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T.T.A.B.

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

MBA

Mailed: December 16, 2010

Opposition No. 91187342

Sean Puffy Combs

v.

Pacific Rim Marketing Inc.

**Before Kuhlke, Taylor and Bergsman, Administrative Trademark
Judges**

By the Board:

This case now comes up for consideration of opposer's combined motion for leave to file a second amended notice of opposition to add a claim of nonuse, and for summary judgment on the proposed new claim. The motion is fully briefed.

Background and Undisputed Facts

Pro se applicant seeks registration of IDIDDY, in standard characters, for "Headphones and cases specially adapted for MP3 players, cell phones and video disc players."¹ In his amended notice of opposition, opposer alleges that he "has been known worldwide under the name P.

¹ Application Serial No. 78615932, filed April 25, 2005, based on a claimed date of first use in commerce of April 6, 2005.

DIDDY since at least as early as 2001." As grounds for opposition, opposer alleges: (1) prior use and registration of P. DIDDY for a wide variety of entertainment-related goods and services,² and that use of applicant's mark is likely to cause confusion with, and dilute, opposer's mark; (2) "use of IDIDDY by Applicant will falsely suggest a connection with Opposer, in violation of Section 2(a) of the Lanham Act;" and (3) applicant's mark "is descriptive of the goods covered by the subject application." In its answer, applicant denies the salient allegations in the amended notice of opposition.

Opposer's motion is based on a copy of applicant's press release of May 16, 2005, and applicant's September 7, 2010 responses to opposer's first requests for admission. Specifically, in the press release, applicant indicated that its products to be sold under its involved mark "are in production and scheduled to ship to customers at the end of May" 2005. In its responses to opposer's requests for admission, applicant admitted that the copy of the press release upon which opposer relies is accurate, and that prior to May 16, 2005, applicant had not shipped, sold or

² Registration No. 3109611, issued June 27, 2006 based on dates of first use in commerce of 2001-2003 for musical and video recordings, live musical performances, providing a Web site featuring information on fashion and culture and related goods and services.

charged any customers for any IDIDDY products, nor had any customers paid for any IDIDDY products.

Opposer's Motion and Applicant's Response

By his motion for leave to amend, opposer seeks to add a claim that applicant "made no use in commerce of the mark IDIDDY on any goods whatsoever including" the goods identified in the involved application, "and, thus, such application was and is void *ab initio* under § 1(a)" of the Act. Opposer argues that its motion for leave is timely because it was filed one month after applicant responded to opposer's requests for admission, and that applicant would not be prejudiced by the proposed amendment because "the facts concerning Applicant's alleged first use in commerce were solely in Applicant's possession." Opposer further argues that summary judgment on the proposed nonuse claim is appropriate because applicant's press release and responses to opposer's requests for admission establish that there is no genuine issue of material fact that applicant "had not used its alleged IDIDDY mark in commerce prior to the filing date of its application"

In response, applicant does not dispute opposer's allegations or introduce any evidence. Instead, applicant claims that it believed it was using the mark as of the filing date of the application.

When we paid money and brought up the website ididdy.com, we believed that the

mark was being used in commerce. When we contracted for packaging design and the logo for ididdy, we believed we were using the mark in commerce. When we placed a manufacturing order and deposit for ididdy manufacturing we believed we were using the mark in commerce. Monetary payment had taken place with respect to the mark and we believed that it was being used in commerce.

Applicant admits, however, that it made a "mistake" in claiming use of the mark as of the filing date of the involved application, but claims that the mistake was made "with no intent to deceive or defraud." Applicant also points out that its "first customer order and shipment predates" the filing of one of opposer's unpleaded applications. Applicant contends that it would be "unfair" to enter judgment in opposer's favor based on the facts of record.

In reply, opposer argues that applicant "admits that it had not used its alleged IDIDDY mark in commerce prior to the filing date of its opposed application," and that this is "dispositive."³

Decision

Turning first to the motion for leave to amend, under Fed. R. Civ. P. 15(a), leave to amend a pleading "shall be freely given when justice so requires." Accordingly, the Board is generally liberal in granting leave to amend

³ Applicant filed a surreply on October 11, 2010, which has been given no consideration. TBMP § 502.02(b) (2d ed rev. 2004).

pleadings, "unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." International Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 (TTAB 2002). Indeed

[i]f the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason - such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. - the leave sought should, as the rules require, be "freely given."

Foman v. Davis, 331 U.S. 178, 182 (1962) (quoted with approval in Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1505 (TTAB 1993)).

Here, opposer filed its motion for leave one month after applicant served its responses to opposer's requests for admission. Opposer's motion was therefore timely. Furthermore, applicant has not established that it would be prejudiced if leave to amend is granted, and we agree with opposer that because the facts relevant to whether and when applicant used its mark are within applicant's control, applicant should not require discovery on this claim and would not be prejudiced by the addition of the proposed claim. Finally, there is no evidence of bad faith or dilatory motive.

For all of these reasons, opposer's motion for leave to amend is hereby **GRANTED**, and opposer's proposed second amended notice of opposition is hereby accepted and made of record, and is now opposer's operative pleading herein.

Turning next to opposer's motion for summary judgment on his nonuse claim, summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). Opposer, as the movant seeking summary judgment, bears the initial burden of demonstrating the absence of any genuine issue of material fact. See, Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1563, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, in this case applicant, and all justifiable inferences are to be drawn in applicant's favor. Lloyd's Food Products, Inc. v. Eli's,

Inc., 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra. The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See, Lloyd's Food Products, 987 F.2d at 766, 25 USPQ2d at 2029; Olde Tyme Foods, 961 F.2d at 200, 22 USPQ2d at 1542.

Standing

There is no genuine issue of material fact regarding opposer's standing. Opposer's pleaded registration establishes opposer's standing.⁴ Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's registration establishes standing); Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581, 1586 (TTAB 2008); L.C. Licensing Inc. v. Berman, 86 USPQ2d 1883, 1887 (TTAB 2008).

Whether Applicant Used Its Mark Prior to the Filing Date of Its Application

Under 15 U.S.C. § 1051(a)(1), only "[t]he owner of a trademark used in commerce may request registration" of a mark. "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade." 15 U.S.C. § 1127. Furthermore, bona fide use requires that "the goods are sold or transported in commerce." Aycock Engineering,

⁴ A current printout from the Office's TARR database showing the status and title of opposer's pleaded registration is attached to opposer's now-operative second amended notice of opposition. Trademark Rule 2.122(d)(1).

Inc. v. Airflite, Inc., 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009); Paramount Pictures Corp. v. White, 31 USPQ2d 1768, 1772 (TTAB 1994), aff'd, 108 F.3d 1392 (Fed. Cir. 1997).

Here, there is no genuine issue of material fact that applicant did not use IDIDDY within the meaning of the Act prior to the filing date of the involved application. Indeed, applicant's responses to opposer's requests for admission and motion for summary judgment establish that applicant did not sell or transport its IDIDDY goods prior to the filing date of its application. In fact, "[m]ere adoption (selection) of a mark accompanied by preparations to begin its use are insufficient as a matter of law as a foundation for claiming ownership of and applying to register the mark." Intermed Communications, Inc. v. Chaney, 197 USPQ 501, 507 (TTAB 1977) (applying superseded, and less strict, standard of "use"). Any shipment of applicant's goods "in preparation for offering the goods for sale" is insufficient. Avakoff v. Southern Pacific Company et al., 765 F.2d 1097, 226 USPQ 435, 436 (Fed. Cir. 1985) (also applying less strict standard). And while "there must be an open and notorious public offering of the [goods] to those for whom the [goods] are intended," applicant's responses to opposer's requests for admission establish that there was not. Intermed Communications, 197 USPQ at 507.

Conclusion

For all of these reasons, we find that there is no genuine issue of material fact that applicant, who chose to proceed without an attorney, did not use its mark prior to the filing date of its involved application. Accordingly, the application is void, *ab initio*, and opposer's motion for summary judgment is accordingly **GRANTED**. The Opposition is sustained and registration to applicant is refused.
