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

| | |
|------------------------|--|
| Proceeding | 91195328 |
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5 UNITED STATES PATENT AND TRADEMARK OFFICE
6 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

7 HardCandy Cases, LLC,) Opposition No.: 91195328
8)
9 Opposer,) **OPPOSER'S TRIAL BRIEF**
10 v.)
11 Hard Candy, LLC,) In Re Application Serial
12) No.:77700557
13)
14) For the Mark: Hard Candy
15)
16) Applicant.) Filed: 27 March 2009
17)
18) Published in the Trademark
19) Official Gazette: 16 February,
20) 2010
21)
22)
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1 **TABLE OF AUTHORITIES**

2 **Cases**

3 *Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581 (TTAB2008)*
4 30, 31

5 *Commodore Electronics Ltd. V. CBM Kabushiki Kaisha, 26 USPQ2d 1503,*
6 *1507 (TTAB 1993)* 30

7 *Honda Motor Co., Ltd. v. Friedrich Winkelmann, 90 U.S.P.Q.2d 1660*
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9 *L.C. Licensing Inc. v. Berman, 86 USPQ2d 1883 (TTAB 2008)* 28

10 *Lane Ltd. v. Jackson International Trading Co., 33 USPQ2d 1351 (TTAB*
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12 *Salacuse v. Ginger Spirits, 44 U.S.P.Q.2d 1415 (TTAB 1997)* 32

13 **Statutes**

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15 FRE 401(b) 12, 20, 21, 22, 23, 24

16 FRE 403 14, 16, 17, 18, 19, 20, 21, 22

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20 *PRL USA Holdings Inc. v. Rich C. Young, Opp. No. 91206856* 25

21 **Other Authorities**

22 86 S. REP. No. 100-515, at 23-24, 2d Sess. (1988) 34

23 T.M.R.P. Rule 2.89(d) 25, 27

24 TMBP §527.01 (e) 15

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1 **1. Introduction**

2

3 Opposer Hard Candy Cases ("Opposer") is the owner of the pending

4 mark HARD CANDY CASES (Serial No. 77/917,147) for use in conjunction

5 with "protective cases, bags, fitted plastic films known as skins for

6 covering and providing a protective barrier, and covers for laptop

7 computer, notebook computers, smartphones, cellular phones, handheld

8 mobile digital electronic devices, portable and handheld digital

9 electronic devices, MP3 players, personal digital assistants, and

10 electronic and digital handheld consumer devices" (IC 009).

11

12 Applicant Hard Candy LLC ("Applicant") is seeking registration of

13 the mark HARD CANDY (U.S. Serial No. 77/700557) for use with "leather

14 goods, namely, leather bags, suitcases, wallets, leather cases,

15 leather handbags, leather key chains, leather pouches, traveling bags,

16 and purses" (IC 018).

17

18 Opposer opposes Applicant's registration on the basis of

19 Applicant's lack of *bona fide* intent to use the mark with the listed

20 goods at the time of filing, as shown by Opposer's failure to produce

21 any evidence of such intent, Opposer's failure to provide any

22 explanation for the absence of this evidence, as well as Opposer's

23 demonstrated pattern and practice of filing and subsequently

24 abandoning numerous trademark applications also without this intent.

25

26

27

28

1 **2. Description of the Record**

2
3 The evidence of record in this matter consists of the following:

4 I. August 2, 2013, Opposer's Notice of Reliance, including;

5 1) A true and correct copy of the online Official Record of
6 Application No. 75136497 (ONR Exh. A).

7 2) A true and correct copy of the online Official Record of
8 Application No. 75136495 (ONR Exh. B).

9 3) A true and correct copy of the online Official Record of
10 Application No. 75136451 (ONR Exh. C).

11 4) A true and correct copy of the online Official Record of
12 Application No. 75223383 (ONR Exh. D).

13 5) A true and correct copy of the online Official Record of
14 Application No. 75223385 (ONR Exh. E).

15 6) A true and correct copy of the online Official Record of
16 Application No. 75223384 (ONR Exh. F).

17 7) A true and correct copy of the online Official Record of
18 Application No. 75223388 (ONR Exh. G).

19 8) A true and correct copy of the online Official Record of
20 Application No. 75223387 (ONR Exh. H).

21 9) A true and correct copy of the online Prosecution History
22 of Application No. 78441342 (ONR Exh. I).

23 10) A true and correct copy of the online Prosecution
24 History of Application No. 78441354 (ONR Exh. J).

25 11) A true and correct copy of the online Prosecution
26 History of Application No. 78488630 (ONR Exh. K).

27 12) A true and correct copy of the online Prosecution
28 History of Application No. 78441211 (ONR Exh. L).

1 13) A true and correct copy of the online Prosecution
2 History of Application No. 75715785 (ONR Exh. M).

3 14) A true and correct copy of the online Prosecution
4 History of Application No. 78481659 (ONR Exh. N).

5 15) A true and correct copy of the online Prosecution
6 History of Application No. 76539353 (ONR Exh. O).

7 16) A true and correct copy of the online Prosecution
8 History of Application No. 77832682 (ONR Exh. P).

9 17) A true and correct copy of the online Prosecution
10 History of Application No. 85092902 (ONR Exh. Q).

11 18) A true and correct copy of the online Prosecution
12 History of Application No. 85092911 (ONR Exh. R).

13 19) A true and correct copy of the online Prosecution
14 History of Application No. 77700560 (ONR Exh. S).

15 20) A true and correct copy of the online Prosecution
16 History of Application No. 77700565 (ONR Exh. T).

17 21) A true and correct copy of the online Prosecution
18 History of Application No. 77700552 (Exh. U).

19 22) A true and correct copy of the online Prosecution
20 History of Application No. 77552278 (Exh. V).

21 II. August 2, 2013, Opposer's Notice of Reliance, including:

22 1) A true and correct copy of the Prosecution History of
23 Application No. 77700562 (ONR Exh. W).

24 2) A true and correct copy of the Prosecution History of
25 Application No. 85093041 (ONR Exh. X).

26 3) A true and correct copy of the Prosecution History of
27 Application No. 75223386 (ONR Exh. Y).

28 4) A true and correct copy of the Prosecution History of
 Application No. 85093043 (ONR Exh. Z).

1 5) A true and correct copy of the Prosecution History of
2 Application No. 76095857 (ONR Exh. AA).

3 6) A true and correct copy of the Prosecution History of
4 Application No. 77551710 (ONR Exh. AB).

5 7) A true and correct copy of the Prosecution History of
6 Application No. 76095850 (Exh. AC).

7 8) A true and correct copy of the Prosecution History of
8 Application No. 77700558 (ONR Exh. AD).

9 9) A true and correct copy of the Prosecution History of
10 Application No. 76095853 (ONR Exh. AE).

11 10) A true and correct copy of the Prosecution History of
12 Application No. 76095861 (ONR Exh. AF).

13 11) A true and correct copy of the Prosecution History of
14 Application No. 77700551 (ONR Exh. AG).

15 12) A true and correct copy of the Prosecution History of
16 Application No. 77700564 (ONR Exh. AH).

17 III. August 2, 2013, Opposer's Notice of Reliance, including:

18 1) A true and correct copy of the Prosecution History of
19 Application No. 76095852 (ONR Exh. AI).

20 2) A true and correct copy of the Prosecution History of
21 Application No. 77700563 (ONR Exh. AJ).

22 3) A true and correct copy of the Prosecution History of
23 Application No. 76095855 (ONR Exh. AK).

24 4) A true and correct copy of the Prosecution History of
25 Application No. 85092915 (ONR Exh. AL).

26 5) A true and correct copy of the Prosecution History of
27 Application No. 85092917 (ONR Exh. AM).

28 6) A true and correct copy of the Prosecution History of
Application No. 85092919 (ONR Exh. AN).

1 7) A true and correct copy of the Prosecution History of
2 Application No. 85093035 (ONR Exh. AO).

3 8) A true and correct copy of the Prosecution History of
4 Application No. 85092904 (ONR Exh. AP).

5 9) A true and correct copy of the Prosecution History of
6 Application No. 85092905 (ONR Exh. AQ).

7 10) A true and correct copy of the Prosecution History of
8 Application No. 85093032 (ONR Exh. AR).

9 IV. August 2, 2013, Opposer's Notice of Reliance, including:

10 1) A true and correct copy of the Prosecution History of
11 Application No. 85205945 (ONR Exh. AS1-AS2).

12 2) A true and correct copy of the Prosecution History of
13 Application No. 77551700 (ONR Exh. AT1-AT2).

14 3) A true and correct copy of the Prosecution History of
15 Application No. 77511309 (ONR Exh. AU1-AU2).

16 V. August 2, 2013, Opposer's Notice of Reliance, including:

17 1) A true and correct copy of the Prosecution History of
18 Application No. 77511318 (ONR Exh. AV1-AV2).

19 2) A true and correct copy of the Prosecution History of
20 Application No. 77700553 (ONR Exh. AW1-AW5).

21 VI. March 10, 2014, Applicant's Testimony for Defendant including
22 Opposer's Exhibits A-G and Applicant's Exhibits 1-13.

23 VII. December 11, 2013, Opposer's Testimony for Plaintiff including
24 Certified copies of the testimony deposition of Timothy Hickman
25 and David Adam, which includes exhibits.

26 VIII. The other pleadings contained in the Board's file.
27
28

1 **3. Statement of the Facts**

2

3 Opposer, Hard Candy Cases, has been in the business of protective

4 covers and cases for consumer electronics since the fall of 2009

5 (Hickman Dep., pages 6-8, specifically page 6, lines 14-21). The

6 business was founded by Tim Hickman, who had considerable "experience

7 in marketing cases for iPhone, iPad, and such..." (Adam Dep. page 7,

8 specifically line 11), and David Adam, who at the time had "15 years

9 of product design consulting" (Adam Dep. page 6, specifically lines

10 22-23). On January 21, 2010, Opposer filed an application for

11 registration of the mark HARD CANDY CASES in IC 009, including

12 "protective cases" for various electronic devices (Appl. Serial No.

13 77/917,147)

14

15 Applicant, Hard Candy, LLC, was formed "approximately five or six

16 years ago" (Falic Dep. page 5, specifically lines 8-11.) after its

17 founders had "bought the [HARD CANDY] trademark approximately ten or

18 12 years ago" (Falic Dep. page 6, lines 2-3). Currently, Applicant

19 "has a very extensive cosmetic and fragrance brand," as well as

20 "sunglasses, cosmetic bags, and apparel" (Falic Dep., page 7,

21 specifically lines 15-16 and 18-19).

22

23 Since 1997, at least, Applicant has filed over 130 federal

24 trademark applications that have subsequently been abandoned either

25 expressly or for failure to file a statement of use. (Opp. Notice of

26 Reliance Exhs. A-AW5 and public record.) Applicant filed 11 intent-to-

27 use applications on March 27, 2009, on an expansive range of goods,

28 including "cheese-flavored snacks" in IC 030 (Appl. Serial No.

1 77/700,562), "beauty beverages" in IC 045 (Appl. Serial No.
2 77/700,564), "MP3 players" in IC 009 (Appl. Serial No. 77/700,559) and
3 "leather goods" in IC 018 (Appl. Serial No. 77/700,557). To date, none
4 of these have registered. The '562 and '564 applications were
5 abandoned due to Applicant's failure to file a Statement of Use years
6 after they were allowed. The '559 application has also been recently
7 abandoned due to an *inter partes* decision by the TTAB in the present
8 case.

9
10 Prior to filing the '557 application, in early 2009, Applicant
11 met with the Beanstalk Group ("Beanstalk"), "a company that helps
12 develop brands that want to license various (sic) products into
13 various retailers" (Falic Dep. page 15, specifically lines 9-12.) On
14 February 14, 2009, Beanstalk sent a "Licensing Representation
15 Proposal" to Applicant (Opp. Exh. D). Although this proposal refers to
16 the notion of a "lifestyle brand," the only specific product even
17 mentioned in the document is cosmetics. (Opp. Exh. D.) In regards to
18 proposed "strategic partnerships," besides Walmart as a retailer, the
19 only company mentioned is Nu World, which is "a company that
20 manufactures and distributes and licenses various cosmetic products"
21 (Falic Dep. page 18, specifically lines 13-14.) The proposal also
22 states that "Beanstalk will apply our proprietary strategic process
23 resulting in a recommendation of specific categories for brand
24 extension." (Opp. Exhibit D.) However, this proposal was never
25 executed; Applicant "did not engage them [and] didn't hire them"
26 (Falic Dep. page 17, specifically line 21.)

27
28 On October 7, 2009, over 6 months after filing the '557
application, Applicant received an email from Stu Dolleck at Nu World

1 Beauty regarding "rough concepts" of products and included images of
2 several types of products for the HARD CANDY brand (App. Exh.4). On
3 May 24, 2010, over a year after filing the '557 application, Applicant
4 received a "Hard Candy Lifestyle Deck," including images of handbags
5 among many other products (App. Exh.5) Three months later, in August
6 2010, Applicant executed a licensing agreement with Nu World covering
7 "cosmetic bags, cosmetic cases, and hand bags" (App. Ex.6).

8
9 More than a year later (and now two years since filing the '557
10 application) in August 2011, Applicant received emails from Alberto
11 Kamhazi of Supply 26 that included images for iPad and iPhone cases
12 (App. Exhs. 7 and 8). Applicant later received additional photoshopped
13 images on October 19, 2011, to show Applicant's logo position on
14 iPhone and iPad cases (App. Ex. 9).

15
16 On July 29, 2012, Applicant received a "Hard Candy Accessories
17 Weekly Recap" from Jordan Pagonakis describing a recent trip to a
18 Walmart store that stated "S1 and S2 key items include...cell phone
19 holders" (App. Exh. 12). On November 1, 2012, Applicant sent an email
20 to Morris Tbeile of One Step Up to follow up on a previous meeting
21 "months ago" regarding developing iPhone and iPad cases for Applicant
22 (App. Ex. 10). Eventually, on November 19, 2012, Applicant received a
23 price quote from Solomon Fallas of LifeWorks Technology Group for
24 manufacturing iPad and iPhone cases (App. Ex. 11). A review of all
25 documents produced by Applicant shows that:

26
27 Applicant did not produce any documents dated on or before the
28 date of filing that associate the HARD CANDY mark with leather goods.
(App. Exhibits 1-13 from Falic Dep.)

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Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with backpacks. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with leather bags. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with suitcases. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with wallets. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with leather cases. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with leather handbags. (App. Exhibits 1-13 from Falic Dep.)

Applicant did not produce any documents dated on or before the date of filing that associate the HARD CANDY mark with leather key chains. (App. Exhibits 1-13 from Falic Dep.)

1 Applicant did not produce any documents dated on or before the
2 date of filing that associate the HARD CANDY mark with leather
3 pouches. (App. Exhibits 1-13 from Falic Dep.)
4

5 Applicant did not produce any documents dated on or before the
6 date of filing that associate the HARD CANDY mark with traveling bags.
7 (App. Exhibits 1-13 from Falic Dep.)
8

9 Applicant did not produce any documents dated on or before the
10 date of filing that associate the HARD CANDY mark with purses. (App.
11 Exhibits 1-13 from Falic Dep.)
12

13 Applicant did not produce any documents dated on or before the
14 date of filing that showed the intent to manufacture the goods listed
15 in the application. (App. Exhibits 1-13.)
16

17 During these proceedings, Applicant produced a copy of the
18 "Licensing Representation Proposal" of February 14, 2009, and a series
19 of images of purses and other goods, all dated after the filing date
20 of March 27, 2009. (App. Exhs. 1-13.) Applicant stated that "no
21 further responsive, non-privileged documents have been located."
22 (Applicant's Response to Motion to Compel, dated July 15, 2013, page
23 4).
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1 **4. Argument**

2 **4.1 DEPOSITION OBJECTIONS**

3 Opposer raises for ruling and seeks to preserve the following
4 objections raised in the deposition for appeal:

5 **4.1.1 HICKMAN DEPOSITION**

6 **4.1.1.1 Objection to Mr. West's question regarding**
7 **the accuracy of a Hard Candy Cases sales**
8 **presentation in reflecting "the types of**
9 **products that [Hard Candy Cases] manufacture[s]"**
10 **(Hickman Depo at. 10)**

11
12 Mr. Groisman objected to the question, "And does that accurately
13 reflect the types of products that you manufacture?" based on lack of
14 foundation. A witness "may testify to a matter only if evidence in
15 introduced sufficient to support a finding that the witness has
16 personal knowledge of the matter (FRE 602). It had already been
17 established that Mr. Hickman is the CEO of Hard Candy Cases (Hickman
18 Depo. at 6) and he had already described they types of products
19 ("protective cases for consumer electronics") made by Hard Candy Cases
20 (Hickman Depo. at 8). Therefore, foundation had been established and
21 the objection should be overruled.

22
23 **4.1.2 FALIC DEPOSITION**

24 **4.1.2.1 Objection to Mr. Kaplan's question**
25 **regarding the filing date of the '559 application**
26 **being March 27, 2009 (Falic Depo. at 10)**

1 Mr. West objected to the question, "If you turn back one page it
2 indicates that the filing date was March 27, 2009. Do you see that?"
3 because the question related to an application no longer at issue in
4 the present case. "Evidence is relevant if the fact is of consequence
5 in determining the action" (FRE 401(b)). The question referred to the
6 application that had been withdrawn from the present case. Therefore,
7 the answer to it would be irrelevant and the objection should be
8 sustained.

9 **4.1.2.2 Objection to Mr. Kaplan's question**
10 **regarding the types of goods covered in**
11 **international class 009. (Falic Depo. at 10)**
12

13 Mr. West objected to the question, "What's your understanding of
14 the type of goods that [class 009] covers?" because the question
15 called for legal conclusion regarding listing of goods. "If a witness
16 is not testifying as an expert, testimony in the form of an opinion is
17 limited to one that is not based on...specialized knowledge within the
18 scope of FRE 702" (FRE 701(c)). The question called for a legal
19 conclusion as to the specific goods in a class under the Trademark
20 Manual of Examining Procedure, and as the witness has no specialized
21 training in the law, he cannot provide a legal opinion on this issue.
22 Therefore, the objection should be sustained.

23
24 **4.1.2.3 Objection to Mr. Kaplan's question**
25 **regarding whether Applicant had an intent to use**
26 **its mark in conjunction with consumer**
27 **electronics. (Falic Depo. at 11)**
28

1 Mr. West objected to the question, "did Hard Candy have an intent
2 to use its Hard Candy trademark in the category of consumer
3 electronics?" because the question called for legal conclusion as to
4 the determination of "intent." "If a witness is not testifying as an
5 expert, testimony in the form of an opinion is limited to one that is
6 not based on...specialized knowledge within the scope of FRE 702" (FRE
7 701(c)). The question called for a legal conclusion as to the issue of
8 "intent to use," and as the witness has no specialized training in the
9 law, he cannot provide a legal opinion on this issue. Therefore, the
10 objection should be sustained. Moreover, the testimony is irrelevant
11 because it is related to an application for consumer electronics which
12 has now been withdrawn.

13
14 **4.1.2.4 Objections to Mr. Kaplan's questions**
15 **regarding whether Applicant had a bona fide to**
16 **use its mark in conjunction with leather goods**
17 **and purses. (Falic Depo. at 13)**
18

19 Mr. West objected to the questions, "did Hard Candy have a bona
20 fide intent to use the mark in connection with leather goods?" and
21 "Did Hard Candy have a bona fide intent to use the mark in connection
22 with leather goods and purses when you signed and filed this
23 application in march of 2009?" because the question called for legal
24 conclusion regarding the determination of "bona fide intent." "If a
25 witness is not testifying as an expert, testimony in the form of an
26 opinion is limited to one that is not based on...specialized knowledge
27 within the scope of FRE 702" (FRE 701(c)). The question called for a
28 legal conclusion as to the issue of "bona fide intent" and as the
witness has no specialized training in the law, he cannot provide a

1 legal opinion on this issue. Therefore, the objection should be
2 sustained.

3
4 **4.1.2.5 Objection to Mr. Kaplan's question**
5 **regarding the nature of the Beanstalk proposal.**
6 **(Falic Depo. at 16)**

7
8 Mr. West objected to the question, "What did you understand the
9 proposal to be?" because the document speaks for itself. The court may
10 exclude relevant evidence if the probative value is outweighed by
11 confusing the issues or wasting time (FRE 403). The document is
12 clearly titled "Licensing Representation Proposal." Therefore, the
13 witness' interpretation of this is unnecessary and could potential
14 confuse the issues and the objection should be sustained.

15
16 **4.1.2.6 Objection to Mr. Kaplan's question**
17 **regarding a listing of products in the Beanstalk**
18 **proposal. (Falic Depo. at 16)**

19
20 Mr. West objected to the question, "Did the products include
21 handbags and purses?" because the document speaks for itself. The
22 court may exclude relevant evidence if the probative value is
23 outweighed by confusing the issues or wasting time (FRE 403). On its
24 face, the Beanstalk proposal did not include any such language.
25 Therefore, the question is irrelevant and the objection should be
26 sustained.

1 **4.1.2.7 Objection to Mr. Kaplan's question**
2 **regarding the "key items" mentioned in the**
3 **Pagonakis email. (Falic Depo. at 32)**
4

5 Mr. West objected to the question, "What did this mean as you
6 understood it, key items?" because it called for speculation as to the
7 intent of the language used in the document. A witness "may testify to
8 a matter only if evidence is introduced sufficient to support a
9 finding that the witness has personal knowledge of the matter (FRE
10 602). To answer, the witness was required to have personal knowledge
11 of the email author's intent behind the phrase "key items," which had
12 not been established. Therefore, the answer would be speculation as to
13 this intent and the objection should be sustained.
14

15 **4.1.2.8 Objection and motion to strike Mr. Kaplan's**
16 **attempt to move into evidence Applicant's Exhibit**
17 **No. 13. (Falic Depo. at 37)**
18

19 Mr. West objected to the introduction of this document into
20 evidence on the grounds that the Court had already ruled that no
21 additional discovery could be provided by Applicant. This objection
22 applies to all questions related to this exhibit. During the TTAB
23 proceedings, the Interlocutory Attorney ruled that "applicant has no
24 other documents other than those already produced to oppose, which
25 could be used to demonstrate that at the time the subject applications
26 were filed, applicant had a bona fide intent to use the mark HARD
27 CANDY in commerce with the goods identified in the involved
28 applications" (TTAB Order dated December 9, 2013). Under TMBP §527.01
(e), Opposer must file a motion to strike the introduced evidence.

1 Wherefore, Opposer objects and moves to strike the document and any
2 testimony related to the document.

3
4 **4.1.2.9 Objection to Mr. West's question regarding**
5 **the list of goods for the current '557**
6 **application. (Falic Depo. at 41-42)**
7

8 Mr. Kaplan objected to the question, "And this document that you
9 are looking at, Opposer's Exhibit B, it lists the current
10 application...for the Hard Candy mark with the goods, leather goods,
11 namely backpacks, leather bags, suitcases, wallets, leather cases,
12 leather handbags, leather key chains, leather pouches, traveling bags
13 and purses, correct?" on the grounds that the document speaks for
14 itself and lack of foundation. The court may exclude relevant evidence
15 if the probative value is outweighed by confusing the issues or
16 wasting time (FRE 403). A witness "may testify to a matter only if
17 evidence in introduced sufficient to support a finding that the
18 witness has personal knowledge of the matter (FRE 602). The witness'
19 answer is relevant because it goes to demonstrating Applicant's
20 knowledge of the contents of the document, and, since the witness was
21 responsible for the filing of the application shown, it had been
22 established that he had personal knowledge of the matter. Therefore,
23 this objection should be overruled.

24
25 **4.1.2.10 Objections to Mr. West's questions**
26 **regarding the description of goods for the**
27 **current '557 application. (Falic Depo. at 42-43)**
28

1 Mr. Kaplan objected to the question, "Does the document
2 accurately reflect the current description of the goods and services
3 on the pending application serial number 77700557?" and subsequent
4 questions on the grounds that they called for a legal conclusion and
5 lack of foundation. "If a witness is not testifying as an expert,
6 testimony in the form of an opinion is limited to one that is not
7 based on...specialized knowledge within the scope of FRE 702" (FRE
8 701(c)). A witness "may testify to a matter only if evidence in
9 introduced sufficient to support a finding that the witness has
10 personal knowledge of the matter (FRE 602). The witness was not being
11 asked to render a legal opinion on the content of the list, but rather
12 asked if the document accurately reflected the list of goods. Further,
13 as a person responsible for filing the application, the witness would
14 have had personal knowledge as to the listed goods. Therefore, the
15 objection should be overruled.

16
17 **4.1.2.11 Objections to Mr. West's questions**
18 **regarding any goods listed in the Beanstalk**
19 **proposal. (Falic Depo. at 44)**
20

21 Mr. Kaplan objected to the question, "And looking through the
22 document nowhere in the document does it list leather goods, correct?"
23 on the grounds that the document speaks for itself. The court may
24 exclude relevant evidence if the probative value is outweighed by
25 confusing the issues or wasting time (FRE 403). The question addresses
26 the witness' knowledge of the contents of the document, rather than
27 the contents of the document itself. Therefore, the testimony is
28 relevant and the objection should be overruled.

1 **4.1.2.12**Objection and motion to strike the witness'
2 **answers to the question regarding any goods**
3 **listed in the Beanstalk proposal. (Falic Depo. at**
4 **44-47)**

5
6 Mr. West objected to the witness' answers to the question,
7 "nowhere in the document does it list leather goods, correct?" because
8 the witness did not answer the question posed. Additionally, Opposer
9 moves to strike the answer as the witness testified without answering
10 the question posed. Therefore, the answer should be stricken.

11
12 **4.1.2.13**Objection to Mr. West's question regarding
13 **whether the Beanstalk document included the words**
14 **"leather goods" (Falic Depo. at 45)**

15
16 Mr. Kaplan objected to the question, "the document does not
17 include the word leather goods, correct?' on the grounds it was asked
18 and answered. The court may exclude relevant evidence if the probative
19 value is outweighed by confusing the issues or wasting time (FRE 403).
20 The witness' answer to this question is directly relevant to the
21 intent to use the mark in conjunction with these specific goods.
22 Therefore, a specific answer to the question is admissible and the
23 objection should be overruled.

24
25 **4.1.2.14**Objections to Mr. West's question regarding
26 **whether the Beanstalk proposal listed "leather**
27 **bags" (Falic Depo. at 45)**

1 Mr. Kaplan objected to the question, "the document does not list
2 leather bags, correct?" on the grounds that the document speaks for
3 itself. The court may exclude relevant evidence if the probative value
4 is outweighed by confusing the issues or wasting time (FRE 403). The
5 witness answer to this question goes to the intent to use the mark in
6 conjunction with these specific goods at the time of filing.
7 Therefore, the answer to the question is admissible and the objection
8 should be overruled.

9
10 **4.1.2.15 Objections to Mr. West's questions**
11 **regarding specific items from the listed goods in**
12 **the '557 application not mentioned in the**
13 **Beanstalk proposal. (Falic Depo. at 45-47)**
14

15 Mr. Kaplan objected to the questions whether the goods in '557
16 application are listed in the Beanstalk proposal on the grounds that
17 the document speaks for itself. The court may exclude relevant
18 evidence if the probative value is outweighed by confusing the issues
19 or wasting time (FRE 403). The witness answer to this question goes to
20 the intent to use the mark in conjunction with these specific goods at
21 the time of filing because it relates the document, which Applicant is
22 attempting to use to show this intent, to the goods listed in the
23 application. Therefore, the answer to the question is admissible and
24 the objection should be overruled.

25
26 **4.1.2.16 Objections to Mr. West's question regarding**
27 **previous e-mails relating to the Beanstalk**
28 **proposal. (Falic Depo. at 47)**

1 Mr. Kaplan twice objected to the question, "so you have no record
2 of those e-mails, correct?" on the grounds of vagueness and ambiguity.
3 "Evidence is relevant if the fact is of consequence in determining the
4 action" (FRE 401(b)). The question specifically relates to an
5 introduced document and seeks information directly related to its
6 content and Applicant's alleged bona fide intent Therefore, the
7 question is relevant and the objections should be overruled.

8
9 **4.1.2.17 Objections to Mr. West's question regarding**
10 **requests for production of previous e-mails**
11 **relating to the Beanstalk proposal. (Falic Depo.**
12 **at 48)**

13
14 Mr. Kaplan objected to the question, "Were you asked to locate
15 those documents?" on the grounds of lack of foundation. A witness "may
16 testify to a matter only if evidence is introduced sufficient to
17 support a finding that the witness has personal knowledge of the
18 matter (FRE 602). The witness' answer is admissible because it goes to
19 proving Applicant's lack of documentary evidence to prove its alleged
20 bona fide intent. Therefore, the objection should be overruled.

21
22 **4.1.2.18 Objection to Mr. West's question regarding**
23 **Applicant's licensee list. (Falic Depo. at 49)**

24
25 Mr. Kaplan objected to the question, "there are additional
26 licensees that are not on this list?" on the grounds of having been
27 asked and answered, as well as vagueness and ambiguity. The court may
28 exclude relevant evidence if the probative value is outweighed by
confusing the issues or wasting time (FRE 403). "Evidence is relevant

1 if the fact is of consequence in determining the action" (FRE 401(b)).
2 The witness' answer goes to demonstrating a lack of licensees in the
3 area covered by the listed goods in the application. Therefore, it is
4 relevant to disproving Applicant's claim of bona fide intent and the
5 objection should be overruled.

6
7 **4.1.2.19 Objections to Mr. West's question regarding**
8 **Applicant's licensee list. (Falic Depo. at 50)**

9
10 Mr. Kaplan objected to the question, "Hard Candy has additional
11 licensees that are not listed on Opposer's Exhibit F entitled Hard
12 Candy licensee list; is that correct?" on the grounds of lack of time
13 frame. "Evidence is relevant if the fact is of consequence in
14 determining the action" (FRE 401(b)). The question can reasonably be
15 related to the relevant time frame of the proceedings. Therefore, the
16 objection should be overruled.

17
18 **4.1.2.20 Objections to Mr. West's question regarding**
19 **any mention of leather goods in Applicant's**
20 **licensee list (Falic Depo. at 50)**

21
22 Mr. Kaplan objected to the question, "In this document anywhere
23 does it list leather backpacks?" on the grounds that the document
24 speaks for itself. The court may exclude relevant evidence if the
25 probative value is outweighed by confusing the issues or wasting time
26 (FRE 403). The witness' answer goes to Applicant's knowledge of the
27 contents of the licensee list, which relates to Applicant's bona fide
28 intent at the time of filing. Therefore, the objection should be
overruled.

1 **4.1.2.21**Objection to Mr. West's question regarding
2 **whether suitcases are handbags (Falic Depo. at**
3 **51)**

4
5 Mr. Kaplan objected to the question, "So you are stating that you
6 believe suitcases are handbags?" on the grounds that the question was
7 asked and answered. The court may exclude relevant evidence if the
8 probative value is outweighed by confusing the issues or wasting time
9 (FRE 403). The question was not repetitive of other questions because
10 it specifically inquired about "suitcases and handbags," which could
11 reasonably lead to evidence disproving Applicant's lack of bona fide
12 intent to use the mark with this line of products. Therefore, the
13 objection should be overruled.

14
15 **4.1.2.22**Objection to Mr. West's question regarding
16 **the status of a license with the Accessory**
17 **Exchange (Falic Depo. at 52)**

18
19 Mr. Kaplan objected to the question, "So as of the date of this
20 document, there was not an active license with the accessory
21 exchange?" on the grounds of a lack of time frame. "Evidence is
22 relevant if the fact is of consequence in determining the action" (FRE
23 401(b)). The question can reasonably be related to the relevant time
24 frame of the proceedings and goes to disproving Applicant's claim of
25 bona fide intent at the time of filing. Therefore, the objection
26 should be overruled.

27
28 **4.1.2.23**Objections to Mr. West's question regarding
 the inclusion of "tangible products" in

1 **Applicant's presentation (Ex.4) . (Falic Depo. at**
2 **53)**

3
4 Mr. Kaplan objected to the question, "and that presentation did
5 not as of the date of this document include tangible products, did
6 it?" on the grounds of vagueness and ambiguity. "Evidence is relevant
7 if the fact is of consequence in determining the action" (FRE 401(b)).
8 The witness' testimony here goes to the question of whether Applicant
9 had any actual products at the time of filing, which is related to a
10 finding of bona fide intent. Therefore, the answer is relevant and the
11 objection should be overruled.

12
13 **4.1.2.24 Objections to Mr. West's question regarding**
14 **the depicted product in "tangible form." (Falic**
15 **Depo. at 58-59)**

16
17 Mr. Kaplan objected to the question "so the product as depicted
18 did not exist in tangible form?" on the grounds of vagueness and
19 ambiguity. "Evidence is relevant if the fact is of consequence in
20 determining the action" (FRE 401(b)). Again, the answer to this
21 question provides evidence as to whether Applicant had developed any
22 actual product at the time of filing and directly relates to a finding
23 of bona fide intent. Therefore, the answer is relevant and the
24 objection should be overruled.

25
26 **4.1.2.25 Objections to Mr. West's questions**
27 **regarding the dates of documents presented by**
28 **Applicant. (Falic Depo. at 67-68)**

1 Mr. Kaplan objected to the question, "all the documents that we
2 have looked at during the entire testimony, there is only one document
3 that existed prior to 3/26/2009?" on the grounds that the document
4 (the Beanstalk proposal) speaks for itself. Mr. Kaplan further
5 objected that the line of questioning was vague and ambiguous and also
6 objected on the grounds that the witness did not "have the exhibits in
7 front of him." "Evidence is relevant if the fact is of consequence in
8 determining the action" (FRE 401(b)). The question goes directly to
9 establishing that Applicant has provided only one document to support
10 its claim of bona fide intent at the time of filing. Therefore, the
11 answer is relevant and admissible.

12
13 **4.2 Lack of Bona Fide Intent-to-Use**

14 **4.2.1 APPLICANT LACKED ANY BONA FIDE INTENT TO USE THE MARK**
15 **IN CONJUNCTION WITH THE LISTED GOODS AT THE TIME OF**
16 **FILING AND REGISTRATION MUST BE DENIED DUE TO THIS**
17 **INEQUITABLE CONDUCT.**

18
19 **4.2.1.1 Applicant has failed to produce adequate evidence**
20 **to support its bona fide intent to use the mark,**
21 **providing sufficient grounds for proving inequitable**
22 **conduct and denying registration.**

23
24 An applicant for a trademark may file without immediately
25 demonstrating use in commerce by filing under an "intent-to-use"
26 application. However, the applicant must possess a "bona fide
27 intention, *under circumstances showing the good faith.*" 15 USC
28 §1051(b) (1) (emphasis added). Although Applicant has asserted a good-
faith intention in filing the '557 application in the present case, it

1 has failed to provide any objective evidence of the circumstances to
2 prove it (App. Response to Motion to Compel, page 4, paragraph 3),
3 which supports a finding of inequitable conduct and requires that
4 registration be denied.

5
6 **4.2.1.2 Applicant's produced documents are insufficient**
7 **to support Applicant's claim of bona fide intent, and**
8 **registration must be denied due to this lack of**
9 **intent.**

10
11 Documentary evidence can include "product or service research or
12 development, market research, manufacturing activities, promotional
13 activities, steps to acquire distributors, steps to obtain
14 governmental approval, or other similar activities." T.M.R.P. Rule
15 2.89(d) (See also *PRL USA Holdings Inc. v. Rich C. Young*, *Opp. No.*
16 *91206856*). To support its claim of bona fide intent prior to or at the
17 time of filing, Applicant has produced a solitary document: a
18 "Licensing Representation Proposal" (Opp. Exh. D). The Licensing
19 Representation Proposal mentions two strategic partnership approaches.
20 The first approach, scenario A, assumes Walmart will, "...offer us the
21 opportunity to develop a cross-departmental strategy to present to
22 Walmart, even before the goods hit the Walmart floor. Following the
23 development of the Hard Candy brand positioning and design aesthetic
24 (discussed in further detail below). Beanstalk professionals will
25 prepare and present a compelling sell-in to Walmart in the agreed upon
26 additional categories." (Opp. Exhibit D, Page 4, first paragraph.)
27 The second approach, scenario B, referenced in the Licensing
28 Representation Proposal assumes, "Walmart chooses not to proceed with
a test or that the *cosmetics* test at Walmart is not a success, in

1 conjunction with Nu World or with an entirely new *cosmetics* partner..."
2 (Opp. Exhibit D, Page 4, second paragraph.) (emphasis added).

3 Applicant's trademark application, the '557 application, lists
4 the following goods in the description; leather goods, namely,
5 backpacks, leather bags, suitcases, wallets, leather cases, leather
6 handbags, leather key chains, leather pouches, traveling bags, purses.
7 (Appl. Serial No. 77700557.)

8 The Licensing Representation Proposal does not mention leather
9 goods. (Opp. Exh. D; Falic Depo, page 45, lines 8-12.)

10 The Licensing Representation Proposal does not mention backpacks.
11 (Opp. Exh. D; Falic Depo, page 46, lines 18-19.)

12 The Licensing Representation Proposal does not mention leather
13 bags. (Opp. Exh. D; Falic Depo, page 45, lines 14-18.)

14 The Licensing Representation Proposal does not mention suitcases.
15 (Opp. Exh. D; Falic Depo, page 47, lines 2-4.)

16 The Licensing Representation Proposal does not mention wallets.
17 (Opp. Exh. D; Falic Depo, page 47, lines 5-6.)

18 The Licensing Representation Proposal does not mention leather
19 cases. (Opp. Exh. D; Falic Depo, page 47, lines 7-8.)

20 The Licensing Representation Proposal does not mention leather
21 handbags. (Opp. Exh. D; Falic Depo, page 47, lines 9-10.)

22 The Licensing Representation Proposal does not mention leather
23 key chains. (Opp. Exh. D; Falic Depo, page 47, lines 11-12.)

24 The Licensing Representation Proposal does not mention leather
25 pouches. (Opp. Exh. D; Falic Depo, page 47, lines 13-14.)

26 The Licensing Representation Proposal does not mention traveling
27 bags. (Opp. Exh. D; Falic Depo, page 47, lines 15-16.)

28 The Licensing Representation Proposal does not mention purses.
(Opp. Exh. D; Falic Depo, page 47, lines 17-18.) Moreover, the term

1 leather is not present in the Licensing Representation Proposal. (Opp.
2 Exh. D.) Finally, the Licensing Representation Proposal is merely a
3 proposal and was never executed. (Opp. Exh. D; Falic Depo, page 44,
4 lines 2-7.) Therefore, this single, third-party document is
5 insufficient to demonstrate Applicant's good faith intent to use the
6 HARD CANDY mark in conjunction with any of the goods listed in
7 Applicant's '557 trademark application.

8
9 This sole document only includes information regarding
10 preliminary potential development of plans rather than any actual
11 plans by Applicant to use the mark. (Opp. Exh. D.) From this document,
12 it appears that Applicant was at the stage of determining the markets
13 in which to extend its brand, and therefore could not have had an
14 intention to specifically go into "leather goods." (Opp., Exh. D.)
15 Further, the agreement was never executed and Applicant did not engage
16 and did not hire Beanstalk for this matter (Falic deposition, Page 17,
17 Line 21.). In other words, it does not even prove that Applicant had a
18 plan in place to research potential brand expansion, let alone
19 expansion into "leather goods." (Opp. Exh. D.) Thus, this document
20 fails to meet any of the criteria set forth in T.M.R.P. Rule 2.89(d)
21 and, therefore, cannot be used to support Applicant's claim of bona
22 fide intent and registration of Applicant's mark must be denied.

23
24 In addition to documentary evidence supporting intent, an
25 applicant must also specifically show the "existence of an *ability* and
26 willingness to use the mark in the United States to identify [the
27 goods in the application]." *Honda Motor Co., Ltd. v. Friedrich*
28 *Winkelmann*, 90 U.S.P.Q.2d 1660 (TTAB 2009) (emphasis added). Applicant
has failed to produce evidence of any existing products or any proof

1 of even the intent to manufacture the listed goods that could
2 demonstrate this ability to use the mark as of the filing date. (App.
3 Exh. 1-13.) Applicant produced images of sample products, namely
4 purses, wallets and cases, within the scope of the listed goods, but
5 these were dated after the filing date of March 27, 2009; the first of
6 which is dated six months after filing (App. Exh. 1-13, specifically
7 Exhs. 4 and 11). Further, according to the emails produced by
8 Applicant, Applicant did not get manufacturing prices for iPad and
9 iPhone cases until November 19, 2012, over three-and-a-half years
10 after filing the application. (Falic deposition, page 60, lines 5-11.
11 App. Exh. 11, Bates numbers HC000138-HC000143.) The produced
12 documents are untimely with regard to demonstrating Applicant's bona
13 fide intent, specifically the ability to manufacture, at the time of
14 filing. If anything, the produced documents show a pattern of delay by
15 Applicant in producing the goods listed in the application. Therefore,
16 Applicant has also failed to provide the requisite documentary
17 evidence showing the ability to use the mark in commerce at the time
18 of filing, again providing grounds to refuse registration of
19 Applicant's mark. (App. Exhs. 1-13.)

20
21 Due to the inadequacy of Applicant's produced documents,
22 Applicant has no corroborative evidence to support its claim of bona
23 fide intent. Mere statements and assertions of intent without
24 corroborative evidence are insufficient to support a claim of bona
25 fide intent to use. *Lane Ltd. v. Jackson International Trading Co.*, 33
26 *USPQ2d* 1351 (TTAB 1994) and *L.C. Licensing Inc. v. Berman*, 86 *USPQ2d*
27 *1883* (TTAB 2008). Opposer made several requests for this documentation
28 during the course of these proceedings, to no avail. (Opp. Motion to
Compel filed June 25, 2013.) Further, in response Opposer's Motion to

1 Compel (filed June 25, 2013), Applicant unequivocally stated, "no
2 further responsive, non-privileged documents have been located
3 therefore there is nothing to compel." (Applicant's Response to Motion
4 to Compel (filed July 15, 2013), page 4). Moreover, the Board
5 indicated in its December 9, 2013 ruling that, "[s]hould applicant
6 seek to introduce other documents to demonstrate its bona fide intent
7 to use the mark HARD CANDY which were not previously produced and
8 should have been, opposer's remedy lies in the filing of a motion to
9 strike." (TTAB ruling on Motion to Compel dated December 9, 2013,
10 Page 7, footnote 3.) Therefore, Applicant has admitted that it does
11 not have any other documents beyond those produced for Opposer to
12 demonstrate that it had a bona fide intent at the time of filing.
13 (Applicant's Response to Motion to Compel (filed July 15, 2013), page
14 4.) Although Applicant asserts that it filed the application in good
15 faith, this is simply not enough without corroborative documentation
16 to support it, and Applicant has stated that no such documentation
17 exists. (Applicant's Response to Motion to Compel (filed July 15,
18 2013), page 4.) Therefore, Applicant did not have a bona fide intent
19 at the time of filing and Applicant's mark cannot register.

20
21 ***4.2.1.3 Applicant's absence of adequate documentation is***
22 ***sufficient proof of Applicant's lack of bona fide***
23 ***intent at the time of filing and grounds for denying***
24 ***registration.***

25
26 In the absence of documentation to prove a claim of bona fide
27 intent, the burden of proof shifts from Opposer to Applicant, and
28 Applicant must then come forward with evidence to explain the failure
to provide the evidence. *Boston Red Sox Baseball Club LP v. Sherman,*

1 88 USPQ2d 1581 (TTAB2008), citing *Commodore Electronics Ltd. V. CBM*
2 *Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). By failing to
3 produce the requisite documentation to prove bona fide intent when
4 repeatedly requested by the Opposer, Applicant has placed itself in
5 the position of requiring Applicant to produce evidence to explain the
6 absence of documents that demonstrate an actual bona fide intent to
7 use. Applicant was given an opportunity to provide evidence to explain
8 the lack of documentation, and again Applicant has produced nothing
9 dated prior to March 27, 2009 other than the Beanstalk contract. (App.
10 Exhs. 1-13.)

11
12 Applicant's Exhibit 4 is dated October 7, 2009 and is therefore
13 not capable of demonstrating Applicant's bona fide intent to use the
14 mark at the time of filing.

15 Applicant's Exhibit 5 is dated May 24, 2010 and is therefore not
16 capable of demonstrating Applicant's bona fide intent to use the mark
17 at the time of filing.

18 Applicant's Exhibit 6 was executed August 16, 2010 and August 17,
19 2010 and is therefore not capable of demonstrating Applicant's bona
20 fide intent to use the mark at the time of filing.

21 Applicant's Exhibit 7 is dated August 2, 2011 and is therefore
22 not capable of demonstrating Applicant's bona fide intent to use the
23 mark at the time of filing.

24 Applicant's Exhibit 8 is dated August 3, 2011 and is therefore
25 not capable of demonstrating Applicant's bona fide intent to use the
26 mark at the time of filing.

27 Applicant's Exhibit 9 is dated October 19, 2011 and is therefore
28 not capable of demonstrating Applicant's bona fide intent to use the
mark at the time of filing.

1 Applicant's Exhibit 10 is dated November 8, 2012 and is therefore
2 not capable of demonstrating Applicant's bona fide intent to use the
3 mark at the time of filing.

4 Applicant's Exhibit 11 is dated November 19, 2012 and is
5 therefore not capable of demonstrating Applicant's bona fide intent to
6 use the mark at the time of filing.

7 Applicant's Exhibit 12 is dated July 30, 2012 and is therefore
8 not capable of demonstrating Applicant's bona fide intent to use the
9 mark at the time of filing.

10 Applicant moves to strike Applicant's Exhibit 13 since it was not
11 provided to Opposer in response to the discovery requests.

12
13 Applicant has failed to produce required documentary evidence to
14 support its claim of bona fide intent or provide any explanation for
15 the absence of this documentation. (App. Exhs. 1-13.) Absence of
16 documentary evidence regarding bona fide intent "constitutes objective
17 proof sufficient to prove that the applicant lacks a bona fide
18 intention to use its mark in commerce." *Boston Red Sox Baseball Club*
19 *LP v. Sherman, 88 USPQ2d 1581 (TTAB2008)*. Further, "absent other facts
20 which adequately explain or outweigh the failure of an applicant to
21 have any documents supportive of or bearing upon its claimed intent to
22 use its mark in commerce, the absence of any documentary evidence on
23 the part of an applicant regarding such intent is sufficient to prove
24 that the applicant lacks a bona fide intention to use its mark in
25 commerce." *Commodore Electronics Ltd. V. CBM Kabushiki Kaisha, Id.* By
26 failing to provide Opposer with neither adequate documentation of its
27 bona fide intent to use the mark, nor any information to explain this
28 failure, Applicant has provided the proof that it lacked any bona fide
intent to use the HARD CANDY mark in conjunction with the "leather

1 goods" listed in the application. (App. Exhs. 1-13.) Therefore,
2 Applicant lacked the requisite bona fide intent at the time of filing
3 and Applicant should be denied registration.
4

5 **4.2.2 Applicant has demonstrated a pattern and practice of**
6 **filing trademark applications that never proceed to**
7 **registration, further supporting a finding of lack of**
8 **bona fide intent in the present case and calling for**
9 **rejection of Applicant's mark.**

10 ***4.2.2.1 Applicant's history of trademark filings***
11 ***and actions in the present case indicate a***
12 ***pattern and practice of filing applications that***
13 ***lack a bona fide intent, providing further proof***
14 ***that registration must be denied due to***
15 ***Applicant's inequitable conduct.***
16

17
18 In *Salacuse v. Ginger Spirits*, the Board addressed whether an
19 Applicant's trademark filing history is relevant to proving a lack of
20 bona fide intent in a particular case. *Salacuse v. Ginger Spirits*, 44
21 *U.S.P.Q.2d 1415 (TTAB 1997)*. While considering petitioner's motion
22 for summary judgment in *Salacuse v. Ginger Spirits*, the Board found
23 that the evidence of the volume of intent-to-use applications filed
24 for the mark for "a wide variety of goods ranging from food and
25 beverages to luggage to furniture to motor vehicles" presented a
26 genuine issue of material fact relating to petitioner's bona fide
27 intent. (*Id*). In its decision, the Board described the types of
28 evidence found in an applicant's trademark filing history that can be
used to prove a lack of bona fide intent:

1
2 "For example, the applicant may have filed numerous
3 intent-to-use applications to register the same mark for
4 many more new products than are contemplated,

5
6 numerous intent-to-use applications for a variety of
7 desirable trademarks intended to be used on [a] single
8 new product,

9
10 numerous intent-to-use applications to register marks
11 consisting of or incorporating descriptive terms
12 relating to a contemplated new product,

13
14 numerous intent-to-use applications which have lapsed
15 because no timely declaration of use has been filed,

16
17 an excessive number of intent-to-use applications to
18 register marks which ultimately were not actually used,

19
20 an excessive number of intent-to-use applications in
21 relation to the number of products the applicant is
22 likely to introduce under the applied-for marks during
23 the pendency of the applications,

24
25 or applications unreasonably lacking in specificity in
26 describing the proposed goods.

27
28 Other circumstances may also indicate the absence of
genuine bona fide intent to actually use the mark.

1 *Salacuse v. Ginger Spirits, Id.*, citing 86 S. REP. No.
2 100-515, at 23-24, 2d Sess. (1988).”

3
4 Applicant’s own filing history reflects this list. Of the more
5 than 130 trademark applications that Applicant has filed since, at
6 least, 1997, only twenty-one (less than 20%) have proceeded to
7 registration. (Opp. Notice of Reliance Exhs. A-AW5.) Forty-three (one-
8 third) of these applications have been abandoned, often for failing to
9 file a statement of use after the maximum time has passed to do so by
10 exhausting the three years of extension requests to file a statement
11 of use. (Opp. Notice of Reliance Exhs. A-AW5.) The vast number of
12 abandoned applications factually memorializes Applicant’s regular
13 practice of egregiously seeking to extend the reach of its mark into
14 areas well beyond the scope of its immediate business interests.

15
16 The basic tenet of trademark protection is the freedom to
17 operate commercially and protect legitimate trademark use. Applicant
18 is a large company while Opposer is comparatively small. Naturally,
19 being a large company, Applicant has greater financial resources to
20 suppress smaller companies with a smaller budget. Applicant has
21 engaged in a practice of hindering and bullying legitimate trademark
22 holders, such as Opposer, from freely using their marks. Applicant has
23 driven up costs for Opposer and others to fight for the free use of
24 their marks in commerce, making opposition efforts financially
25 impractical. Applicant’s activity in the present case is yet another
26 example of Applicant’s oppressive practices to prevent others from
27 properly using their marks and conduct business.

1 At the outset of these proceedings, the present case involving
2 the '557 application had been consolidated with a second case
3 concerning the '559 filing (HARD CANDY in conjunction with "electronic
4 products" in IC 009). (Opp. Notice of Opposition filed June 16, 2010.)
5 However, after almost four years, Applicant abruptly moved to withdraw
6 Application Serial No. 77/700559 without prejudice (App. Motion to
7 Withdraw filed January 1, 2014) and without Opposer's consent,
8 resulting in a default judgment against Applicant. (TTAB ruling dated
9 February 5, 2014 on Motion to Withdraw) Meanwhile, Applicant had filed
10 another intent-to-use application (Appl. Serial No. 86087168) for the
11 similar mark HARD CANDY VINTAGE for use with the identical list of
12 goods in the '559 application, except for the addition of eyewear,
13 which Applicant failed to disclose. Opposer had to spend several years
14 fighting against an application that Applicant never intended to use,
15 as demonstrated by the lack of any evidence showing a bona fide
16 intent to use. This maneuvering illustrates Applicant's established
17 pattern of bad-faith attempts to inappropriately monopolize its own
18 marks to the detriment of legitimate applicants.

19
20 Applicant's history of trademark filings and abandonments
21 illustrates Applicant's pattern and practice of filing frivolous
22 trademark applications in an effort to suppress legitimate trademark
23 applicants from freely using their own marks in commerce. Further,
24 Applicant's actions in the present and formerly related case
25 demonstrate Applicant's intentions to improperly extend its marks.
26 Therefore, to prevent any further abuse of the trademark system by
27 Applicant, the application in the present case must be denied.

CERTIFICATE OF SERVICE

IT IS HEREBY CERTIFIED that a true and correct copy of:

OPPOSER'S TRIAL BRIEF

was served on this 9th day of June, 2014, by First Class Mail to:

Coffey Burlington
c/o Gabriel Groisman
2699 South Bayshore Drive
Penthouse
Miami, FL 33133


Dawn Callender
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