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

Proceeding	91213081
Party	Plaintiff The Trustees of the Bonnie Cashin Foundation Lucia Keller and David Baum
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 85/525339  
Filed January 25, 2012  
For the mark BONNIE CASHIN  
Published in the Official Gazette on June 25, 2012

THE TRUSTEES OF THE BONNIE CASHIN  
FOUNDATION, LUCIA KELLAR AND  
DAVID BAUM, a New York Trust,

*Opposer,*

- against -

STEPHANIE DAY LAKE, an individual,

*Applicant.*

Opposition No. 91213081  
(parent)

COACH, INC.,

*Opposer,*

- against -

STEPHANIE DAY LAKE, an individual,

*Applicant.*

Opposition No. 91213082

**OPPOSERS' REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

Opposers, The Trustees of the Bonnie Cashin Foundation, Lucia Kellar and David Baum (the "Foundation") and Coach, Inc. ("Coach), hereby submit the following Reply Memorandum in support of their Motion for Summary Judgment:

**I. INTRODUCTION**

Applicant Stephanie Lake misses the mark in her Response to Opposers' Motion for Summary Judgment ("Response"). Lake's Response boils down to two flawed contentions: (1) Lake claims that her self-serving and unsubstantiated declaration evidences her bona fide intent to use the BONNIE CASHIN mark in commerce; and (2) Lake erroneously relies on *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993) to

excuse the lack of evidence, citing non-precedential opinions to the exclusion of binding precedent. These contentions ignore key facts and legal principles; as such, they are fatally flawed and insufficient to defeat summary judgment.

First, Lake offers no objective evidence to support her claim that she had a firm bona fide intent to use the BONNIE CASHIN mark in commerce at the time she filed her intent to use application. In responding to Opposers' summary judgment motion, Lake failed to offer a single contemporaneous document to support her claims. Nor did she offer sworn testimony from the third parties with whom she claims to have discussed her business plans after she filed her application. Instead, Lake answered the motion with a self-serving and unsubstantiated declaration consisting mainly of particulars of her post-application efforts to write a book on Bonnie Cashin and attempts to seek out personal publicity in connection with the book.<sup>1</sup> Notably, Lake ignores contradictory deposition testimony and written discovery responses in which she admits she has done nothing toward bringing the identified goods to market and admits to having no objective evidence to support her claim.

Second, Lake relies heavily on *Commodore Electronics Ltd.* to support her argument that the complete absence of record evidence is not fatal to her claim; however, *Commodore Electronics Ltd.* supports the opposite proposition – that the absence of documentary evidence regarding bona fide intent constitutes objective proof sufficient to prove an applicant's lack of bona fide intent. Lake also relies on non-precedential opinions from the TTAB and, more importantly, conspicuously ignores the overwhelming, and more recent, binding authorities cited

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<sup>1</sup> Only one of the documents that Lake includes as an exhibit (Ex. A) with her Response was available during the discovery period – written responses to discovery. The remaining exhibits, even had they been produced during discovery, represent Lake's activities long after she applied for the mark and fail to establish her intent to use the mark at the time she applied for it.

herein stating that a bona fide intent to use a trademark in commerce requires both actual intent and documentary evidence demonstrating such intent.<sup>2</sup>

Because Lake has never produced or even identified a shred of objective admissible evidence demonstrating her bona fide intent, the Board must grant summary judgment.

## **II. SUMMARY JUDGMENT SHOULD BE GRANTED BECAUSE LAKE'S DECLARATION IS NOT SUFFICIENT TO SUPPORT HER CLAIM OF BONA FIDE INTENT TO USE THE MARK**

Federal courts and the Board have consistently found that an applicant's testimony alone is insufficient to show the requisite bona fide intent to use a mark in commerce. In *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q.2d 1883, 1891-92 (TTAB 2008), the trademark applicant offered his own testimony to demonstrate his bona fide intent to use the mark in commerce. In discrediting the applicant's self-serving testimony, the Board stated:

This testimony offers no facts which explain or outweigh the failure of applicant, when he filed his application, to have documents which support his claimed intent to use the ENYCE mark in connection with custom automotive accessories. Applicant's decision to forego a business model until after the opposition is decided does not explain his failure to have any documents whatsoever at the time the application was filed that showed an intent to use the mark.

*Id.* at 1892; *see also Honda Motor Co. v. Friedrich Winkelmann*, 90 U.S.P.Q.2d 1660, 1662 (TTAB 2009) (declarations of intent to use a mark insufficient to demonstrate bona fide intent; summary judgment granted). Moreover, the Board in *L.C. Licensing, Inc.* noted that the "[a]pplicant, in his answers to opposer's interrogatories and document production requests, indicated that he had no documents evidencing an intent to use the ENYCE mark on custom

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<sup>2</sup> Notably, *Commodore Electronics* was cited in 2015 by the Federal Circuit in *M.Z. Berger & Co. v. Swatch AG* and by the TTAB in its ruling in *Honda Motor Co.* in 2009 to support the proposition that the dearth of documentary evidence regarding bona fide intent constitutes objective proof sufficient to prove the applicant's lack of bona fide intent. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015); *Honda Motor Co. v. Friedrich Winkelmann*, 90 U.S.P.Q.2d 1660, 1662 (TTAB 2009).

automotive accessories.” *L.C. Licensing, Inc.*, 86 U.S.P.Q.2d at 1891.

Here, Lake appears to claim that her self-serving declaration is sufficient to demonstrate her intent to use the BONNIE CASHIN mark in commerce. Lake points to her academic interest in Bonnie Cashin’s career, asserts that she (at some undated and uncorroborated time) conducted research into the status of the Foundation, allegedly conducted a trademark search on the status of pending Foundation trademark applications, and, *after filing her application*, purportedly consulted with two individuals about brand strategy. *See* Lake Dec. ¶¶ 9-10, 12-14.<sup>3</sup> These are all activities that should presumably be accompanied by documentary evidence, such as calendar entries, notes on or during the meetings, or papers concerning this alleged brand strategy. However, Lake admitted to not having a single piece of documentary evidence regarding these alleged activities. *See* Lake Dep. 149:9-15.<sup>4</sup> Nor has she offered anything from these individuals about these alleged conversations other than her own self-serving and hearsay-laden testimony.

Lake offered no explanation at all for her failure to have supporting documents as required by *Commodore Electronics, Ltd.*. Instead, Lake relies on her declaration, replete with uncorroborated “facts” and hearsay. Such a statement cannot not qualify as credible evidence of intent in January 2012. *L.C. Licensing, Inc.* 86 U.S.P.Q.2d at 1891-92 (“The mere assertion of an intent to use the mark without corroboration of any sort ... is not likely to provide credible evidence to establish a bona fide intention to use the mark”). Thus, Lake’s reliance on her unsubstantiated declaration fails to satisfy the “objective” evidence requirement.

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<sup>3</sup> Citations to Lake Dec. are to the declaration attached to Lakes’ Response, filed on July 21, 2016.

<sup>4</sup> Citations to Lake Dep. are to the discovery deposition taken of Applicant Lake on April 11, 2016. A copy of the entire deposition transcript is attached as Exhibit 1 to Opposers’ Motion, filed on June 2, 2016.

The absence of documents aside, closer review of the activities Lake claims she undertook makes clear that these activities were either (1) conducted entirely in her capacity as an employee of and for the Foundation years before she applied for the mark, or (2) are activities in which she has engaged long after she applied for the mark and in connection with her own professional and academic endeavors – not for the benefit of commercializing the mark. Indeed, when asked in her discovery deposition to describe steps she had taken to commercialize the mark, Lake revealed that she had merely reserved the mark because she was afraid someone unrelated to Bonnie Cashin would register the trademark. *See* Lake Dep. at 40:2-4; *id.* at 50:3-7 (“that was my concern upon her death, that ... someone outside of Henry, myself and Curtis would purchase the name and do something unrelated to her wishes.”). Lake never met with potential manufacturers, distributors, designers, buyers, licensees, or licensors for her own account at any time prior to filing her application. *See* Lake Dep. at 129:16-23, 141:14-142:13. She never “create[d] any potential [product] designs that [she] would ... consider pursuing,” or make mockups for products she might sell under the mark. *Id.* at 142:14-16. Nor did Lake “develop any marketing plans for the Bonnie Cashin mark,” *id.* at 142:20-143:2, or create any promotional materials. *Id.* at 143:19-144:7. “[P]rior to the registration, [she had no] concrete plans [at all] ... to use the mark in commerce.” *Id.* at 143:15-144:11. And though Lake had no trouble recalling alleged (undocumented) conversations with two people after applying for the trademark about brand strategy, the only tangible effort to market the brand she could cite in her sworn deposition was a meeting she had six years before applying for the mark with G-III on behalf of the Foundation.

Lake’s excuse for a record devoid of evidence? She claims “this Opposition has slowed [her] business discussions. [She] intend[s] to resume discussions with future licensing and retail

partners upon completing of this opposition.” As an initial matter, intent to “resume” discussions with licensing and retail partners implies that she has had *past* discussions with licensing and retail partners – an implication utterly belied by the evidence. More importantly, Lake’s excuse to forego business activities until the instant litigation is resolved does not explain her absolute failure to have a single document regarding her alleged activities and her alleged intent to use the mark at the time that her trademark application was filed. *See L.C. Licensing, Inc.*, 86 U.S.P.Q.2d at 1892. Further, Lake cites to *Nautica Apparel, Inc. v. Crain*, 2001 WL 1182881 (TTAB Sept. 21, 2001) in support of her “business decision” argument. However, *Nautica* is a non-precedential case and is, therefore, of no help here. Even if *Nautica* were precedential, “the decision does not explain the lack of objective evidence at the time of [her] application, which is the applicable time frame.” *See City of Carlsbad v. Shah*, 666 F.Supp.2d 1159, 1167 n.10 (S.D. Cal. 2009). Moreover, Lake’s assertion that the opposition has hampered her efforts to commercialize the mark is contradicted by the very activities she claims support her bona fide intent to use. Clearly this opposition has been no barrier to Lake as she found time and resources to write her 300-page book, pursue a jewelry design business (*see* Lake Dep. at 19:3-22), and seek out personal publicity and interviews; yet, Lake could not find a moment to prepare a simple marketing proposal, marketing strategy, or business plan since January 2012.

Without objective corroborating evidence, Lake’s declaration offers no facts that explain or outweigh her failure to have support for her claimed intent to use the mark in commerce.

### **III. OVERWHELMING AUTHORITY SUPPORTS DENIAL OF LAKE’S TRADEMARK APPLICATION DUE TO HER LACK OF BONA FIDE INTENT TO USE THE MARK IN COMMERCE**

Lake’s heavy reliance on *Commodore Electronics* is misplaced because that case, in fact, supports Opposers’ position. Lake erroneously asserts that *Commodore Electronics* stands for the

proposition that the issue of bona fide intent is not suited for summary judgment. Even if this were true, Lake ignores the numerous other cases cited by Opposers that support its motion for summary judgment and the fact that the *Commodore Electronics*' proposition that documentary evidence is required to demonstrate bona fide intent was more recently reaffirmed by the TTAB.

As an initial matter, courts have overwhelmingly put an objective test on the issue of bona fide intent. *M.Z. Berger*, 787 F.3d at 1376. The mere assertion of intent to use the mark, without corroboration, does not provide credible evidence to establish a bona fide intent to use the mark. *L.C. Licensing, Inc.*, *supra*, 86 U.S.P.Q.2d at 1892; *see also Aktieselskabet af 21. November 2001 v. Fame Jeans, Inc.*, 525 F.3d 8, 21 (D.C. Cir. 2008) (“both actual intent to use a mark in commerce and evidence, contemporary with the application, that objectively demonstrate such an intent” are required under the Trademark Act); *Honda Motor Co.*, 90 U.S.P.Q.2d at 1662 (the absence of documentary evidence constitutes objective proof sufficient to prove that applicant lacks a bona fide intention); *see also SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 U.S.P.Q.2d 1300, 1305 (TTAB 2010) (record “devoid” of evidence such as manufacturing efforts, licensing efforts, test marketing, correspondence).

Moreover, the proposition that summary judgment is appropriate when the applicant fails to produce any documentary evidence of bona fide intent to use the mark has been reaffirmed in more recent cases. *City of Carlsbad*, F.Supp.2d at 1165. For example, in *Honda Motor Co.* the Board noted that, while questions of intent should not generally be decided on summary judgment, it went on to state: “The Board has held, however, 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.” *Id.* at 1662 (citing *Commodore*, 26 U.S.P.Q.2d at 1507). The Board granted summary judgment for Opposer.

Similarly, in *L.C. Licensing, Inc.*, the Board analyzed the applicant's answer to various interrogatories, all of which indicated that he had no documents evidencing his alleged intent to use the marks for which he was seeking to register, just as in the present case. In sustaining the opposition, the Board found that “[t]he mere assertion of an intent to use the mark without corroboration of any sort, whether documentary or otherwise, is not likely to provide credible evidence to establish a bona fide intention to use the mark.” *Id.* at 1892.

Since Lake admits that she has no contemporaneous evidence of her intent to use the mark, she must offer something other than documentary evidence or provide a valid justification to excuse the lack of evidence. *Honda Motor Co.*, 90 U.S.P.Q.2d at 1662. However, the discovery responses on which Lake relies in her Response – answers to four requests from Opposers’ Second Set of Interrogatories (“ROG”) Nos. 3, 5, 9, and 10<sup>5</sup> – fail to satisfy her burden. ROG 3, where Lake merely explained her interest in Bonnie Cashin, does not support her claims of intent; indeed, Lake testified under oath that she applied for the mark to reserve it because she was afraid someone unrelated to Bonnie Cashin would register the trademark. *See* Lake Dep. at 40:2-4; *id.* at 50:3-7. In ROG 5, Lake points to her curated museum exhibitions as proof of intent; however, Lake curated these events at least 10 years before she applied for the mark and one was paid for by Opposer Coach. *See* Lake Dep, at 16:4-18:18, 122:15-124:10, 127:5-21. Similarly, in response to ROG 9 (identify the mediums in which goods sold under the mark were intended to be sold), Lake merely offered hypothetical mediums in which she might,

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<sup>5</sup> A complete set of Lake’s responses to the first and second set of Opposers’ written discovery requests were attached as Exhibits 8 and 15 to the initial Motion for Summary Judgment.

someday, sell goods. More than four years later she has yet to take any concrete objective steps to develop a single product. Finally, in ROG 10, Lake was asked to list websites on which she has a presence. Lake merely lists those websites – without offering anything regarding the content of the websites – as evidence of intent but fails to explain how they have any bearing on her intent in January 2012 to use the mark in commerce.

Indeed, Lake’s written responses to Opposers’ second set of discovery requests (*see* Ex. 15 to the Motion), when read fully and in context, make clear that Lake lacked a bona fide intent to use the mark in commerce when she submitted her application. Put simply, the record is devoid of any evidence such as manufacturing efforts, licensing efforts, test marketing, communications with prospective designers or licensees, consumer research, preparation of marketing plans or business plans, creation of marketing or promotional materials, and the like. *See* Admission 7 and Interrog. 11- 14, 17, 20, 25; Doc. Req. 17, 19-24; Lake Dep. at 141:14-143:6

In short, Lake’s responses to discovery in this proceeding belie her claim that she had the requisite bona fide intent to use the mark in commerce when she applied for the mark in January 2012.

#### **IV. CONCLUSION**

At most, Lake’s “evidence”, as offered in her declaration, provides self-serving indications that she has considered use of the involved mark and may even have confidence in her ability to bring such goods to market at some point in the future. Her aspirations do not, however, amount to a bona fide intent to use the BONNIE CASHIN mark in commerce at the time she applied for the mark. Therefore, Opposers respectfully request that their Oppositions be sustained and Lake’s application be refused.

Date: August 10, 2016

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### **CERTIFICATE OF SERVICE**

I hereby certify that on August 10, 2016 I caused a true and correct copy of the foregoing Reply Brief in Support of Motion for Summary Judgment to be served by U.S. Mail on the attorney and correspondent of record for the Applicant and Opposer as follows:

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