

This Opinion is not a
Precedent of the TTAB

Mailed: October 31, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Julius Sämma n Ltd.
v.
Ibrahim Nasser and Serious Scents, Inc.

Opposition No. 91210658

James E. Rosini of Kenyon & Kenyon for Julius Sämma n Ltd.

Ibrahim Nasser and Serious Scents, Inc., *pro se.*¹

Before Mermelstein, Wellington and Gorowitz,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On June 1, 2012, Ibrahim Nasser filed Application Serial No. 85641084 seeking to register the mark shown below for “air fragrancing preparations” in Class 3 and “air deodorizing preparations” in Class 5:

¹ On January 27, 2015, Mr. Nasser informed the Board that he would be representing himself and that he is President of co-Applicant Serious Scents, Inc. Since that date, all papers filed on behalf Applicants were signed by Mr. Nasser.



The application, as filed, was based upon Mr. Nasser's allegation of first use anywhere and in commerce of the mark, for both classes, on October 31, 1993, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

On May 29, 2014, Mr. Nasser recorded an assignment of the application to Serious Scents, Inc. Hereinafter, Mr. Nasser and Serious Scents, Inc. are collectively referred to as "Applicants."²

Julius Sämman Ltd. ("Opposer") opposes registration of Applicants' mark on the ground that the application is void *ab initio* because Mr. Nasser was not using the mark in interstate commerce at the time he filed the application, thereby rendering the application *void ab initio* under Section 1(a) of the Trademark Act.³ For purposes of standing, Opposer pleaded ownership of several registrations for tree design marks

² On July 23, 2015, the Board joined the latter company as a party-defendant. 35 TTABVUE at Note 1.

³ Opposer pled other grounds for opposition, including likelihood of confusion, fraud, and abandonment based on nonuse. However, in its brief, Opposer argued that the *void ab initio* claim was the only one being pursued. Opposer reiterated this point in its reply brief. See 59 TTABVUE 9-10 ("Opposer ... bases its opposition on Applicant's lack of use as of the filing date of his application, an allegation that, if proven, renders the application void *ab initio*.") Thus we consider any other claim, even if pleaded, as having been waived.

on air deodorant goods, including Reg. Nos. 719498 and 1131617; that its marks are “famous”; and that Applicant’s mark is “confusingly similar” to Opposer’s marks.⁴

An answer was filed denying the salient allegations in the Notice of Opposition.⁵

The parties have submitted trial briefs.⁶

I. The Record and Evidentiary Matters

The record includes the pleadings and, by operation of Rule 2.122(b), the file of the involved application.

During its assigned trial period, Opposer took the testimony of Ms. Anna VanBuskirk, legal coordinator for the Car-Freshener Corporation, Opposer’s exclusive licensee in the United States. A copy of the testimony, with accompanying exhibits, was filed with the Board.⁷ The exhibits include printouts, obtained from the Office’s electronic database, of Opposer’s pleaded registrations. In addition, Opposer introduced the following materials under notices of reliance:⁸ copies of its pleaded registrations and the file histories; certain portions of the discovery deposition of Mr. Nasser as well as exhibits introduced during that deposition that include responses

⁴ 21 TTABVUE.

⁵ 25 TTABVUE.

⁶ Applicants filed a sur-reply brief (60 TTABVUE) containing responses to evidentiary matters raised in Opposer’s reply brief as well as additional argument involving the merits of the opposition. There is no provision for filing a reply brief by a party in the position of defendant and, accordingly, such a brief may be stricken or given no consideration by the Board. TBMP § 802.02(d). However, in this case, we consider the sur-reply filed by Applicants only to the extent that it addresses objections raised in Opposer’s reply brief. All arguments involving the merits have been disregarded.

⁷ 54 TTABVUE.

⁸ 40-44 TTABVUE.

to Opposer's first set of interrogatories, articles from online printed publications involving Opposer's goods, and printouts from Opposer's website and third-party websites offering Opposer's goods for sale.

The aforementioned testimony and materials were properly introduced by Opposer and are of record.

Applicants, during their assigned trial period, did not introduce testimony or any other evidence.⁹

However, with their "Resp[onse] to Opposer's Brief on the Case,"¹⁰ Applicants attached exhibits comprising various documents and materials, including receipts purportedly involving the sale of Applicants' goods. Opposer, in its reply brief, has objected to Applicants reliance on the materials submitted with their brief on the basis that they were not properly introduced into evidence. In response to this objection, Mr. Nasser asserts that Opposer "falsely claims" that he did not submit evidence, but fails to point how or where he did properly introduce any evidence.

⁹ Pursuant to the Board's April 6, 2016 order (53 TTABVUE), Applicants' filing of pretrial disclosures and a "Final Response in Opposition to Opposer [sic] Claim Filed Before Close of Defendant's 30-Day Trial Period Ends," have not been considered by the Board for reasons explained in that order. On May 17, 2016, Mr. Nasser filed a request for reconsideration of the Board's decision with respect to the pretrial disclosures based on the timeliness of their filing. The request is hereby denied; as explained in the Board's order, pretrial disclosures need not — indeed *should* not — be filed with the Board. Thus, the timeliness of Applicants' *filing* of its pretrial disclosures is irrelevant. In any event, even if pretrial disclosures are filed with the Board, they do not constitute, or otherwise substitute for, evidence properly introduced at trial. See TBMP § 702.01.

¹⁰ 56 TTABVUE. We also note that a few days later Applicants filed a "1st Amended Response [sic] to Opposer's Opening Brief on the Case," also with attached materials that were submitted with the original brief. See 57 TTABVUE.

The Board has long held and made abundantly clear that “[e]xhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.” TBMP § 704.05 (b); *Lincoln Nat'l Corp. v. Anderson*, 110 USPQ2d 1271, 1274 n.5 (TTAB 2014) (evidence submitted for the first time with trial brief not considered). Accordingly, Opposer’s objection is sustained and the materials attached to Applicants’ brief are not considered.

Finally, Applicants have objected to Opposer’s reliance on Mr. Nasser’s discovery deposition because he allegedly was not provided with an Arabic translator. Applicants assert that Mr. Nasser “asked for a translator who spoke Arabic” and that the “deposition was to be continued and it was understood [that] an Arabic translator would be there.”¹¹ Opposer responds that this objection lacks merit because neither Mr. Nasser nor his counsel requested that a translator be present or was necessary either prior to or during the hearing. Opposer correctly notes that Applicants did not submit any evidence in support of their contention that a translator had been requested.

Because Applicants have not submitted any evidence to support their assertion that a translator was requested, let alone needed,¹² we deny their objection to Opposer’s reliance on certain excerpts from Mr. Nasser’s testimony. Moreover, we

¹¹ 56 TTABVUE 3.

¹² At several points during the deposition, it appears that there was some confusion or misunderstanding between Opposer’s counsel and Mr. Nasser. See, e.g., Nasser dep. 93:9-25 (42 TTABVUE 41). However, upon review of the deposition excerpts made of record, we find that at no point during the questioning was the need for a translator discussed.

agree with Opposer that this type of objection is a procedural one that should have been raised promptly and, because it was not, is now waived. *See* TBMP § 707.03(b) (“objections on procedural grounds”) and 707.03(c) (“on other procedural grounds ... [that] include objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties...”).

In sum, the record includes the pleadings, the file of the involved application and all of the evidentiary submissions from Opposer. The materials attached to Applicants’ briefs have not been considered.

II. Standing

“Standing requires only that the petitioner have a ‘real interest’ in the cancellation proceeding.” *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002). Opposer here has made of record, *inter alia*, its registered design marks for air freshener goods that, as described, are very similar or identical to Applicant’s goods. Ms. VanBuskirk also testified that Opposer has been using these marks in the United States through its exclusive licensee, the Car-Freshener Corporation. In total, the record shows that Opposer is more than a mere interloper and has a real interest in and standing to bring this proceeding. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

III. Alleged Nonuse of the Mark at the Time of Filing the Application

As noted *supra*, the involved application was filed on June 1, 2012 under Section 1(a) of the Act based on Mr. Nasser's declaration that he was using the mark in commerce as of that date.

An application filed under Section 1(a) is void *ab initio* if the mark was not in use in commerce at the time the application was filed. See 15 USC § 1051(a), Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i); *see, e.g., Lens.com Inc. v. 1-800 Contacts Inc.*, 103 USPQ2d 1672, 1676-77 (Fed. Cir. 2012); *Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (nonuse by respondent at the time of filing the underlying use-based application, cancellation granted) and *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1289 (TTAB 2007) ("an opposition will be sustained as to any of the identified goods as to which it is shown that no use had been made as of the application filing date").

Opposer, as plaintiff in this proceeding, bears the burden of proof of showing by a preponderance of the evidence that Mr. Nasser was not using the applied-for mark at the time of filing the involved application. Opposer may present a *prima facie* case of nonuse based on Applicants' inability to present any evidence that Mr. Nasser was using the mark at the time. *Cf. Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993) (opposer would be entitled to prevail on its claim that applicant lacked a bona fide intent to use its mark if opposer proved that applicant is unable to present any evidence, documentary or otherwise,

supportive or bearing on applicant's claimed bona fide intention to use the mark in commerce); *see also*, *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1197 (TTAB 2011), *vacated on other grounds*, *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 107 USPQ2d 1626 (TTAB 2013) (“If an opposer establishes a prima facie case, the burden shifts to applicant to rebut that prima facie case by producing evidence which would establish that it had the requisite bona fide intent to use the mark when it filed its application.”) (citing *Commodore Electronics*).

In presenting its case, Opposer states that Applicants have offered no evidence that Mr. Nasser was using the mark as of the June 1, 2012 filing date. Opposer acknowledges that Mr. Nasser may have once used the mark but that the evidence “suggests that after eight years of nonuse, Applicant only resumed selling the [goods with the grenade design mark] in either late 2012 or early 2013, ... assuming he made any sales at all.”¹³ In support of its claim of nonuse, Opposer relies exclusively on the excerpts from the Nasser deposition that it introduced and certain accompanying exhibits that include, *inter alia*, Applicants’ interrogatory responses.

In particular and with respect to Mr. Nasser’s purported nonuse of the mark at the time of filing, Opposer asserts that “the actual date [when] production [of goods with the grenade design mark] was restarted . . . is unclear, with Applicant only saying that it was sometime in 2012.”¹⁴ Applicant cites to the following testimony:¹⁵

Q. ... And the last time that you had the Little Grenade product manufactured was when; do you recall?

¹³ 56 TTABVUE 11.

¹⁴ *Id.* at 9.

¹⁵ Nasser Dep. 97:23-98:1

A. Manufactured? 2012.

Opposer further asserts that “[m]ore importantly, though, Applicant admittedly did not begin *distributing* the product until either late 2012 or early 2013”;¹⁶ however, the testimony that Opposer relies on does not necessarily indicate a “late” 2012 date:¹⁷

Q. Do you remember when you sold to them?

A. It was like first in 2012, I think, 2012 or early 2013. I think 2012.

Q. Do you recall what you sold them?

A. Yeah, air freshener.

Q. The Little Grenade [grenade design]?

A. Yes.

Q. This one in this package?

A. Yes. Not this one, the blue one before, the one that had the grenade on it.

Q. The small –

A. Grenade.

Q. – grenade. Okay.

A. It was blue color.

Q. Do you recall how much you sold them?

A. Oh, not too much. Like not even 50 people.

Q. Okay.

A. Like probably 40. And he told me, “Oh, you should advertise.” I left them. I never went back.

¹⁶ 56 TTABVUE 9.

¹⁷ Nasser Dep. 236:10-237:11.

Q. And are these the only two customers?

A. This one – this one, I like. The other one, no.

Opposer contends in its brief that it “requested that Applicant provide evidence relating to the manufacture of LITTLE GRENADE products but no documents were produced.”¹⁸ At one point in Mr. Nasser’s testimony he was asked about receiving “requests” for “documents and information” and he indicates that he did respond:¹⁹

Q. All right. And you recall receiving the requests from Julius Samann's counsel regarding the opposition ...; correct?

A. Yeah.

Q. And what did you do to collect the documents and information that were requested?

A. Did a search.

Q. What did you search?

A. In Google, and all about stories about what the Car-Freshener company do to other company, cancel their trademark and try to attack other company like how they're doing with me.

Q. And did you do anything other than search Google to respond to these requests for information and documents?

A. Depend on the question, what they asking for.

Q. So we can go through them, but in general, did you search through your records or files?

A. No, only Google and whatever personal between me and the company.

Q. Okay. And where did you look for information for your personal information?

A. My personal? Like something if I remembered or if I have the document for it.

¹⁸ 56 TTABVUE 9.

¹⁹ Nasser Dep. 119:4-120:23.

Q. Okay. You testified earlier that you don't keep documents.

A. If I'd have, I said.

Q. So where would you keep documents if you keep them?

A. Oh, in my house.

Q. In your house, your personal –

A. Yeah.

Q. Do you have a filing cabinet or something?

A. Yeah, a small one.

Q. And that –

A. I have like only the first registration and a few documents only. Limited. I never save too many.

Q. And on all of those documents you searched in response to these requests; correct?

A. Yeah.

In analyzing the entirety of the deposition transcript excerpts submitted by Opposer, we are able to discern that there was some miscommunication and confusion during the questioning of Mr. Nasser. However, and giving special consideration to the excerpts that Opposer has cited to, we find no admission or indication that Mr. Nasser was not using the mark on the identified goods in June 2012. We disagree with the conclusion drawn by Opposer that Mr. Nasser “did not begin *distributing* the product until either late 2012 or early 2013” based on his response that he was using the mark in “in 2012, I think, 2012 or early 2013. I think 2012.” With respect to any documents supporting use at that time, it appears that Mr. Nasser (or his

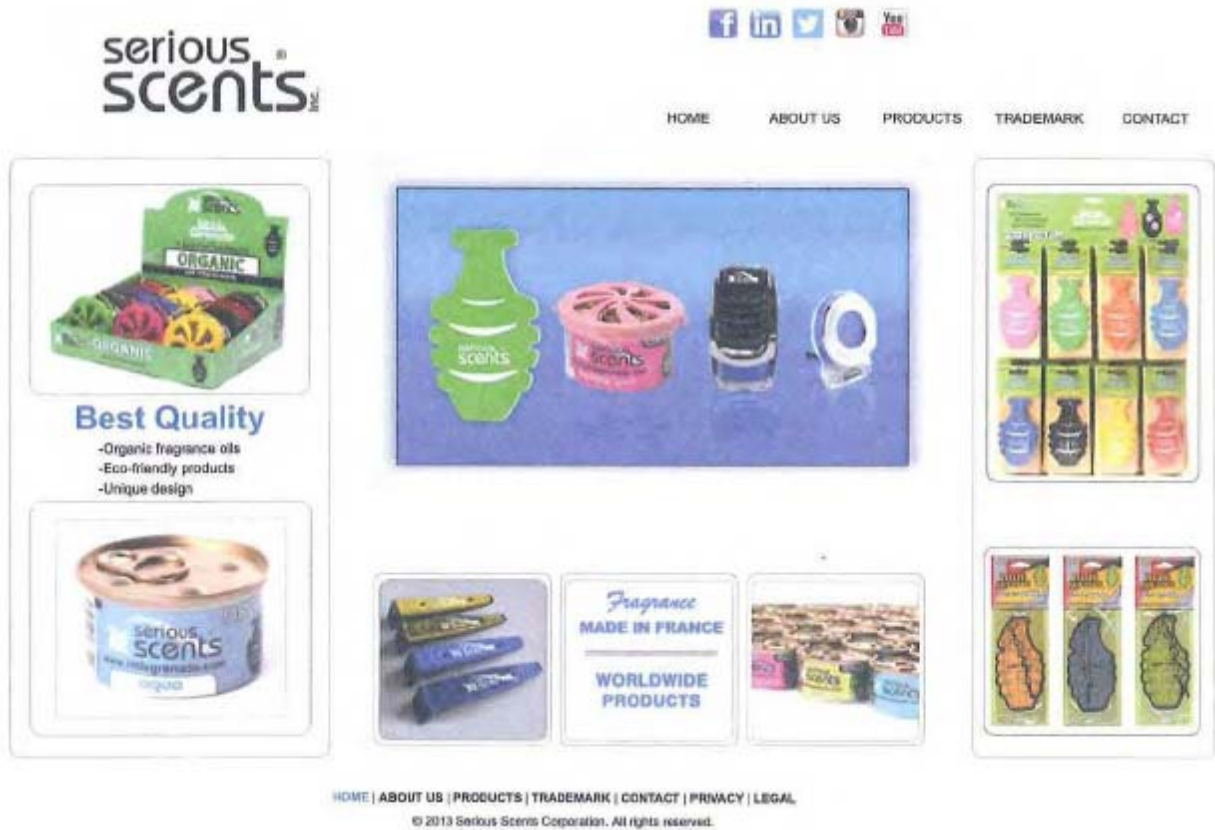
counsel representing him at the time of the deposition) affirmatively stated that there were documents but they were being withheld due to a perceived insufficiency of the Board's standard protective order.²⁰ At one point in the deposition, counsel for Opposer stated that Opposer "reserve[d] the right to seek sanctions for failure to provide additional documents and withhold information on the basis of the inadequacy of the Board's standard protective order."²¹ However, no such motion for sanctions, let alone a motion to compel discovery, was filed by Opposer. Because Opposer did not introduce any requests for the production of documents, or any responses, we cannot now decide on the legitimacy or attach any relevance to a purported failure on Applicants' behalf to produce responsive documents.

In contrast, certain excerpts from the Nasser deposition and exhibits introduced therewith by Opposer, actually indicate that Mr. Nasser was at least advertising air freshener products with the grenade design mark. For example, Mr. Nasser was questioned about the exhibit shown below (Nasser Exhibit 23), described as a printout of his website (www.seriousscents.com):²²

²⁰ Nasser Dep. 25:14-17 ("Ms. Marsh [Opposer's counsel]: And you are withholding documents and/or information on the basis of the insufficiency of the protective order? Ms. Scheufler [Mr. Nasser's counsel at the time] A. Correct"). We further note that in Applicants' responses to Opposer's interrogatories (Nasser Exhibit 15), there is a reference to requests for the production of documents; however, neither the document requests nor responses thereto were introduced.

²¹ *Id.*, 25:22-26:1.

²² Nasser Dep. 152:19-153:8.



Q. We're going to mark this 23. Do you recognize this?

A. Yes.

Q. What is it?

A. That's my website, part of it.

Q. Is this your current website?

A. No.

Q. When was this website up?

A. This one, last year.

Q. Last year. 2013?

A. Yes.

Q. And how long was it up, this particular website?

A. This one, for probably two years.

Q. Two years. Okay. ...

Based on this testimony, the website was in existence from approximately from 2011 to 2013, thus covering the June 2012 filing date. Although the exhibit, even coupled with Mr. Nasser's testimony, does not necessarily evidence actual trademark use, it is consistent with and supports Mr. Nasser's assertion of use of the grenade design during that time period on packaging for related products. This is further bolstered by Applicants' interrogatory response claiming:²³

[Applicant] uses the mark at its website ... where other variations/updates of packaging bearing the mark can be seen. Applicant's responses to Opposer's Requests for Production has included one or more PDFs of each of the website pages that bear the mark which is a single grenade. Please take note that all packages bearing the single grenade appear hung vertically ...

We further note that in a separate interrogatory response requesting Applicants to identify retailers or outlets through which goods bearing the grenade design were sold, Applicants identified more than a dozen specific retailers where the goods "were offered for sale as early as Oct. 31, 1993."²⁴

In sum, the entirety of the evidence presented by Opposer does not create a *prima facie* showing that Mr. Nasser was not making use of the grenade design mark at the

²³ Nasser Exhibit 15 (response to Interrogatory No. 1). We further note that Applicant's response to Interrogatory No. 11, involving advertisements and their publication dates, Applicant stated that its websites www.seriouscents.com and www.littlegrenade.com was [sic] launched on July 5, 2006 and other Internet websites appeared after that date. (Response to Interrogatory No. 11).

²⁴ Id. (response to Interrogatory No. 4)

time of filing the application; and, thus, the burden of proof did not shift to Applicants to prove use of the mark at that time. Noticeably absent from the record are responses to admission requests, document requests or interrogatories showing that Applicants are not able to produce documentary evidence to support use of the mark at that time. *Cf., e.g., ShutEmDown Sports*, 102 USPQ2d at 1040-41) (*prima facie* showing made based on admissions by defendant and “other interrogatory responses coupled with [defendant’s] acknowledgment of the lack of documents such as sales records, bank records, tax returns, sales receipts, invoices, bills of service, advertising and promotional materials”). Indeed, with respect to the list of retailers purportedly selling Applicants’ goods bearing the grenade design mark, Opposer has not presented evidence contradicting or casting doubt on the veracity of this information. As a consequence, the fact that Applicants did not introduce any evidence at trial is immaterial as there was no burden of proof placed on them.

IV. Conclusion

We find that Opposer has not carried its burden of proof to prevail on its claim of nonuse. That is, Opposer has not proven by a preponderance of the evidence that Mr. Nasser was not using the mark in commerce as of June 1, 2012, the filing date of the application.

Decision: The opposition is dismissed.