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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 29, 2016

Opposition No. 91224818

Market America, Inc.

v.

Luciano Sztulman M.D., Inc.

Before Mermelstein, Kuczma and Adlin,
Administrative Trademark Judges.

By the Board:

Luciano Sztulman M.D., Inc. ("Applicant") filed application Serial No. 86469018 on December 2, 2014, to register the mark VITAMINDFUL (standard characters) for "vitamins" in International Class 5, based on a *bona fide* intent to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Market America, Inc. ("Opposer") filed a notice of opposition on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d), alleging common law rights in the mark VITA-MIND for dietary supplements since August 1, 2002,[1] and alleging ownership of Registration No. 2944356, registered April 26, 2005, for the

[1] 4 TTABVUE 6.

mark VITA-MIND (typeset) for "nutritional supplement for mental acuity and alertness" in International Class 5.[2]

In its answer, Applicant denied the salient allegations in the notice of opposition.

During discovery, Opposer concurrently filed

1) a motion for leave to file an amended notice of opposition to add the ground that Applicant lacked a *bona fide* intent to use the mark in commerce at the time Applicant filed its application, and

2) a motion for summary judgment on the proposed claim.

Opposer's motion for leave to amend is granted as conceded. Trademark Rule 2.127(a); TBMP § 502.04 (2016). Opposer's second amended[3] notice of opposition, filed May 24, 2016, is its operative pleading in this proceeding.

Opposer's motion for summary judgment

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact and it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must 1) cite to materials in particular parts of the record; or 2) show 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)(1). 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.

[2] 4 TTABVUE 6. In the now-operative pleading, the allegation is at 8 TTABVUE 14; however, Opposer's reference to the registration date therein as "April 26, 2002" is an obvious typographical error.

[3] Shortly after institution, Opposer filed a first amended notice of opposition as a matter of course pursuant to Fed. R. Civ. P. 15(a)(1)(A).

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. 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.*, *supra*; *Olde Tyme Foods*, 22 USPQ2d at 1544. *See also* TBMP § 528.01, and cases cited therein.

Trademark Act Section 1(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 …

To prevail on summary judgment, Opposer must demonstrate that there is no genuine dispute that: 1) it has standing; and 2) Applicant did not have a *bona fide* intent to use the mark VITAMINDFUL on "vitamins" as of the December 2, 2014 filing date of its application.

<u>*Standing*</u>

In Board proceedings, an opposer must establish that it has a "real interest" in the proceeding, that is, that it has a direct and personal stake in the outcome of the opposition, and a "reasonable basis" for its belief of damage if the subject mark

registered. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). If an opposer establishes standing on one ground, it has the right to assert any other legally sufficient ground(s). *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009). *See also* TBMP § 309.03(b).

Trademark Rule 2.122(d) specifies that a party may make a pleaded registration of record in an *inter partes* proceeding by submitting a copy of the registration, or a printout of information from the USPTO database records, showing current status and title of the registration.[4] Opposer did not avail itself of this option; nor did Opposer establish the current status of and title to its pleaded registration by declaration. TBMP § 528.05(d).

In its pleading, Opposer alleged the following, which Applicant admitted in its answer:

> 6. Market America's VITA-MIND trademark was registered with the Patent & Trademark Office on April 26, 2002, Registration No. 2944356, for "Nutritional Supplement for mental acuity and alertness."

However, because Opposer did not allege both the current status and title of the registration, Applicant's answer is not an admission of current status and title.

Opposer also alleges prior use of its VITA-MIND trademark,[5] which, if shown to be an undisputed fact, would establish Opposer's standing for purposes of summary judgment. *Otto Roth & Co., Inc. v. Universal Foods Corp.,* 640 F.2d 1317, 209 USPQ

[4] The Board does not take judicial notice of applications or registrations residing in the USPTO records. *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009).
[5] 8 TTABVUE 14-15; notice of opp. ¶¶ 5, 7-8.

40, 43 (CCPA 1981). However, Applicant did not admit these allegations in its answer to the original notice of opposition,[6] and Opposer did not establish its prior use as an undisputed fact by declaration or other evidence.

We conclude that Opposer has not established its standing for purposes of summary judgment. Opposer has not shown that there is no genuine dispute regarding its standing.[7] Although lack of standing precludes summary judgment in Opposer's favor, we consider Opposer's substantive claim.

Claim of no bona fide intent to use mark in commerce

An applicant's *bona fide* intent to use a mark must reflect an intention that is "firm," "demonstrable" with "objective evidence of intent" and "more than a mere subjective belief." *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008 (TTAB 2015), *citing M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897-98 (Fed. Cir. 2015). Such intent 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), *citing* Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988), *reprinted in* United States Trademark Association, *The Trademark Law Revision Act of 1988* 176-77 (1989). The Board considers the evidence as a whole, including any documentary evidence, and any clear

[6] 6 TTABVUE 2-3.
[7] At trial, Opposer should make its pleaded registration of record pursuant to Trademark Rules 2.122(d)(1) or (d)(2). TBMP § 704.03(b)(1)(A).

interrelationships that exist between the evidence of record, to determine whether the evidence, in its totality, indicates the requisite intent to use. *Swatch AG v. M. Z. Berger & Co.,* 108 USPQ2d 1463, 1471 (TTAB 2013), *aff'd* 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *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). There is no express requirement as to the contemporaneousness of an applicant's documentary evidence corroborating a claim of *bona fide* intent. *Lane Ltd. V. Jackson Int'l Trading Co.,* 33 USPQ2d at 1356. The focus is on the entirety of the circumstances, and the issue is decided case-by-case. *Honda Motor Co. v. Winkelmann,* 90 USPQ2d 1660, 1662 (TTAB 2009).

Opposer bases its motion on Applicant's discovery responses, in particular its response of "None" to Opposer's requests seeking documents regarding persons responsible for the selection of the mark (Request No. 5), the planned or intended goods and services (Request No. 10), plans for development and expansion (Request No. 13), channels of trade (Request No. 14) and geographic regions (Request No. 14).[8] Opposer also points to Applicant's eight-page document production consisting of emails between Applicant and its counsel regarding a trademark clearance search.[9] Opposer also relies on emails Applicant sent to Opposer's counsel, dated a week before the notice of opposition was filed, and in response to a cease and desist notice.[10]

[8] 9 TTABVUE 6-7, 24-25, 30.
[9] 9 TTABVUE 7, 33-40.
[10] 9 TTABVUE 7, 71-72.

Contesting the motion, Applicant states in a declaration, "[S]ince the filing of the application, I have purchased domain names, had a website built, had video commercials produced, developed labels and purchased product."[11] He relies on documents he served on Opposer after Opposer filed the summary judgment motion.[12] Such documents include:

1) Order confirmation and receipts from GoDaddy, dated September 16, 2014 and December 14, 2014, for Applicant's purchase of the domain names vitamindful.com and vitamindful.com.br;[13] in its brief, Applicant states that "[A]pplicant purchased the domain names vitamindful.com and vitamindful.com.br on December 15, 2014."[14]

2) Undated web pages that show the mark "VITAMINDFUL," and the wording "VITAMINDFUL by Dr. Luciano," as well as bottles bearing the mark VITAMINDFUL and online ordering information;[15] in its brief, Applicant states that "[A]pplicant had a website designed on December 31, 2014;[16]

3) An undated web page that shows the mark VITAMINDFUL with Applicant's name, and links to three YouTube videos;[17] in its brief, Applicant states that "[A]pplicant produced video commercials in November and December 2014 that may be seen on YouTube via the World Wide Web;"[18]

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[11] 11 TTABVUE 86.
[12] Opposer acknowledges in its reply brief that after it filed its summary judgment motion, Applicant "produced the additional documents that he attached to his Opposition Brief." 12 TTABVUE 4.
[13] 11 TTABVUE 52-59.
[14] 11 TTABVUE 3.
[15] 11 TTABVUE 61-73.
[16] 11 TTABVUE 3.
[17] 11 TTABVUE 75.
[18] 11 TTABVUE 3. Providing a link to Internet materials does not suffice to make the linked materials of record in a Board proceeding. If a party wishes to present evidence that cannot be electronically filed as a document through ESTTA (*e.g.*, audio or video files), it may submit the evidence to the Board by mail (or by hand deliver), recorded on readily accessible media (*e.g.*, CD, DVD, flash drive), in a commonly used format (*e.g.*, .mpg or .wav). *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791-92 (TTAB 2013). Accordingly, we have not considered the videos referenced by Applicant. *See* TBMP §§ 110-111, for important information about non-electronic and electronic filing.

4) An image of a bottle bearing the mark VITAMINDFUL and the wording "Dietary Supplement," and an invoice dated March 30, 2015 listing a purchase of an item called "Vitamindful;"[19] in its brief, Applicant states that "[A]pplicant developed labels and purchased product;"[20] and

5) A list captioned "Compilation of Vitamindful Campaign Expenses;"[21] in its brief, Applicant identifies this as "[A] complete compilation of Applicant's expenses."[22]

The documentation on which Applicant relies suffers from deficiencies, including lack of authentication and insufficient detail provided in Applicant's declaration. However, for purposes of determining if summary judgment is warranted, we have viewed the documents in a light most favorable to Applicant for whatever probative value they have, and have drawn all justifiable inferences in Applicant's favor. *Copelands' Enter. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991).

Although the materials on which Applicant relies do not comprise a strong evidentiary record, the record, considered as a whole, indicates that there is a genuine dispute regarding whether Applicant had a *bona fide* intent as of the application filing date. We have not considered whether each exhibit, standing alone, raises a genuine dispute. Rather, upon consideration of the totality of the record, a reasonable fact finder could find that Applicant's materials substantiate its claim that it had a *bona fide* intent to use the mark VITAMINDFUL on or in connection with "vitamins" as of December 2, 2014. Moreover, the factual question of intent is particularly unsuited

[19] 11 TTABVUE 77-83.
[20] 11 TTABVUE 3.
[21] 11 TTABVUE 85.
[22] 11 TTABVUE 3.

to disposition on summary judgment. *Copelands' Enter. Inc. v. CNV Inc.*, 20 USPQ2d at 1299. Furthermore, the fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

In view of these findings, Opposer has not met its burden of demonstrating that it is entitled to judgment as a matter of law on its claim of lack of *bona fide* intent to use, and its motion for summary judgment is denied.

The record on summary judgment includes documents that Applicant produced *after* Opposer filed its motion. In the event that Applicant, pursuant to Fed. R. Civ. P. 33(d) or otherwise, provided any of the documents in response to one or more interrogatories, Applicant has a duty to serve supplemental responses, as appropriate, indicating which documents are in response to which interrogatories. Fed. R. Civ. P. 26(e). *See also* TBMP § 408.03. Also, the parties are reminded that they may be barred from introducing at trial information and documents that they failed to produce in response to properly propounded requests during discovery. TBMP § 527.01(e).

Lastly, the parties shall note that the evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion, absent a written stipulation providing otherwise. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Answer; Schedule

Proceedings are resumed. Applicant is allowed until thirty days from the mailing date of this order to file its answer to the second amended notice of opposition filed May 24, 2016. The parties are allowed until thirty days from the mailing date of this order to serve responses to any outstanding discovery. Expert disclosure, discovery and trial dates are reset as follows:

Expert Disclosures Due	**11/30/2016**
Discovery Closes	**12/30/2016**
Plaintiff's Pretrial Disclosures Due	**2/13/2017**
Plaintiff's 30-day Trial Period Ends	**3/30/2017**
Defendant's Pretrial Disclosures Due	**4/14/2017**
Defendant's 30-day Trial Period Ends	**5/29/2017**
Plaintiff's Rebuttal Disclosures Due	**6/13/2017**
Plaintiff's 15-day Rebuttal Period Ends	**7/13/2017**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.