

THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB

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

COHEN

Mailed: October 16, 2013

Opposition No. 91206846

PRL USA Holdings, Inc.

v.

Rich C. Young

**Before Cataldo, Taylor, and Masiello,
Administrative Trademark Judges.**

By the Board:

Rich C. Young ("applicant") seeks to register the mark IRISH POLO CLUB USA and design depicted below ("applicant's mark"):



for "shirts" in International Class 25.¹

PRL USA Holdings, Inc. ("opposer") filed its notice of opposition to the registration of applicant's mark on the

¹ Application Serial No. 85477199 was filed November 19, 2011 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an assertion of a bona fide intent to use the mark in commerce.

grounds of likelihood of confusion and dilution.² Applicant submitted its answer,³ generally denying the allegations of the notice of opposition.

This case now comes up on the following motions:

1. Opposer's motion to amend its notice of opposition (filed July 8, 2013) to add a claim that applicant's application is void *ab initio* based on a lack of bona fide intent to use; and
2. Opposer's motion for summary judgment based on its claim of no bona fide intent to use (filed July 8, 2013).

Each motion has been fully briefed. The Board will consider each motion in turn.

Motion to amend

Opposer seeks to amend the notice of opposition to add a claim of lack of bona fide intent to use the mark in commerce. Applicant has opposed the motion.

² In support of these grounds opposer has claimed ownership of numerous registrations containing, *inter alia*, POLO, POLO RALPH

LAUREN and/or the design  and alleges that it uses "American iconography, including the words, 'USA' and 'America,'" in connection with its marks.

³ On November 11, 2012, applicant filed an "answer" in Opposition No. 91206846. To the extent that the November 11, 2012 "answer" does not comply with Fed. R. Civ. P. 8(b)(1), applicant's "answer" is treated as a general denial of all allegations of the notice of opposition. See Fed. R. Civ. P. 8(b)(3).

Amendments to pleadings in *inter partes* proceedings before the Board are governed by Fed. R. Civ. P. 15, which is made applicable to Board proceedings by Trademark Rule 2.116(a). See also TBMP § 507.01. Fed. R. Civ. P. 15(a) governs amendments before trial. Pursuant to Fed. R. Civ. P. 15(a)(2), where, as here, a party may not amend its pleading as a matter of course,

...a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See TBMP § 507.02.

The timing of the motion for leave to amend plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. See, e.g., *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (applicant not prejudiced because proceeding still in pre-trial phase); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's

testimony period permitted); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had yet taken testimony); *Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 182 USPQ 511, 512 (TTAB 1974) (applicant would not be unduly prejudiced since no testimony has yet been taken); TBMP § 507.02(a). For example, the Board generally will grant such motions when the proceedings are still in the pre-trial stage. See, e.g., *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974).

On review of the parties' arguments,⁴ the Board finds no evidence of undue delay by opposer in filing its motion to amend its pleading. Opposer alleges its motion is predicated on information learned during discovery, and there are no allegations that opposer unduly delayed filing its motion after learning the information in discovery.

Additionally, it appears unlikely that applicant will be prejudiced by allowance of the amendment. Trial has not yet begun and additional discovery does not appear to be necessary since neither party has requested additional

⁴ In applicant's response to opposer's motion to amend its notice of opposition, applicant appears to also move to amend some of his discovery responses. The parties have a duty to correct or supplement their discovery responses. See Fed. R. Civ. P. 26(e). To the extent applicant's request may be deemed a motion to amend his discovery responses, the motion is unnecessary. Applicant is under a duty to correct or supplement his discovery responses and may do so under his own initiative.

discovery. Indeed, opposer is seeking summary judgment on the additional ground of lack of bona fide intent to use in the amended pleading.

In view of the foregoing, opposer's motion to amend is hereby **GRANTED**. The amended notice of opposition included in opposer's motion shall be treated as opposer's operative pleading in this case.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). The non-moving party, however, may not rest on the mere allegations of its pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. Consequently, factual assertions without evidentiary support are insufficient to defend against a motion for summary judgment. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001); and *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 (TTAB 1987). For purposes of this motion, we deem all new allegations in the amended notice of opposition to be denied and a matter of dispute, unless the parties' submissions on this motion resolve such dispute by means of sufficient evidence.

We turn first to the issue of standing, a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50

USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). The Board finds that there is no genuine dispute of material fact concerning opposer's standing. Opposer submitted a status and title copy of its pleaded registrations with its amended notice of opposition which sufficiently establishes its standing to bring this proceeding. See *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709 (TTAB 2011); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010). Moreover, applicant has not disputed opposer's standing.

Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent 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) and must reflect an intention to use the mark "in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. Section 1127, and citing Senate Judiciary Comm. Rep. on S.

1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)).

A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); see also *Aktieselskabet AF 12. November 2001 v. Fame Jeans Inc.*, 86 USPQ2d 1527, 1537-38 (D.C. Cir. 2008) ("Here, Congress made clear that a 'bona fide intent to use' also involves an objective standard by specifying there must be 'circumstances showing . . . good faith.' Thus, an opposer may defeat a trademark application for lack of bona fide intent by proving the applicant did not actually intend to use the mark in commerce or by proving the circumstances at the time of filing did not demonstrate that intent."). In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

As a general rule, the factual question of intent is unsuited to disposition on summary judgment. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). Nonetheless, one way 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. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010). Where there is no evidence of an applicant's bona fide intent to use the mark at issue on the claimed goods or services, entry of summary judgment on a claim that the applicant had no bona fide intent to use the mark in commerce when he filed his involved application may be warranted. See *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).

In support of its motion for summary judgment, opposer has submitted copies of its discovery requests and applicant's discovery responses. Opposer alleges, *inter alia*, that based on applicant's discovery responses, applicant did not have the required bona fide intent to use his mark at the time of filing his application. Specifically, opposer refers to applicant's responses to

interrogatories nos. 1, 3, 5-6, and 8-9.⁵ Those interrogatories ask, in general, that applicant identify, *inter alia*, the products to be sold under applicant's mark, applicant's general revenue and/or goods sold (without regard to whether the revenue or goods are in association with applicant's mark) in past years, and any market research conducted with respect to applicant's mark.

Applicant's response to each of these interrogatories is that he is in an "intention to use status" and that he does not have "any business planning yet." Opposer also

⁵ Those interrogatories are:

Interrogatory 1: Identify all Products offered or intended to be offered for sale by Applicant bearing Applicant's Mark.

Interrogatory No. 3: Identify all Persons responsible for inventing, creating, manufacturing, designing, and/or revising any Products that bear or will bear Applicant's Mark.

Interrogatory No. 5: Identify Applicant's total revenues from the sale and/or licensing of goods in 2011 and 2012.

Interrogatory No. 6: Identify the goods manufactured, sold and/or distributed by Applicant in 2011 and 2012.

Interrogatory No. 8: Identify all market research relating to Applicant's Mark or any product and/or service marketed or proposed to be marketed under Applicant's Mark.

Interrogatory No. 9: Identify all Persons with whom Applicant has entered or intends to enter into a license, contract or other agreement, including but not limited to coexistence agreements, regarding use of Applicant's Mark.

refers to applicant's lack of document production in response to document requests 2-4, and 6-8⁶ wherein opposer asks applicant, *inter alia*, to produce documents regarding his agreements, proposals or negotiations to sell and/or license his products under applicant's mark, manufacturing of goods with applicant's mark, and the types of product lines to be sold under applicant's mark. Applicant responds to those document requests by indicating no documents exist

⁶Those document requests are:

Document Request No. 2: All Documents that relate to the creation, selection, adoption and/or development of Applicant's Mark.

Document Request No. 3: All Documents concerning agreements, proposals or negotiations with any Person to license, produce, sell, offer for sale and/or distribute products bearing Applicant's Mark.

Document Request No. 4: All Documents concerning the manufacturing and/or planned manufacturing, including orders and/or samples, of Products that bear or will bear Applicant's Mark.

Document Request No. 6: All Documents concerning: (a) searches performed with respect to all trademarks considered for products bearing Applicant's Mark, and (b) opinions of counsel rendered regarding these marks.

Document Request No. 7: Documents sufficient to identify each different product and/or product line sold or intended to be sold by Applicant under Applicant's Mark.

Document Request No. 8: Documents sufficient to identify the scope and operation of Applicant's business, including but not limited to Documents showing total revenues and sales for the past three years and Documents showing distributors, manufacturers, and retailers with which Applicant does business.

apparently because he is in an "intention to use status" and does not "have any business planning yet" or that he does not "have business activities yet."

Opposer argues that these responses are evidence that applicant "has engaged in no relevant business activities or planning beyond his initial Application"; that applicant is not involved in any manufacturing, sale, licensing or distribution of any goods whatsoever; and that, therefore, applicant's application is void *ab initio* because applicant lacked the requisite bona fide intent to use applicant's mark at the time the application was filed.

In response to the motion for summary judgment, applicant argues, *inter alia*, that his interrogatory responses and lack of document production are a result of being in an "intention to use status" and not yet being open for business; that if the "Board approve[s] [applicant's mark for registration] . . . Applicant will made [sic] the Tee shirts, Polo shirts with [applicant's mark and] . . . will distribute through EBay and Amazon systems throughout [the] whole U.S.A."; that he will have all the documentary evidence required such as "business activities, business planning, identify or conceive which the mark intent to use [sic]" after the Board approves applicant's mark; and that therefore, his discovery

responses demonstrate his bona fide intent to use applicant's mark.

The record demonstrates that applicant has no documentary evidence of business plans, marketing or promotional activities, nor any discussions with manufacturers or licensees which could substantiate his claim of a bona fide intent to use applicant's mark in commerce as of the filing date of the application. *Cf. Lane Ltd. v. Jackson*, 33 USPQ2d 1351. Applicant has failed to produce any evidence of any current business, whether related to the goods listed in applicant's application or otherwise. His response to the motion for summary judgment does not include any objective evidence of "circumstances showing... good faith," and does not support a finding that his intent to use is bona fide.

The Board has "repeatedly found a lack of bona fide intent to use a mark by individuals who lack the demonstrated capacity to produce the goods identified in the application." *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co., Inc.*, ___ USPQ2d ___, (TTAB, Opposition No. 91187092, September 30, 2013); *see L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012); *Saul Zaentz Co.*, 95 USPQ2d at 1726-27; *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007).

On this record, and upon careful consideration of the parties' arguments and the evidence submitted, we find that applicant's intent at the time he filed his application was "merely to reserve a right in the mark" in case it was later approved for registration by the USPTO; and that applicant would only at some unspecified future time begin developing a business. This is not a bona fide intent to use the mark in commerce as defined by Section 45 of the Trademark Act on the identified goods. See *Swatch AG v. M.Z. Berger*, ___ USPQ2d ___ (TTAB 2013). Applicant's mere statements of intent to use applicant's mark and his denial that he lacked a bona fide intent is not adequate evidence of a bona fide intent to use a mark. See *Saul Zaentz Co.*, 95 USPQ2d at 1726-27. Because there is no documentary evidence of applicant's bona fide intent to use applicant's mark in commerce to identify his goods at the time he filed his application, and applicant has not come forth with any evidence to explain his lack of documentary evidence, the Board cannot conclude that applicant had a bona fide intent to use his mark at the time of filing the application.

In view thereof, opposer has established that there is no genuine dispute of material fact as to applicant's lack of bona fide intent to use applicant's mark as of the filing date of the application. Accordingly, opposer's motion for

Opposition No. 91206846

summary judgment is **granted** on its claim of no bona fide intent to use the mark in commerce. The opposition is sustained under Trademark Act Section 1(b) and application Serial No. 85477199 is refused registration.