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

Proceeding	91214508
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TEKNI-PLEX, INC.,)	
)	Opposition No. 91214508 (parent)
Opposer,)	Opposition No. 91215874
)	
v.)	Serial No. 86/001,725
)	Filed July 3, 2013
)	Mark: EDGEPULL
SELIG SEALING PRODUCTS, INC.,)	
)	Serial No. 86/001,764
Applicant.)	Filed July 3, 2013
)	Mark: EDGEPEEL
)	

**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY
JUDGMENT**

The Opposer, Tekni-Plex, Inc. (hereinafter, “Tekni-Plex” or “Opposer”), submits this Reply Brief in support of its Motion for Summary Judgment, pursuant to Fed. R. Civ. P. 56(a) and Trademark Rules of Practice 2.127(e), on the grounds that Applicant, Selig Sealing Products, Inc. (hereinafter “Selig” or “Applicant”) lacked a *bona fide* intent under 15 U.S.C. §1051(b) to use the marks EDGEPULL and EDGEPEEL (the “Marks”) in commerce at the time of filing of its applications, U.S. Serial Nos. 86/001,725 and 86/001,764 (hereinafter, the “Selig Applications”).

In its Response to Opposer’s Motion for Summary Judgment (“Response”— filed in Proceeding No. 91214508, Dkt. # 21)¹, Selig again attempts to divert the Board’s attention from the clear lack of objective evidence of *bona fide* intent to use the Marks at the time the Selig Applications were filed. Selig instead attempts to focus the Board’s attention on the timing of

¹ For ease of reference for the Board, Opposer will refer to the record in Proceeding No. 91214508, and will refer to the Motion for Summary Judgment filed in that proceeding, though all arguments made are applicable to both the EDGEPULL and EDGEPEEL Marks and both Selig Applications.

Tekni-Plex's Motion and other matters that are not relevant to the question of *bona fide* intent, distorting the facts that are relevant to the Motion in the process. These attempts cannot substitute for evidence of *bona fide* intent to use the EDGEPULL and EDGEPEEL Marks that was unquestionably absent in discovery, and likewise is not found in Selig's Response. Absent such evidence, there is no genuine issue for trial, the Selig Applications should be deemed void *ab initio*, and summary judgment should be granted in favor of Tekni-Plex in both consolidated Proceedings.

Accordingly, Opposer requests entry of summary judgment and refusal to register the Marks, as there is no genuine issue of material fact on the ground that the Selig Applications were void *ab initio* for failure to have a *bona fide* intent to use the Marks in connection with the identified goods at the time of filing.

A. Selig's Attempts to Divert the Board from the Lack of Evidence of *Bona Fide* Intent Must Fail

In its Response, Selig questions the timing of Tekni-Plex's additional claim for lack of *bona fide* intent to use the Marks, accusing Tekni-Plex of raising this issue and filing its Motion "on the eve of trial." (Response at 1, 5). The Board already found the timing of this claim proper when it granted Opposer's Motion to Amend the Notices of Opposition, finding that "the proposed new claim is legally sufficient," that "Applicant ignores the possibility that its own discovery responses could have rebutted any assumption made by Opposer regarding Applicant's lack of *bona fide* intent to use based on its multiple filings," and that "the Board sees no prejudice to Applicant inasmuch as all information relevant to Applicant's intent plainly is already available to Applicant." (Dkt. No. 18 at 6). Moreover, TBMP § 528.02 makes clear that the timing of Opposer's Motion was well within the rules, which state that motions for summary judgment should be filed prior to commencement of the first testimony period. Selig's attempts

to sway the Board's decision by alleging that Opposer has somehow acted improperly, despite the Board's determination on the issue and the rules regarding the same, should be rejected out of hand.

Selig also attempts to distort the facts which form the basis of Opposer's Motion for Summary Judgment. Selig notes that "the record makes objectively plain that the discovery period closed without any motions alleging misbehavior in discovery" when arguing that Opposer has failed to submit evidence to support its motion based on a lack of *bona fide* intent. (Response at 2). However, Opposer's Motion for Summary Judgment was not based on improper behavior by Selig during the discovery phase, but rather contended that Selig's failure to produce any documentary evidence during discovery constitutes objective proof of its lack of *bona fide* intent to use the Marks. There is no dispute as to Selig's failure to produce any documentary evidence of *bona fide* intent in discovery, or at any time thereafter. (*See* Applicant's Answers to Am. Notices of Opp., Dkt. # 19 ¶ 17, Dkt. # 20 ¶ 18). To date, Selig has provided no explanation or excuse for its failure to produce any evidence which would support an alleged *bona fide* intent as of the time the Selig Applications were filed.

In a related vein, Selig suggests that Tekni-Plex should somehow be faulted for not inquiring more deeply into Selig's "intent to use" during discovery. (Response at 5). This is simply incorrect, as illustrated in Opposer's Motion for Summary Judgment at 6-10. Opposer's First Set of Interrogatories, in fact, expressly sought "all facts relating to Selig's selection and adoption of the Applied for Mark[s]" and "each product offered or sold (or intended to be offered or sold) by Selig under or bearing the Applied for Mark[s]," among other information. (*See* Opposer's Motion, Ex. 3, Nos. 3 & 9). It was the complete lack of evidence in response to such interrogatories and related requests for document production which gave rise to Opposer's claim

for a lack of *bona fide* intent to use the Marks. Thus, Selig’s assertion that Opposer should have pointedly asked more about “Selig’s intent to use” the Marks in the interrogatories is both meritless and irrelevant.²

Further, Selig focuses on the fact that Opposer’s Motion for Summary Judgment is based on the claim for lack of *bona fide* intent—which was properly added in the Amended Notice of Opposition by the Order of the Board—rather than on a likelihood of confusion. (Response at 2) (“...the opposer submits no evidence in support of its original cause of action, that of – in sum – priority and likelihood of confusion.”). Selig even contends that Opposer has “abandon[ed] its original cause of action and pursu[ed] an eve-of-trial substitute” by not asserting such argument in the Motion for Summary Judgment. *Id.* at 5. Opposer has not, however, abandoned or forfeited any argument or cause of action relevant to this proceeding, or improperly moved for Summary Judgment. Rather, Opposer has moved for Summary Judgment on a cause of action in which there is demonstrably “no genuine issue as to any material fact” and on which Opposer “is entitled to judgment as a matter of law.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986) (citing Fed. R. Civ. P. 56(c)).

B. Selig Has Presented No Evidence Showing a Genuine Issue of Material Fact

The central issue relevant to Opposer’s Motion for Summary Judgment—which Selig ignores entirely in its Response—is that Selig failed to provide, throughout discovery, a single piece of documentary or other evidence that it ever possessed a *bona fide* intent to use the Marks

² Opposer also disagrees with Applicant’s characterization of the deposition scheduling. (Response at 2). Opposer twice noticed the depositions of Applicant’s witnesses; against the backdrop of discussing a possible resolution, counsel for Applicant ultimately notified Opposer’s counsel that it would be unable to make the rescheduled dates because it had not been able to produce documents prior to the depositions. As admitted by Applicant, to date it has not produced any documents in this matter. (Answers to Am. Notices of Opp., Dkt. # 19 ¶ 17, Dkt. # 20 ¶ 18).

in U.S. commerce in connection with the goods “Primarily non-metal seals comprised of various layers including a metallic foil layer for use in container closures and caps” in International Class 17.

As noted in its Motion, Tekni-Plex served multiple discovery requests seeking to elicit information about how Selig came to select the EDGEPULL and EDGEPEEL Marks for its sealing products and about Selig’s intent to adopt and use the Marks. In response, Selig produced no evidence of 1) its development, creation, or adoption of the Marks; 2) business plans, promotional activities, marketing, advertising, or communications suggesting that Selig had a *bona fide* intent to use the Marks in commerce at the time of filing; 3) Selig’s decision to apply to register the Marks; or 4) Selig’s *bona fide* intent to use the Marks. (*See* Opposer’s Motion at 6-12 and citations therein). In fact, Selig did not produce a single document, such as internal emails, notes, or marketing plans, relating to the Marks.

Nor has Applicant provided any evidence of its *bona fide* intent to use either the EDGEPULL or EDGEPEEL Marks in its Response to Opposer’s Motion for Summary Judgment. Instead, the only information Selig provides in support of its claim is that it “is and has been squarely and demonstrably in the business of making the specified seals... [and that] printing marks, designs, artwork, and text on the seals such that producing branded seals, like EDGEPULL and EDGEPEEL, is already what Selig does.” (Response at 3) (emphasis added). Selig argues that its “website demonstrates that Selig offers printing services in the ordinary course of business for embellishing its seals with trademarks, logos and artwork.” *Id.* at 5.

However, not only did Selig not produce these materials in response to numerous discovery requests (but instead only now attached these documents—which were clearly available to Selig during discovery—to its Response), but the purported evidence provided in

Selig's Response makes no mention whatsoever of either the EDGE PULL or EDGE PEEL Marks. Conceding this fact, Applicant asserts that documents showing its general capability to produce and sell sealing products bearing any one of a number of other trademarks somehow constitute evidence of a *bona fide* intent to use these Marks. (Response at 2-3). Opposer respectfully submits that such an assertion is supported by neither the facts nor the applicable law.

As noted in Opposer's Motion, this irrelevant assertion has been the sole basis for Selig's alleged *bona fide* intent, namely that it "has for many years produced seals with a variety of trademarks and continues to develop and explore new products and marks," and that "applicant has existing products which can be adopted to use this mark once it is cleared of objections." (See Opposer's Motion at 8, and citations therein). That Applicant may print seals bearing a "myriad of customer trademarks," see Response at 2, as well as other of Selig's own marks, however, does not evidence that that Selig possessed, as of its July 3, 2013 filing date, an actual *bona fide* intent to use either the EDGE PULL and EDGE PEEL Marks. If it did, such evidence could support an application for any trademark whatsoever.

In further support of its contention, Selig cites to *M.Z. Berger & Co., Inc. v. Swatch AG*, 787 F.3d 1368 (Fed. Cir. 2015), for the proposition that "fully entrenched in the field of making the specified goods, Selig's ultimate use of the subject marks merely takes printing the mark on seals or packaging." Response at 5. However, *Swatch* did not hold that a mere ability to make a product on which a mark could be placed is sufficient to establish a *bona fide* intent. Rather, the Court in *Swatch* held that such ability is one factor to consider in a "totality of the circumstances" determination regarding *bona fide* intent. *Swatch*, 787 F.3d at 1376.

In fact, the Federal Circuit in *Swatch* sustained a determination by the Trademark Trial

and Appeal Board that the applicant there lacked a *bona fide* intent to use the applied-for mark in commerce at the time of the application, stating that the Board found unpersuasive of an alleged *bona fide* intent the applicant’s “use of a subsequent mark, i-Kidz and its efforts to develop the mark iMove for watches... as these efforts were related to different marks and had occurred almost three years after the iWatch application was filed.” *Swatch*, 787 F.3d at 1373-75. In its holding, the Federal Circuit noted that “whether an applicant had a ‘bona fide intent’ to use the mark in commerce at the time of the application requires objective evidence of intent. Although the evidentiary bar is not high, the circumstances must indicate that the applicant’s intent to use the mark was firm and not merely intent to reserve a right in the mark. The Board may make such determinations on a case-by-case basis considering the totality of the circumstances.” *Id.* at 1376 (internal citations omitted) (emphasis added). Here, the fact that Applicant filed applications for three similar marks—EDGE PULL, EDGE PEEL and EDGE TAB—for the same goods, on the same day, coupled with the absence of any documentary evidence regarding intent to use either of the Marks, indicates a mere intent to reserve a right in the Marks rather than a firm intent to use them.

Selig’s “immersion in the industry and ready capability to print marked seals,” *see* Response at 6, is not evidence of a *bona fide* intent to use the specific Marks as of the application filing dates. This is further illustrated in *City of Carlsbad v. Shah*, 666 F. Supp. 2d 1159, 1166-67 (S.D. Cal. 2009), where the District Court for the Southern District of California granted summary judgment based on the applicant’s lack of *bona fide* intent and held that “activities which allegedly show Defendant’s intention to use the marks, including the alleged designs and merchandise, should be accompanied by documentary evidence, ‘such as bank statements, purchase orders, invoices, and written communications. However, despite numerous

interrogatories and requests for production of documents, [applicant] has failed to produce a single piece of documentary evidence regarding these alleged activities.” (emphasis added).³

Selig also alleges, in support of its position, that it “has existing products which can be adopted to use this mark once it is cleared of objections.” Response at 4. As seen above in *City of Carlsbad*, this argument is insufficient to support a *bona fide* intent to use the Marks as of the application filing dates. In *City of Carlsbad*, the applicant “made a business decision not to proceed with commercial activities related to the mark until a legal dispute over the mark was resolved.” 666 F. Supp. 2d at 1167 (internal citations omitted). In granting summary judgment, the Court found that the “decision to forgo a business model until after the opposition is decided does not explain [applicant’s] failure to have any documents whatsoever at the time the application was filed that showed an intent to use the mark.” *Id.* Like the applicant in *City of Carlsbad*, Selig has failed to produce any documentary evidence to support its contention of a *bona fide* intent to use the Marks but its alleged decision not to proceed with use of the Marks until after resolution of this proceeding. Accordingly, this argument fails in this proceeding as well.

Furthermore, Selig has provided no evidence to explain or excuse its lack of documentary evidence supporting a *bona fide* intent to use the Mark. “[A]bsent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a

³ Nor does “ready capability to use the subject marks” distinguish this case from other precedent where lack of intent to use was found as a matter of law. (Response at 3-4). Lack of capability can indicate lack of intent, but it does not follow that capability necessarily establishes intent. As in those cases, the totality of the circumstances here, including lack of any documentary evidence supporting an alleged intent to use, warrants summary judgment in favor of the Opposer.

bona fide intention to use its mark in commerce as required by Section 1(b).” *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, No. 86336, 1993 TTAB LEXIS 6, *13 (T.T.A.B. Feb. 3, 1993); *see also Honda Motor Co. v. Winkelman*, No. 91170552, 90 U.S.P.Q.2d 1660 (T.T.A.B. Apr. 8, 2009). Selig did not submit an affidavit of a representative explaining the failure to produce any such documents, or provide any other basis for its allegation that the documents submitted with its Response—all of which are identified as “promotional information and the gallery of seals from the www.seligsealing.com website”—were not submitted in response to Opposer’s discovery demands. *See* Response at 2.

Where there is no evidence of an applicant’s *bona fide* intent to use a mark on the claimed goods, “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.” *PRL USA Holdings, Inc. v. Rich C. Young*, Opp. No. 91206846, 2013 WL 5820848, at *9 (T.T.A.B. Oct. 16, 2013) (citing *Honda*, 90 U.S.P.Q.2d at 1660). Accordingly, absent any such evidence in this proceeding, there is no genuine issue of material fact on the question of Selig’s *bona fide* intent to use the Marks, thereby warranting summary judgment in favor of Opposer.

Selig has produced no evidence that would suggest it possessed a *bona fide* intent to use the Marks in commerce at the time of filing the Selig Applications in connection with the goods identified therein. Selig has made no attempts to market, advertise, or sell products using the Marks, and it could not provide a single piece of documentary evidence regarding its development, creation, or adoption of the Marks, its decision to file the Selig Applications, or its alleged *bona fide* intent to use the Marks. There is no objective proof to support that conclusion, and Selig’s subjective, conclusory assertion of its “ready capability” to make a product using the Marks is not evidence that can overcome summary judgment. *Venture Out Props. LLC v. Wynn*

Resort Holdings LLC, 81 U.S.P.Q.2d 1887, 1890 (T.T.A.B. Jan. 3, 2007) (“The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.”).

As such, no genuine issue of material fact exists on this issue, and Tekni-Plex respectfully requests that the Board grant this Motion for Summary Judgment, sustain Tekni-Plex’s Oppositions, and refuse to register the Marks on the grounds that the Selig Applications were void *ab initio* for a lack of *bona fide* intent to use the Marks in commerce at the time of filing.

Respectfully submitted,

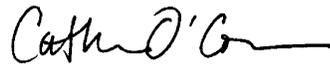
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CERTIFICATE OF SERVICE

I hereby certify that on this date a true and correct copy of the foregoing was served upon the attorney of record for the Applicant by electronic mail, as agreed to between the parties, as follows:

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