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

Proceeding	91224818
Party	Plaintiff Market America, Inc.
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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. 86469018

For the mark VITAMINDFUL

Published in the Official Gazette on September 15, 2015

Market America, Inc.,

Opposer,

v.

Luciano Sztulman M.D., Inc.,

Respondent.

Opposition No. 91224818

**OPPOSER’S CONSOLIDATED REPLY IN FURTHER SUPPORT OF
ITS MOTION TO AMEND AND MOTION FOR SUMMARY JUDGMENT**

On May 24, 2016, Opposer, Market America, Inc. (“Market America”), filed its Motion to Amend and Motion for Summary Judgment (collectively, the “Motions”). The Motions were made on the basis that, through its discovery responses, Applicant demonstrated that he had no *bona fide* intent to use the mark that is the subject of this Opposition, VITAMINDFUL, at the time the application was filed.

Subsequently, and only because of the Motions, Applicant produced more documents than it had in its response to Market America’s discovery requests. On June 21, 2016, Applicant filed Applicant’s Objections to Opposer’s Motion for Summary Judgment (“Opposition Brief”), objecting to Market America’s Motion for Summary Judgment. Applicant “acknowledges” that Market America seeks leave to amend its Notice of Opposition, but does not appear to object to such request.

I. Motion to Amend

“[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party.” *Zanella Ltd. v. Nordstrom, Inc.*, 90 U.S.P.Q.2d 1758, 2008 WL 6092354, *1 (T.T.A.B. 2008); TBMP § 507.02. “This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint.” TBMP § 507.02. The Board will grant motions to amend when the applicant will not be unduly prejudiced, particularly when the proceedings are still in the pre-trial stage. *See, e.g., See Tekni-Plex, Inc. v. Selig Sealing Prods., Inc.*, 2015 WL 8966287 (T.T.A.B. 2015) (“*Tekni-Plex*”); *PRL USA Holdings, Inc. v. Young*, Opposition No. 91206846 (T.T.A.B. 2013) (“*PRL USA*”) (attached hereto as Exhibit G); *Honda Motor Co., Ltd. v. Friedrich Winkelman*, 90 U.S.P.Q.2d 1660, 2009 WL 962810 (T.T.A.B. 2009) (“*Honda Motor Co.*”); *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 2008 WL 4149008 (T.T.A.B. 2008) (“*Boston Red Sox*”).

In this instance, Applicant has not asserted that he would be prejudiced in any way by the Board’s grant of leave to file an Amended Notice of Opposition. Applicant similarly has not put forward any facts that would support such a conclusion. As such, Market America respectfully submits that its Motion to Amend should be granted as conceded.

II. Motion for Summary Judgment

In his response to Market America’s Document Requests, untimely served on Market America on or about May 5, 2016, Applicant failed to produce responses or documents to support a claim that he had a *bona fide* intent to use the VITAMINDFUL mark on or in connection with the goods he identified in his application when he applied to register the VITAMINDFUL mark. As shown in Market America’s moving brief, Applicant produced few documents and, in fact,

explicitly indicated that no responsive documents existed to show his *bona fide* intention to use the VITAMINDFUL mark in commerce. After Market America filed its Motion for Summary Judgment, Applicant produced the additional documents that he attached to his Opposition Brief. Nonetheless, Applicant has not served any additional or replacement substantive responses to Market America's discovery requests. As such, his existing responses must be taken as true, including his responses to Market America Document Requests indicating "none" on 17 of 26 responses. What he *did* belatedly produce does not support his alleged *bona fide* intent to use the VITAMINDFUL in commerce at the time of his application.

The web pages printed as part of Applicant's document production (Exhibits 4 and 5 to the Opposition Brief) do not contain dates or indicate the url for such pages. The documents indicate that Applicant purchased ".com" domains, as well as ".br" domains, which are intended for Brazil. Nowhere does he indicate or allege that at the time of his application he had an intent to use the mark in commerce in the United States, and it is clear that he intended to use the VITAMINDFUL mark in Brazil. None of the remaining documents pre-date Applicant's application, and as such do not indicate any intent to use at the time the application was filed.

Applicant also submitted a Declaration, attached to his Opposition Brief, which attaches an e-mail to his legal counsel in which he states that "at that point in time" he had no intention to use the mark. He indicates further that "[he] had put this venture on hold, and this was a dormant business." Opposition Brief, Ex. 3 to Declaration of Luciano Sztulman. This is consistent with what he has said to Market America and its counsel, as further shown in Market America's moving brief.

Applicant's belated production of documents and self-serving statements to the contrary, in his answers to the Interrogatories, Applicant made clear that he did not have a *bona fide* intention

to use the mark in commerce. Indeed, his answers to the Interrogatories, dated April 6, 2016, are inconsistent with such intention.

6. Identify all goods and services that Respondent has offered for sale, sold, or provided under or in connection with the Challenged Mark in the United States.

ANSWER: Intent to produce multivitamins.

7. For each good or service that you have offered, sold, or provided under or in connection with the Challenged Mark, state the date ranges of actual and planned use of the Challenged Mark in connection with the good or service, including the specific date of first use or intended first use of the mark for each good or service.

ANSWER: Intent to use.

8. Describe the nature of any advertisements, promotional materials, and marketing materials (for example, newspaper advertisements, magazine advertisements, internet websites, television commercials, brochures), including by identifying the specific media in which Respondent is using, has used, or plans to use the Challenged Mark.

ANSWER: Intended marketing through the Internet is on hold pending the outcome of the instant Opposition Procedure.

16. Identify and describe all expenditures incurred by you in connection with the development, production, distribution, promotion, advertisement, and sale of any goods or services under the Challenged Mark, including by identifying the nature and amount of each expenditure.

ANSWER: Attorney's fees and Domain name fees.

Despite Applicant's attempt to amend his discovery responses with an array of documents, the undisputed facts still show that Applicant had no *bona fide* intent to use the VITAMINDFUL mark in commerce at the time he filed his application.¹ The absence of any evidence to the contrary constitutes objective proof sufficient to show that Applicant lacked such intent. As such, no genuine issue of material fact exists for the Board to decide.

¹ Applicant's documents now indicate that he intends to use the mark in the near future, including, apparently, on Market America's own website, specifically because of this Opposition: "I had put this venture on hold, and this was a dormant business. But now I actually am more interested then [*sic*] ever, because it might be a great deal, better then [*sic*] I thought! Otherwise, why would they oppose?" Opposition Brief, Ex. 3 to Declaration of Luciano Sztulman.

CONCLUSION

For the foregoing reasons and those explored in greater detail in the Motions, Market America requests that the Trademark Trial and Appeal Board grant its Motion to Amend and Motion for Summary Judgment, sustain Market America's opposition to the VITAMINDFUL mark, and refuse to register the VITAMINDFUL mark on the grounds that the application was void *ab initio* for lack of *bona fide* intent to use the VITAMINDFUL mark in commerce at the time of filing of Applicant's application.

Dated: June 30, 2016

Respectfully submitted,



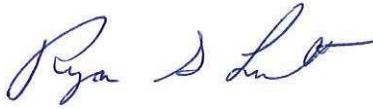
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the attached Consolidated Reply in Further Support of its Motion to Amend and Motion for Summary Judgment was served upon Luciano Sztulman M.D., Inc., through its counsel of record, by U.S. mail on June 30, 2016 at the following address:

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