

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 16, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

James Barnard

v.

Mandala Wear, LLC

Opposition No. 91252489

Michael Harris of SoCal IP Law Group LLP,
for James Barnard.

Karen Kreider Gaunt of Dinsmore & Shohl LLP,
for Mandala Wear, LLC.

Before Bergsman, Wolfson, and Greenbaum,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Applicant, Mandala Wear, LLC, seeks registration on the Principal Register of the standard character mark MANDALAEVERYWEAR for “marketing consulting services for charitable and non-profit entities; marketing consulting, namely, designing promotional and marketing campaigns for charitable and for non-profit entities; retail and online store services featuring co-branded apparel, sportswear,

sporting good accessories, and promotional goods; providing a searchable website featuring the goods and services of other vendors and of third party charitable and non-profit entities,” in International Class 35.¹

James Barnard (“Opposer”) opposes registration of Applicant’s mark, alleging that he filed an application for the MANDALA mark (in standard characters) that has been refused registration because of potential likelihood of confusion with Applicant’s mark;² that he has priority of use of the mark MANDALA (use alleged since October 2018); and that there is a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) between his mark and Applicant’s mark. 1 TTABVUE 5.³ Opposer did not specifically plead use of MANDALA with respect to specific goods or services, but referred to his application, which was filed for:

Brand concept and brand development services for corporate and individual clients; Brand evaluation services; Brand positioning services; Branding services, namely, consulting, development, management and marketing of brands for businesses and/or individuals; Business consultation services, namely, business process improvement and enterprise architecture design; Business development services, namely, providing start-up support for businesses of others; Business support services, namely, business consulting to freelancers, start-ups, existing businesses and non-profit organizations;

¹ Application Serial No. 88357257, filed March 26, 2019, based on Applicant’s allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Serial No. 88503503, filed July 8, 2019, claiming first use and use in commerce of October 2018.

³ Citations to the opposition record refer to TTABVUE, the Board’s online docketing system. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding “TTABVUE” corresponds to the docket entry number, and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

Consulting services in the field of human resources development, namely, utilizing technology for the promotion of employee retention, career growth and increased productivity for employees and employers; Consulting services in the fields of business management, human resources, and business organizational design; Consulting in the field of sales methods, sales management, and sales improvement; Corporate image development consultation; Dissemination of advertising, scheduling and managing of training courses and programs for others via a global computer network; Incubation services, namely, providing work space containing business equipment to freelancers, start-ups, existing businesses and non-profits; Management consulting and advisory services in the areas of corporate growth strategy, innovation and growth processes, organizational transformation, and talent management and development strategies; New business venture development and formation consulting services; Promoting public interest in education, recognition, career advancement, and leadership for elite managers and executives in corporations and professional service firms; Providing consulting services in the field of facilitating the planning, buying, and selling of media; Providing consumer news and information in the field of educational products and services that help individuals and businesses make and save money; Turnkey retail start-up services, namely, coordination and assumption of responsibility for all aspects of the store-opening process of others; Management services, namely, on-line business development services, namely, providing start-up support for businesses of others,

in International Class 35. The application includes the following translation statement: “The English translation of mandala in the mark is circle.”

In its answer, Applicant denied the salient allegations in the Notice of Opposition and asserted that Opposer failed to state a claim upon which relief can be granted; that Opposer’s alleged use was not “in interstate commerce;” that Opposer committed fraud; and further advanced the affirmative defenses of estoppel, unclean hands and

bad faith. Applicant did not pursue any of alleged affirmative defenses at trial; they are therefore waived and will be given no further consideration.⁴ *See Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013); *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. Am. Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

I. THE RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. Only Opposer filed additional evidence, and only Opposer filed a brief. Opposer's evidence consists of the testimonial deposition of James Barnard and the following accompanying exhibits:

1. Printout from the Trademark Electronic Search System (TESS) of Opposer's application for the mark MANDALA, Serial No. 88503502, including a copy of the September 28, 2019 Office Action suspending Opposer's application based on Applicant's "prior-filed potentially conflicting pending application." 8 TTABVUE 57;
2. Printout of Opposer's application Serial No. 88503502 from the USPTO Trademark Electronic Application System (TEAS Plus), including a copy of the specimen submitted in that application;
3. Copy of pages from Opposer's website;

⁴ Failure to state a claim upon which relief must be granted is not a true affirmative defense "because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim." *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010). Since Applicant did not file a formal motion to dismiss, Applicant's assertion that Opposer failed to state a claim upon which relief may be granted is considered waived.

4. Printout from the Trademark Electronic Search System (TESS) of Applicant's application;

5. Copy of a marketing proposal prepared by Opposer; and

6. Copy of a September 28, 2019 Office Action in Serial No. 88503502.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action⁵ is a threshold issue in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of another's mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff's reasonable belief in damage is proximately caused by registration of the defendant's mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020), *cert denied*, ___ S.Ct. ___ (2021).

Opposer has established his statutory entitlement to bring this opposition proceeding based on the suspension of his application on the ground of likelihood of confusion with Applicant's application. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA (1982)) ("To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition

⁵ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, *2 (TTAB 2020).

may assert ... a rejection of an application during prosecution.”); *Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) (“The filing of opposer’s application and the Office’s action taken in regard to that application [a provisional refusal based on the involved application] provides opposer with a basis for pleading [entitlement to a statutory cause of action].”). *Cf. Weatherford/Lamb Inc. v. C&J Energy Servs. Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) (finding “standing” in cancellation proceeding based on Office action suspending plaintiff’s trademark application pending possible refusal based on alleged likelihood of confusion with defendant’s registration made of record).

III. Likelihood of Confusion

To prevail on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, based on a previously used mark, it is the opposer’s burden to prove both priority of use and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). A party who opposes a registration under Section 2(d) must prove that it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion as to source. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). A party may establish its own prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994).

Here, because Opposer has not pleaded use analogous to trademark use, or ownership of any prior registrations, he must rely on his asserted common law rights,

which must precede Applicant's actual or constructive use of its mark. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018). Although Applicant did not submit evidence of use, it may rely on March 26, 2019, as its constructive use priority date. *See Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) ("applicant may rely without further proof upon the filing date of its application as a 'constructive use' date for purposes of priority"); *Zirco Corp. v. Am. Tel. and Tel. Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights."). Accordingly, Opposer must show that he used his mark prior to March 26, 2019.

Section 45 of the Trademark Act, 15 U.S.C. § 1127, reads, in pertinent part, as follows:

Use in commerce. The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce--

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

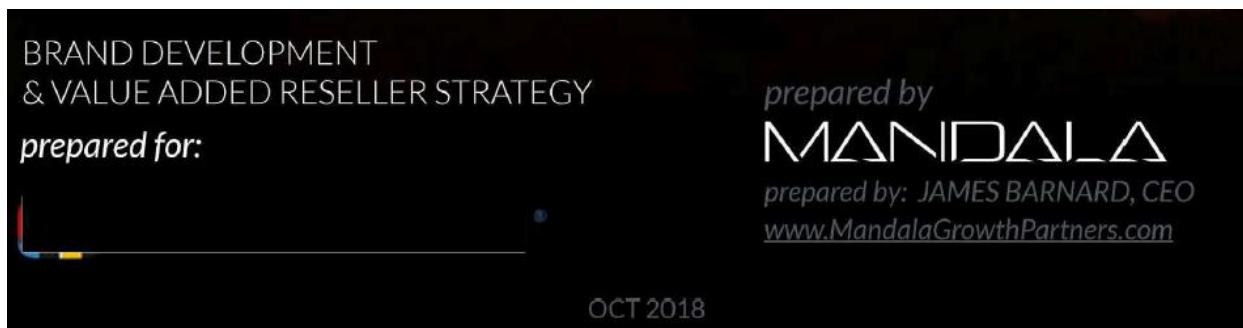
In this regard, Opposer must establish proprietary rights in his pleaded common-law mark that precede Applicant's constructive use of its involved mark. *See Otto*

Roth & Co., 209 USPQ at 43; *Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1180 (TTAB 2017); *Larami Corp. v. Talk To Me Programs*, 36 USPQ2d 1840, 1845 (TTAB 1995). In other words, because unregistered marks are not entitled to the presumptions established under Section 7(b)-(c) of the Trademark Act, 15 U.S.C. 1057(b)-(c), it is Opposer's burden to demonstrate that he owns a trademark that was used prior to Applicant's constructive use of its mark and not abandoned. *See Exec. Coach Builders*, 123 USPQ2d at 1180; *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

Opposer James Barnard testified that he is the founder of "Infinite Synergy Learning Systems" (Infinite), a "marketing consulting and website design" company that has been in business since 2005.⁶ 8 TTABVUE 9. "We've done some technology development, software applications, and events. It's in the creative field, mostly." *Id.* at 10. Barnard attests that Infinite "first started using MANDALA as a trademark, service mark" in October 2018. *Id.* at 12. Barnard authenticated the web pages from his website that he submitted as a specimen to his trademark application in 2019, and attested that these webpages were "displayed in 2018," *id.* at 13, "[were] in existence at the time [Opposer] filed the trademark application," *id.*, and "it is still there." *Id.* at 14.

⁶ Opposer alleges that Infinite Synergy Learning Systems is his "d/b/a." Notice of Opposition, 1 TTABVUE 4. Opposer has not submitted evidence supporting the allegation, but Applicant affirmed Opposer's use of his d/b/a in Applicant's Answer: "James Barnard, dba Infinite Synergy Learning Systems (hereinafter "Barnard" or "Opposer"), filed a Notice of Opposition against the Application on November 22, 2019..." Answer, 4 TTABVUE 2. We note Opposer also attests to being the "CEO" of Infinite, but there is nothing in the record to suggest that Infinite is anything other than an informal trade name of Barnard's, and has no independent corporate status.

Mr. Barnard also authenticated Exhibit 5 as “a proposal to a prospect presentation” that was created in October 2018. *Id.* at 15. A copy of select slides from the proposal is reproduced below:⁷



ABOUT US

MANDALA

MANDALA is an experience agency specializing in high impact media, content marketing, strategic sales and technology development.

Our network of creative executives, media and technology professionals have a vast range of expertise and deep experience developing media, marketing and sales strategies.

We discover, conceptualize, invent & deliver cutting edge and memorable experiences for top tier brands and pioneers of innovation.

⁷ 8 TTABVue 42-55.

Allied Production Companies & Agencies

MANDALA will engage allied partnerships to develop user test cases and proof of concept, while building a knowledge-base of best practices and product use examples.



Gersh



THE CONFLUENCE

PARTIAL CLIENT LIST



KAY
JEWELERS

NordicTrack



Microsoft



Electrolux

Expedia



UNITED

MAZDA



Nutrisystem

COX

PRO-FORM

BURT'S
BEES



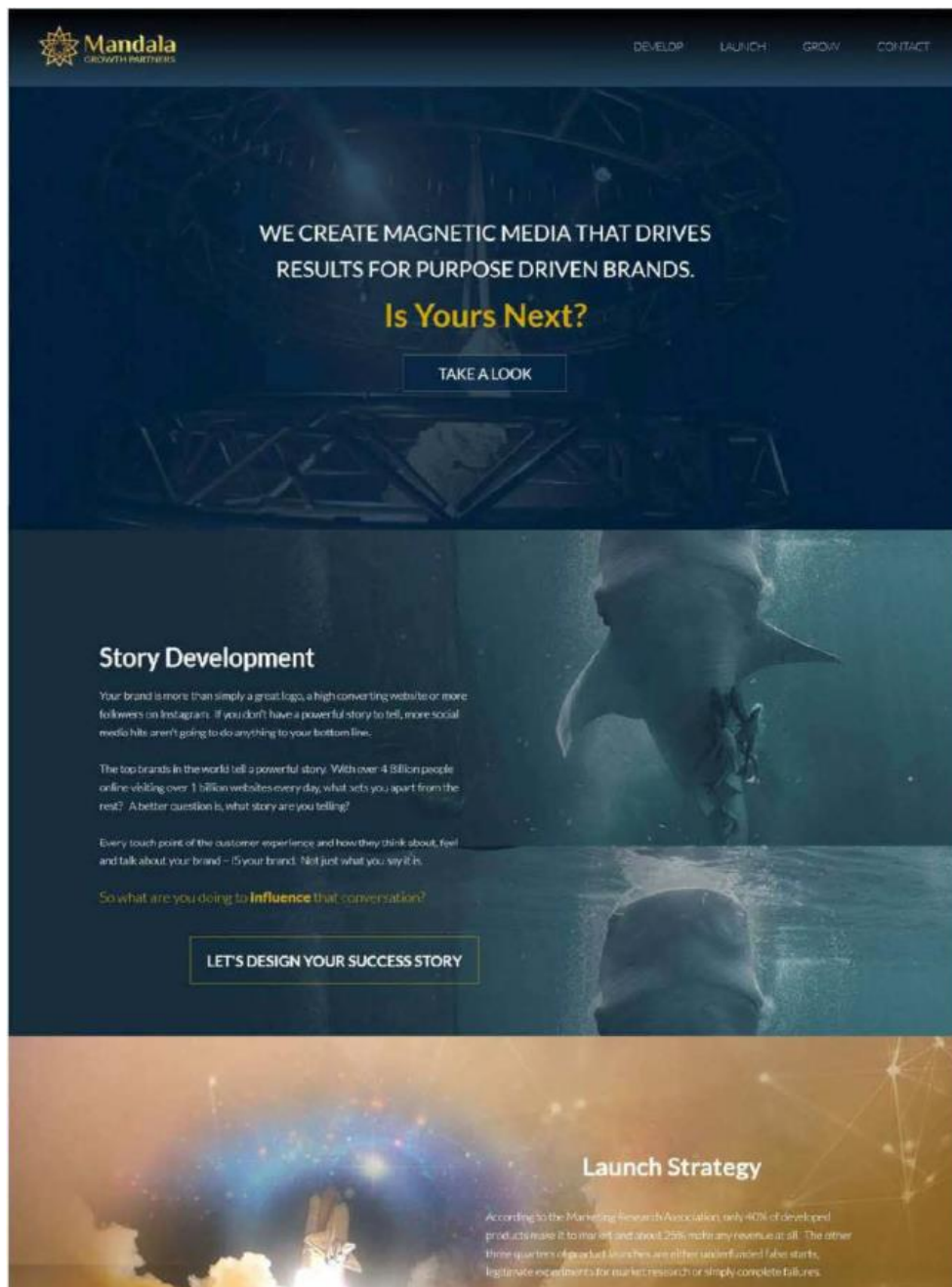
MAXFACTOR

MANDALA is ready to create a scalable product, and leverage growth through our network of partnerships

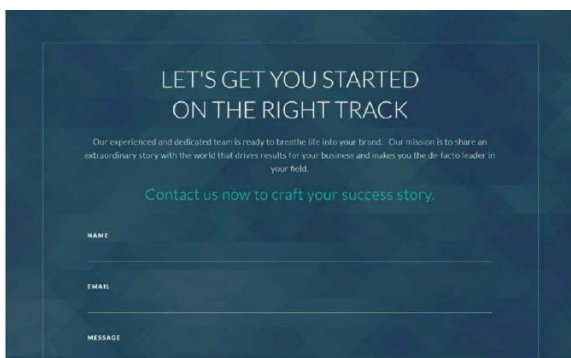
contact:
JAMES BARNARD, CEO
james@infinitesynergy.net
805 613 7550
MandalaGrowthPartners.com

MANDALA
GROWTH PARTNERS

The specimen of use that was submitted with Opposer's trademark application is reproduced below:⁸



⁸ *Id.* at 31-33.



The webpages and specimen of use support Opposer's advertising his mark for "Brand concept and brand development services for corporate and individual clients; Brand evaluation services; Brand positioning services; Branding services, namely,

consulting, development, management and marketing of brands for businesses and/or individuals.” However, they do not prove that Opposer has rendered these services.

Barnard’s averments regarding his specimen and website uses relate only to the offering of Opposer’s services, but not to the rendering of those services. As explained above, to be considered use in commerce, not only must the mark be used or displayed in the sale or advertising of the services, the services must be actually rendered. Opposer never affirmatively asserted that he has rendered brand concept or brand development services to any customer under the MANDALA mark. Thus, Opposer has not submitted either a statement of facts set forth in detail in an affidavit by a knowledgeable affiant (*see Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (internal citation omitted)) or any additional evidence to demonstrate that Opposer ever rendered his identified services in commerce.

In view of the foregoing, we find that Opposer has failed to establish a date of priority before Applicant’s constructive use date, an essential element of any claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Accordingly, we need not reach the issue of likelihood of confusion, because without proof of priority, Opposer cannot prevail. *See Exec. Coach Builders*, 123 USPQ2d at 1199.

Decision: We dismiss the opposition.