

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Hearing: July 20, 2010

Mailed: November 29, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SmithKline Beecham Corp.

v.

Omnisource DDS, LLC

Opposition No. 91178539
to application Serial No. 78893144

Glenn A. Gundersen, Erik Bertin and Jacob R. Bishop of
Dechert LLP for SmithKline Beecham Corp.

Erik M. Pelton of Erik M. Pelton & Associates for Omnisource
DDS, LLC.

Before Quinn, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Omnisource DDS, LLC, filed an intent-to-use application to register on the Principal Register the mark AQUAJETT for "dental instruments, namely oral irrigators" in International Class 10.¹ Opposer, SmithKline Beecham Corp., opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles

¹ Application Serial No. 78893144 was filed on May 25, 2006.

opposer's previously used and registered AQUAFRESH and AQUAFRESH-formative marks for toothpaste, toothbrushes, and related oral care products as to be likely to cause confusion. Opposer, in an amended notice of opposition, added a claim that applicant lacked a bona fide intent to use the mark in commerce when the application was filed.²

Applicant, in its answers, denied the salient allegations in the original and amended notices of opposition.³

The parties submitted briefs on the merits of the case and opposer submitted a reply brief. In addition, counsel for the parties presented arguments at an oral hearing held before the Board on July 20, 2010.

Evidentiary Matters

In an interlocutory order issued on June 10, 2009, the Board granted applicant's motion to strike opposer's ninth notice of reliance and deferred until final hearing applicant's motion to strike Exhibit A from opposer's second, third and fourth notices of reliance on the ground that the materials comprising such exhibits are inadmissible hearsay. In the same order, as well as a related

² In addition, opposer asserted a claim of dilution, but did not pursue this claim at trial or present arguments with regard thereto in its brief. Accordingly, such claim is deemed waived.

³ Also, in its answers applicant asserted numerous "affirmative defenses" that are more in the nature of amplifications of its denials of the allegations contained in the notices of opposition and have been so construed.

interlocutory order issued on October 5, 2009, the Board granted opposer's motion to strike Exhibit 7, portions of Exhibit 8, and Exhibits 11-13 from applicant's notice of reliance.

In their briefs, each party has filed further objections against certain testimony and exhibits introduced by its adversary. We note, however, that none of the testimony and/or exhibits sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties, with the exception of those specifically excluded as indicated above. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

Standing

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). The purpose of the standing requirement is to prevent litigation when there is no real controversy between the parties. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

In this case, opposer properly introduced copies showing the current status and title of its pleaded registrations for its AQUAFRESH and AQUAFRESH-formative marks for toothbrushes, toothpaste, and other oral care products.⁴ This evidence establishes that opposer has a real interest in the outcome of this proceeding; that is, opposer has a direct and personal stake in preventing the registration of applicant's mark for the identified goods. Once the standing threshold has been crossed, opposer may rely on any legal ground that negates applicant's right to the registration it seeks. *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Bona Fide Intent

Opposer maintains that applicant lacked the requisite bona fide intent to use the mark in commerce when it filed the involved application. Specifically, opposer argues:

Applicant was formed in 2005;⁵

The goods identified in the subject application are described in the following U.S. Patents, all issued in 1996, Patent Nos. 5511693 and 5556001, owned by applicant's principal Dr. William Weissman, and Patent No. 5564629, owned by Dr. Weissman and co-inventors;⁶

⁴ Opposer submitted copies of 17 registrations, of which 12 currently remain valid and subsisting.

⁵ Opposer's 5th Notice of Reliance; Weissman Deposition at p. 52.

⁶ *Id.*, at 18, 22, 26-7; Opposer's 11th Notice of Reliance, Weissman Deposition, Exhibits 2-4.

Opposition No. 91178539

Dr. Weissman has not assigned or licensed the above-noted patents to applicant or to any third party;⁷

Applicant has neither used nor licensed the AQUAJETT mark either on the goods identified in the subject application or any other goods or services;⁸

Applicant's principal prepared a single prototype for the above-noted patent applications, but its whereabouts currently are unknown;⁹

Applicant has not sold nor attempted to sell any oral irrigators under the AQUAJETT mark, nor does applicant have any inventory of such goods;¹⁰

Applicant has neither identified nor considered the possible users of its goods under the AQUAJETT mark nor considered when such products would be sold;¹¹

Applicant has neither given thought to where its goods under the AQUAJETT mark would be manufactured, nor identified or contracted with third parties who might manufacture such goods, nor identified materials needed therefor, nor prepared any schematics therefor, nor prepared instructional manuals therefor;¹²

⁷ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 19; Opposer's 6th Notice of Reliance, Exhibit C; Opposer's 7th Notice of Reliance, Exhibits A, B.

⁸ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 28-9; Opposer's 7th Notice of Reliance, Exhibits A, B.

⁹ Opposer's 5th Notice of Reliance, Weissman Deposition, at p. 29.

¹⁰ Opposer's 7th Notice of Reliance, Exhibits A, B.

¹¹ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 23.

¹² Id. at p. 30-9.

Opposition No. 91178539

In response to opposer's discovery requests, applicant did not produce any documents supporting its bona fide intent to use the AQUAJETT mark other than copies of the patents noted above;¹³

Applicant possesses no business or marketing plans, nor has applicant identified or contracted with third parties to create a business plan;¹⁴

In response to opposer's discovery requests, applicant indicated it possesses no documents relevant to its selection, adoption or use of the AQUJETT mark;¹⁵

Applicant has neither planned nor created labels, tags, or packaging for its products under the AQUAJETT mark, nor identified or contracted with third parties to do so;¹⁶

Applicant has neither planned nor created marketing, advertising or promotional materials for the goods under the AQUJETT mark, nor identified or hired third parties to do so;¹⁷ and

Applicant has neither set prices for the goods identified under the AQUJETT mark, nor prepared a budget for their production and marketing, nor attempted to obtain

¹³ Id. at 45-7; Opposer's 6th Notice of Reliance, Exhibit B; Opposer's 11th Notice of Reliance, Exhibit 11.

¹⁴ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 48-9.

¹⁵ Opposer's 6th Notice of Reliance, Exhibit A.

¹⁶ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 39-41; Opposer's 7th Notice of Reliance, Exhibits A, B.

¹⁷ Opposer's 5th Notice of Reliance, Weissman Deposition at p. 34-47; Opposer's 7th Notice of Reliance, Exhibits A, B.

liability insurance therefor.¹⁸

Based upon the foregoing, opposer points to the absence of evidence, documentary or otherwise, to support applicant's assertion of its bona fide intent to use the AQUJETT mark at the time of filing. Further, opposer argues that applicant did not offer any testimony or evidence regarding its intent.

Applicant counters by contending that it "has provided a plethora of evidence in a variety of forms which substantiate its *bona fide* intent to use the AQUJETT mark."¹⁹ Specifically, applicant argues:

Its principal, Dr. Weissman, is a practicing dentist who has attended trade shows where oral irrigators are marketed by others;²⁰

Dr. Weissman's testimony, reproduced below, is proffered as evidence that applicant has "considered the potential types of customers and channels of trade for oral irrigators;"

Q. What is the target audience or the target market for the oral irrigators that Omnisource intends to sell?

A. To the general consuming public who's interested in oral care goods.

Q. Ordinary consumers?

A. Ordinary consumers.

¹⁸ Id. at 35-50.

¹⁹ Applicant's brief, p. 29.

²⁰ Weissman Deposition at p. 23-4, 41-2.

Q. ... Just to clarify, "oral care goods" again would include toothpaste, toothbrushes, toothpicks, floss, oral irrigators. Anything else in that category?

A. Mouthwash. Yeah, those are generally the items.

Q. And the users of those items would be ordinary consumers?

A. Yes.²¹

Dr. Weissman's further testimony, reproduced below, is offered as evidence that applicant "has considered options for the manufacturing and licensing of its product;"

Q. Do you plan to manufacture them yourself or do you plan to contract with a third-party to manufacture them?

A. More than likely, contract with a third-party.

Q. Are you planning to sell oral irrigators yourself, or are you planning to license them to third-parties who would then sell them to consumers?

A. Both ways have been contemplated, but no decision has been made.

Q. Have you given any thought to what types of third-parties that you would license this product to?

A. Generally, companies which would be in the oral care industry.

Q. If I could clarify that answer a little bit, what segment of the oral care industry, if any?

A. That would probably be any companies that would be in the oral care industry who are in the

²¹ Applicant's Brief, p. 30, citing Weissman Deposition at p. 22, 51.

preventative oral care field.

Q. What, if anything, have you done to identify any potential licensees?

A. Being a dentist, I'm aware of the different companies that are involved with dental care. So those would just be general companies that would come to my mind.

Q. But you have not contacted any specific companies?

A. Back in 1990, back when this was done, I remember I did send off letters to different oral care companies regarding the oral irrigator.

Q. So at the time that your patent was issued or some time - early '90s or mid '90s?

A. Anywhere between 1990 and 1996, '97.

Q. You would have made these contacts?

A. Correct.

Q. And do you remember what you did in that regard?

A. To my recollection, I sent off letters to the different companies.

Q. Do you have a copy of those letters?

A. No.

Q. Do you remember what companies they were that you sent the letters to?

A. Not specifically.

Q. Have you made any attempts to contact any of those companies since 1996?

A. No.²²

²² Applicant's brief, p. 30, citing Weissman Deposition at p. 22-58.

Applicant has offered in evidence minutes from its June 14, 2006, annual meeting noting the following:

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.²³

Applicant has produced minutes from its June 1, 2007, annual meeting noting the following:

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 will be signing NDA's with interested parties and then determining if potential sale or licensing agreements can be made. We anticipate the next 6 months will be spent furthering our business plans as most of our research has been completed.²⁴

Applicant has produced the above-noted patents, as well as testimony concerning its prototype and the manner in which such product would operate;²⁵ and

Applicant alleges that it has exercised due diligence in selecting and filing the application for the AQUJETT mark and retained counsel to assist therewith.²⁶

Trademark Act Section 1(b), 15 U.S.C. §1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use

²³ Applicant's Notice of Reliance, Exhibit 8.

²⁴ Weissman Deposition at p. 23; Applicant's Notice of Reliance, Exhibit 8.

²⁵ Id.; Applicant's Notice of Reliance, Exhibit 9.

²⁶ Weissman Deposition, Exhibit 8.

Opposition No. 91178539

a trademark in commerce" may apply for registration of the mark. A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). Opposer has the burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof that is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). *See also Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); and *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008).

In this case, we find that opposer has met its burden of demonstrating applicant's lack of a bona fide intent to use the mark by showing that applicant has no documentary evidence regarding such intent. The patents issued to applicant's principal and co-inventors indicate only that the named inventors sought to protect the device described therein, not that applicant possesses a bona fide intent to use the AQUAJETT mark on the goods identified in the

Opposition No. 91178539

involved trademark application. Similarly, the minutes from applicant's annual meetings contain only vague references to research and development of products in the dental field for consumers and dental professionals, filing various trademark applications for unspecified products, and the creation of a business plan. No reference is made in the minutes either to the AQUAJETT mark or the oral irrigators identified thereby, let alone any plans to build, license, market or sell such goods. Furthermore, applicant has not made of record copies of any business plans mentioned above in the minutes of its 2007 annual meeting. Finally, applicant has not produced the letters assertedly sent by its principal to oral care companies regarding the manufacturing and licensing of products under the AQUAJETT mark.

In sum, applicant has no documentation to demonstrate that it had the requisite bona fide intent to use the mark AQUAJETT in commerce when it filed the present application. As evidenced by its responses to discovery requests, applicant has no plans relating to manufacture, licensing, marketing or use of the mark. So as to be clear, the record is devoid of any evidence such as manufacturing efforts, licensing efforts, test marketing, correspondence with prospective licenses, preparation of marketing plans or business plans, creation of labels, marketing or promotional materials, and the like.

Applicant has not rebutted opposer's showing that applicant lacked the requisite bona fide intent. The fact that applicant filed applications for various marks, including the one at issue herein, hardly establishes a bona fide intent to use the mark. 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, because an inter partes proceeding can only be brought if the defendant has filed an application. *See Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009). However, our precedent and the legislative history of the Trademark Law Revision Act clearly contemplate such a claim.²⁷ The absence of documentation coupled with applicant's failure to take testimony or offer any evidence supporting its bona fide intent to use the AQUAJETT mark in connection with the identified goods convince us that applicant did not possess a bona fide intent to use the mark.

Further, applicant's mere statement that it intends to use the mark, and its denial that it lacked a bona fide intent, do not establish, in fact, that it had a bona fide intent to use the mark in commerce when it filed the involved application. Evidence bearing on bona fide intent

²⁷ Trademark Law Revision Act of 1988, 15 U.S.C. §1051 (1982).

is "objective" in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not solely by applicant's uncorroborated testimony as to its subjective state of mind. That is to say, Congress did not intend the issue to be resolved simply by an officer of applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future." J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §19:14 (4th ed. 2009). Here, the lack of documentation or testimony clearly outweighs any subjective or sworn intent to use the mark. *Cf. Imperial Tobacco Ltd. v. Philip Morris Inc.*, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990) ("Nothing in the statute entitles a registrant who has formerly used a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subjective affirmative 'intent not to abandon.'").

As discussed above, applicant's vague and speculative statements in the minutes from its annual meetings fail to make any mention of the AQUAJETT mark or the goods identified thereby. Similarly, the patent registrations and asserted prototype fail to mention the AQUAJETT mark or provide evidence that applicant had a bona fide intent to use such mark on oral irrigators at the time applicant filed the involved trademark application. The asserted letters

Opposition No. 91178539

sent by applicant's principal to potential manufacturers of the identified goods are not of record, and applicant's principal testified that he cannot remember to whom they were sent. Furthermore, the mere fact that applicant's principal is a practicing dentist who attends trade shows at which oral irrigators are marketed by others falls far short of demonstrating that applicant itself sought to market the oral irrigators under its AQUAJETT mark at such trade shows. Similarly, the statements by applicant's principal that he contemplated whether the identified goods would be directly marketed by applicant or licensed to a third party and that he considered who would be the intended consumers of the goods fail to demonstrate that applicant possessed a bona fide intent to use the AQUAJETT at the time the application was filed.

Finally, applicant argues that opposer has failed to introduce evidence that applicant acted in bad faith and that "Opposer's claim that Applicant did not have a *bona fide* intent to use the AQUAJETT mark in connection with the identified good 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."²⁸ In so arguing, applicant essentially seeks to conflate the requirements for pleading and proving the lack

²⁸ Applicant's brief, p. 1-2.

of a bona fide intent to use a mark with the requirements for pleading and proving fraud. This is incorrect. Applicant cites to no authority for its apparent position that a plaintiff seeking to prove that an applicant lacked a bona fide intent to use its mark at the time it filed its application must demonstrate that applicant acted in bad faith and intended to deceive the USPTO. To the contrary, the absence of evidence of an applicant's bona fide intent to use a mark does not necessitate a showing that such applicant acted in bad faith. Simply put, the lack of a good faith intent to use a mark does not equate to bad faith.

Priority and Likelihood of Confusion

Because we have found that applicant lacked a bona fide intention to use the mark in commerce at the time it filed the involved application, we decline to make a determination on the merits on the ground of priority and likelihood of confusion. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff'd unpublished*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Decision

The opposition is sustained on the ground of a lack of bona fide intention to use the mark in commerce; and registration to applicant is refused.