mark.

The meanings of AQUAJETT and AQUAFRESH are different particularly in light of their respective goods. Opposer's AQUAFRESH marks are used on toothpaste, Toothbrushes, Toothbrush cleaners and oral appliance cleaners, dental gels, and dentifrices. *See Table 2.* JETT is a misspelling of JET and connotes a spray or stream of liquid. In contrast FRESH means "new" or unspoiled. *See Applicant's Testimony Exhibit 3, Dictionary.com Random House Dictionary Definition.* JETT suggests a spraying action created by a feature of Applicant's physical product, while FRESH suggests the smell or taste of Opposer's goods in the mouth of its users.

As a result of its meaning, its suggestiveness, and its presence in multiple registrations for the same types of goods, the term AQUA has little source identifying significance and consumers are more likely to look to the other elements, namely, the significant differences

between FRESH and JETT.

1. AQUA- is a common a descriptive prefix

Merely having a common prefix is insufficient to create a likelihood of confusion between marks. *Keebler Company v. Murray Bakery Products*, 866 F.2d 1386 (Fed. Cir. 1989) (no likelihood of confusion between "PECAN SANDIES" and "PECAN SHORTEES," both for cookies); *Stouffer Corporation v. Health Valley Natural Foods, Inc.*, 1 U.S.P.Q.2d 1900, 1903 (T.T.A.B. 1986) (no likelihood of confusion between "LEAN CUISINE" and "LEAN LIVING," both for low-fat frozen foods).⁸

Opposer has provided no evidence that Opposer uses AQUA alone or in combination with suffixes other than FRESH such that consumers would believe that AQUA or other AQUA-formative marks originate from Opposer. AQUA means "water." See Applicant's Testimony Exhibit 3, Dictionary.com Random House Dictionary Definition. Water is necessarily used throughout oral care and hygiene and in connection with Opposer's goods.

2. Third Party Registrations Containing AQUA- Prefix

Multiple third-party registrations of marks for related goods have weakened the trademark significance of the term AQUA and the scope of protection afforded to Opposer's marks. Evidence establishing that the consuming public is exposed to third-party use of similar marks on similar goods "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). Admittedly, the probative value of third-

⁸ See also *Electronic Water Conditioners, Inc. v. Turbomag Corporation*, 221 USPQ 162 (TTAB 1984) (TURBO-MAG and ELECTRO-MAG, both for water conditioning units for electromagnetically treating water and removing scale, held not confusingly similar); *Fort Howard Paper Company v. Marcal Paper Mills, Inc.*, 189 USPQ 305 (TTAB 1975) (SOF-PAC for toilet tissue and SOF-KNIT for paper towels and toilet tissue and SOFNAP for paper napkins held not confusingly similar).

party registrations is “minimal” absent some direct evidence of use. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001). However, third party registration “may be used to indicate that a commonly registered element has a suggestive (or descriptive) meaning for particular goods such that the differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable.” *Tractech, Inc. v. American Axle & Mfg., Inc.*, Opposition 109,261 (TTAB 2000); see also *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, f.n. 15 (TTAB 1992).

The extent of third-party registrations of AQUA within the dental and oral field provides some indication that term AQUA is diluted and therefore entitled to a more limited scope of protection. At least nine live use-based third-party trademark registrations that include the term AQUA appear on the principal register and identify some form of oral or dental goods or services. See *Table 3* below and Ex. 4 of Applicant’s Testimony. These registrations are indicative of the frequency with which sellers of the relevant goods have selected and registered marks having the prefix AQUA- as well as the USPTO’s willingness to permit multiple registrations containing the prefix AQUA- to share the register in the relevant classes of goods.

Table 3: Third-Party Registrations

Reg.No.	Mark	Goods/Services
3139793	C.E.T. AQUADENT	VETERINARY DENTAL CARE PREPARATIONS, NAMELY ADDITIVES FOR THE WATER OF DOGS AND CATS FOR REDUCING DENTAL PLAQUE AND FOR BREATH FRESHENING
3133049	AQUASEPT	Dental air and water delivery system comprising a dental syringe, hand piece hose, water control valve and water supply
3113171	AQUA BOND	DENTAL SEALANT FOR USE IN A WET OR MOIST ENVIRONMENT, ALL OF THE AFORESAID SOLD TO DENTAL CARE PROFESSIONALS

Reg.No.	Mark	Goods/Services
3134655	AQUACUT	Abrasive media for use in dentistry; particulate materials for use in cutting and abrading teeth; dental powders for use in the treatment of teeth; dental cements; dental wax; all of the aforesaid sold to dental professionals; dental apparatus and instruments namely tips for dental purposes; dental apparatus and instruments for the abrading of teeth; dental apparatus and instruments for the air abrading of teeth; dental apparatus and instruments for polishing teeth; dental apparatus and instruments for scaling teeth; dental apparatus and instruments for cutting teeth; dental apparatus and instruments for drilling teeth; dental drills; dental drill bits; teeth cutters; teeth scalers; teeth cleaners; teeth abraders; teeth polishers; parts and fittings for all the aforesaid goods; all of the aforesaid sold to dental professionals
2983556	AQUALITECH	amalgam separators, to be sold to others, that remove mercury and arsenic from dental wastes for recycling purposes
2811171	AQUIS	Colognes, perfumes and toilet waters; shaving cream, shaving balm, shaving gel, after-shave lotions; potpourri, sachets, scented body oils and bath oils, essential oils for personal use; non-medicated bath salts; massage oils; bath and shower gels, bubble bath and bath powder; body powder, talcum powder and non-medicated foot powder; cosmetics, namely, lipstick, lip gloss, eye makeup, blusher, foundation, face powder, makeup, and makeup removers; artificial eyelashes; astringents for cosmetic purposes; cold cream, skin cleansing creams and lotions, facial scrubs, soaps for hands, face and body, skin emollients, hand cream, skin moisturizers, skin clarifiers and skin lighteners; baby oils and powders, shampoo, hair conditioners, hair spray, hair bleaching preparations, hair dyes, hair color removers, hair lighteners, hair straighteners, hair styling preparations, pomades, and hair waving lotions; nail polish, nail polish remover, nail buffing preparations, nail strengtheners, nail hardeners, nail glitter, nail tips and glue, false nails, cuticle removing preparations, and emery boards; adhesives for attaching artificial eyelashes and fingernails; sunscreen preparations, sun block preparations, and sun tanning preparations; toothpaste and tooth gel, dentifrice, and mouthwash; cotton puffs, cotton swabs and cotton sticks for cosmetic purposes; and pre-moistened cosmetic tissues, towelettes and wipes
2667735	AQUASAFE	filters for dental waterline filtration systems used for removing microbial contamination and sterilizing water for dentists and dental technicians
1168165	AQUA-TORCH	Gas Welding Apparatus for Use in Welding Small Dental, Optical and Horological Items
1122734	AQUA-SOL	SOLUBLE LUBRICATING REAGENT SOLD AS A COMPONENT OF DENTAL FLOSS

In light of the extensive use of the term AQUA on the principal register of trademarks by third-parties to identify dental goods and services, the prefix AQUA is diluted and is therefore not likely to be perceived by purchasers as distinguishing source. *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004).

C. Differences Between the Goods Further Reduce Any Likelihood Of Confusion Between Applicant's AQUAJETT and Opposer's AQUAFRESH Marks

Goods or services “may fall under the same general product category but operate in distinct niches. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that customers are not likely to assume the products originate from the same mark.” *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, No. 00-2373 (3rd Cir. Oct. 19, 2001). In *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988), the Board held that the simultaneous use of XPRESS on information software and X*PRESS for the transmission of information to computers is not likely to cause confusion.

Opposer's Brief repeatedly refers to “Opposer's oral care products.” Opposer's Brief at p. 28. Yet Opposer's marks, as detailed in its Brief and testimony, are registered and use primarily for toothbrushes and toothpaste. While Applicant acknowledges that Opposer's toothpaste and toothbrushes may be sold through the same channels of trade and used by the same general consumers as its oral irrigators,⁹ Applicant has not admitted that the goods are identical or even very similar.

⁹ Opposer here relies on Applicant's deposition testimony, yet Opposer discounts or dismisses statements in the deposition about Applicant's actions indicating Applicant's bona fide intent to use, such as activities related to Applicant's consideration of the users and channels of trade, tradeshow attendance, potential licensing, experience in the industry, and the like.

Oral irrigators are not closely related to toothpaste and toothbrushes. Oral irrigators are substantially different than toothpaste and toothbrushes for several reasons: 1) oral irrigators are either battery-operated or electrical appliances; 2) oral irrigators generate a stream of water for cleaning inside the mouth; and 3) usage of an oral irrigator does not replace brushing of the teeth with toothpaste.

Opposer's evidence does not demonstrate that its products are closely related to Applicant's products or that oral irrigators and toothbrushes or toothpaste frequently emanate from a single source. There is similarly no evidence in the record of either party's plan to expand use of its mark for use in connection with the other party's goods. There is no evidence of record regarding the purchasing condition of the parties' respective products, the differences in price of the goods, or the rates of consumption of the respective goods. This absence of evidence contradicts Opposer's contention that the goods are very similar. Here, the goods are not identical and Applicant contends that they are not shown to be very related.

D. The Alleged Fame of Opposer's Mark is Insufficient to Overcome the Dissimilarities Between the Marks and the Differences in the Identified Goods

It is the duty of a plaintiff asserting that its marks are famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOH Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). "Fame is a factual matter which must be established on the record in each proceeding." *Hasbro, Inc. v. Braintrust Games, Inc.*, Opposition No. 91169603, n. 8 (T.T.A.B. Aug. 24, 2009)(finding CLUE not famous with respect to board games on the record before the Board even though CLUE had been found famous in two prior TTAB decisions). Any fame attributed to Opposer's marks is for AQUAFRESH as a whole and not for the prefix AQUA- in conjunction with other wording. Regardless of the amount of fame attributed the Opposer's AQUAFRESH marks, any fame is

outweighed by the other *du Pont* factors, primarily the differences between the marks.

E. Balancing the *du Pont* Factors

Evaluating the *du Pont* factors together, the balance overwhelmingly tips in favor of a finding that there is no likelihood of confusion between Applicant's AQUAJETT mark and Opposer's AQUAFRESH and AQUAFRESH-formative marks.

As in *Tocad*, the dissimilarities of the marks and the significantly different commercial impressions they create ensure that there is no likelihood of confusion among the marks. Nothing in the record of the present case justifies a finding different from the one reached by the Board in *Tocad*. The differences between the AQUAJETT and AQUAFLOSS are sufficient to preclude a finding of confusion regardless of any fame or similarity of the goods.

Because Applicant's AQUAJETT mark is not likely to cause confusion with any of Opposer's marks, Applicant respectfully requests that Opposer's opposition based on likelihood of confusion be denied.

II. OPPOSER'S CLAIM THAT APPLICANT LACKED A *BONA FIDE* INTENT TO USE ITS AQUAJETT MARK IN COMMERCE SHOULD BE DENIED BECAUSE OPPOSER HAS NOT PRESENTED ANY EVIDENCE SHOWING APPLICANT ACTED IN BAD FAITH, AND APPLICANT HAS PRODUCED EVIDENCE CORROBORATING ITS *BONA FIDE* INTENT

Opposer contends that Applicant's application should be deemed void on the grounds that Applicant has not proven a *bona fide* intent to use its mark in commerce. However, Opposer's argument ignores the fact that it has the burden of proof of establishing, by a preponderance of the evidence, its claim that Applicant lacked the requisite *bona fide* intention to use the AQUAJETT mark. *Collagenex Pharmaceuticals, Inc. v. Four Star Partners*, Opposition No. 91,150,890 (TTAB Sept. 24, 2003). Applicant, on the other hand, has provided testimony and evidence supporting its *bona fide* intent, and any lack of additional production is justified and

tempered by other facts, including the experience of Applicant's principal as a professional in the relevant industry, relevant patents owned by Applicant's principal, attendance at a tradeshow, Applicant's other trademark filings, and absence of evidence indicating any bad faith. Consequently, Opposer has not met its burden, and its opposition should be denied.

A. Opposer Bears the Burden to Produce Evidence of Applicant's Deceptive Intent or Show That Applicant Has Not Produced Any Evidence Corroborating Its *Bona fide* Intent

The current standard applied by the Board is derived predominantly from the Board's decisions in *Lane* and *Commodore*. Under this standard, "the determination of whether applicant had the requisite *bona fide* intention to use its mark on the goods identified in the application must be a fair objective determination based on all of the circumstances." *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) [precedential]; see *Lane Limited v. Jackson International Trading Company Kurt D. Bruhl Gesellschaft m.b.G. & Co. KG*, 33 USPQ2d 1352 (TTAB 1994); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

Under the *Commodore/Lane* standard, Opposer bears the burden to prove its claim by a preponderance of the evidence. *Intel Corp. v. Enemy*, 2007 TTAB LEXIS 101 (TTAB May 15, 2007). Opposer must first establish a *prima facie* case that the applicant's application is invalid for lack of the requisite *bona fide* intention to use its mark. *Id.* If the opposer is successful, the burden then shifts to applicant to come forward with evidence to refute such claims. *Id.* Even though this burden to produce evidence may shift to the applicant, "the burden of persuasion by a preponderance of the evidence remains with the party asserting a lack of a *bona fide* intention to use." *Id.*

Congress amended the Lanham Act to allow intent to use (“ITU”) applications under 15 U.S.C. 1051 Sect. 1(b) to provide a means of securing rights in a mark before use in commerce without resorting to the, then common, practice relying on “token use.” H.R. Rep. No. 100-1028 at 8-9 (1988). However, Congress also recognized that the new ITU regime presented an opportunity for abuse by applicants attempting to “monopolize a vast number of potential marks on the basis of a mere statement of intent to use the mark in the future.” S. Rep. No. 100-515 at 6 (1988). Consequently, the Senate Report on the bill identifies several examples of circumstances which “may cast doubt on the *bona fide* nature of the intent or even disprove it entirely:”

- Filing numerous intent-to-use applications to register the same mark for many more new products than are contemplated;
- Filing numerous intent-to-use applications for a variety of trademarks intended for a single new product;
- Filing numerous intent-to-use applications incorporating descriptive terms relating to a new contemplated product;
- Filing numerous intent-to-use applications to replace prior intent to-use applications that have lapsed;
- Filing an excessive number of intent-to-use applications to register marks that were no ultimately used;
- Filing applications unreasonably lacking in specificity in describing the goods.
- Filing an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce;
- Maintaining additional applications where another mark has already been selected for the intended product without good cause;
- The absence of concrete steps to commence use of the mark in commerce *since the filing of a previous statement of continuing intent to use.*

S. Rep. No. 100-515, at 23-24 (1988) [emphasis added]. While each of these circumstances may “cast doubt” on an applicant’s *bona fide* intent to use the applied-for mark, none of them constitutes a *per se* showing of lack of *bona fide* intent. Rather, Congress purposely avoided explicitly defining *bona fide* intent with the expectation that it “should be read to mean a fair, objective determination of the applicant’s intent based on all the circumstances.” *Id.* at 24.

Following this guidance from Congress, the Board has generally required opposers to present indicia of an applicant's bad faith similar to those detailed in the Senate Report in order to prevail in a claim based on a lack of *bona fide* intent. For example, in *Intel*, the Board found that a number of the indicia listed in the Senate Report applied to the applicant, who identified an unreasonably broad list of goods and services in its application, admitted he wanted to preclude the acquisition of rights in the mark by others rather than use it himself, and had previously submitted eight other ITU applications that were ultimately abandoned for lack of use, each for marks identifying laundry lists of goods. *Intel Corp.v. Enemy*, 2007 TTAB LEXIS 101 (TTAB May 15, 2007).

However, even with a finding that some of the factors indicating possible bad faith were present, applicants have successfully corroborated their *bona fide* intent using any of a wide range of available types of evidence. For example, in *Lane*, the applicant relied on correspondence with potential licensees eleven months after the application was filed as well as evidence showing that applicant's principal had prior experience in the relevant industry. *Lane*, 33 USPQ2d 1352 (TTAB 1994).

In recognition of the inherent difficulty of affirmatively proving that an applicant did not have a *bona fide* intent at the time it filed the application, the Board has permitted opposers, in exceptional cases, to rely on an applicant's inability to produce *any* evidence corroborating a *bona fide* intent. In *Commodore Electronics* the Board stated:

Although admittedly a *close question*, we hold that *absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce*, the absence of documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a *bona fide* intention to use the mark in commerce as required by Section 1(b).

26 USPQ2d at 1507(emphasis added). In other words, even where an applicant has absolutely no documentary evidence supporting its *bona fide* intent to use, the applicant may rely on “other facts” which may “adequately explain or outweigh” its lack of production. *Id.*

Commodore does not impose a standard under which applicants have an affirmative obligation, absent a showing of other evidence by opposers that a *bona fide* intent was lacking, to produce documentary evidence supporting their efforts to put the applied-for mark into use in commerce. “[O]pposer has the burden of proof of establishing, by a preponderance of the evidence [the] 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.” *Intel Corp. v. Emeny*, No. 91123312, 2007 WL 1520948 (TTAB May 15, 2007). “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.” *Id.*

In each of the cases cited by Opposer, the Board has only found an applicant’s lack of production to be evidence of bad faith where the applicant totally failed to produce any evidence whatsoever, documentary or otherwise, relevant to a showing of *bona fide* intent. *See, Intel Corp. v. Enemy*, 2007 TTAB LEXIS 101 (TTAB May 15, 2007) (“[T]he record remains void of any evidence in support of applicant’s alleged *bona fide* intent.”); *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009) (“The absence of documentation coupled with applicant’s failure to take testimony or *offer any evidence supporting its bona fide intent to use convince us that applicant did not have a bona fide intent to use.*” (emphasis added)); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (“This testimony offers *no facts which explain or outweigh* the failure of applicant... to have documents which support his claimed intent to used the ENYCE mark...” (emphasis added)); *Boston Red Sox Baseball Club*

Limited Partnership v. Sherman, 88 USPQ2d 1518 (TTAB 2008) (“Applicant has submitted no evidence, documentary or otherwise, to support or have a bearing on his claimed *bona fide* intention to use the mark when the application was filed.”); *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (“[W]e find there is no evidence of applicant’s *bona fide* intent to use the mark in the United States to identify the claimed goods.”); *DC Comics v. Silver*, 2009 TTAB LEXIS 566 (TTAB Aug. 21, 2009) (“[W]e find there is no evidence of applicant’s *bona fide* intent to use the mark on the identified goods when he filed his application.”); *Montblanc-Simplo GmbH v. United Brands International, Inc.*, Opposition No. 91185637 (September 29, 2009) (“[W]e 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”).

Therefore, to show that Applicant lacked a *bona fide* intent to use its mark, under the *Commodore/Lane* standard, Opposer has the burden of either (1) providing affirmative evidence of bad faith that Applicant cannot explain or outweigh, or (2) showing that Applicant has provided absolutely no evidence relevant to its *bona fide* intent to use its marks in commerce. As Applicant demonstrates below, Opposer has not succeeded to satisfy either of these burdens.

B. Opposer Has Offered No Direct Evidence That Would Cast Doubt Upon Applicant’s *Bona Fide* Intent

Opposer has not provided a scintilla of evidence that Applicant’s intent in filing its application for the AQUAJETT mark was anything other than *bona fide*. There are no indications that any of the circumstances surrounding the filing of the application resemble the circumstances that Congress concluded would “cast doubt” on an applicant’s *bona fide* intent. S. Rep. No. 100-515 at 23-24 (1988). Likewise, none of Applicant’s activities conform to those the Board has deemed indicative of a lack of *bona fide* intent to use, such as:

- an unrealistically broad listing of goods and services;

- a defensive intent to prevent others from using the mark;
- the filing of numerous intent-to-use applications without ever using them or subsequently abandoning them;
- the absence of any steps or planning to use the mark;
- lack of industry-relevant experience;
- misrepresentation of goods or services in order to reserve a mark; and
- trafficking in trademarks as a business model

Edelman, *Proving Your Bona fides - Establishing Bona Fide Intent to Use Under the U.S.*

Trademark (Lanham) Act, 99 Trademark Reporter 763, 782-783 (May-June 2009) (citations omitted) (emphasis added).

Here, Opposer has offered no evidence that any of these circumstances are relevant to Applicant's intent to use. For example, Applicant has not applied for "an unrealistically broad listing of goods and services." In contrast to the applications in *Collagenex Pharmaceuticals* which identified 730 goods; the intent to use application in this proceeding identifies only "dental instruments, namely, oral irrigators." *Collagenex Pharmaceuticals, Inc. v. Four Star Partners*, No. 91150890, 2003 WL 22273118 at 6 (TTAB Sept. 24, 2003).

Likewise, there is no evidence that the Applicant in this case was motivated by a desire to prevent others from gaining rights in the mark. *Cf., Intel Corp.v. Enemy*, 2007 TTAB LEXIS 101 (TTAB May 15, 2007)(finding applicant admitted he wanted to preclude the acquisition of rights in the mark by others rather than use it himself); and *Caesars World, Inc. v. Milanian*, 247 F.Supp.2d 1171, 1182 (D. Nev. 2003)(where the applicant, an individual, applied for the COLOSEAUM mark for casino and entertainment services two weeks after the owners of Caesar's Palace in Las Vegas publically announced their plans to build a new entertainment complex called the COLOSEAUM).

Unlike the applicant in *Caesar's World*, there is also no allegation that the Applicant in this case has misrepresented the applied-for goods or has ever trafficked in trademarks as a

business. 247 F.Supp.2d at 1192 (finding that the applicant was “reserving what he perceived to be desirable names with the intent to sell or license them to others.”).

As noted by Opposer, Applicant has filed other intent to use applications for similar goods, however there is no allegation that this was the result of bad faith or deceit. In fact, Congress recognized the legitimate value of registering multiple marks, even though the ultimate decision about which mark to ultimately use is based on some contingency. S. Rep. No. 100-515 at 24 (1988)(“Thus, an applicant could, under certain circumstances, file more than one intent-to-use application covering the same goods and still have the requisite *bona fide* intention to use each mark”).

Opposer has alleged that Applicant lacks industry-relevant experience, but Opposer has ignored the fact that Applicant’s principal is a dentist with proven experience designing related devices, resulting in the invention of three patents for oral irrigator technologies. Applicant’s Testimony Ex. 9; Weissman Dep. 23-24, 32. Notably, the Board has credited applicants with the experience of their principals in the past, and should do likewise here. *See Lane*, 33 USPQ2d 1352 (TTAB 1994)(finding the actions of applicant’s principal “relevant because it establishes that applicant's principal was engaged in the tobacco marketing business, including the export of tobacco to the United States under the previous SMUGGLER mark.”)

Finally, in the absence of any actual evidence of bad intent, Opposer claims that “Applicant does not have any objective evidence” demonstrating *bona fide* intent and that “Applicant has not taken any steps to put this mark into use.” Opposer’s Brief at p. 1. However, these claims fail for two reasons: (1) Applicant has in fact provided significant evidence and testimony corroborating its intent, as discussed in detail in Section II.C below; and (2) Applicant has provided an adequate explanation for not possessing each and every item of evidence

requested by Opposer. Specifically, Applicant is a small, closely held research and development company. Consequently, product ideas are necessarily in various stages, and development efforts are often informal and undocumented. *See* Applicant's Testimony Ex. 8, Response to Interrog. No. 1. Furthermore, Applicant has never asserted that it has used its mark in commerce in connection with oral irrigators under Trademark Act § 1(a), nor has it been required to at this time. Finally, applicants are permitted to place their development and marketing plans on hold until a trademark opposition proceeding is resolved, and the Board has recognized this as a reasonable explanation as to why use of the mark has not commenced during the course of a proceeding. *Imedica Corp. v. Medica Health Plans*, Cancellation No. 92043288, 2007 WL 1697344, at 16 (T.T.A.B. June 7, 2007). The Board has repeatedly recognized that intent to use applicants are not required to devote resources to bringing products to market under marks while their right to use them is still in doubt. *Id.* ("The fact that the applicant did not have 'current plans to use the mark' did not mean that the applicant had 'no plans to use the mark.' Moreover, the applicant's explanation that it had placed its plans on hold until the trademark conflict was resolved provided a reasonable explanation as to why use of the mark had not commenced.")

Consequently, Opposer has produced no direct evidence of any bad faith on the part of Applicant, and therefore relies solely on the unsupported allegation that Applicant has produced no evidence corroborating its *bona fide* intent.

C. Applicant Has Produced Evidence And Testimony Corroborating Its Bona Fide Intent To Use The AQUAJETT Mark

Applicant's evidence constitutes credible, objective corroboration of its statement in the application that it had a *bona fide* intention to use its AQUAJETT mark in commerce. In fact, Applicant has provided a plethora of evidence in a variety of forms which substantiate its *bona fide* intent to use the AQUAJETT mark.

Testimonial evidence presented by Applicant shows objective manifestations of Applicant's *bona fide* intent to use the AQUAJETT trademark in commerce. Applicant has produced testimony showing its principal is a practicing dentist (Weissman Dep. at 23, 24); has attended trade shows where oral irrigators are marketed (Weissman Dep. at 41-42); has considered the potential types of customers and channels of trade for oral irrigators (Weissman Dep. at 22, 51); and has considered options for the manufacturing and licensing of its product (Weissman Dep. at 30-32, 58)

Applicant has produced minutes from its June 14, 2006 annual meeting noting "Events of significance of the past year include the following: 1. The continued research and development of new and novel products for the dental marketplace for both the consumer and the dental profession." Ex. A to Opposer's Requests for Admission incorporated by reference to Applicant's Response to Request for Admission No. 174 in Applicant's Notice of Reliance Ex. 8. Applicant has produced three patents for oral irrigators invented by its principal (Applicant's Notice of Reliance Ex. 9; Applicant's Supplemental Response to Interrog. No. 10 in Applicant's Testimony Ex. 8), testimony that a prototype oral irrigator was built (Weissman Dep. at 23), and testimony that consideration has been given as to how the product would operate (Weissman Dep. at 23).

Evidence of record also shows Applicant exercised due diligence in selecting and filing for the AQUAJETT mark regarding its trademark prior to filing for AQUAJETT in connection with oral irrigators by conducting a search of the USPTO records and retaining counsel to assist with filing. *See* Applicant's Testimony Ex. 8, Applicant's Response to Interrog. No. 7.

The determination of whether an applicant has a *bona fide* intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances. "Trademark

Act §1(b) provides in pertinent 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 to register the trademark under this Act....’ *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993); *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). “[I]t was the intent of Congress in enacting Section 1(b) that the *bona fide* requirement thereof focus on an objective good-faith test to establish that an applicant's intent is genuine.” *Id.*

Here, Applicant has produced a myriad of evidence that confirms its *bona fide* intent to use to use the AQUAJETT mark. Applicant has shown objective manifestations of its *bona fide* intent, such as its principal’s patents and experience in the industry, which demonstrate its intent to use the AQUAJETT mark has been *bona fide*. Combined with the absence of any evidence indicating a malicious intent, Applicant’s evidence is sufficient to rebut the assertions of Opposer under the *Commodore/Lane* standard. As a result, Opposer’s claims under 15 U.S.C. 1051(b) must fail.

III. IN THE ALTERNATIVE, OPPOSER’S CLAIM THAT APPLICANT DID NOT HAVE A BONA FIDE INTENT MUST BE DENIED BECAUSE OPPOSER’S CLAIM IS NECESSARILY AN ALLEGATION OF FRAUD THAT HAS NEITHER BEEN SUFFICIENTLY PLED NOR PROVEN BY CLEAR AND COVINCING EVIDENCE

The current standard under *Lane/Commodore* does not require that a fraudulent declaration of a *bona fide* intent to use a mark be proven to the hilt and with clear and convincing evidence. *Intel Corp.v. Enemy*, 2007 TTAB LEXIS 101 (TTAB May 15, 2007). The current standard does not require substantial evidence to show the intent of the applicant is contrary to the declaration of a “*bona fide* intent” to use the applicant’s mark for the goods and services in the application. Yet the current *Lane/Commodore* standard has the effect of applying a fraud

remedy without requiring the heightened pleading and proof required for fraud because the remedy applied to applicants found to have less than *bona fide* intentions, namely invalidation of the application, corresponds to the penalty imposed on an applicant or registrant found to have made a fraudulent statement. *See Lane Limited v. Jackson International Trading Company Kurt D. Bruhl Gesellschaft m.b.G. & Co. KG*, 33 USPQ2d 1352 (TTAB 1994).

The Federal Circuit's recent *In re Bose Corp.* decision clearly delineated the difference between a merely false statement and a fraudulent statement. 91 USPQ2d 1938 (Fed. Cir. 2009). The former may occur by mere mistake, but the latter must be accompanied by deceptive intent. *Id.* *Bose* makes it clear that cancellation of a trademark record based on a fraudulent statement requires that a party knowingly makes a statement that is false, material, and with the intent to deceive the USPTO. *Bose*, 91 USPQ2d 1938 (“[W]e hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.”)

Furthermore, a fraudulent statement must be proved to the hilt by clear and convincing evidence. *Bose*, 91 USPQ2d 1938. Unlike the preponderance of evidence standard the Board applies to claims based on a lack of *bona fide* intent to use, “[a] party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof.” *Bose*, 91 USPQ2d 1938; *see also W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004 (CCPA 1967). “[T]he very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB. 1981).

Following the Federal Circuit's decision in *Bose*, a reexamination of the standard and burdens applied to a claim of lack of *bona fide* intent to use is justified.

In applying for registration under 15 U.S.C. § 1051(b), Applicant's declaration of *bona fide* intent to use the applied for mark in connection with the listed goods and services is necessarily a statement which is material and which is made knowingly. Because an applicant under §1(b) makes a declaration as to his own *bona fide* intent to use the mark, an applicant who falsely declares a *bona fide* intent cannot do so as a result of an honest, good faith error without the intent to deceive. A deceptive intent for filing an application under §1(b) is a fraudulent statement regarding Applicant's asserted *bona fide* intent.

In other words, a declaration regarding an Applicant's *bona fide* intent to use its mark is exactly the type of statement that *Bose* addresses and for which the Federal Circuit mandates a higher standard. Consequently, *Bose* requires that an allegation that an applicant under §1(b) lacked a *bona fide* intent to use the mark on goods and services must be plead with particularity and proven with clear and convincing evidence. FRCP 9(b); *Bose*, 91 USPQ2d 1938.

Even under a heightened standard applying *Bose*, many of the cases in which the Board has previously found a lack of *bona fide* intent would not reach a different result. Actions such as trafficking in trademarks, unrealistically broad listing of goods and services, misrepresentation of goods or services, or a defensive intent to prevent others from using the mark are objective manifestations of intent to deceive. But under a heightened standard, the mere absence of experience (*Boston Red Sox Baseball Club v. Sherman*, 88 U.S.P.Q.2d 1581), the absence of steps or planning to use the mark (*Id.*), the absence of documentary evidence (*Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660), or a decision to forego developing a business model until after Opposition proceeding is resolved (*L.C. Licensing, Inc. v. Cary Berman*, 86 USPQ2d 1883),

would not be objective indicia of intent to deceive, as they are not deceptive and are not grounds for finding a lack of a *bona fide* intent absent other evidence. Furthermore, any evidence showing Applicant's intent that was malicious, dishonest, unlawful, or illegitimate would clearly remain cause for showing fraudulent intent and for cancellation of the application under a heightened standard.

Regardless of the standard applied to claims alleging lack of *bona fide* intent to use, an applicant ultimately must later demonstrate use in commerce in order to complete the registration process and sign the necessary declaration in a statement or allegation of use. As a result, the public as well as potential competitors are still protected against use and use statements which are fraudulent or token, as the remedy to bring an action for cancellation based on a fraudulent use declaration will still exist.

In the present, there is no evidence that Applicant possessed a deceptive or non-*bona fide* intent; to the contrary Applicant has introduced testimony regarding objective manifestations of its intent. Furthermore, Opposer has not met its burden to show a lack of *bona fide* intent by clear and convincing evidence. As a result, Opposer's claims under 15 U.S.C. 1051(b) must fail.

CONCLUSION

Opposer has failed to meet its burdens under Trademark Act §2(d) and §1(b) to sustain the notice of opposition. The AQUAJETT and AQUAFRESH marks are not confusingly similar given the differences between the marks, the differences in goods, the dilution of AQUA, and the Board's prior decisions in similar cases. Regarding Opposer's claim that Applicant lacked a *bona fide* intent to use its mark, Applicant has provided documents and testimony showing objective manifestations of its *bona fide* intent, and any lack of additional production is justified and

tempered by other facts including Applicant's principal's patents and professional experience in the industry, as well as Applicant's attendance at tradeshow and its other trademark filings. Whether the Board applies a standard to the issue of bona fide under *Lane*, *Commodore* and subsequent cases, or a standard derived from *Bose*, there is no evidence that Applicant's intent was deceptive or not *bona fide*. As a result, Applicant respectfully requests that the Board dismiss the Opposition.

Dated this 25th day of January, 2010.



Erik M. Pelton
ERIK M. PELTON & ASSOCIATES, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089

Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of APPLICANT'S TRIAL BRIEF has been served on the following by delivering said copy on January 25, 2010, via first class mail, to counsel for Opposer at the following address:

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

By: _____



Erik M. Pelton, Esq.

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 78893144

Filing Date: 05/25/2006

*NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	AQUAJETT
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	AQUAJETT
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
APPLICANT INFORMATION	
*OWNER OF MARK	Omnisource DDS, LLC
*STREET	10902 Riverside Drive
*CITY	North Hollywood
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	91602
AUTHORIZED TO COMMUNICATE VIA EMAIL	No
LEGAL ENTITY INFORMATION	

*TYPE	LIMITED LIABILITY COMPANY
*STATE/COUNTRY UNDER WHICH ORGANIZED	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	010
*DESCRIPTION	Dental instruments, namely, oral irrigators
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	James H. Wynn
FIRM NAME	Lord, Bissell & Brook LLP
STREET	300 South Grand Avenue
CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90071
PHONE	(213) 687-6769
FAX	(213) 485-1200
EMAIL ADDRESS	jwynn@lordbissell.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	

*NAME	James H. Wynn
FIRM NAME	Lord, Bissell & Brook LLP
*STREET	300 South Grand Avenue
* CITY	Los Angeles
* STATE (Required for U.S. applicants)	California
* COUNTRY	United States
* ZIP/POSTAL CODE (Required for U.S. applicants only)	90071
PHONE	(213) 687-6769
FAX	(213) 485-1200
* EMAIL ADDRESS	jwynn@lordbissell.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	275
TOTAL FEE DUE	275
SIGNATURE INFORMATION	
* SIGNATURE	/William R. Weissman/
* SIGNATORY NAME	William R. Weissman
SIGNATORY POSITION	President
* SIGNATURE DATE	05/24/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Thu May 25 16:41:51 EDT 2006
TEAS STAMP	USPTO/FTK-63.150.115.34-2 0060525164151862929-78893 144-332f5d2905ebb5246977b eefe555148d13-CC-380-2006 0524200410931262

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 78893144

Filing Date: 05/25/2006

To the Commissioner for Trademarks:

MARK: AQUAJETT (Standard Characters, see [mark](#))

The literal element of the mark consists of AQUAJETT. The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Omnisource DDS, LLC, a limited liability company organized under the laws of California, residing at 10902 Riverside Drive, North Hollywood, California, United States, 91602, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 010: Dental instruments, namely, oral irrigators

If the applicant is filing under Section 1(b), intent to use, the applicant declares that it has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(b), as amended.

If the applicant is filing under Section 1(a), actual use in commerce, the applicant declares that it is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

If the applicant is filing under Section 44(d), priority based on foreign application, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on a specified foreign application(s). 15 U.S.C. Section 1126(d), as amended.

If the applicant is filing under Section 44(e), foreign registration, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and submits a copy of the supporting foreign registration(s), and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

The applicant hereby appoints James H. Wynn of Lord, Bissell & Brook LLP, 300 South Grand Avenue, Los Angeles, California, United States, 90071 to submit this application on behalf of the applicant.

The USPTO is authorized to communicate with the applicant or its representative at the following email address: jwynn@lordbissell.com.

A fee payment in the amount of \$275 will be submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /William R. Weissman/ Date: 05/24/2006

Signatory's Name: William R. Weissman

Signatory's Position: President

Mailing Address:

James H. Wynn
300 South Grand Avenue
Los Angeles, California 90071

RAM Sale Number: 380

RAM Accounting Date: 05/26/2006

Serial Number: 78893144

Internet Transmission Date: Thu May 25 16:41:51 EDT 2006

TEAS Stamp: USPTO/FTK-63.150.115.34-2006052516415186

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AQUAJETT