

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

Mailed: March 1, 2016

Opposition No. 91219179

Spliethoff's Bevrachtingskantoor B.V.

v.

*United Yacht Transport LLC dba United
Yacht Transport*

Geoffrey M. McNutt, Interlocutory Attorney:

This case comes before the Board for consideration of Opposer's November 4, 2015, unopposed motion for leave to amend its notice of opposition and Applicant's November 4, 2015, fully-briefed motion to compel discovery.

Opposer's Motion for Leave to Amend the Notice of Opposition

By its proposed amendment, Opposer seeks to add two fraud claims. *See* 13 TTABVUE 16–26. Applicant did not file a response contesting the motion. Opposer's motion to amend therefore is granted as conceded, to the extent that one of the two fraud claims is properly pleaded. *See* Trademark Rule 2.127(a) (“When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded.”).

As noted, in the proposed notice of opposition Opposer seeks to add two fraud claims as additional grounds for opposition. The second of the two fraud claims alleges that Applicant committed fraud on the USPTO by falsely averring that the

mark UNITED YACHT TRANSPORT was in use in commerce at least as early as the filing date of the subject application, and then again by falsely averring that the substitute specimens of use filed by Applicant were in use in commerce as of the application filing date. Amended Notice of Opposition ¶¶ 46–48 (13 TTABVUE 25). This fraud claim is sufficiently pleaded.

Opposer's first fraud claim alleges that Applicant committed fraud on the USPTO by filing and then continuing to prosecute its application to register the mark UNITED YACHT TRANSPORT with knowledge of Opposer's prior rights in the mark. Amended Notice of Opposition ¶¶ 24–27 (13 TTABVUE 21–22). The Board construes this claim as alleging that Applicant fraudulently averred in the declaration in support of the subject application that it believed itself to be the owner of the mark sought to be registered, and that to the best of its knowledge and belief, no other person or entity had the right to use the mark in commerce, either in the identical or a confusingly similar form. This fraud claim is not sufficiently pleaded. A plaintiff claiming that the declaration or oath in defendant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for

believing otherwise; and that (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). The first fraud claim in Opposer's proposed amended notice of opposition fails to state a claim for fraud because it has failed to plead particular facts sufficient to establish the third and fourth elements of the claim, as listed above.¹

If Opposer believes that it has a claim for fraud under the legal principles discussed above, then it is allowed until **TWENTY DAYS** from the date of this order to file and serve an amended complaint which states such a claim, failing which Opposer's current amended notice of opposition will become the operative complaint but the first fraud claim (alleging fraud filing the application in view of Opposer's use) will be stricken.² Proceedings otherwise are suspended until such time as Opposer submits a second amended pleading the time for it to do so expires. The Board will set Applicant's time to file an answer at that time.

Applicant's Motion to Compel

Applicant, in its motion to compel, seeks a Board order compelling Opposer to produce documents responsive to Document Request No. 55 (from Applicant's first

¹ In contrast, Opposer's claim that Applicant committed fraud with respect to its allegation of use and specimens, expressly states that "Applicant, *with the intent to deceive the USPTO, knowingly made false representations to the USPTO.*" Amended Notice of Opposition ¶ 46 (13 TTABVUE 25).

² In the event Opposer submits an amended notice of opposition, it is advised, that other than status and title copies of pleaded registrations, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced into evidence as exhibits. *See* Trademark Rules 2.122(c) and (d); TBMP §§ 317 and 704.05(a).

set of document requests) and Document Request Nos. 10, 24, and 25 (from Applicant's second set of document requests). Applicant further asks the Board to determine the relevancy of documents Applicant has sought from non-parties Sevenstar and Clemens Van der Werf pursuant to subpoenas issued by the United States District Court for the Southern District of Florida.

As an initial matter the Board finds that Applicant's motion to compel is timely and that Applicant satisfied its obligation to confer with Opposer and make a good faith effort to resolve the issues in dispute prior to filing its motion to compel. Trademark Rule 2.120(e)(1).

Document Request No. 55

Applicant, in Document Request No. 55, seeks "[a]ll emails, correspondence or other documents related to removing or altering the name United Yacht Transport on any internet website owned or operated by Opposer." Opposer responded "[o]n information and belief, no such documents exist; however inquiry is being made. If any such documents are located, [Opposer] will produce such documents."³

In its motion to compel, Applicant contends that "[a]lthough [Opposer's] predecessor altered its website to display the United Yacht Transport name for a brief two-week period of time before removing the name, [Opposer] has not produced any documents responsive to request number 55." Applicant's Motion, p. 6 (16 TTABVUE

³ Although Opposer's response that "[o]n information and belief, no such documents exist; however inquiry is being made" could suggest that Opposer did not discharge its duty to search its records for responsive documents, *see* TBMP 408.02, here Opposer reiterated in its response to Applicant's motion that it "has no documents responsive to request 55." Opposer's Response p. 12 (20 TTABVUE 13).

7) (emphasis added). In response, Opposer argues that Request No. 55 seeks documents relating only to “any internet website owned or operated by Opposer” and that the definitions in Applicant’s first set of document requests do not define “Opposer” to include its predecessors.⁴ Opposer therefore contends that the request, on its face, does not encompass Opposer’s predecessor, and that Applicant cannot add new requests or broaden the scope of prior requests through a motion to compel. Opposer’s argument is well-taken. A party may not, by way of a motion to compel, widen the scope of the discovery sought, and therefore those inquiries into matters not previously explored need not be answered. *See Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980). Accordingly, Opposer’s response that no responsive documents exist is acceptable. Applicant’s motion to compel Opposer to produce document responsive to Request No. 55 is **denied**.

Document Request No. 10

In Document Request No. 10, Applicants seeks “[a]ll emails, correspondence and other documents between 2011 and 2013 which discuss or relate to repainting the sidewall of any vessel to change the name from Dockwise Yacht Transport to United Yacht Transport.”

Opposer, in its written response to this request, stated that it “already has produced all documents located to date within its possession, custody or control which

⁴ Applicant’s first set of document requests includes the following definition of “Opposer”: “‘Opposer’ as used herein means Opposer, Spliethoff’s Bevrachtungskantoor B.V., and all of its subsidiaries (including but not limited to Sevenstar), as well as any officers, directors, employees, agents, and any other persons acting on behalf of Opposer or any subsidiaries.” *See* 16 TTABVUE 29.

are responsive to this Request.” Opposer, in its brief in response to Applicant’s motion to compel, further states that it has conducted a diligent search of its records and produced all responsive documents located as a result of the search. Opposer’s Response, p. 6–7 (20 TTABVUE 7–8). Opposer’s written response is acceptable. Accordingly, Applicant’s motion to compel Opposer to produce additional documents responsive to Request No. 10 is **denied**.

Document Request Nos. 24 and 25

In Document Request No. 24, Applicants seeks “[a]ll emails, correspondence, and other documents between Opposer (or any predecessors listed in Paragraph 12 of the Notice of Opposition) and any customers, potential customers, vendors, or potential vendors related to United Yacht Transport.”

In Document Request No. 25, Applicants seeks “[a]ll Facebook and internet postings by Opposer (or any predecessors listed in Paragraph 12 of the Notice of Opposition) related to United Yacht Transport.”

Opposer has objected to both Request No. 24 and Request No. 25 on the ground that the requested documents are irrelevant.

In its answer to the notice of opposition, Applicant has asserted abandonment as an affirmative defense. In connection with its motion to compel, Applicant contends that Opposer made statements to third parties referring to the UNITED YACHT TRANSPORT mark in a negative manner, which would support the inference that Opposer did not intend to resume use of the mark. Applicant’s Reply Brief pp. 1–2 (21 TTABVUE 2–3). Opposer, on the other hand, contends that any such negative

statements are not relevant because the question of whether or not Opposer intended to resume use of the mark only becomes relevant if non-use is proven first. Opposer's Response, pp. 8–10 (20 TTABVUE 9–11).

Opposer's objection and arguments are not well-taken. Applicant may obtain discovery regarding any non-privileged matter that is relevant to any of its claims or defenses and proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1). Here Opposer has asserted a claim of likelihood of confusion based on its alleged common law rights in the mark UNITED YACHT TRANSPORT. To establish priority on a likelihood of confusion claim based on common law rights, a party must prove that it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Applicant, in its answer, raised the affirmative defense of abandonment. Section 45 of the Trademark Act provides that a mark shall be deemed abandoned "[w]hen its use has been discontinued with intent not to resume such use." 15 U.S.C. § 1127 (definition of "abandoned"). Intent not to resume may be inferred from circumstances. *Id.*

If, at trial, Applicant can prove that Opposer did in fact discontinue use of the mark, then evidence showing that Opposer made statements to third parties placing the mark in negative light could be relevant to the question of whether or not Opposer intended to resume use of the mark. Opposer has cited no authority for its contention that Applicant must prove the first prong of abandonment (non-use) before Applicant is entitled to discovery regarding the second prong, *i.e.*, circumstances from which Opposer's intent not to resume use may be inferred. Indeed, a determination of non-

use would not be made until final decision, thereby effectively preventing Applicant from obtaining discovery on the issue of Opposer's alleged intent not to resume use.

Accordingly, Applicant's motion to compel Opposer's production of documents responsive to Request Nos. 24 and 25 is **granted in part**, solely to the extent that Opposer is directed to produce responsive, non-privileged documents in its custody or control that refer to the mark UNITED YACHT TRANSPORT, or services provided in connection with the mark, in a negative manner.

To the extent such documents contain confidential information, Opposer may produce them in accordance with the parties' stipulated protective order. Further, Opposer may redact any customer or dealer names. *See* TBMP § 414(3) ("the names of customers (including dealers) constitute confidential information, and generally are not discoverable, even under protective order).

Documents Sought from Non-Parties Sevenstar and Clemens Van der Werf

In its motion to compel, Applicant also asks the Board to determine whether or not documents Applicant has requested from Sevenstar Yacht Transport USA Agencies LLC and Clemens Van der Werf are relevant to this proceeding. Neither Sevenstar nor Mr. Van der Werf are parties to this Board proceeding, and Applicant seeks documents from them pursuant to subpoenas issued by the United States District Court for the Southern District of Florida. *See* 16 TTABVUE 49–72.

As Applicant acknowledges, the Board has no authority over a subpoena issued by a district court. *See generally* TBMP § 404.03(a)(2) and cases cited therein.

Moreover, the Board does entertain motions in limine or otherwise exclude evidence prospectively. *See* TBMP § 527.01(f) and cases cited therein.

Accordingly, the Board declines to make any determinations with respect to the relevancy of documents Applicant has sought from these non-parties or the scope and enforceability of the subpoenas issued by the district court. Enforcement of the subpoenas is a matter for district court.

Conclusion

In sum, Applicant's motion to compel production of documents responsive to Document Request No. 55 (from its first set of requests) and Document Request No. 10 (from its second set of requests) is **denied**.

Applicant's motion to compel the production of documents responsive to Document Request Nos. 24 and 25 (from its second set of requests) is **granted in part and denied in part**. Opposer is directed to produce responsive, non-privileged documents in its custody or control that refer to the mark UNITED YACHT TRANSPORT, or services provided in connection with the mark, in a negative manner. To the extent such documents contain confidential information, Opposer may produce them in accordance with the parties' stipulated protective order, and Opposer may redact any customer or dealer names.

The Board has given no consideration to Applicant's request that the Board determine the relevancy of documents that Applicant has sought from non-parties Sevenstar and Clemens Van der Werf pursuant to subpoenas issued by the United

States District Court for the Southern District of Florida. To the extent Applicant's request can be construed as a motion to compel, it is **denied**.

Opposer is allowed until **THIRTY DAYS** from the mailing date of this order in which to serve documents responsive to Request Nos. 24 and 25, to the extent it is directed to do so in this order.

Proceedings otherwise remain **SUSPENDED** and Opposer is allowed **TWENTY DAYS** in which to further amend its notice of opposition to re-plead its first fraud claim (alleging fraud in view of Opposer's use), failing which the current amended notice of opposition will become the operative complaint but the first fraud claim will be stricken. After Opposer submits a revised amended notice of opposition or its time for doing so expires, the Board will set Applicant's time to file an answer and reset remaining discovery and trial dates.