

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  
General Contact Number: 571-272-8500

JK

Mailed: November 25, 2015

Opposition No. 91214508 (parent case)

Opposition No. 91215874

Tekni-Plex, Inc.

v.

Selig Sealing Products, Inc.

**Before Quinn, Zervas and Bergsman.  
Administrative Trademark Judges.**

**By the Board:**

These consolidated proceedings are before the Board for consideration of Opposer's February 2, 2015 motions for summary judgment pursuant to Fed. R. Civ. P. 56(a), on its claim that the involved applications listed below are void *ab initio* on the ground that Applicant lacked a *bona fide* intent to use the marks at the time it filed its applications for the identified 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 of the July 3, 2013 filing date of the applications:

- Serial No. 86001725 for the mark EDGEPULL, and
- Serial No. 86001764 for the mark EDGEPEEL.

Prior to consolidation, Opposer filed the same motion for summary judgment in each proceeding. Applicant opted to file, in parent case Opposition No. 91214508, one brief in combined response to the motions. Accordingly, the motions are fully briefed.

The Board presumes familiarity with the parties' respective marks as set forth in the July 10, 2015 consolidation order, and with the operative pleadings - the amended notices of opposition filed February 2, 2015,<sup>1</sup> and the answers filed August 10, 2015.<sup>2</sup>

### **Analysis**

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed.

---

<sup>1</sup> In Opposition No. 91214508, 10 TTABVUE; in Opposition No. 91215874, 8 TTABVUE.

<sup>2</sup> In Opposition No. 91214508, 19 TTABVUE; in Opposition No. 91215874, 17 TTABVUE.

In its answers to the amended notices of opposition, Applicant unqualifiedly denied the salient allegations underlying the claim of lack of *bona fide* intent to use the mark at the time of filing the applications.

Cir. 1992). The party seeking judgment in its favor carries the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986).

Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. TBMP § 528.01 (2015), and cases cited therein.

Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states:

a person who has a *bona fide* intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register ...

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 such as 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, 1506 n.7 (TTAB 1993). The determination of whether an applicant has a *bona fide* intention to use the mark in commerce is made on a case-by-case basis considering the totality of circumstances, and requires objective evidence of intent. Although the evidentiary bar is not high, the circumstances must indicate that the intent to use was firm and not merely an intent to reserve a right in the mark. *M. Z. Berger & Co. v. Swatch*

*AG*, 787 F.2d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). *See also Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994) (“the determination of whether an applicant has a *bona fide* intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances”).

The evidence necessary to support a finding of a *bona fide* intent to use will differ in each case, depending on the circumstances. *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1664 (TTAB 2009). The Board considers the evidence as a whole, and any clear interrelationships that exist between the several pieces of evidence of record, to determine whether the evidence, in its totality, establishes a *bona fide* intent to use the mark for the identified goods. *Cf. West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). The Board may look to inconsistencies in the record, as well as the general lack of documentary support or other objective evidence. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2010 (TTAB 2015).

In the proceedings before us, to prevail on summary judgment in either proceeding, Opposer must demonstrate that there is no genuine dispute that 1) it has standing, and 2) Applicant lacked a *bona fide* intent to use the mark on “primarily non-metal seals comprised of various layers including a metallic foil layer for use in container closures and caps” as of the July 3, 2013 application filing date. Opposer may demonstrate a *prima facie* case that Applicant lacked a *bona fide* intent use the marks as of the filing date of the applications by establishing

that there is an absence of any documentary evidence on Applicant's part regarding such intent. *Commodore Electronics Ltd.*, 26 USPQ2d at 1507.

Opposer's standing

Opposer has standing to bring both proceedings. In its motion for summary judgment, under the declaration of its counsel Catherine Dugan O'Connor, Opposer states that on January 16, 2014 it filed application Serial No. 86167739 to register the mark EDGEPULL for "adhesive seals for use in packaging," that said application was filed based on use of the mark in commerce and alleging a date of first use at least as early as October 1, 2012, and that on February 25, 2014 the USPTO suspended action on its application until Applicant's application Serial No. 86167739 either registered or abandoned, based on a likelihood of confusion.<sup>3</sup> The O'Connor declaration includes a true and correct copy of Opposer's application,<sup>4</sup> as well as a true and correct copy of the suspension letter to which the examining attorney attached a copy of Applicant's application Serial No. 86001725.<sup>5</sup>

By way of these allegations, Opposer has sufficiently established that it has a real interest in the outcome of each of the opposition proceedings. That is, opposer has a direct and personal stake in the outcome. *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). *See also Lipton Industries*,

---

<sup>3</sup> 11 TTABVUE 5 (brief on motion). 11 TTABVUE 15-16 (O'Connor decl.)

<sup>4</sup> 11 TTABVUE 15 (O'Connor decl., para. 4, exh. 1).

<sup>5</sup> 11 TTABVUE 15 (O'Connor decl., para. 5, exh. 2). The suspension letter is erroneous on its face inasmuch as it states that Opposer's application Serial No. 86167739 is suspended pending the same application - Serial No. 86167739. However, the error is an obvious one; Opposer's application is clearly suspended pending Applicant's Serial No. 86001725 (*see* 11 TTABVUE 29).

*Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“We regard the desire for a registration with its attendant statutory advantages as a legitimate commercial interest. To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit (as in *Norac*) or, as here, a rejection of an application during prosecution.”).

No bona fide intent

Opposer submits and relies on Applicant’s responses to its interrogatories and document requests. Trademark Rule 2.127(e)(2); TBMP § 528.05(c) (2015). It submits the declaration of counsel attesting that Opposer served its first set of interrogatories and first request for production of documents on Applicant on September 5, 2014, and that Applicant served responses on October 6, 2014 but did not produce therewith any documents.<sup>6</sup> In particular, Opposer points to interrogatories 2, 3, 9 and 10, as well as document requests 3, 5, 6, 8, 11-14, 17, 18, 28 and 32.<sup>7</sup> In these document requests, Opposer specifically sought, with respect to the applied-for marks, documents concerning: public filings, brochures, press releases, communications, advertisements, promotional or marketing materials; adoption of the marks; business plans, marketing plans, sales agreements, distribution agreements, proposals, price quotes; branding, sales or distribution plans, strategies and forecasts; sales or offers to sell goods in the United States, and communications with customers or potential customers. In summary, Applicant’s

---

<sup>6</sup> 11 TTABVUE 16 (O’Connor decl.)

<sup>7</sup> 11 TTABVUE 8.

responses consist of boilerplate objections (*e.g.* request 6), or boilerplate objections coupled with the repeated response that it “will produce” relevant and non-privileged documents “if any exist” or similar wording.

On the issue of what it produced in discovery, Applicant argues that it “responded to Interrogatories and accurately stated that it has existing products available for the EDGEPULL and EDGEPEEL marks,”<sup>8</sup> and cites its responses to interrogatories 3 and 10. However, in these two responses, aside from boilerplate objections, Applicant merely states that it “has for many years produced seals with a variety of trademarks and continues to develop and explore new products and marks. One long existing product has the phrase Pull from Edge to Open” (response to interrogatory 3),<sup>9</sup> and “has existing products which can be adopted to use this mark once it is cleared of objections” (response to interrogatory 10).<sup>10</sup> Such responses do not raise a genuine dispute with respect to Applicant’s *bona fide* intent to use the marks at issue in these proceedings.

Turning to Applicant’s submissions, it proffers what it describes in its brief as “pages from its website, [www.seligsealing.com](http://www.seligsealing.com), showing the history of Selig as well as its products and services.”<sup>11</sup> In its brief, it states that “[T]hese pages display the variety of trademarked packaging seals readily available from Selig,” that the pages show “promotional information and the gallery of seals,” that “[T]his gallery displays a myriad of customer trademarks and brands that Selig prints on seals as

---

<sup>8</sup> 21 TTABVUE 5.

<sup>9</sup> 11 TTABVUE 38.

<sup>10</sup> 11 TTABVUE 41.

<sup>11</sup> 21 TTABVUE 3.

well as Selig's own marked seals, all printed in the ordinary course of its business,"<sup>12</sup> and that "[T]he website demonstrates Selig's substantial business and presence in the sealing business contemporaneous with the filing of the EDGEPULL and EDGEPEEL trademark applications."<sup>13</sup>

The marks EDGEPULL and EDGEPEEL do not appear anywhere on the web pages, and Applicant is silent as to where either mark appears. Further, there is no indication of when the web pages were created, and they are not submitted with an affidavit or declaration of a person with personal knowledge as to their identity, content or when they were created or accessed.

Fed. R. Civ. P. 56(c)(1) requires a nonmoving party to cite to particular parts of the record or to show that the materials cited do not establish the absence or presence of a genuine dispute, or that the moving party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c)(1). As noted above, Opposer may demonstrate a *prima facie* case that Applicant lacked a *bona fide* intent use the marks as of the filing date of the applications by establishing that there is an absence of any documentary evidence on Applicant's part regarding such intent. *Commodore Electronics Ltd.*, 26 USPQ2d at 1507. Opposer has made such a showing. Here, Applicant has not proffered evidence to demonstrate that it ever had a *bona fide* intention to use the marks EDGEPULL and EDGEPEEL on or in connection with the products it identified in its applications. Applicant has not come forward with evidence indicating, for example, current business plans,

---

<sup>12</sup> 21 TTABVUE 3.

<sup>13</sup> 21 TTABVUE 6.



ongoing discussions, or promotional activities to corroborate its claim of a *bona fide* intent to use either EDGEPULL or EDGEPEEL in commerce. In sum, Applicant has produced no evidence supporting or confirming the *bona fide* intent to use the mark in commerce which it asserted in its two involved applications. Given the several opportunities that Applicant has had to come forward with evidence of its intent to use the involved marks, as well as the deficient nature of the discovery responses that Applicant did provide, the Board must conclude that Applicant produced no evidence because it has none. Moreover, for the reasons that we have stated, the web pages upon which Applicant relies are insufficient to raise a genuine dispute of material fact as to its lack of *bona fide* intent to use the marks EDGEPULL and EDGEPEEL.

Based on the record on summary judgment, Opposer has carried its burden on summary judgment and is entitled to judgment as a matter of law. Analyzing the evidence as a whole as to what it demonstrates and in a light most favorable to Applicant as the non-movant, the record does not indicate that Applicant had a *bona fide* intent to use the mark EDGEPULL or the mark EDGEPEEL on or in connection with “primarily non-metal seals comprised of various layers including a metallic foil layer for use in container closures and caps” as of the date that Applicant filed the involved applications. Accordingly, the applications are void *ab initio*.

Opposition No. 91214508 (parent case); Opposition No. 91215874

In view of the Board's grant of the motion for summary judgment on Opposer's claim of no *bona fide* intent to use, the Board need not reach Opposer's likelihood of confusion claim.

In view of these findings, Opposer's motions for summary judgment in Opposition Nos. 91214508 and 91215874 are granted; the oppositions are sustained, and registration of application Serial Nos. 86001725 and 86001764 is refused.