

ESTTA Tracking number: **ESTTA756219**

Filing date: **07/05/2016**

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

Proceeding	91205896
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Attachments	Applicant Trial Brief -- DIZZY.pdf(88264 bytes )

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

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BEAU L. TARDY,

Opposer,

Opp. No. 91205896

v.

WILD BRAIN ENTERTAINMENT, INC.,

Applicant.

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**APPLICANT'S BRIEF ON THE CASE**

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## I. INTRODUCTION

This is not a serious case. Opposer, Beau L. Tardy, has not offered any admissible evidence to establish his standing to oppose the Subject Application (Serial No. 85509929) filed by Applicant, Wild Brain Entertainment, Inc., nor has he made out a *prima face* case in support of the grounds he asserted in his Notice of Opposition. Thus, now that “trial” (such as it were) is complete, the Opposition should be resolved in Applicant’s favor, and the Subject Application be allowed to progress to registration.

## II. EVIDENTIARY OBJECTIONS

Applicant did not offer any testimony during his trial period. Instead, Applicant merely filed three Notices of Reliance (D.I. 60-63) and now during briefing attempts to rely on the various documents he attached to those filings. *See Opp. Tr. Br.* Almost all of Opposer’s “evidence,” however, is either inadmissible or cannot support his case. The bases for Applicant’s evidentiary objections are set forth in detail below.

### A. Opposer’s First Notice of Reliance (D.I. 60-61)

Exhibit A: Applicant’s Responses to First Set of Requests for Admissions<sup>1</sup>  
Applicant’s Responses to Amended Requests for Admissions

Neither of these discovery documents is objectionable *per se*. However, none of the four admissions on which Opposer relies (¶¶ 11-14; *see Opp. Tr.. Br.*, p. 9) supports

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<sup>1</sup> Opposer’s filing is confusing. For example, he includes a copy of his November 2013 “First Set of Requests for Admissions” (Nos. 1-25) even though those requests were superceded by service of his December 2013 “First Set of Requests for Admission” (Nos. 1-26). *Compare* D.I. 60, pp. 9-15 *with id.*, pp. 19-25. To simplify matters, Applicant will only discuss its *responses*, which set forth in their entirety the operative requests for admission posed by Opposer to which Applicant was responding.

his case, and one (§ 14) actually *contradicts* Opposer’s theory of no *bona fide* intent. *See* D.I. 60, p. 35; *Opp. Tr. Br.*, p. 9 (§ 8) (acknowledging that Applicant had “manufacturing or distributing plans” for the goods about which Opposer was requesting an admission).

Exhibit B: Applicant’s Responses to First Set of Request for Production<sup>2</sup>  
Applicant’s Supplemental Responses to Requests for Production

As Opposer correctly observes, “responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents.” *See* D.I. 60, p. 2 (citing *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1675 n.10 (TTAB 2013); *accord, e.g., ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 at n.7 (TTAB 2012)). None of Applicant’s responses, however, *contain* any such statement. Rather, Applicant consistently objected to most of Opposer’s requests (which primarily related to applications for other marks and thus were irrelevant), and in response to the one request that Opposer directed to the topic of whether Applicant had “documentary evidence showing plans for marketing and selling all of the goods” listed in the Subject Application, *see* D.I. 60, p. 17 (Amended Req. No. 25), Applicant clearly stated that **it**

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<sup>2</sup> Again, Opposer’s filing is confusing. Opposer attached his November 2013 Requests for Production (misabeled as his “First Set of Requests for Admission”), *see* D.I. 60, pp. 49-53, but the document to which Applicant responded in January 2014 was Opposer’s *December 2013* Requests for Production, which superceded the November 2013 Requests and which Opposer has failed to attach. *Compare id. with id.*, pp. 54-63 (Applicant responded to twenty-six documents requests; Opposer’s November 2013 Requests only contained *twenty-five* requests). Thus, Applicant will again cite only to its responses, which correlate to the Requests for Admission (No. 1-26) that Opposer served in December 2013 (D.I. 60, pp. 19-25), as modified by the Amended Requests for Admission that Opposer later served in January 2014 (D.I. 60, pp. 16-18).

**would produce** whatever non-privileged and responsive documents it had in its possession, custody, or control. *See id.*, pp. 67-68 (Supp. Resp. to Req. No. 25).

Applicant's discovery responses are therefore inadmissible. Further, it must be noted that Opposer has not offered any testimony about (or sought to introduce and then discuss) the documents Applicant *has* produced. *Cf., e.g.,* D.I. 54 (in an earlier filing, Opposer acknowledged that Applicant produced hundreds of pages of documents).<sup>3</sup>

Exhibit C: U.S. Serial No. 85741800

This document is not objectionable. It is important to note, however, that the filing date of this application (September 28, 2012) was three months after the start of this case. Furthermore, the application is not evidence of anything other than the fact that it was filed. *See, e.g., Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978). Thus, it cannot be relied on to support Opposer's claim that he supposedly had standing when this case was filed. *Cf. Opp. Tr. Br.*, p. 10.

Exhibit D: Various Applications Owned by Applicant

These application files are also not objectionable. Again, though, they do not support Opposer's case. The fact that Applicant has not obtained registrations for *all* of the marks it applied to register based on an "intent to use" is not indicative of Applicant's

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<sup>3</sup> Because Opposer did not offer into evidence at trial the production documents from Applicant that Opposer had attached to his earlier filing, they will not be discussed here. *See* D.I. 54, p. 2 (finding Opposer's earlier filing to be "premature" and stating that it "will receive no consideration"); *see also* 37 CFR 2.120(j)(3)(ii) ("A party that has obtained documents from another party through disclosure or under [Federal] Rule 34 ... may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).").

intent with respect to the mark *at issue here*, particularly given the evidence that Applicant has (as one might expect) regularly obtained issued registrations for a variety of marks based on *other* applications that it filed under Section 1(b). *Cf.* D.I. 64.

**B. Opposer's Second Notice of Reliance (D.I. 62)**

Exhibit E: Declaration of Applicant (Beau Tardy) and Supporting Exhibit

The parties did not agree that a witness may submit testimony through a written declaration in lieu of testifying at a trial deposition. As such, Opposer's declaration and the documents he attached as an exhibit to his self-serving testimony are both *per se* inadmissible. *See, e.g., Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) (a declaration cannot be submitted in lieu of a testimony deposition absent a stipulation by the parties); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364, 1365 n.3 (TTAB 1999) ("statement" with exhibits by defendant's officer stricken where there was no agreement that the defendant could file testimony in form of an affidavit or declaration); *cf.* 37 CFR 2.123(b).

Opposer attempts to avoid the import of this plain rule by labeling his November 2014 declaration a "Supplemental Disclosure" and suggesting that the document was requested by the Board. *See* D.I. 61, p. 2. What the Board ordered in November 2014, however, was that Opposer serve supplemental *interrogatory responses* following Applicant's filing of a motion to compel. *See* D.I. 43; *see also* D.I. 45, 59 (subsequently discussing the inadequacy of Opposer's "Supplemental Disclosure" as a response to the propounded interrogatories). Thus, at best, Opposer's declaration could be considered an interrogatory response. *But see* D.I. 45, 59. Even then, though, the document would *still*

be inadmissible. *See, e.g.*, 37 CFR 2.120(j)(5) (written disclosures and interrogatory answers may ordinarily be made of record “only by the receiving or inquiring party”).<sup>4</sup>

**C. Opposer’s Third Notice of Reliance (D.I. 63)**

Exhibit F: Internet Pages

Opposer’s final submission is a collection of Internet pages that supposedly purport to show the “Screenshot History” and “WHOIS Record” for a series of domain names. *See* D.I. 63, pp. 4-38. Internet documents, however, “may not be used to demonstrate the truth” of what appears on their pages. *See* TBMP, § 704.08(b). That is to say, a party may only rely on Internet documents to show that a given website publicly displays a particular page—the party may not rely on the statements that appear *on* the page for the “truth of the matter asserted.” *Cf. e.g.*, Fed. R. Evid. 801, 802.

The cited Internet pages therefore are not competent evidence to show either *what* the websites for the referenced domains looked like years ago (even assuming the pages were accessible back then), or *who* supposedly owned (or owns) the domain names. *See* Fed. R. Evid. 802; *accord* TBMP, § 704.08(b) (“Internet printouts ... are acceptable to show that the statements contained therein were made or that information was reported, but not to prove the truth of the statements contained therein”); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009). To establish the truth of those key matters, Opposer had to offer testimony, which he failed to do. Thus, there

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<sup>4</sup> If the receiving party has offered into evidence “fewer than all of the written disclosures [or] answers to interrogatories,” then the disclosing party “may introduce under a notice of reliance any other written disclosures [or] answers to interrogatories ... which should in fairness be considered so as to make not misleading what was offered by the receiving ... party.” *See* 37 CFR 2.120(j)(5). That exception, however, is not applicable here.

is no evidence in the record as to who owned any of the domains at any particular time or what may or may not have been displayed on the websites years ago.

**D. “Facts” Asserted in Opposer’s Brief (D.I. 65)**

As demonstrated above, Opposer offered almost no admissible evidence at trial. Thus, many of the “facts” asserted by Opposer in his brief are unsupported. Listed below are several such statements, all of which should be disregarded by the Board.

- (1) “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.” (*Opp. Tr. Br.*, p. 6).

No admissible evidence supports these statements, as is made clear by the fact that Opposer cites to his Notice of Opposition as “support.” A party obviously cannot rely on statements made in his own pleadings as evidence to support his case. *Accord*, e.g., TBMP, § 704.06(a). Thus, all we know about Opposer based on the *trial record* is that he first filed this opposition and then three months later filed his own application to register the DIZZY mark for goods in Class 9. *See* D.I. 32; D.I. 60, Ex. C.

- (2) “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.” (*Opp. Tr. Br.*, p. 8, ¶ 1).

Applicant’s original Answer contained no such admission. What Applicant said in its prior Answer was that Opposer *did not own* the “dizzythecat.com” website, and that

no use of DIZZY as a mark was evident on that site. *See* D.I. 4, ¶ 1(f).<sup>5</sup> As such, Applicant’s prior statements were not admissions against interest and have no evidentiary value. *See Kellogg Co. v. Pack’Em Enterprises Inc.*, 14 USPQ2d 1545, 1548 n.6 (TTAB 1990) (pleadings have evidentiary value only if they contain an admission against interest). Furthermore, even if Applicant *had* made a prior judicial admission, *but see supra*, it would not control here given that (as the Board has explained) “Applicant’s answer to the original notice of opposition is no longer the operative responsive pleading herein, having been superseded by Applicant’s answer to the fourth amended notice of opposition that Applicant filed on May 28, 2014.” D.I. 43, p. 5; *accord* TBMP, § 507.02.

- (3) “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)..” (*Opp. Tr. Br.*, p. 9).

Applicant never admitted that Opposer owns either the domain name “dizzythecat.com” or “a cartoon character,” and Applicant most assuredly does not agree that Opposer has standing. Opposer’s lack of standing is discussed in Section V.A, *infra*.

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<sup>5</sup> Specifically, Applicant stated, in response to Opposer’s allegation that he owned the dizzythecat.com domain and was presently using the DIZZY mark (*see* D.I. 1, ¶ 1), that the website in question was actually owned *by a third party* (Aquarium Creative Agency Corp.) and that the only content on that site “appear[ed] to be” a few cartoons bearing a copyright claim (made in the name of yet another third party) of 2006. *See* D.I. 4, ¶ 1(f), Ex. 6. Applicant further noted that the website did not show any use of DIZZY *as a mark* “on or in connection with any goods or services.” *See* D.I. 4, ¶ 1(f). Applicant’s current operative Answer (D.I. 38) similarly contains no admissions about Opposer’s activities. *See, e.g.*, D.I. 38, ¶ 1 (“Applicant admits the allegations as they relate to Applicant’s activities. Applicant is without knowledge or information as to Opposer’s activities sufficient to form a belief as to the truth of the allegations set forth in this paragraph”).

### **III. DESCRIPTION OF THE EVIDENCE OF RECORD**

#### **A. Opposer's Evidence**

As explained, most of the evidence submitted by Opposer, Beau L. Tardy, is either *per se* inadmissible (such as Opposer's declaration) or incompetent for the purpose for which Opposer has proffered the evidence (such as the Internet pages). *See supra*. The only admissible evidence Opposer has submitted comprises (1) certain admissions made by Applicant, both in response to Opposer's Requests (D.I. 60, Ex. A) and in its operative Answer (D.I. 38); (2) a copy of U.S. Serial No. 85741800 (D.I. 60, Ex. C); and (3) records relating to certain trademark applications previously filed by Applicant (D.I. 61, Ex. D). As will be discussed, however, none of this evidence serves to establish Opposer's standing or helps him carry his burden to make out a *prima facie* case.

#### **B. Applicant's Evidence**

Given Opposer's failure to prove up standing or make out a *prima facie* case on the merits, Applicant had no need to submit testimony about its business or its planned trademark use. As such, the only evidence Applicant offered was a Notice of Reliance (D.I. 64) showing that Applicant, contrary to Opposer's contention, regularly obtains issued registrations based on applications it has filed on the basis of an intent to use. Opposer did not object in his opening brief to the introduction of this evidence.

### **IV. ISSUES PRESENTED**

The first issue for the Board to consider is whether Opposer has standing to pursue this opposition. The second (but no less important) issue is whether Opposer has

successfully established a *prima facie* case that Applicant supposedly lacked a *bona fide* intent to use the Subject Mark at the time the Subject Application was filed.

## VI. ARGUMENT

### A. Opposer Has Not Carried His Burden to Prove Standing

A key initial question in any opposition proceeding is whether the opposer has standing to pursue the action. *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 231 USPQ 926, 931 (TTAB 1986) (“Standing to oppose is an essential element of proof in opposition proceedings.”). As the Federal Circuit has explained, “an opposer [must] show that he has a ‘real interest’ in the outcome of a proceeding in order to have standing.” *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The burden to allege and then later prove up standing rests squarely on the party (here, Opposer) who seeks to invoke the jurisdiction of the Board.<sup>6</sup> *See* TBMP, § 309.03(b); *see also, e.g., Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999).

Whether a party has standing to pursue a cause of action must be assessed under the facts as they existed at the time the case was filed. *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 569-70 nn. 4, 5 (1992); *see also, e.g., Mollan v. Torrance*, 22 U.S. (9 Wheat.) 536, 538 (1824) (jurisdiction “depends upon the state of things at the time of the action brought”). Thus, Opposer was required to prove at trial that when this case began

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<sup>6</sup> Opposer suggests that Applicant needed to dispute Opposer’s standing in its Answer, such as by raising “specific challenges” or “affirmative defenses.” *See Opp. Tr. Br.*, p. 9. Standing, however, is an element of *Opposer’s* case and, as such, must “be affirmatively proved by the plaintiff at trial[.]” *See* 37 CFR 2.104; *Ritchie*, 50 USPQ2d at 1029. The defense of “lack of standing” also can never be waived. *Cf.* Fed. R. Civ. P. 12(h)(3).

he had a “direct and personal stake” in its outcome and a reasonable belief he would suffer damage if Applicant’s mark registered. *See Ritchie*, 50 USPQ2d at 1025-26.

Opposer, however, **did not offer any evidence** that he had an interest in the DIZZY mark when these proceedings began—he did not show that he *owned* the mark, that he had *used* the mark previously, or that he *intended* to use the mark in the future. *Cf.* TBMP, § 309.03(b) (discussing the ways a party may establish standing).<sup>7</sup> And although Opposer eventually filed an application to register “DIZZY” three months *after* this case began—and after, notably, Applicant denied Opposer’s allegations of standing in its original Answer and put Opposer on notice that standing would be at issue in this case; *see* D.I. 4, ¶¶ 1, 4—a party cannot retroactively create standing as of the time proceedings began if none existed before. *Cf., e.g., Matos v. Secretary of Dept. of Health and Human Services*, 35 F.3d 1549, 1553 (Fed. Cir. 1994) (a jurisdictional defect cannot be cured by a court’s nunc pro tunc order, because “such an order cannot change the fact that [jurisdiction did not exist at the time of filing]”); *Insect Science Resource LLC v. Timberline Fisheries Corp.*, 2010 WL 431233, \*4-\*5 (N. D. Ga. 2010) (dismissing trademark infringement action for lack of standing where title to the mark was not in the plaintiff’s name when the complaint was filed, even though mark owner subsequently sought to assign the rights to plaintiff [his alter-ego corporation] retroactively).<sup>8</sup>

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<sup>7</sup> To be sure, Opposer arguably *pled* that he had a real and personal stake in this proceeding. *See* D.I. 32, p. 6, ¶ 1. However, “[a]llegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial[.]” TBMP, § 309.03(b); *see also, e.g., Ritchie*, 50 USPQ2d at 1029.

<sup>8</sup> It has been suggested that standing can also be established at the pleading stage by alleging that a party “has a bona fide intent to use the same mark for related goods, and is about to file an intent-to-use application to register the mark, and believes registration of (continued)

Proof of standing in a Board proceeding is “a low threshold.” *See Syngenta*, 90 USPQ2d at 1118. The record in this case, however, is devoid of *any* evidence establishing Opposer’s business history or activities; his prior or present ownership or use of the DIZZY mark; or his plans (if any) to use the mark in the future. Moreover, it is notable that Opposer **withdrew with prejudice** his original claim that he supposedly had priority over Applicant to use the DIZZY mark—suggesting Opposer knew he could not claim rights in the mark based on prior use and that he instead needed to rely on the application he filed after the case began. *See* D.I. 36, p. 2. Filing an application after an opposition begins (particularly after having being “spurred” to do so by an applicant’s challenge to a claim of standing; *cf.* D.I. 4, ¶¶ 1, 4), however, cannot retroactively convey standing without eviscerating the doctrine and turning it on its head. As such, Opposer has failed to carry his burden on “an essential element of proof,” *see, e.g., Yamaha*, 231 USPQ at 931, and judgment should therefore be entered in Applicant’s favor.

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the mark will be refused in view of defendant’s registration.” *See* TBMP, § 309.03(b) (citing *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992)). In *American Vitamin Products*, however, the Board based its finding that standing had been adequately pled on the pleaded allegations that petitioner was “engaged in the manufacture and sale of goods which are related to those identified in the subject registrations” and had a “bona fide intention to use the mark ... in connection with those goods.” *See* 22 USPQ2d at 1314 (“Clearly, petitioner has demonstrated an interest in the proceedings beyond that of a mere intermeddler. Whether those allegations are true, is a question of fact to be determined at trial.”). The Board in *American Vitamin Products* did not face the circumstances presented here—namely, a situation where, following trial, there is no proof that Opposer had *any interest* in (or an intent to use) the subject mark as of the time the opposition began, let alone a reasonable basis to believe that he would be damaged if the mark were to be registered by Applicant.

**B. Opposer Has Not Made Out a *Prima Facie* Case on the Merits**

Because Opposer failed to establish his standing at trial, the Board lacks jurisdiction to decide the merits of Opposer's pleaded opposition grounds. However, even if Opposer's standing could be presumed, the Opposition should still be dismissed.

The sole ground for opposition pled by Opposer is that Applicant, when it filed the Subject Application, supposedly lacked a *bona fide* intent to use the DIZZY mark for some or all of the covered goods. *See* D.I. 32, p. 8, ¶ 4; *accord Opp. Tr. Br.*, p. 4. Opposer thus had the initial burden of “demonstrating by a preponderance of the evidence that applicant lacked a *bona fide* intent to use the mark on the identified goods.” *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). The burden of production does not shift to Applicant unless and until Opposer first “meets this initial burden of proof[.]” *The Saul Zaentz Company dba Tolkien Enterprises v. Joseph M. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010).

“One way in which an opposer can establish its *prima facie* case of no *bona fide* intent is by proving that applicant has no documentary evidence to support its allegation in the application of its claimed *bona fide* intent to use the mark in commerce as of the application filing date.” *Id.* at 1727; *accord Boston Red Sox Baseball Club*, 88 USPQ2d at 1587. In the present case, though, Opposer has not made such a showing. As discussed, *see* pp. 2-3, *supra*, Applicant's discovery responses stated that Applicant *would produce* “documentary evidence [from around the time Applicant ‘submitted their application for DIZZY in IC9’] showing plans for marketing and selling all of the goods” listed in the Subject Application, *see* D.I. 60, p. 17 (Amended Req. No. 25), pp. 67-68

(Supp. Resp. to Req. No. 25), and Opposer has not offered any evidence to suggest that the documents Applicant later produced in this case were in any way insufficient.

Given that Opposer is basing his *prima facie* case on his claim (*see Opp. Tr. Br.*, p. 11) that Applicant supposedly failed to produce documents demonstrating its intent to use the mark as of the application filing date (a conclusion with which Applicant most certainly disagrees), it was incumbent upon Opposer to *prove up* that allegation. Opposer, however, did not put into evidence the documents Applicant produced, nor did he offer any testimony *about* those documents. Instead, he simply cites to Applicant's written discovery responses, which, as noted before, *contradict* Opposer's position.

Separately, Opposer tries to carry his burden by noting the innocuous fact that Applicant in the past abandoned a number of the single-class "intent to use" applications it filed for four marks (DIZZY, BIT, UMIGO, and TEAM SMITHEREEN) after those applications had been allowed. *See* D.I. 61; *see also Opp. Tr. Br.*, pp. 12-17. Opposer, though, fails to mention that Applicant also secured *registrations* off of two of the intent-to-use applications it filed for those marks, *see* D.I. 64, Exs. A, B, and Opposer did not offer at trial any evidence about *the reasons* why Applicant abandoned those other applications, nor did he establish Applicant's intent at the time those other applications were filed (which would be the more relevant inquiry). Instead, Opposer simply wants the Board to adopt a *per se* rule that if a party files multiple intent-to-use applications and does not secure registrations for all of them (or at least some high percentage), the party will be presumed to have engaged in a "pattern of willful misrepresentation" and to have demonstrated a "pattern of lack of bona fide intent." *See Opp. Tr. Br.*, pp. 12, 16.

Opposer's proposal makes no practical or legal sense. Not only would it be arbitrary (after all, what precise ratio of abandoned-to-allowed applications would trigger the presumption?), Applicant respectfully submits that permitting a handful of applications to go abandoned following allowance does not even remotely constitute "objective proof sufficient to prove that the applicant lacks a bona fide intention to use" a mark in commerce, particularly where (as here) none of the abandoned applications were for the same mark and the same goods. *Cf. Boston Red Sox Baseball Club*, 88 USPQ2d at 1587. Indeed, given that the whole *point* of the intent-to-use filing system is to permit an applicant to secure trademark rights *in advance of use*, adopting a rule that would penalize a party if it ever abandons an application (*e.g.*, when business plans change) would make no sense and would have a chilling effect on further trademark filings.

Furthermore, the reality is that Opposer is asking the Board to adopt his new rule (for which he cites no supporting case law) based solely on the fact that Applicant applied for four marks over four years (2008 to 2012), and notwithstanding that Applicant (a) obtained registrations in two classes for one of the marks (UMIGO), and (b) is fighting here to register another (DIZZY).<sup>9</sup> Moreover, even if the Board *wanted* to adopt Opposer's position and hold that evidence of an applicant's abandonment of prior applications is sufficient to carry an opposer's burden to show that the applicant lacked a

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<sup>9</sup> Opposer focuses on the number of single-class applications filed by Applicant (*see, e.g., Opp. Tr. Br.*, pp. 12-16), overlooking the fact that Applicant just as easily could have filed four *multi-class* applications and then later divided out the classes for which it wished to file Statements of Use. If Applicant had prosecuted its marks that way, it presumably would have avoided the criticism that Opposer now levels because Applicant would have wound up with a total of just seven applications—the four parent applications (which would have gone abandoned), the two divided applications that issued into (continued)

*bona fide* intent with respect to a *different* (and later-filed) application, *but see supra*, logic dictates that the opposer would need to offer evidence about the applicant’s intent when it made those earlier filings, something Opposer has not done here.<sup>10</sup>

Finally, the “admissions” Opposer cites (*see, e.g., Opp. Tr. Br.*, pp. 9 (¶¶ 5-8), 17-18) do not help him make out a *prima facie* case of no *bona fide* intent. To start, it must be noted that Opposer’s requests for admission were limited to just one of the covered goods—namely, “hand held units for playing electronic games for use with external display screen or monitor”—and mostly concerned matters that typically would not be addressed by a company until much later in the product development process (“projected first use date,” “projected retail or wholesale prices,” “licensee contracts”). *See* D.I. 60, pp. 34-35 (Resp. Nos. 11-13). More important, though, Opposer put into evidence the fact that Applicant, at the time it filed the Subject Application, had “**manufacturing or distribution plans**” for its “hand held units.” *See id.*, p. 35 (Resp. No. 14); *see also Opp. Tr. Br.*, p. 9, ¶ 8.<sup>11</sup> Thus, Opposer’s own evidence, far from establishing a *prima facie* case, proves that Applicant had a *bona fide* intent to use the Subject Mark.

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registrations, and the Subject Application. *See generally* D.I. 61; D.I. 64, Exs. A, B.

<sup>10</sup> Of course, proving that an applicant lacked a *bona fide* intent to use the marks that were at issue in earlier filings would be onerous and effectively lead to a trial-within-a-trial. The easier approach would be for an opposer—if it truly believed that an applicant was routinely making improper filings (*see Opp. Tr. Br.*, p. 12)—to prove that the applicant lacked the proper intent when it filed the application *subject to the opposition*.

<sup>11</sup> Because Opposer put Applicant’s response to Request No. 14 into evidence, *see* D.I. 60, p. 35, and relied on it in his brief, *see Opp. Tr. Br.*, p. 9, ¶ 8, Applicant may rely on it as well. *See* 37 CFR 2.120(j)(7) (“When ... an admission[] has been made of record by one party [through a notice of reliance in accordance with 37 CFR 2.120(j)(3)], it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”).

## VI. CONCLUSION

Opposer did not and cannot support his pleaded case. Opposer did not offer at trial any admissible evidence in support of his claim of standing and he failed to carry his burden of establishing a *prima facie* case that Applicant supposedly lacked a *bona fide* intent to use the DIZZY mark. The Opposition should therefore be denied.

Respectfully submitted,

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Date: July 5, 2016

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## CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing *Applicant's Trial Brief*, along with all associated exhibits (if any), was served on the parties or counsel indicated below by electronic mail sent to the address(es) listed below (as agreed to by the parties):

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