

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: May 29, 2025

Mailed: July 16, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Disney Enterprises, Inc.*

*v.*

*R.H. Lemorande*

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Opposition No. 91255366

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Jason M. Joyal, Linda K. McLeod, and Lauren Jancuska of Kelly IP, LLP,  
for Disney Enterprises, Inc.

R.H. Lemorande, pro se.

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Before Cohen, Elgin, and Lavache,  
Administrative Trademark Judges.

Opinion by Lavache, Administrative Trademark Judge:

R.H. Lemorande (“Applicant”) seeks registration on the Principal Register of the standard character mark **OSWALD THE RABBIT** for services ultimately identified as “Direction or presentation of plays; Entertainment, namely, production of plays; Entertainment, namely, production of musicals; Planning arrangement of showing

movies, shows, plays or musical performances; Providing facilities for movies, shows, plays, music or educational training,” in International Class 41.<sup>1</sup>

In its amended pleading,<sup>2</sup> Disney Enterprises, Inc. (“Opposer”) opposes registration of Applicant’s mark based on (i) a claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and (ii) a claim under Section 1(b), 15 U.S.C. § 1051(b), that Applicant lacked of a bona fide intent to use the mark in commerce for Applicant’s identified services as of the application filing date.<sup>3</sup> In support of the likelihood-of-confusion claim, Opposer alleges prior common law rights in the mark **OSWALD THE LUCKY RABBIT** in connection with a variety of goods and services, including video games, films, theme park attractions, toys, watches, clothing, and beverageware;<sup>4</sup> and claims ownership of registrations for the stylized mark below for, inter alia, collectable toy figures, dolls, clothing, and beverageware.<sup>5</sup>

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<sup>1</sup> Application Serial No. 88196427 was filed on November 16, 2018, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> On November 7, 2022, the Board granted Opposer’s motion for leave to amend the notice of opposition to add a claim of lack of bona fide intent to the mark. 34 TTABVUE. The amended pleading appears at 29 TTABVUE.

Citations to the record refer to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number, and any numbers following “TTABVUE” refer to the page numbers of the docket entry where the cited materials appear. In addition, case citations in this opinion are in a form recommended in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024).

<sup>3</sup> Opposer’s Amended Notice of Opposition, 29 TTABVUE 19-21.

<sup>4</sup> *Id.* at 13-16.

<sup>5</sup> *Id.* at 16-17. The claimed registrations are Registration No. 5563927, registered on September 18, 2018, and renewed; Registration No. 5317925, registered on October 24, 2017, and renewed; and Registration No. 5317926, registered on October 24, 2017, and renewed. Opposer also claimed ownership of Registration No. 5464663 in the Amended Notice of Opposition, but that registration has since been cancelled. In addition, Opposer’s First Notice



Applicant's Answer denies most of the salient allegations in the Amended Notice of Opposition, but admits that Applicant filed, and is the owner of, Application Serial No. 88196427.<sup>6</sup>

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of Reliance included status-and-title copies of additional registrations for the same stylized mark, which were not pleaded in the Amended Notice of Opposition. 51 TTABVUE 3-5. Because we do not reach Opposer's likelihood-of-confusion claim, we need not address these additional registrations.

<sup>6</sup> Applicant's Answer to the Amended Notice of Opposition, 50 TTABVUE 3. Applicant explicitly denies some of Opposer's allegations, but, for the most part, states that he "is without sufficient information to form a belief as to the averments." *Id.* at 2-4. Such statements are deemed to "have the effect of a denial." Trademark Rule 2.106(b)(2), 37 C.F.R. § 2.106(b)(2). Applicant's Amended Answer also includes "affirmative defenses" based on "the First Amendment right to free expression," the doctrine of nominative fair use, and an assertion that Opposer cannot establish priority. 50 TTABVUE 7. As to the latter "defense," priority is a prerequisite to establishing a likelihood-of-confusion claim under Trademark Act Section 2(d). *See Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 1162 (Fed. Cir. 2002). Therefore, an assertion of lack of priority is not an affirmative defense, and is, instead, essentially an amplification of Applicant's denial of Opposer's likelihood-of-confusion claim. *See Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at \*3 n.5 (TTAB 2021) (noting that a mere amplification of a denial of a likelihood of confusion is not an affirmative defense). The "fair use" and "First Amendment" affirmative defenses appear to rely on Applicant's assertions that it should be free to register its applied-for mark because of the purported public domain status of the "Oswald the Lucky Rabbit" character name. *See* 50 TTABVUE 7. These defenses appear to be directed to Opposer's likelihood-of-confusion claim, which we do not reach. In any event, we need not address the applicability, or inapplicability, of these defenses in this proceeding, because, although Applicant's brief reiterates that the Oswald character name is in the public domain, *see, e.g.*, 96 TTABVUE 3, 8, the brief does not specifically raise or address the "affirmative defenses." Thus we deem them impliedly waived. *See Tequila Cuadra S. de RL de CV v. Manufacturera de Botas Cuadra, S.A. de C.V.*,

The case is fully briefed,<sup>7</sup> and an oral hearing was held on May 29, 2025. As explained below, we **sustain** the opposition based on Opposer’s claim of lack of bona fide intent under Section 1(b). We therefore do not reach Opposer’s claim of likelihood of confusion under Section 2(d).

## **I. The Record**

The record includes the pleadings, the submissions of the parties during their respective trial periods, and, by rule, Applicant’s involved application file. *See* Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). Although we do not list the contents of the record, it has been reviewed and considered in its entirety. *See Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1036 (Fed. Cir. 2021) (“We have held ‘on multiple occasions that failure to explicitly discuss every issue or every piece of evidence does not alone establish that the tribunal did not consider it.’” (quoting *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017))); *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1348 (Fed. Cir. 2012) (“[T]he mere fact that the Board did not recite all of the evidence it considered does not mean the evidence was not, in fact, reviewed.” (citing *Plant Genetic Sys., N.V. v. Dekalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed. Cir. 2003))).

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Opp. No. 91282327, 2025 TTAB LEXIS 207, at \*2 n.3 (TTAB 2025) (considering pleaded affirmative defenses not pursued in the brief to be waived).

<sup>7</sup> Opposer’s Main Brief, 94 TTABVUE; Applicant’s Brief, 96 TTABVUE; Opposer’s Reply Brief, 97 TTABVUE.

## II. Evidentiary Objections

Before turning to the merits, we address Opposer's statement of objections,<sup>8</sup> which was filed concurrently with Opposer's main brief and contains objections to portions of declarations submitted by Applicant, as well materials in Applicant's various notices of reliance.<sup>9</sup> As to the declarations, Opposer objects on grounds that some of the testimony they contain lacks foundation, lacks personal knowledge, consists of speculation, and includes inadmissible hearsay.<sup>10</sup> As to the notices of reliance, Opposer objects on grounds that some include documents that are not self-authenticating or are offered for the truth of the matter asserted therein, while others contain improper argument.<sup>11</sup> Applicant's brief, in turn, sets forth Applicant's responses to these objections.<sup>12</sup>

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<sup>8</sup> 95 TTABVUE.

<sup>9</sup> *See id.* at 2.

<sup>10</sup> *See id.*

<sup>11</sup> *See id.* As Opposer acknowledges in its statement of objections, *id.* at 2 n.1, the objections to improper arguments in Notice of Reliance Nos. 4 and 5 were included in a prior motion to strike and, in deciding that motion, the Board indicated that, "[w]hile Applicant continues to assert arguments as to the merits and/or probative value of his alleged evidence in connection with Opposer's claims within each of these notices, the Board will disregard such statements and they will receive no consideration." 90 TTABVUE 3. Therefore, Opposer need not have raised these same objections in its statement of objections. *See Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 TTAB LEXIS 600, at \*26-27 (TTAB 2005) (indicating that the some of the parties' objections did not need to be raised in the parties' briefs because the objections merely reiterated issues already raised and addressed in prior motions to strike), *aff'd*, 479 F.3d 825 (Fed. Cir. 2007); TBMP § 707.04 ("[P]arties are discouraged from filing objections that are . . . duplicative of issues previously raised via a motion to strike.").

<sup>12</sup> 96 TTABVUE 15-16.

We find it unnecessary to make specific rulings on these objections.<sup>13</sup> The Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the concerns raised by the objections. *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at \*4-5 (TTAB 2014); *see also Hangzhou Mengku Tech. Co. v. Shanghai Zhenglang Tech. Co.*, Opp. No. 91272143, 2024 TTAB LEXIS 575, at \*9 (TTAB 2024) (“Administrative Trademark Judges are not lay jurors who might easily be misled, confused, or prejudiced by irrelevant or unreliable evidence.”). Accordingly, in our analysis below, we have cited any evidence we have credited, and we have given no weight to factual assertions that are not supported by evidence properly introduced into the record. *See Pierce-Arrow Soc’y v. Spintek Filtration, Inc.*, Opp. No. 91224343, 2019 TTAB LEXIS 388, at \*9 (TTAB 2019); *Krause v. Krause Publ’ns Inc.*, Can. No. 92041171, 2005 TTAB LEXIS 487, at \*10 (TTAB 2005) (“Where we have relied on testimony to which respondent objected, it should be apparent to the parties that we have deemed the material both admissible and probative to the extent indicated in the opinion.”). Additionally, to the extent we rely on any of the objected-to evidence, we keep in mind any deficiencies and have accorded whatever probative value the evidence merits. *See*

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<sup>13</sup> We do note, however, that, to the extent any of Opposer’s objections are procedural in nature (e.g., lack of foundation, lack of authentication), such that the relevant defects could have been cured if the objections were raised earlier, these objections are untimely and thus waived. *See, e.g., Moke Am. LLC v. Moke USA, LLC*, Opp. No. 91233014, 2020 TTAB LEXIS 18, at \*16 (TTAB 2020) (“An objection to foundation raised for the first time in a trial brief is untimely because the party offering the testimony (whether by deposition, affidavit or declaration) does not have the opportunity to cure the alleged defect.”)

*Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, Opp. No. 91190827, 2017 TTAB LEXIS 6, at \*4 (TTAB 2017).

### **III. Opposer's Entitlement to a Statutory Cause of Action**

Establishing an entitlement to a statutory cause of action is a threshold requirement in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020). Thus, Opposer, as plaintiff in this opposition proceeding, must prove its entitlement to a statutory cause of action by a preponderance of the evidence. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 228, at \*8 (TTAB 2022).

To establish its entitlement to a statutory cause of action, Opposer must demonstrate that it has: (1) an interest falling within the zone of interests protected by the statute, and (2) a reasonable belief in damage proximately caused by the registration of the mark. *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1367 (Fed. Cir. 2025) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129-34 (2014)); *Corcamore*, 978 F.3d at 1304-07; *see also Made in Nature*, 2022 TTAB LEXIS 228, at \*18.

Here, Opposer has provided status-and-title copies of its pleaded registrations for a stylized mark containing the wording OSWALD THE LUCKY RABBIT, forming the basis for a plausible Section 2(d) likelihood-of-confusion claim. *See Conopco, Inc. v. Transom Symphony OpCo, LLC*, Opp. No. 91256368, 2022 TTAB LEXIS 194, at \*10 (TTAB 2022); *Made in Nature*, 2022 TTAB LEXIS 228, at \*19 (finding opposer's pleaded registrations established its "interest in marks similar to the mark sought

for registration by Applicant, and thus Opposer's entitlement to bring a colorable claim under Trademark Act Section 2(d)"). Applicant does not argue otherwise. Therefore, Opposer has demonstrated, by a preponderance of the evidence, that it has a real interest in the proceeding and a reasonable belief that it would be damaged by the registration of Applicant's mark, thus establishing Opposer's entitlement to bring and maintain this opposition under Trademark Act Section 13, 15 U.S.C. § 1063, on the ground of likelihood of confusion.

Further, because Opposer has established its entitlement to a statutory cause of action for its asserted likelihood-of-confusion claim, its entitlement to assert its claim based on lack of bona fide intent is also established. *See Enbridge, Inc. v. Excelerate Energy LP*, Opp. No. 91170364, 2009 TTAB LEXIS 642, at \*21 n.10 (TTAB 2009) ("If an opposer can show standing as to one ground, it has the right to assert any other ground as well.").

#### **IV. Lack of Bona Fide Intent**

We turn now to Opposer's claim that Applicant lacked a bona fide intent to use the OSWALD THE RABBIT mark in U.S. commerce for the services identified in Applicant's application as of the application's filing date.

To reiterate, Applicant's identified services are:

Direction or presentation of plays; Entertainment, namely, production of plays; Entertainment, namely, production of musicals; Planning arrangement of showing movies, shows, plays or musical performances; Providing facilities for movies, shows, plays, music or educational training, in International Class 41.



### **A. Factual Background**

Applicant testified that he has “professional experience and some success with musical film productions,”<sup>14</sup> including *Yentl*, *Captain EO*, and *Electric Dreams*, and has also been commissioned to write, create, or adapt stage musicals, including *The Amazing Mr. Marvel*, *Angels With Dirty Faces*, *Miss Saigon*, and *Sunset Boulevard*.<sup>15</sup> Of particular relevance here, in the early 1980s Applicant “was contacted by veteran stage producer Alan Carr (*La Cage Aux Folles*, *Grease* - the film) to develop a stage musical,”<sup>16</sup> prompting Applicant to propose a “musical pertaining to Oswald the Rabbit and his early relationship to Walt Disney.”<sup>17</sup> This led to further discussions with individuals who could compose music, write lyrics, and provide puppeteering for the production.<sup>18</sup> Applicant also commissioned the creation of “small maquettes (study models) of the intended animated characters . . . in addition to a miniature stage set, intended to further the interest of producer Alan Car and later, [puppeteer] Jim Henson.”<sup>19</sup> Ultimately, all of the other identified parties to these discussions in the early 1980s died without the project coming to fruition<sup>20</sup> and without any

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<sup>14</sup> Declaration of Ralph Lemorande (corrected), 83 TTABVUE 2.

<sup>15</sup> *Id.* at 3-4.

<sup>16</sup> *Id.* at 5.

<sup>17</sup> *Id.* According to Applicant, the idea for such a musical first occurred to him in the 1970s when he was studying motion picture history. *Id.* at 6.

<sup>18</sup> *Id.* at 5-6.

<sup>19</sup> *Id.* at 6. Applicant also testified that “[l]egal fees were also to determine with certainty that Oswald the Rabbit—the character and his early stories—were in the public domain.” *Id.* The record is unclear, however, as to whether Applicant, or anyone else, actually engaged a lawyer for these services.

<sup>20</sup> See Applicant’s Brief, 96 TTABVUE 7.

contractual agreements or licenses otherwise resulting.<sup>21</sup> According to Applicant, however, “development of . . . stage productions can occur over a great duration of time, sometimes decades,”<sup>22</sup> and “[i]n 2018, anticipating possible completion of the project, [he] filed an Intent to Use application for . . . ‘Oswald The Rabbit.’”<sup>23</sup>

## **B. Relevant Law**

Under Trademark Act Section 45, 15 U.S.C. § 1127, a “service mark” is:

any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

Further, Trademark Act Section 1(b), 15 U.S.C. § 1051(b), provides that “[a] person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark [or service mark] in commerce may request registration of its trademark [or service mark].” “Because a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark [or service mark] application under Section 1(b), the lack of such intent is a basis on which an opposer may challenge an applicant’s mark.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015).

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<sup>21</sup> See Opposer’s Second Notice of Reliance, 52 TTABVUE 21 (“[A]pplicant does not recall those discussions leading to contractual agreements, licenses, or similar.”)

<sup>22</sup> Declaration of Ralph Lemorande (corrected), 83 TTABVUE 7.

<sup>23</sup> *Id.* Applicant’s declaration does not further explain why he was “anticipating possible completion of the project.”

“Whether an applicant has a bona fide intent to use a mark in commerce is an objective inquiry based on the totality of the circumstances; and those circumstances must indicate the applicant’s intent to use the mark that are ‘firm’ and ‘demonstrable.’” *Societe Des Produits Nestle S.A. v. Taboada*, Opp. No. 91232597, 2020 TTAB LEXIS 267, at \*39 (TTAB 2020) (quoting *M.Z. Berger*, 787 F.3d at 1375-76); *see also Tequila Cuadra*, 2025 TTAB LEXIS 207, at \*12 (“A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances.” (quoting *Boston Red Sox Baseball Club L.P. v. Sherman*, Opp. No. 91172268, 2008 TTAB LEXIS 67, at \*16 (TTAB 2008))). The record “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 Elecs. Ltd. v. CBM K.K.*, Opp. No. 91086336, 1993 TTAB LEXIS 6, at \*12 n.7 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. § 1127).

Opposer bears the burden of demonstrating by a preponderance of the evidence that Applicant lacked a bona fide intent to use the mark for all of the services identified in the involved application when the application was filed. *See Tequila Cuadra*, 2025 TTAB LEXIS 207, at \*12-13; *Nestle*, 2020 TTAB LEXIS 267, at \*28-29. Opposer may satisfy this burden by showing, inter alia, an absence of any documentary evidence regarding such intent on Applicant’s part. *See Nestle*, 2020 TTAB LEXIS 267, at \*29; *Rsch. in Motion Ltd. v. NBOR Corp.*, Opp. No. 91179284, 2009 TTAB LEXIS 673, at \*12 (TTAB 2009) (citing *Commodore Elecs.*, 1993 TTAB LEXIS 6, at \*13). If Opposer satisfies this initial burden of proof, the burden of

production shifts to Applicant to offer additional evidence showing his bona fide intent to use his mark in commerce in connection with the identified services. *Saul Zaentz Co. v. Bumb*, Opp. No. 91156452, 2010 TTAB LEXIS 236, at \*13 (TTAB 2010) (citing *Commodore Elecs.*, 1993 TTAB LEXIS 6, at \*13 n.11).

### **C. Opposer's Arguments and Evidence**

Opposer contends that “Applicant’s discovery responses confirm that, as of the November 16, 2018 Application Filing Date, Applicant did not have any documents to support a bona fide intent to use Applicant’s Mark for Applicant’s Services,”<sup>24</sup> and that “Applicant’s intent to advertise, promote, or offer to sell any of Applicant’s services is ‘speculative at this point in time,’<sup>25</sup> . . . and ‘premature, prospective, and largely inchoate.’”<sup>26</sup>

Specifically, Opposer asserts that these discovery responses show that:

- “Applicant has no business plans to refer to his use of intended use of Applicant’s Mark,” because, as stated by Applicant, “any plans are ‘tentative and inchoate’”;<sup>27</sup>
- Applicant “has no advertising, promotional, or marketing materials showing use of Applicant’s Mark . . . and has not engaged any marketing or advertising agency ‘because the matter is premature at this stage’”;<sup>28</sup>

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<sup>24</sup> Opposer’s Main Brief, 94 TTABVUE 51.

<sup>25</sup> *Id.* at 33 (quoting Applicant’s Responses to Opposer’s First Requests for Production, 52 TTABVUE 13).

<sup>26</sup> *Id.* (quoting Applicant’s Responses to Opposer’s First Set of Interrogatories, 53 TTABVUE 24).

<sup>27</sup> *Id.* (quoting Applicant’s Responses to Opposer’s First Set of Interrogatories, 53 TTABVUE 23).

<sup>28</sup> *Id.* (quoting Applicant’s Responses to Opposer’s First Set of Interrogatories, 53 TTABVUE 25).

- “Applicant has no ‘contractual agreements, licenses or similar’ that refer or relate to Applicant’s Mark or Applicant’s Services under that mark”;<sup>29</sup> and
- Applicant has not approached any producers involved with, or expected to be involved with, the production of any of Applicant’s services to be offered under Applicant’s mark and, therefore, no documents showing such producer involvement exist.<sup>30</sup>

Opposer further argues that, “while Applicant subjectively recounts vague discussions and ‘interest’ from industry veterans such as Jim Henson and Alan Carr, that all occurred forty years ago with individuals who have long since passed” and thus “Applicant’s forty-year-old discussions are ‘not even remotely contemporaneous with the filing of the application.’”<sup>31</sup> Nor, Opposer notes, has Applicant provided “any documents or evidence of any such communications, or of any agreements with any individual or entity for the purpose of offering any of Applicant’s Services (presentation and production of plays and musicals) under Applicant’s Mark.”<sup>32</sup>

Opposer likewise dismisses Applicant’s testimony and evidence that Applicant “commissioned ‘small maquettes (study models) of the intended animated characters’ and a ‘miniature stage set’”<sup>33</sup> to “further the interest” of potential producers.<sup>34</sup> Opposer notes that these items were commissioned and produced in the early 1980s

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<sup>29</sup> *Id.* (quoting Applicant’s Responses to Opposer’s First Requests for Production, 52 TTABVUE 21).

<sup>30</sup> *See id.* (citing Applicant’s Responses to Opposer’s First Requests for Production, 52 TTABVUE 20-21).

<sup>31</sup> *Id.* at 52 (quoting *Boston Red Sox*, 2008 TTAB LEXIS 67, at \*18).

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* (quoting Declaration of Ralph Lemorande (corrected), 83 TTABVUE 6).

<sup>34</sup> Declaration of Ralph Lemorande (corrected), 83 TTABVUE 6

and “Applicant did not even recall their existence until years after his Application filing date.”<sup>35</sup>

Lastly, Opposer points out that Applicant “did not own or operate any website prior to the Application Filing Date that refers or relates to Applicant’s Mark or Applicant’s Services, and only created one during his testimony period—nearly 6 years after the Application Filing Date.”<sup>36</sup> Opposer asserts that “Applicant appears to have created his website solely as a medium to publish his 40-year-old photographs [of the maquettes] and to make it seem like a theatrical production is in the works,”<sup>37</sup> “which actually makes clear that he had no true bona fide intent to use OSWALD THE RABBIT when he filed his application.”<sup>38</sup>

#### **D. Applicant’s Arguments and Evidence**

For his part, Applicant states that his discussions in the early 1980s with potential interested parties about his idea for a musical pertaining to Oswald the Rabbit “were pre-internet and email,” rendering it impossible to prove such discussions “other than through Applicant’s own credibility.”<sup>39</sup> He suggests that the testimony and evidence as to the creation of “costly maquettes” at the time, and “puppet prototypes” more recently, “would seem sufficient” to establish his intent.<sup>40</sup> Regardless, he contends, a

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<sup>35</sup> Opposer’s Main Brief, 94 TTABVUE 34.

<sup>36</sup> *Id.* at 51 (emphasis omitted).

<sup>37</sup> *Id.* at 53-54.

<sup>38</sup> *Id.* at 11.

<sup>39</sup> Applicant’s Brief, 96 TTABVUE 7.

<sup>40</sup> *Id.* While not completely clear, we construe Applicant’s argument to be that the evidence as to the maquettes establish that the discussions with potential interested parties actually

“solo writer/creator of a theatrical entertainment typically has no need” to “create[] and maintain[] copious administrative documentation of all [his] efforts and plans.”<sup>41</sup>

As to Opposer’s argument that, by Applicant’s own admission, his plans “were ‘tentative and inchoate’ and/or ‘speculative’” at the time his application was filed,<sup>42</sup> Applicant asserts that “[i]n fact, intentions are often ‘tentative,’ ‘inchoate’ and can be ‘speculative,’” thus the reason for filing an intent-to-use application.<sup>43</sup>

## **E. Findings as to Bona Fide Intent**

### **1. Opposer’s Initial Burden**

Upon reviewing the record and the parties’ arguments, we find that, in view of the general lack of documentary evidence evincing Applicant’s intent to use the applied-for OSWALD THE RABBIT mark in connection with the identified services, Opposer has met its initial burden of demonstrating by a preponderance of the evidence that when Applicant’s application was filed, Applicant had no bona fide intent to use the mark as to any of the identified services. *See, e.g., Saul Zaentz Co.*, 2010 TTAB LEXIS 236, at \*19 (finding opposer met its burden to show no bona fide intent where the record contained no documentary evidence to establish applicant’s intent and applicant’s testimony indicated only a “vague plan for, or conception of,” how the mark would be used).

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occurred and that this tends to suggest that Applicant intended to use the OSWALD THE RABBIT mark in connection with a theatrical production.

<sup>41</sup> *Id.* at 6.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 7.

Applicant does not specifically address, nor does the record contain any evidence concerning, Applicant's efforts with regard to the identified services of "providing facilities for movies, shows, plays, music or educational training." Rather, Applicant's arguments appear to implicate the remaining identified services of directing, presenting, producing, and planning arrangement of showing, plays or musicals.

However, as Opposer points out, Applicant has not provided any business plans, communications, contracts, agreements, or any other external or internal business documents establishing that, as of November 16, 2018, Applicant had a bona fide intent to use the OSWALD THE RABBIT mark in connection with any of these identified services. *See Tequila Cuadra*, 2025 TTAB LEXIS 207, at \*24-25 (finding no bona fide intent to sue the mark where applicant failed to identify any business plans, contracts, or business communications indicating an intent to sell its alcoholic beverage in the United States). Again, Applicant stated in his discovery responses that he has no business plans as to the use or intended use of his applied-for mark,<sup>44</sup> and "any plans to bring to market each of Applicant's Services that [Applicant] intended to offer under Applicant's Mark" were "tentative and inchoate";<sup>45</sup> that he had no documents "sufficient to identify each of Applicant's Services . . . intended to be advertised, promoted, offered for sale, or sold in commerce on or in connection

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<sup>44</sup> Opposer's Second Notice of Reliance, 52 TTABVUE 13 (Applicant's Responses to Opposer's First Requests for Production).

<sup>45</sup> Opposer's Third Notice of Reliance, 53 TTABVUE 33 (Applicant's Responses to Opposer's First Set of Interrogatories).



Applicant's Mark," because his intention is "speculative at this point in time;"<sup>46</sup> that he had not engaged in any advertising, promotion, or marketing efforts, "because the matter is premature at this stage";<sup>47</sup> that "no correspondence exists including licenses or contractual documentation" "concerning the use and/or registration of Applicant's Mark in connection with Applicant's Services";<sup>48</sup> and that he had not approached any producers involved with, or expected to be involved with, the production of any of Applicant's services to be offered under Applicant's mark.<sup>49</sup>

Applicant's evidence of the maquettes and miniature stage set, at best, corroborates his testimony that he engaged in discussions intended to generate interest in a stage production featuring the character Oswald the Rabbit (and other related characters) during the early 1980s. This evidence does not establish, however, that Applicant had the requisite bona fide intent to use the OSWALD THE RABBIT mark in connection with the identified services at the time he filed his application for in November 2018.

First, given that this evidence relates to activities that took place over four decades ago, it is simply too temporally remote to be probative of Applicant's intent as of the application filing date. *See, e.g., A&H Sportswear Co. v. Yedor*, Opp. No.

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<sup>46</sup> Opposer's Second Notice of Reliance, 52 TTABVUE 13 (Applicant's Responses to Opposer's First Requests for Production).

<sup>47</sup> Opposer's Third Notice of Reliance, 53 TTABVUE 25 (Applicant's Responses to Opposer's First Set of Interrogatories).

<sup>48</sup> Opposer's Second Notice of Reliance, 52 TTABVUE 21 (Applicant's Responses to Opposer's First Requests for Production).

<sup>49</sup> *Id.* at 20-21.

91235843, 2019 TTAB LEXIS 75, at \*14 (TTAB 2019) (finding use of Applicant's mark on a prototype t-shirt in 2005 was not probative of Applicants bona fide intent to use the mark when the involved application was filed because the use was not sufficiently contemporaneous with the 2016 filing date of the application).

Second, and perhaps more importantly, Applicant's desire in the early 1980s to create a stage production that features the Oswald the Rabbit character is qualitatively different than an intent to use the mark OSWALD THE RABBIT as an indicator of source for the various services identified in Applicant's 2018 application. In other words, the maquettes and miniature stage set may reflect Applicant's efforts at one point to develop or demonstrate the conceptual elements of a production featuring Oswald the Rabbit as a character, subject, or namesake for the production's title. But they do not show that Applicant had taken any steps or made any plans as of the application's filing date to offer any of the identified services under the applied-for OSWALD THE RABBIT service mark.<sup>50</sup>

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<sup>50</sup> One of Opposer's interrogatories asked Applicant "to describe in detail the play and/or musical that he intends to produce under his mark, including a description of the plot, characters, cast, and location where the production will be shown." 27 TTABVUE 3. Applicant's original unverified response to this interrogatory stated that "[t]he production has not been finalized and is still subject to substantial revision. Current concepts are confidential trade secrets of applicant, are subject to change, and beyond the general scope of the entertainment services set forth in the application. Therefore, such an interrogatory is irrelevant to the service mark issue." Opposer's Third Notice of Reliance, 53 TTABVUE 23. In granting, in part, Opposer's motion to compel a further response over Applicant's objections, the Board required Applicant to provide "a general and brief description" of Applicant's script for a potential production. 27 TTABVUE 3. Applicant then provided a supplemental unverified response indicating, in part, that "the primary characters are Walt Disney and the imaginary Oswald the Rabbit. . . . Mr. Disney opines on his life in dialogue with his imaginary friend, Oswald the cartoon rabbit." 53 TTABVUE 29. This response indicates, at most, that Applicant had conceived a general concept for the content of a potential play, but, as with the maquettes and miniature stage set, it does not show that he

Applicant also submitted photographs<sup>51</sup> showing what he describes as a “full-sized prototypes of puppets (characters) that would be used in a live production” made by “skilled seamstresses/puppet builders.”<sup>52</sup> Applicant states that he “elected to create” these prototypes, which appear to be approximately 18-24 inches tall,<sup>53</sup> in “further development of the musicals” in 2018.<sup>54</sup> It is not clear from the record, however, when the prototypes were actually ordered or created. The only documentation supporting Applicant’s testimony is email correspondence apparently relating to one of the prototypes, with a picture labeled “Oswald horse” showing “the lines on the feet as they should be,” dated February 2, 2019—several months after the filing date of the application.<sup>55</sup> And Applicant has not submitted any testimony from the makers of the puppets verifying when the puppets were ordered. In any event, like the maquettes and miniature stage set created in the early 1980s, these prototypes, at best, show a conceptual element of a potential stage production. Without further supporting evidence, they do not establish that Applicant had a bona fide intent to use the mark OSWALD THE RABBIT in connection with any of the identified services.

As to the evidence from Applicant’s website, which features information on the Oswald the Lucky Rabbit character and references a “theatrical project,” the record

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has taken any actual steps to offer any of the identified entertainment services under the OSWALD THE RABBIT mark.

<sup>51</sup> Declaration of Ralph Lemorande (corrected), 83 TTABVUE 9, 31-32.

<sup>52</sup> *Id.* at 9.

<sup>53</sup> *See id.* at 31-32.

<sup>54</sup> *Id.* at 9.

<sup>55</sup> *See id.* at 29.

indicates that the website was not created until well after the filing of the application at issue here.<sup>56</sup> Certainly, actions taken by an applicant after the filing of an application may corroborate that the requisite bona fide intent existed at the time of filing. *See, e.g., Lane Ltd. v. Jackson Int’l Trading Co.*, Opp. No. 91092025, 1994 TTAB LEXIS 41, at \*19 (TTAB 1994) (finding correspondence, which concerned a potential licensing agreement and occurred months after the filing of the application, corroborated applicant’s bona fide intent to use the mark). But “a long gap between the filing of an application and the activities asserted to demonstrate bona fide intent tends to undercut an inference that the applicant actually had a bona fide intent to use the mark.” *Nestle*, 2020 TTAB LEXIS 267, at \*43. And, aside from that, Applicant has acknowledged that the website was created for the purpose of submitting evidence in connection with this proceeding.<sup>57</sup>

## **2. Applicant’s Burden of Production**

Having found that Opposer has met its initial burden, we find, in turn, that Applicant has not satisfied his burden of production to come forward with “other facts which adequately explain or outweigh the failure . . . to have any documents

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<sup>56</sup> *See* Applicant’s Third Notice of Reliance (corrected), 84 TTABVUE 2 n.1 (“The website was recently created by Applicant.”); Applicant’s Brief, 90 TTABVUE 12 (“As stated previously (and admitted to herein by Opposer) the website was recently recreated [sic].”)

<sup>57</sup> *See* Applicant’s Brief, 90 TTABVUE 14 n.5. Applicant’s reference to the “TTAB’s instruction that certain evidence (such as a Notice of Reliance) would be propounded by website creation” reflects Applicant’s apparent misunderstanding of Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), which indicates that “Internet materials may be admitted into evidence under a notice of reliance.” That, is Applicant seems to mistakenly believe that he was required to create the website in order to submit certain evidence. *See* Applicant’s Brief, 96 TTABVUE 12 (“As is well known to the TTAB and Disney [the website] was created as necessary to provide a proper Notice of Reliance under advice from the TTAB.”)

supportive of or bearing upon [his] claimed intent to use its mark in commerce” as to the identified services. *Commodore Elecs.*, 1993 TTAB LEXIS 6, at \*13; *see also Honda Motor Co. v. Winkelmann*, Opp. No. 9117052, 2009 TTAB LEXIS 202, at \*5 (TTAB 2009) (“The Board has held . . . that the absence of any documentary evidence regarding an applicant’s bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention . . . unless other facts are presented which adequately explain or outweigh applicant’s failure to provide such documentary evidence.”).

A lack of documentary evidence is not necessarily fatal to establishing a bona fide intent, if there is otherwise testimony evidence that establishes intent. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, Can. No. 92047438, 2011 TTAB LEXIS 164, at \*32 (TTAB 2011) (“While it is certainly preferable for a party’s testimony to be supported by corroborating documents, the lack of documentary evidence is not fatal.”), *aff’d*, 188 F. Supp. 3d 22 (D.D.C. 2016), *aff’d*, 743 F. App’x 457 (D.C. Cir. 2018). Here, however, Applicant’s testimony and discovery responses indicate that he had not made any specific plans or efforts to provide any of the identified services under the applied-for mark, such as producing a business plan, engaging in promotion, entering into contractual agreements, or approaching producers. Instead, he stated that such plans and efforts were “tentative,”<sup>58</sup>

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<sup>58</sup> Opposer’s Third Notice of Reliance, 53 TTABVUE 23 (Applicant’s Responses to Opposer’s First Set of Interrogatories).

“inchoate,”<sup>59</sup> and “premature,”<sup>60</sup> and characterized his intention as “speculative.”<sup>61</sup> *See, e.g., L’Oreal S.A. v. Marcon*, Opp. No. 91184456, 2012 TTAB LEXIS 77, at \*36 (TTAB 2012) (finding that applicant’s “failure to take any concrete actions or to develop any concrete plans for using the mark . . . demonstrates that applicant objectively lacks the requisite bona fide intent to use the . . . mark in commerce”).

We acknowledge Applicant’s point that a “solo writer/creator of a theatrical entertainment typically has no need” to “create[] and maintain[] copious administrative documentation of all [his] efforts and plans.”<sup>62</sup> We also understand that promotional, marketing, and licensing efforts may be premature during the early stages of developing an entertainment production, such as a musical play. Nonetheless, it is not unreasonable to expect that, if Applicant had any plans whatsoever to use the applied-for mark in connection with any of the identified services as of the application filing date, then at least some documentary evidence showing these plans would exist.

We also acknowledge that evidence of an applicant’s ability and means to develop and offer the services can, in certain circumstances, establish a bona fide intent where documentary evidence of such intent is otherwise lacking. *C.f., e.g., Nestle*, 2020 TTAB LEXIS 267, at \*41-42 (“[A]n applicant’s capacity to market and manufacture the

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<sup>59</sup> *Id.*

<sup>60</sup> *Id.* at 25.

<sup>61</sup> Opposer’s Second Notice of Reliance, 52 TTABVUE 13 (Applicant’s Responses to Opposer’s First Requests for Production).

<sup>62</sup> Applicant’s Brief, 96 TTABVUE 6.

identified goods consistent with the natural extension of its current product line can rebut the lack of documentary evidence.”); *Wet Seal, Inc. v. FD Mgmt.*, Opp. No. 91157022, 2007 TTAB LEXIS 21, at \*47 (TTAB 2007) (finding applicant’s capacity to market and manufacture goods, having previously done so under different marks, rebutted claim of lack of bona fide intent). However, in this case, Applicant’s prior experience, ability, and success in creating, writing, and adapting musical productions is not sufficient to establish his bona fide intent to use the applied-for mark in connection with any of the identified services, when the record otherwise plainly establishes that his plans to use the OSWALD THE RABBIT mark as a service mark for these services were tentative, speculative, and inchoate. *Cf. M.Z. Berger*, 787 F.3d at 1373, 1378 (affirming the Board’s finding of lack of bona fide intent where, inter alia, applicant had a history of making and selling watches generally but “never took any step toward developing any [watches with certain technological] features, either contemporaneous with the filing of the application or in the eighteen months thereafter”).

#### **F. Conclusion**

Our determination must be based on objective evidence “in the form of real[-]life facts and by the actions of the applicant, not by the applicant’s testimony as to its subjective state of mind.” 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:14 (5th ed. 2025); *see also L’Oreal*, 2012 TTAB LEXIS 77, at \*40-41. The record here, at best, establishes that, decades ago, Applicant conceived an idea for a play involving Oswald the Rabbit; attempted, with limited success, to interest other parties in the play during early 1980s; and, more recently, has carried on with the

idea of producing the play. However, Applicant's subjective intent to produce such a play, and his very limited recent efforts to develop conceptual elements of a potential live production by commissioning prototype puppets around the time of filing his application, are simply not sufficient to indicate an intent to actually use the mark OSWALD THE RABBIT as a service mark in connection with the identified services. In short, we cannot conclude that Applicant's intent to use the applied-for mark as an indicator of source for the particular services identified in the application was firm and demonstrable when he filed his application. *See M.Z. Berger*, 787 F.3d at 1375-76. Rather, the record, including Applicant's own statements, evinces a "vague plan for, or conception of" a musical production featuring the Oswald the Rabbit character and, at most, a speculative desire to reserve a right in the OSWALD THE RABBIT mark should a production ever come to fruition. *See Saul Zaentz Co.*, 2010 TTAB LEXIS 236, at \*18-19. We therefore find that Applicant lacked a bona fide intent to use the mark OSWALD THE RABBIT in connection with the identified services as of the application's filing date.

**Decision:** The opposition to registration of Applicant's OSWALD THE RABBIT mark is **sustained** as to the claim of lack of bona fide intent to use under Trademark Act Section 1(b). We do not reach the likelihood-of-confusion claim under Trademark Act Section 2(d).