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

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| Proceeding | 91205896 |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Opposition Proceeding 91205896

In the matter of Trademark Application No. 85509929

For the mark: DIZZY

Published for Opposition Date: June 5, 2012

Beau Tardy ('Tardy'), Opposer

v.

Wild Brain Entertainment, Inc. ('Wild Brain'), Applicant

OPPOSER'S (NON-CONFIDENTIAL) TRIAL BRIEF

Opposer Beau Tardy, hereby files this brief in support of its opposition to Applicant, Wild Brain's Application No. 85509929 for the mark DIZZY.

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I. PRELIMINARY STATEMENT/ISSUES FOR REVIEW

Only one ground for opposition was maintained throughout the proceeding (lack of bona fide intent-to-use in commerce at the time of the application). There were no affirmative defenses pleaded by Applicant.

Applicant cannot satisfy the threshold question of establishing it had a bona fide intent to use the mark in commerce at the time of its application or since. Other than prosecution documents for the subject application and documents relating to another mark (UMIGO), there is no documentary evidence reflecting any bona fide efforts by Applicant to begin use of the DIZZY mark in commerce for any goods and specifically not the goods in this application.

No facts have been propounded by Applicant which adequately explain or outweigh the failure to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce. Precedent holds that the failure to show bona fide intent-to-use of any good in the class renders the entire Class, and in turn the entire application, void ab initio.

Numerous other USPTO records concerning this same Applicant cast doubt on this application, and many other applications by same Applicant where the Section 1(b) applications were abandoned before filing a statement of use.

The Lanham Act does not support the actions of a party to simply reserve a mark with an intent-to-use application without demonstrating objective steps towards commercial use of the mark. This application along with the other abandoned DIZZY applications present a

perfect example of a party “reserving a mark” with a long wish list of goods without any bona fide intention to actually use the mark for the applied-for goods or services.

As Applicant has produced no documentary evidence supporting any intent to use the mark, and because Applicant cannot overcome this lack of documentary evidence by pointing to concrete and objective steps toward actual commercial use of the applied-for mark, Applicant’s mark should be refused registration.

II. INTRODUCTION

A. BEAU TARDY

As pleaded in the Notices of Opposition, DIZZY is the brand name owned by Beau Tardy as an individual and as several business entities continuously, substantially exclusively, openly and obviously throughout the years 1996 to present (2016). The DIZZY name is and has been a company name, merchandise, pop culture websites, cartoon character, TV show, comics, and web streaming entertainment. Dizzy went from being the name of a business that provided production services, to a brand on its own.

B. WILD BRAIN ENTERTAINMENT INC.

No information regarding the Applicant’s business or use of the mark DIZZY in commerce is in the record.

C. PROCEDURAL INFORMATION

Wild Brain Entertainment Inc. (“Applicant”) filed an intent-to-use application SN 85509929 to register DIZZY in standard characters on the Principal Register for: *Electrical and scientific apparatus, namely, electronic game software; computer game software; downloadable computer games; computer and video-game cassettes, cartridges, discs and programs; downloadable game software; motion picture films featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; pre-recorded video and audio cassettes, video and audio tapes, video and audio discs, CD ROMs, compact discs, digital versatile discs, musical video recordings, musical sound recordings and phonograph records featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; software and manuals sold as a unit in the field of children's education, namely, for use in creating, updating and maintaining calendars, for information management and for use as computer screen savers; decorative refrigerator magnets; hand held units for playing electronic games for use with external display screen or monitor* in International Class 9.

On July 3, 2012, Beau Tardy (“Opposer”) opposed registration under Section 2(d) and because the application was “[t]oo similar to a brand name and cartoon character already in use that has received wide public attention, including being broadcast on national TV and was originally trademarked.”

On February 1, 2013 the Second Amended Notice of Opposition (15 TTABVUE) became the operative Notice and added Lack of Bona Fide Intent-to-Use under Section 1(b) as a ground for opposition.

The Fourth Amended Notice of Opposition (32 TTABVUE), which withdrew Opposer's Section 2(d) claim, became the operative notice on February 12, 2014.

Applicant, in its answers, denied most of the salient allegations in the Notices of Opposition while at the same time making specific admissions. These specific admissions are listed in the undisputed facts section of this brief.

Applicant did not continue with any of the affirmative defenses that were listed in the original answer 4 TTABVUE in later pleadings. Applicant did not seek to amend the list of goods to a smaller set on which to claim that it had bona fide intent-to-use.

III. DESCRIPTION OF THE RECORD

The evidence of record consists of:

- (1) The pleadings and the file history of the subject application;
- (2) Opposer's U.S. Trademark Application;
- (3) Portions of Applicant's responses to Opposer's First and Second Sets of Discovery Requests and Admissions; Opposer's Requests for Production of Documents and
- (4) Internet materials (dizzythecat.com website amongst others) submitted with Opposer's Notice of Reliance;

(5) Abandoned applications of Applicant that were abandoned after no Statement of Use was filed;

(6) One Notice of Reliance at 64 TTABVUE submitted by Applicant with status copies of registrations for UMIGO (RNs 4358390 and 4335252); a status copy of a registration for WILD BRAIN (RN 2625527); and a fourth document, a status copy of the cancelled registration RN 2729703 for POOCHINI.

IV. STATEMENT OF FACTS

- 1: Applicant admits in its first answer at 4 TTABVUE 3 that Opposer has cartoons dating from 2006 on his website dizzythecat.com. Applicant produced two pages from the site at 4 TTABVUE 26-27.
- 2: Applicant admits it has not offered any of the goods listed in the subject application for sale to the public under the involved mark, DIZZY. (38 TTABVUE 4, ¶8).
- 3: Applicant admits that on Sept. 2, 2013, the Office deemed U.S. Application No. 85509933 [DIZZY IC 28] to have been abandoned because no Statement of Use or Request for an Extension of Time to File a Statement of Use was received by the Office following the issuance of the Notice of Allowance. (38 TTABVUE 3, ¶5.c.)
- 4: Applicant admits that on Sept. 2, 2013, the Office deemed U.S. Application No. 85509926 (DIZZY IC 16] to have been abandoned because no Statement of Use or Request for an Extension of Time to File a Statement of Use was received by the Office following the issuance of the Notice of Allowance. (38 TTABVUE 3-4, ¶5.d.)

- 5: Applicant admits that when it submitted the subject application for DIZZY in IC 9 it had no projected first use date for hand held units for playing electronic games for use with external display screen or monitor. (60 TTABVUE 34-35, ¶11)
- 6: Applicant admits that when it submitted the subject application for DIZZY in IC 9 it had no licensee contracts for hand held units for playing electronic games for use with external display screen or monitor. (60 TTABVUE 35, ¶12)
- 7: Applicant admits that when it submitted the subject application for DIZZY in IC 9 it had no projected retail or wholesale prices for hand held units for playing electronic games for use with external display screen or monitor. (60 TTABVUE 35, ¶13)
- 8: Applicant admits that when it submitted the subject application for DIZZY in IC 9 it had manufacturing or distributing plans for hand held units for playing electronic games for use with external display screen or monitor. (60 TTABVUE 35, ¶14)

V. ARGUMENT

A. STANDING

Applicant does not challenge Opposer's standing in its Answer(s) at 37 TTABVUE or 38 TTABVUE. Applicant did argue Opposer's standing with regard to likelihood of confusion in its motion to compel but Applicant never amended its Answer to add any specific challenges or affirmative defenses.

Opposer is admitted as the owner of dizzythecat.com, a cartoon character, and has standing under *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750 (TTAB 2013). (As a competitor who uses the term "Annapolis Tours" as part of its domain

name, petitioner has shown that it is not a mere intermeddler, but has a real interest in this proceeding.)

DIZZY and DIZZY are identical marks. Both marks are for collateral goods in IC 9 where the goods are based on the cartoon characters from each owner which are DIZZY and DIZZY THE CAT for Opposer and DIZZY for Applicant. Opposer has a reasonable basis for a belief that he is damaged by the registration sought to be cancelled by virtue of the fact that both parties' marks are identical, and their goods are at least arguably related. *Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliigi*, 99 USPQ2d 1545 (TTAB 2011).

Opposer's refused application for DIZZY in IC 9 at 60 TTABVUE 71 and 63 TTABVUE contains various pieces of the Opposer's DIZZY puzzle that as a whole can be taken to prove Opposer's standing is that above an intermeddler. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

B. LACK OF BONA FIDE INTENT

A bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under § 1(b) of the Lanham Act. See 15 U.S.C. § 1051(b)(1) ("person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register").

Section 1(b) requires both an actual intent to use a mark in commerce and evidence, contemporary with the application, that objectively demonstrates such an intent. *Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 21 (D.C. Cir. 2008); *City of Carlsbad v. Shah*, 666 F. Supp. 2d 1159, 1163-1168 (S.D. Cal. 2009). This Board has held "absent other facts which

adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b).” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

If “there is an absence of documentary evidence showing the applicant's intent to use the mark, the burden shifts to the applicant to adequately explain that lack of documentary evidence.” *W. Brand Bobosky v. Adidas AG*, 2011 U.S. Dist. LEXIS 149611, 14-20 (D. Or. Dec. 29, 2011) (citing, *Boston Red Sox Baseball Club Ltd. P'ship v. Brad Francis Sherman*, 88 U.S.P.Q.2d 1581, 1587 (TTAB 2008)). This “emphasizes the need for ITU applicants to document their plans and intentions by means of some written business plan made in the ordinary course of trade.” J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 19:14 (4th ed. 2012).

1. Applicant Has Submitted No Contemporaneous Evidence To support its Intent to Use application, the Applicant must submit evidence demonstrating an intent to use the mark that is contemporaneous with the filing of its application. See, *Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 21 (D.C. Cir. 2008) (“The TTAB has held § 1(b) to require both actual intent to use a mark in commerce and evidence, contemporary with the application, that objectively demonstrate such an intent”).

In its responses to documents in 60 TTABVUE 54-68, Applicant identified no documents that were responsive to showing that any actions had been taken for any of the DIZZY marks to show subjective or objective intent-to-use in commerce. Other than the parts of the application that are automatically part of the record, Applicant has provided no documents to show contemporaneous intent to use DIZZY on any goods.

2. Applicant Offers No Explanation for the Lack of Documentary Evidence.
Applicant didn't take any testimony. The Board has held that the absence of any

documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

3. Applicant's Past Shows A Pattern of Lack of Bona Fide Intent-To Use.

Applicant's wish lists on prior application were also long, sometimes identical and show the intent to "leave all doors open" when filing intent-to-use applications. *SWATCH AG (SWATCH SA) (SWATCH LTD.) v. M. Z. BERGER & CO., INC.*, 108 USPQ2d 1463, 1477, n. 91 (TTAB 2013), aff'd __ F.2d __, __ USPQ2d __, No. 14-1219 (Fed. Cir. June 4, 2015). Applicant's filing and eventual abandonment of prior intent to use applications to register the mark DIZZY for other goods and to register the same goods under other marks indicate a strong and repeated pattern of willful misrepresentation along with a repeated pattern of lack of bona fide intent. (See the status reports for the applications in this chart at 61 TTABVUE 3-49.)

| SN | MARK | LIVE OR DEAD STATUS | GOODS |
|----------|-------|---------------------|---|
| 85509930 | DIZZY | DEAD | Clothing, namely, shirts, t-shirts, sweatshirts, sweaters, vests, jackets, warm-up suits, robes, pants, shorts, clothing belts, dresses, overalls, infantwear, playsuits, cloth bibs, headwear, footwear, boots, socks, tights, beachwear, swimsuits, swimwear, bathing caps, tennis wear, rainwear, coats, gloves, mufflers, hats, sun visors, neckwear, cummerbunds, bandanas, scarves, pajamas, nightshirts, nightgowns, undergarments, aprons, masquerade costumes, masquerade costumes with masks sold in connection therewith, tank tops, underwear, and wristbands, all in the field of character merchandise/children's entertainment |
| 85509933 | DIZZY | DEAD | Toys, games and sporting goods, namely, board games, card games, play figures and accessories therefor, action figures and accessories therefor, toy figures, electric action toys, mechanical action toys, dolls and accessories therefor, doll playsets, plush toys, stuffed toys, puppets, windup toys, dominoes, jigsaw puzzles, manipulative games, marbles, paddle ball games, yo-yo's, balloons, jump ropes, kites and accessories therefor, namely, kite boards, kite handles, kite string, kite tails and kite reels, bubble making wands and solution sets, magic tricks, bath toys, play swimming pools, |

| | | | |
|----------|-------|------|--|
| | | | toy vehicles and accessories therefor, toy model hobby craft kits, toy banks, toy boxes, toy guns, toy holsters, toy archery bows and arrows, toy rockets, toy bucket and shovel sets, children's play cosmetics, baby rattles, baby multiple activity toys, toy construction blocks, musical toys, target games, action skill games, balls, namely, baseballs, basketballs, footballs, golf balls, tennis balls, playground balls, sport balls, soccer balls, volleyballs, rubber balls, foam rubber balls, baseball bats, baseball gloves, flying disks, disc type toss toys, body boards, badminton sets, dart flights, golf club head covers, roller skates, skateboards, toy scooters, swim fins, swim floats for recreational use, face masks, pinball-type games, Christmas tree decorations, egg decorating kits, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, arcade game machines, arcade-type electronic video game machines, pinball machines, pinball-type game machines, stand-alone video game machines, LCD game machines, beach balls, in-line skates, ride-on toys, toy swords, and playing cards |
| 85509926 | DIZZY | DEAD | Paper goods and printed matter, namely, a series of fiction books featuring stories in the field of children's education; trading cards; collectors cards; comic books and magazines in the field of children's education; graphic novels; novels; printed postcards; picture postcards; comic postcards; postcards; notebooks; binders; decals; stickers; posters; photograph and scrapbook albums; calendars; greeting cards; folders; desk pads; writing pads; stationery folders and stationery; pens; pencils; erasers; video game strategy manuals and books; computer game instruction manuals; paper towels; paper storage containers; chalk boards; dry erase writing boards and writing surfaces; paper flags; paper pennants |
| 85509846 | BIT | DEAD | Paper goods and printed matter, namely, a series of fiction books featuring stories in the field of children's education; comic books and magazines in the field of children's education; graphic novels; novels; video game strategy manuals and books; computer game instruction manuals; paper towels |
| 85509866 | BIT | DEAD | Toys, games and sporting goods, namely, board games, card games, play figures and accessories therefor, action figures and accessories therefor, toy figures, electric action toys, mechanical action toys, dolls and accessories therefor, doll playsets, plush toys, stuffed toys, puppets, windup toys, dominoes, jigsaw puzzles, manipulative games, marbles, paddle ball games, yo-yo's, balloons, jump ropes, kites and accessories therefor, namely, kite boards, kite handles, kite string, kite tails and kite reels, bubble making wands and solution sets, magic tricks, bath toys, play swimming pools, toy vehicles and accessories therefor, toy model hobby craft kits, toy banks, toy boxes, toy guns, toy holsters, toy archery bows and arrows, toy rockets, toy bucket and shovel sets, children's play cosmetics, baby rattles, baby multiple activity toys, toy construction blocks, musical toys, target games, action skill games, balls, namely, baseballs, basketballs, footballs, golf balls, tennis balls, playground balls, sport balls, |

| | | | |
|----------|-------|------|---|
| | | | soccer balls, volleyballs, rubber balls, foam rubber balls, baseball bats, baseball gloves, flying disks, disc type toss toys, body boards, badminton sets, dart flights, golf club head covers, roller skates, skateboards, toy scooters, swim fins, swim floats for recreational use, face masks, pinball-type games, Christmas tree decorations, egg decorating kits, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, arcade game machines, arcade-type electronic video game machines, pinball machines, pinball-type game machines, stand-alone video game machines, LCD game machines, beach balls, in-line skates, ride-on toys, toy swords, and playing cards |
| 85509859 | BIT | DEAD | Clothing, namely, shirts, t-shirts, sweatshirts, sweaters, vests, jackets, warm-up suits, robes, pants, shorts, clothing belts, dresses, overalls, infantwear, playsuits, cloth bibs, headwear, footwear, boots, socks, tights, beachwear, swimsuits, swimwear, bathing caps, tennis wear, rainwear, coats, gloves, mufflers, hats, sun visors, neckwear, cummerbunds, bandanas, scarves, pajamas, nightshirts, nightgowns, undergarments, aprons, masquerade costumes, masquerade costumes with masks sold in connection therewith, tank tops, underwear, and wristbands |
| 85509856 | BIT | DEAD | Electrical and scientific apparatus, namely, electronic game software; computer game software; downloadable computer games; computer and video-game cassettes, cartridges, discs and programs; downloadable game software; motion picture films featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; pre-recorded video and audio cassettes, video and audio tapes, video and audio discs, CD ROMs, compact discs, digital versatile discs, musical video recordings, musical sound recordings and phonograph records featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; software and manuals sold as a unit in the field of children's education, namely, for use in creating, updating and maintaining calendars, for information management and for use as computer screen savers; decorative refrigerator magnets; hand held units for playing electronic games for use with external display screen or monitor |
| 85179808 | UMIGO | DEAD | toys, games and sporting goods, namely, board games, card games, play figures and accessories therefor, action figures and accessories therefor, toy figures, electric action toys, mechanical action toys, dolls and accessories therefor, doll playsets, plush toys, stuffed toys, puppets, windup toys, dominoes, jigsaw puzzles, manipulative games, marbles, paddle ball games, yo-yo's, balloons, jump ropes, kites and accessories therefor, namely, kite boards, kite handles, kite string, kite tails and kite reels, bubble making wands and solution sets, magic tricks, bath toys, play swimming pools, toy vehicles and accessories therefor, toy model hobby craft kits, toy banks, toy boxes, toy guns, toy holsters, toy archery bows and arrows, toy rockets, toy bucket and shovel sets, children's play cosmetics, baby rattles, baby multiple activity |

| | | | |
|----------|-------|------|---|
| | | | toys, toy construction blocks, musical toys, target games, action skill games, balls, namely, baseballs, basketballs, footballs, golf balls, tennis balls, playground balls, sport balls, soccer balls, volleyballs, rubber balls, foam rubber balls, baseball bats, baseball gloves, flying disks, disc type toss toys, body boards, badminton sets, dart flights, golf club head covers, roller skates, skateboards, toy scooters, swim fins, swim floats for recreational use, face masks, pinball-type games, Christmas tree decorations, egg decorating kits, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, arcade game machines, arcade-type electronic video game machines, pinball machines, pinball-type game machines, stand-alone video game machines, LCD game machines, beach balls, in-line skates, ride-on toys, toy swords, and playing cards |
| 85179774 | UMIGO | DEAD | clothing, namely, shirts, t-shirts, sweatshirts, sweaters, vests, jackets, warm-up suits, robes, pants, shorts, clothing belts, dresses, overalls, infantwear, playsuits, cloth bibs, headwear, footwear, boots, socks, tights, beachwear, swimsuits, swimwear, bathing caps, tennis wear, rainwear, coats, gloves, mufflers, hats, sun visors, neckwear, cummerbunds, bandanas, scarves, pajamas, nightshirts, nightgowns, undergarments, aprons, masquerade costumes, masquerade costumes with masks sold in connection therewith, tank tops, underwear, and wristbands |
| 85179761 | UMIGO | DEAD | Bedding, namely, bed linens; duvet covers; fabric table runners; curtains; textile wall hangings; bath linens; bath mitts; bath sheets; bath towels; beach towels; bed blankets, blanket throws; shower curtains; bed canopies; crib canopies; cloth flags; cloth pennants; felt pennants; fabric flags |
| 85179753 | UMIGO | DEAD | housewares, namely, mugs, beverage glassware, beverage stirrers, beverage ware, bottle openers, portable beverage coolers, insulating sleeve holders for beverage cans, portable beverage dispensers, portable ice chests for food and beverages, thermal insulated containers for food or beverages, thermal insulated bags for food or beverages; bath accessories, namely, hair brushes, sponges, and cup holders; cleaning cloths; lunch boxes, paper cups, paper plates; pre-moistened towelettes for household cleaning; and wiping cloths, namely, shammies; plastic storage containers for domestic use |
| 85179743 | UMIGO | DEAD | Paper goods and printed matter, namely, a series of fiction books featuring stories in the field of children's education; trading cards; collectors cards; comic books and magazines in the field of children's education; graphic novels; novels; printed postcards; picture postcards; comic postcards; postcards; notebooks; binders; decals; stickers; posters; photograph and scrapbook albums; calendars; greeting cards; folders; desk pads; writing pads; stationery folders and stationery; pens; pencils; erasers; video game strategy manuals and books; computer game instruction manuals; paper towels; paper storage containers; chalk boards; dry erase writing boards and writing surfaces; paper flags; and paper pennants |

| | | | |
|----------|-----------------|------|--|
| 77581487 | TEAM SMITHEREEN | DEAD | Clothing, namely, shirts, t-shirts, sweatshirts, sweaters, vests, jackets, warm-up suits, robes, pants, shorts, clothing belts, dresses, overalls, infantwear, playsuits, cloth bibs, headwear, footwear, boots, socks, tights, beachwear, swimsuits, swimwear, bathing caps, tennis wear, rainwear, coats, gloves, mufflers, hats, sun visors, neckwear, cummerbunds, bandanas, scarves, pajamas, nightshirts, nightgowns, undergarments, aprons, masquerade costumes, masquerade costumes with masks sold in connection therewith, tank tops, underwear, and wristbands. |
| 77581495 | TEAM SMITHEREEN | DEAD | Toys and sporting goods, namely, play figures and accessories therefor, action figures and accessories therefor, toy figures, electric action toys, mechanical action toys, dolls and accessories therefor, doll playsets, plush toys, stuffed toys, puppets, windup toys, board games, card games, dominoes, jigsaw puzzles, manipulative games, marbles, paddle ball games, yo-yo's, balloons, jump ropes, bubble making wands and solution sets, magic tricks, bath toys, play swimming pools, toy vehicles and accessories therefor, toy model hobby craft kits, toy banks, toy boxes, toy guns, toy holsters, toy archery bows and arrows, toy rockets, toy bucket and shovel sets, children's play cosmetics, baby rattles, baby multiple activity toys, toy construction blocks, musical toys, target games, action skill games, baseball bats, baseball gloves, flying disks, disc type toss toys, body boards, badminton sets, dart flights, golf club head covers, roller skates, skateboards, toy scooters, swim fins, swim floats for recreational use, pinball-type games, Christmas tree decorations, egg decorating kits, hand held units for playing electronic games, arcade game machines, arcade-type electronic video game machines, pinball machines, pinball-type game machines, stand-alone video game machines, LCD game machines, in-line skates, ride-on toys, toy swords, and playing cards; Toys and sporting goods, namely, kites and accessories therefor, namely, kite boards, kite handles, kite string, kite tails and kite reels; Toys and sporting goods, namely, balls, namely, baseballs, basketballs, footballs, golf balls, tennis balls, playground balls, sport balls, soccer balls, volleyballs, rubber balls, foam rubber balls, and beach balls; Toys and sporting goods, namely, costume face masks, paper face masks, and face masks for football. |

The length of this chart speaks to the weight of evidence of misuse of the intent-to-use basis for registration. It is clear that these are boiler plate applications with the intent to reserve the right to the mark for these goods in the event that they are produced in the future.

“[C]ircumstances may cast doubt upon the bona fide nature of the intent or even disprove it entirely. For example, the applicant may have filed ... an excessive number of intent-to-use applications to register marks which ultimately were not

actually used, [or] an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce under the applied-for marks during the pendency of the applications. ... In connection with this bill, ‘bona fide’ should be read to mean a fair, objective determination of the applicant's intent based on all the circumstances. To avoid abuse of the intent-to-use system, the committee amended the first paragraph of proposed Section 1(b) of the Act to require that applicant's bona fide intention must reflect the good-faith circumstances surrounding the intended use. An applicant's bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing). ... In addition, an applicant's bona fide intent must reflect an intention to use the mark in the context of the legislation's revised definition of ‘use in commerce,’ that is, use ‘in the ordinary course of trade, ... and not [made] merely to reserve a right in a mark’. This bona fide intention must be present for all the goods or services recited in the application.

Senate Judiciary Comm.Rep. on S. 1883, S.Rep. No. 515, 100th Cong., 2d Sess. 23-25. (1988), reprinted in United States Trademark Association, *The Trademark Law Revision Act of 1988* 175-77 (1989) (emphasis added).

4. Applicant’s Lack of a Bona Fide Intent to Use the Mark on Any of the Goods in Class 009 Makes the Application Void ab Initio.

Applicant’s admissions that it had no sales of any of the goods, no projected first use dates for the hand held units for playing electronic games for use with external display screen or monitor, no licensing for the hand held units for playing electronic games for use with external display screen or monitor, and no pricing or manufacturing for the hand held units for playing electronic games for use with external display screen or monitor support a lack of bona fide intent for those goods. The complete lack of evidence to support any intent to use the DIZZY mark with one or any of the goods

identified in the application means that Applicant's entire application is *void ab initio*. *W. Brand Bobosky v. Adidas AG*, 2011 U.S. Dist. LEXIS 149611, 14-20 (D. Or. Dec. 29, 2011).

VI. CONCLUSION

Seeking to leave all doors open, Applicant filed intent-to-use DIZZY applications in IC 9, IC 16, IC 25, and IC 28 for a long list of goods in each application.

For IC 9, Applicant has not actually sold any DIZZY products. Applicant has no documentary evidence supporting any efforts to actually develop, market or sell DIZZY products. Applicant has offered no objective evidence of concrete steps toward commercial use of the DIZZY mark. The subject application is void for lack of a bona fide intent to use the mark. Registration should be refused.

Submitted By: /Wendy Peterson/

Date: May 6, 2016

Wendy Peterson, Attorney for Opposer, Beau Tardy

Not Just Patents

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CERTIFICATE OF SERVICE

I hereby certify that on May 6, 2016, the foregoing was served on Applicant's correspondents of record by email to:

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wmerone@kenyon.com,
tmdocketny@kenyon.com