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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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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.	:	

OPPOSER'S REPLY BRIEF

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INTRODUCTION

Opposer, SmithKline Beecham Corporation, respectfully submits this Reply 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"). Opposer demonstrated that Applicant has failed to produce any evidence – documentary or otherwise – showing that it had a *bona fide* intent to use this mark for oral irrigators when the Application was filed. Applicant did not dispute any of the facts that are set forth in Opposer's description of the record, and did not respond to many of the arguments that are set forth in Opposer's brief. Moreover, Applicant has failed to cite any other evidence in the record – documentary or otherwise – which would adequately explain or outweigh the lack of evidence concerning its alleged intent.

Likewise, Applicant has failed to rebut the evidence of likelihood of confusion that Opposer submitted in this case. Applicant concedes that Opposer's AQUAFRESH marks are famous and distinctive within the oral care field, and there is no evidence that they have been diluted by any third party marks. As such, these marks must be given a wide latitude of legal protection. If consumers see the AQUAJETT mark on other oral care devices – such an oral irrigator – it is inevitable that the fame associated with the mark will rub off onto those products, and consumers will associate those products with Opposer and the well-known toothpaste and toothbrushes that it provides. The Applicant's mark would be used on an ordinary consumer product that is closely related to the oral care products that Opposer provides under its AQUAFRESH marks. Applicant admits that these products will be offered to the same classes of customers and through the same channels of trade. Applicant's arguments are primarily based on the alleged differences in the marks and the alleged weakness of the prefix that they share in common. However, there is no evidence in the record to indicate that any third parties actually use the prefix AQUA within the oral care field, and Opposer has demonstrated that AQUAJETT is similar to AQUAFRESH in terms of its appearance, spelling, pronunciation, and commercial impression.

In short, the arguments and evidence in this case overwhelmingly favor Opposer. The opposition should be sustained.

ARGUMENT

I. REGISTRATION OF APPLICANT'S MARK SHOULD BE REFUSED BECAUSE APPLICANT DOES NOT HAVE A BONA FIDE INTENT TO USE AQUAJETT

A. Applicant Misstates The Test For Showing Lack Of *Bona Fide* Intent Under § 1(b)

Applicant claims that Opposer must prove that the Applicant acted in bad faith or acted with deceptive or malicious intent when it filed its Application for AQUAJETT. (Applicant's Brief ("App. Br.") at 22, 26.) That is not the correct legal test. The Board has held that an opposer "has the burden of demonstrating by a preponderance of the evidence that [the] applicant lacked a bona fide intent to use the mark on the identified goods." *Research In Motion, Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1930 (TTAB 2009) (precedential decision). An opposer may satisfy its burden of proof on this issue based on "[t]he absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce" or based on other circumstances that cast doubt on the *bona fide* nature of the applicant's intent or even disprove it entirely. *Id.* While evidence of bad faith or deceptive intent may cast doubt on an applicant's *bona fide* intent, it is not a mandatory requirement for challenging an application under § 1(b) and Applicant offers no legal authority to suggest that it is. Indeed, in the most recent decisions where the Board refused registration under §1(b) there was nothing in the record to suggest that the applicant acted in bad faith or with deceptive intent. *See id.* at 1930-31; *Honda Motor Co., Ltd. v. Winkelmann*, 90 USPQ2d 1660, 1662-64 (TTAB 2009).

Once the opposer has made this initial showing, the burden shifts to the applicant to come forward with evidence which would adequately explain or outweigh its failure to provide evidence regarding its *bona fide* intent. *See Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USQP2d 1581, 1587 (TTAB 2008) (precedential decision). Applicant claims that in all of the cases where the Board refused registration under § 1(b) the applicant "failed to produce any evidence whatsoever" concerning its *bona fide* intent. (App. Br. at 25.) That is not correct. In the vast majority of

these cases the applicant submitted documents or deposition testimony as evidence that it had a *bona fide* intent to use its mark. However, the Board ruled against these applicants because the "evidence" they submitted did not outweigh the lack of evidence that the opposers identified in their briefs, or because the applicants did not provide an adequate explanation as to why they failed to produce such evidence. The same result is warranted in this case. *See Research in Motion,* 92 USPQ2d at 1931 (correspondence with applicant's counsel not evidence of *bona fide* intent); *Montblanc Simplo GmbH v. United Brands International, Inc.,* 2009 TTAB LEXIS 633, **11, 20 n.6 (TTAB Sept. 29, 2009) (applicant's prior experience in marketing and manufacturing, articles of incorporation, and minutes from annual meeting not evidence of *bona fide* intent); *DC Comics v. Silver,* 2009 TTAB LEXIS 566, *16-18 (TTAB Aug. 21, 2009) (checklist of activities to be conducted, formula for product described in the application, photograph of a different mark on a different product not evidence of *bona fide* intent); *Honda Motor Co.,* 90 USPQ2d at 1664 (printouts from foreign websites not evidence of *bona fide* intent); *Boston Red Sox Baseball Club,* 88 USPQ2d 1581, 1587 (TTAB 2008) (five years of experience in online marketing and internet search results conducted two years after the application filing date not evidence of *bona fide* intent)

B. Applicant Has Not Explained Why It Failed To Produce Any Documents Or Other Evidence Demonstrating A *Bona Fide* Intent To Use Its Mark In Commerce

Opposer demonstrated that Applicant failed to produce any documents showing that it had a *bona fide* intent to use this mark for oral irrigators when the Application was filed. (Opposer's Brief ("Opp. Br.") § I.F.) Applicant tries to explain the lack of documentary evidence by claiming that it is a "small, closely held research and development company," and that its development efforts "are often informal and undocumented." (App. Br. at 29.) However, Applicant did not provide any evidence to support this assertion. The Applicant refers the Board to its response to Interrogatory No. 1, but that response simply states that Applicant does not have any subsidiaries, parent companies, or related companies that use the AQUAJETT mark. (Opposer's Sixth Notice of Reliance, Ex. B, Int. 1.) Since Applicant's explanation is not supported by any evidence in the record, it should be given no consideration. *Boston Red Sox*

Baseball Club Limited Partnership v. Sherman, 88 USPQ2d at 1587 ("We can accord no evidentiary value or consideration to unsupported factual statements made by a party in its brief.")

Opposer also demonstrated that Applicant has done nothing to develop an oral irrigator product or to put its AQUAJETT mark into use, either before or after the Application was filed. (Opp. Br. § I.G.) Applicant claims that its lack of effort should be excused, because the Application has been opposed and the Applicant should not be expected to put its mark into use until the Board has issued a final decision in this proceeding. (App. Br. at 29.) The Board considered and rejected this argument in *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008), a precedential decision that is binding upon the panel assigned to this case. The Board explained that an applicant's decision to forgo developing a business model until after an opposition has been decided is not an adequate excuse, because it does not explain why the applicant failed to produce any other evidence demonstrating that it had a *bona fide* intent to use its mark at the time the application was filed. *See id.* at 1891-92.

Applicant filed its Application more than four years ago on May 25, 2006. Opposer did not file its notice of opposition until July 24, 2007 and did not ask the Board for leave to assert a *bona fide* intent claim until April 8, 2008. (*See* Docket Nos. 1, 18.) The fact that the Application has been opposed does not explain why Applicant never developed any business or marketing plans. Nor does it explain why the Applicant made no effort to put its mark into use between the date that the Application was filed and the date that the Application was opposed. Applicant purportedly intends to use its mark for an oral irrigator that is described in three Patents which were issued in 1996, but Applicant admits that it does not own or have a license to use these Patents. (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.) Needless to say, the fact that the Application for AQUAJETT was opposed in 2007 does not explain why "nothing" has been done to develop an oral irrigator between the date that these Patents were issued in 1996 and the date that the Application was filed in 2006. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 29.)

Applicant claims that it has put its plans "on hold" until this proceeding has been resolved (App.

Br. at 29), but in fact, there is no evidence that the Applicant ever developed any plans for this mark in the first place. Applicant has never prepared any business plans, any marketing plans, or any media plans concerning the AQUAJETT mark. Likewise, Applicant has never drafted any budgets for the production, marketing, or sale of an oral irrigator, it has never identified any retail outlets where this type of product might be sold, and it has never given any thought to the types of marketing materials that might be developed for this type of product or its mark. (*See* Opp. Br. §§ I.C – I.G.) Applicant's brief provides no explanation as to why it failed to produce these categories of documents and failed to engage in these types of activities.

C. The "Evidence" Cited In Applicant's Brief Does Not Establish Its *Bona Fide* Intent To Use AQUAJETT And Is Outweighed By The Lack Of Evidence Cited In Opposer's Brief

1. The Patents and prototype are not evidence of Applicant's *bona fide* intent

Opposer demonstrated that Dr. Weissman's Patents are not evidence that the Applicant had a *bona fide* intent to use AQUAJETT at the time the Application was filed. Opposer also demonstrated that the 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). (*See* Opp. Br. at 21-23.) The Applicant did not respond to these arguments and did not attempt to distinguish the *DC Comics* decision.

Dr. Weissman explained that he prepared a single prototype for the patent applications that he filed in 1994. (Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 29.) Dr. Weissman created this prototype 12 years before the Applicant filed the Application for AQUAJETT. 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.) The fact that Dr. Weissman created a prototype for the technology that is described in his Patents is not evidence of the Applicant's state of mind at the time that the Application was filed, nor is it evidence that the Applicant had a *bona fide* intent to use AQUAJETT for the oral irrigators that are described in that Application. Moreover, Dr. Weissman is not certain where this prototype is currently located, which casts doubt on whatever probative value this

"evidence" may have. (Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 29.)

2. Designing technology for an oral irrigator is not evidence of a *bona fide* intent to manufacture, market, and distribute that product

Applicant claims that Dr. Weissman has "proven experience" in designing oral irrigator technologies, because he received three patents for his inventions in 1996. (App. Br. at 28.) However, Dr. Weissman did not design these technologies by himself. He developed them with three other individuals who are named as co-inventors in his Patents, and Applicant has offered no evidence concerning the specific contribution that Dr. Weissman made to these inventions. (Opposer's Eleventh Notice of Reliance, Weissman Dep. Ex. 2, 3, 4.) In any event, Applicant has not explained why Dr. Weissman's experience in developing this technology demonstrates that the Applicant had a *bona fide* intent to use AQUAJETT for the oral irrigator products that are described in the Application. The Application was filed 10 years after Dr. Weissman received the Patents for his invention, but there is no evidence that the technology described in these Patents actually works, that it would be feasible to manufacture or commercially market this technology, or that the technology described in a Patents would be competitive with current-day oral irrigator products. *See Montblanc Simplo GmbH,* 2009 TTAB LEXIS at *11 (applicant's alleged experience in marketing and manufacturing not evidence of *bona fide* intent to use mark for electronics); *Boston Red Sox Baseball Club,* 88 USPQ2d at 1587 (applicant's alleged experience in online marketing not evidence of *bona fide* intent to use mark for clothing)

Applicant argues that the Board allowed another applicant to rely upon the prior experience of its principal as evidence of its *bona fide* intent. (App. Br. at 28.) However, the facts at issue in *Lane Ltd. v. Jackson International Trading Co.,* 33 USPQ2d 1351 (TTAB 1994) are clearly distinguishable. In *Lane* the applicant sought to register SMUGGLER & DESIGN for tobacco and related products. The evidence confirmed that the applicant's predecessor in interest entered into a license agreement with a foreign company. Under the terms of this agreement, the foreign company manufactured tobacco for the applicant's predecessor in interest, and exported those products to the United States under another version of the applicant's SMUGGLER mark. The evidence also confirmed that the applicant had offered to

license SMUGGLER & DESIGN to six foreign companies and one company in the United States within a year after it filed its application for that mark. *Id.* at .1352-53, 1356.

Applicant has not done anything to develop the technology that is described in Dr. Weissman's Patents, and in fact Applicant does not own or have a license to use those Patents. Applicant has never manufactured an oral irrigator, it has never contracted with any third parties to manufacture an oral irrigator, and it has not attempted to identify any third parties who might be able to manufacture this type of product on its behalf. (Opp. Br. § I.E.) Likewise, Applicant has never used AQUAJETT or any other mark for oral irrigators, and Applicant has never licensed or attempted to license its AQUAJETT mark to any third parties for use in the United States or anywhere else. *See Honda Motor Co.,* 90 USPQ2d at 1662 n.5 (declining to follow *Lane* because there was no evidence that the applicant was engaged in the manufacture or sale of automobiles under the claimed mark, and thus, no evidence of a bona fide intention to use the mark for such products.). (Opp. Br. §§ G.1, G.3.) In fact, the Patents were issued to Dr. Weissman in 1996 and he admitted that "nothing" has been done since then to develop the technology that is described in those Patents and "nothing" has been done to bring those technologies to market. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 29.)

3. Letters prepared in the 1990's are not evidence of Applicant's *bona fide* intent to use a mark in 2006

In its statement of facts Applicant claims that "Applicant contacted several potential licensees for his patent product in writing in the 1990's," but in fact, Applicant did not even exist until 2005 (App. Br. at 9; Opposer's Fifth Notice of Reliance, Weissman Dep. at 52.) Applicant has not submitted any documentary evidence to substantiate this claim, and Applicant did not discuss these alleged contacts in its legal argument.

Dr. Weissman claims that, at some point between 1990 and 1997, he sent letters to companies that produce oral care products concerning the oral irrigator technology that is described in his Patents. However, Dr. Weissman could not identify any of these companies, he does not have copies of these letters, and he admitted that he has never attempted to contact any of these oral care companies since the

1990s. (Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 32-33; Opposer's Eleventh Notice of Reliance, Weissman Dep. at 33-34.) Applicant was not involved in these efforts, since Applicant was not incorporated until 2005. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 52.) These alleged letters do not prove that Applicant had a *bona fide* intent to use AQUAJETT, because they were prepared more than 10 years before the Application was filed. *See Boston Red Sox*, 88 USPQ2d at 1587 (internet searches conducted two years after the applicant's filing date "were not even remotely contemporaneous with the filing of the application"). Likewise, the fact that Dr. Weissman made no attempt to contact any of these companies since the 1990s confirms that Applicant did not have any plans to use its AQUAJETT mark for oral irrigators as of its 2006 filing date.

4. Practicing dentistry is not evidence of Applicant's *bona fide* intent to manufacture, market, and distribute oral irrigators

Applicant claims that it has the experience needed to market an oral irrigator, because the president of the company is a practicing dentist. (App. Br. at 28, 30.) However, Applicant does not explain why this demonstrates a *bona fide* intent to use AQUAJETT on or in connection with oral irrigators, or how this demonstrates that Applicant had the requisite intent at the time that it filed its application. *See Montblanc Simplo GmbH,* 2009 TTAB LEXIS at *11 (applicant's alleged experience in marketing and manufacturing not evidence of *bona fide* intent to use mark for electronics); *Boston Red Sox Baseball Club,* 88 USPQ2d at 1587 (applicant's alleged experience in online marketing not evidence of *bona fide* intent to use mark for clothing). Applicant has not offered any evidence to suggest that a dentist would be likely to expand his or her business from the practice of ordinary dental medicine to the manufacture, distribution, marketing, and sale of a consumer product, such as an oral irrigator. In fact, the president of the company admitted that he does not use oral irrigators in his practice, and he is not aware of any other dentists who do. (Opposer's Eleventh Notice of Reliance, Weissman Dep. at 13, 14; Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 24.)

5. Attending a trade show is not evidence of Applicant's *bona fide* intent

Applicant claims that the president of the company has attended a trade show where oral

irrigators are marketed, but has not submitted any documentary evidence to substantiate that claim. (App. Br. at 30.) According to Dr. Weissman, the event is sponsored by the California Dental Association and it is intended for dentists who want to learn about new developments in the dental field. Since Dr. Weissman is a practicing dentist, the fact that he attended this event does not prove that the Applicant had any plans to produce an oral irrigator or that it had a *bona fide* intent to use AQUAJETT for that type of product. In fact, Dr. Weissman admitted that Applicant has never shown an oral irrigator product at this event or any other trade shows. Applicant has never prepared any brochures, fliers, hand-outs or other advertising, marketing or promotional materials for use at this event or any other trade show, and has never hired anyone to create any promotional materials on its behalf. In fact, Applicant has not given any thought to the type of marketing materials that might be created for such a product. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 34, 41, 44; Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 41; Opp. Br. § G.7.)

6. Applicant has no plans for its AQUAJETT mark

Applicant claims that it has considered the potential classes of customers and channels of trade for the oral irrigator that is described in its Application, and has considered options for manufacturing and licensing this type of product. (App. Br. at 30.) But under cross-examination, Applicant admitted that it has never developed an oral irrigator, it has not given any thought as to when it might prepare a business plan or a media plan for this type of product or the AQUAJETT mark, it has not given any thought as to where this type of product might be manufactured, and it has not given any thought as to how it might go about selling this type of product. In fact, 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, 28, 29, 30, 36, 48, 49; Opposer's Seventh Notice of Reliance, Exs. A & B, Req. 91, 94.)

7. The minutes from the Applicant's annual meetings are not evidence of its *bona fide* intent

Applicant has attempted to use the minutes from its annual meetings for 2006 and 2007 to prove the truth of the matters asserted therein. As such, they are inadmissible hearsay which may not be

considered by the Board.[1] But even if the Board allowed these documents into evidence, they do not demonstrate that Applicant had a *bona fide* intent to use AQUAJETT for oral irrigators at the time the Application was filed.[2] *See Montblanc Simplo GmbH,* 2009 TTAB LEXIS at *20 n.6 (minutes from applicant's annual meeting not evidence of *bona fide* intent).

The minutes explain the Applicant has filed a number of trademark applications, but as discussed below, filing a trademark application – in and of itself – does not prove that the Applicant had a *bona fide* intent to use the mark that is shown in that application. (Opposer's Eleventh Notice of Reliance, Weissman Dep. at 55.)

Applicant admits that the other statements that appear in these documents do not refer to the AQUAJETT mark or the oral irrigators that are described in its Application. Instead, the minutes refer to other products that are not mentioned in the Application and are not at issue in this proceeding. For example, Applicant admits that it has not conducted any research involving oral irrigators since the 1990s. Applicant admits that it has not contacted any third parties to discuss the possible licensing or sale of an oral irrigator product, and admits that it did not have any specific plans for making such contacts when these minutes were prepared. Applicant admits that it has not signed any non-disclosure agreements with any third parties involving oral irrigators, and has no specific plans to offer an oral irrigator to any third

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[1] Opposer respectfully submits that Opposer's Request for Admission No. 174 and Applicant's response to that request should be excluded for this reason, and the reasons set forth in section II of its Statement of Objections and section of III.A of Opposer's motion to strike.

[2] This is the first time that Applicant has cited these minutes as evidence of its *bona fide* intent. Opposer asked Applicant "[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." In response to this request, 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," and that "[o]ther than the documents previously produced and the patents referenced herein, Applicant is not in possession of any responsive documents regarding the manner in which [it] intends to use the mark." (Opposer's Sixth Notice of Reliance, Ex. B, Int. 10.) When Opposer asked Applicant to identify these "other documents" Applicant's referred to its trademark applications and patent filings, but did not mention the minutes from its annual meetings. (Opposer's Fifth Notice of Reliance, Weissman Dep. at 45-47; Opposer's Eleventh Notice of Reliance, Weissman Dep. at 4-5 and Weissman Dep. Exs. 2-4, 5-9, 10.)

parties. In fact, Applicant admits that it did not engage in any activities involving oral irrigators in the 12 months that passed between its 2006 and 2007 annual meetings. (Applicant's Supplemental Notice of Reliance, Ex. 2, Weissman Dep. at 51-52, 58, 59; Opposer's Eleventh Notice of Reliance, Weissman Dep. at 53-57.)

In its statement of facts, Applicant claims that the company is developing other products besides oral irrigators, but did not discuss these other products in its legal argument.[3] (App. Br. at 10.) There is no evidence that Applicant plans to use AQUAJETT for these other products, and in fact, the minutes from Applicant's annual meeting state that Applicant intends to offer these products under the mark OMNIFRESH. (Applicant's Notice of Reliance, Ex. 8, Request for Admission No. 174.) Because these other products are not mentioned in the Application and because Applicant intends to offer them under a completely different mark, any evidence concerning those other products has no bearing upon Applicant's alleged intent to use AQUAJETT for oral irrigators. *Honda*, 90 USPQ2d at 1664 (evidence showing use of a mark on car care packages is not evidence of the applicant's *bona fide* intent to use the same mark for automobiles); *DC Comics v. Silver*, 2009 TTAB LEXIS at *17 n.9 (evidence showing use of the mark TEXASTEA on petroleum products "has no bearing upon applicant's intent to use SUPER HERO, a completely different mark," on sun screens, beauty creams, skin moisturizers, and skin toners).

8. Conducting a trademark search and filing a trademark application is not evidence of Applicant's *bona fide* intent

"If 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 to use 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 Ltd.*, 92 USPQ2d at 1931. Thus, the fact that Applicant conducted "a

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[3] In its statement of facts, Applicant claims that it is "engaged in research and development of dental and oral care products," and refers the Board to its response to Interrogatory No. 1. Applicant's claim is not supported by the evidence in the record, because as discussed above, the response to Interrogatory No. 1 simply states that Applicant does not have any subsidiaries, parent companies, or related companies that use the AQUAJETT mark. (Opposer's Sixth Notice of Reliance, Ex. B, Int. 1.)

basic search" of the Trademark Office's online database and hired an attorney to file its Application is not evidence that it had a *bona fide* intent to use the mark that is shown in that Application.

9. Opposer is not required to submit evidence concerning all of the factors mentioned in the legislative history for § 1(b)

As Applicant explained, the legislative history for Section 1(b) provides "several examples of 'circumstances that may cast doubt on the *bona fide* nature of the applicant's intent or even disprove it entirely.'" (App. Br. at 23, quoting Senate Rep. No. 100-515, 100th Cong., 2d Sess. at 23 (1988), *reprinted in* 7 U.S.C.C.A.N 5577, 5586 (1988).) Applicant claims that Opposer has not satisfied its burden of proof, because it failed to demonstrate that all of these circumstances are present in this case. However, the Board has held that "neither the statute nor the legislative history of the [Trademark Law Revision Act of 1988] specifies the particular type or quantum of objective evidence that an applicant must produce to corroborate or defend its claimed bona fide intention to use the mark in commerce." *Lane*, 33 USPQ2d at 1355-56. Instead, the "determination of whether an applicant has a bona fide intention to use the mark in commerce," requires "a fair, objective determination based on all the circumstances." *Id.* The fact that all of the circumstances mentioned in the legislative history may not be present in this case is irrelevant, because as Applicant admits, these are merely "examples" of what demonstrates a lack of *bona fide* intent and there is no *per se* rule that all of these examples must be shown in order to oppose registration under §1(b). (App. Br. at 23.)

Applicant claims that it has not applied to register its mark for an unrealistically broad listing of goods and services, because the Application only covers a single class of goods. (App. Br. at 27.) An application listing hundreds of goods or services may cast doubt on an applicant's *bona fide* intent, but the Board has never suggested that an application containing a single class of goods is automatically immune from attack under § 1(b). On the contrary, an applicant must have a *bona fide* intent to use its mark for each item that is listed in the application, regardless of whether the identification contains one item or hundred. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha,* 26 USPQ2d 1503, 1507 n.7 (TTAB 1993). Where – as here – the applicant has failed to demonstrate the requisite intent for even one

class of goods, registration must be refused for failure to comply with § 1(b). *See Research In Motion*, 92 USPQ2d at 1928, 1931 (computer software); *Honda Motor Co.*, 90 USPQ2d at 1661, 1664 (vehicles for transportation and parts therefore); *Boston Red Sox Baseball Club*, 88 USPQ2d at 1582-83, 1587 (clothing); *L.C. Licensing*, 86 USPQ2d at 1885, 1891-92 (custom automotive accessories).

Applicant claims that it has a *bona fide* intent to use AQUAJETT for oral irrigators, because it has filed other intent to use applications that cover the same goods. (App. Br. at 28.) The fact that Applicant has filed numerous intent to use applications for the exact same goods actually casts doubt on its *bona fide* intent to use AQUAJETT, because the Applicant has received a notice of allowance for five of these other marks, but has not submitted a statement of use for any of them, and as a result, all five of these applications have been abandoned. (Opposer's Eighth and Tenth Notices of Reliance.)

Finally, Applicant claims that there is no evidence that it misrepresented the nature of the goods that are described in the Application, no evidence that it filed the Application in order to block other companies from applying for the same mark, and no evidence that Applicant has trafficked in trademarks as a business. (App. Br. at 28-29.) While these factors may cast doubt on an applicant's *bona fide* intent, Applicant has offered no authority to suggest that these factors must be proven in every case, and in fact, the Board has issued precedential decisions where these factors were absent. *See Research in Motion*, 92 USPQ2d at 1931; *Honda Motor Co.*, 90 USPQ2d at 1664.

C. Opposer Is Not Required To Submit Proof of Fraud

Applicant admits that Opposer is not required to plead or prove that the Applicant submitted "a fraudulent declaration" when it filed its Application for AQUAJETT, and admits that registration may be refused under §1(b) if there is no evidence in the record demonstrating that the Applicant had a *bona fide* intent to use this mark as of its filing date. (App. Br. at 31.) The Board adopted this standard in 1993 in the *Commodore* decision and has applied this test in more than a dozen decisions which have been issued since then. Applicant argues that the Board should overturn *Commodore*, *Lane*, and their progeny, and impose the heightened standard for pleading and proving fraud that the Federal Circuit adopted in the *Bose* decision. In other words, Applicant claims that the Opposer should be required to prove that the

Applicant made a false, material statement with the intent to deceive the Trademark Office when it claimed to have a *bona fide* intent to use its AQUAJETT mark. (App. Br. at 32-34.)

The Board addressed this issue in *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007), which is a precedential decision that is binding upon the panel assigned to this case. The Board explained that "an application will not be deemed void for lack of a bona fide intention to use" a mark, "absent proof of fraud, ***or*** proof of a lack of bona fide intention to use the mark on all of the goods identified in the application." *Id.* at 1633 (emphasis added). In other words, an opposer may challenge an application under §1(b) on the grounds that the applicant did not have a *bona fide* intent to use its mark in commerce at the time application was filed. In the alternative, opposer may challenge an application under §1(b) on the grounds that the applicant made a false material representation, such as claiming that it had a *bona fide* intent to use the mark for all of the products listed in the application, when in fact it only intended to use the mark for one of them.

The registration at issue in *Bose* was not challenged under §1(b) and there is nothing in the Federal Circuit's decision that would require the Board to abandon the dual framework that it adopted in *The Wet Seal.* In fact, the Board issued a precedential decision involving the issue of *bona fide* intent within four months after *Bose*, and the Board applied the same test that it adopted in *Commodore, Lane,* and their progeny. *Research in Motion,* 92 USPQ2d at 1930. *Research in Motion* confirms that the Opposer is not required to produce evidence of fraud in order to challenge the Application under §1(b), but more importantly, it confirms that registration must be refused where – as here – the record is "devoid of any evidence such as 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, and the like." *Id.* at 1931.

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

A. There Is No Dispute That Opposer Has Priority

Applicant has conceded that Opposer has priority. (App. Br. at 10 n.5.)

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

The *DuPont* factors that are relevant to this opposition favor Opposer, and if the Board has any doubts as to whether there is a likelihood of confusion, they must be resolved in Opposer's favor.

The AQUAFRESH mark is strong and distinctive and must be given a wide latitude of legal protection. The fame of a mark may be measured by the length of time that the mark has been in use; the extent of actual recognition of the mark; the duration, extent, and geographic reach of advertising and publicity associated with the mark; and the amount of unsolicited media attention that the mark has received. *Bose Corp. v. QSC Audio Prods. Inc.,* 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). Opposer has demonstrated that the AQUAFRESH mark is famous by all these measures. (Opp. Br. at 30.)

Applicant does not dispute any of this. (App. Br. at 20.) Instead, Applicant claims that the prefix AQUA is entitled to only a limited scope of protection, because third parties have registered AQUA formative marks within the dental and oral field. (App. Br. at 16-17.) However, Applicant admits that third party registrations have "minimal" probative value "absent some direct evidence of use," because trademark registrations do not prove that a third-party mark is actually in use or that consumers are familiar with the mark. (App. Br. 16-17, Opposer's Statement of Objections at 1.) In this case Applicant has not offered any evidence that any of these third party marks are actually in use, or that the alleged use of these marks is likely to affect the public's perception of Opposer's AQUAFRESH marks. Moreover, one of these registrations does not even contain the term AQUA, one of them covers dental preparations for dogs and cats, and the rest cover dental instruments products used by dentists rather than ordinary consumers. (Opposer's Statement of Objections at 1-2.) As such, this "evidence" has no probative value and should be ignored.

The goods and services described in the application and registrations are not restricted to any particular class of customers, channels of trade, or nature of use. (Opp. Br. at 33-35.) Therefore, the Board must assume that the parties will offer their goods and services to all of the potential purchasers and through all of the appropriate channels of trade for those goods and services. Applicant does not

dispute any of this, and in fact, admits that the parties' goods and services may be used by the same consumers and sold through the same channels of trade. (App. Br. at 19.)

Applicant claims that oral irrigators are not closely related to toothpaste or toothbrushes, because oral irrigators are electric or battery operated, they clean the inside of the mouth by generating a stream of water, and they are not intended to replace the need for brushing with toothpaste. (App. Br. at 20.) Applicant has not offered any evidence to support these claims, and in fact, Applicant admitted that oral irrigators, toothbrushes, and toothpaste would be used for the same purpose. (*See* Opposer's Fifth Notice of Reliance, Weissman Dep. at 11, 12, 15, 17, 51.) Moreover, Opposer has registrations of AQUAFRESH for "toothbrushes." Because these registrations are unrestricted, the Board must assume that the mark could be used for any type of toothbrush, including electric toothbrushes, which by definition, would be electric or battery operated.

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, and Opposer has demonstrated that the similarities between Applicant's mark and Opposer's mark are sufficient to create a likelihood of confusion or mistake. (Opp. Br. at 27.)

III. OPPOSER HAS STANDING TO OPPOSE THIS APPLICATION

Opposer demonstrated that it has standing to oppose the Application by submitting copies of its pleaded registrations, and by demonstrating that its registrations are valid and subsisting. (Opp. Br. at 31.) Applicant failed to address this issue in its brief.

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. Accordingly, Opposer respectfully requests that the Board sustain the opposition and deny registration to Application Serial No. 78/893,144.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Reply 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 February 8, 2010.

Jacob R. Bishop