

THIS ORDER IS NOT A
PRECEDENT OF THE
TTAB

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
General Email: TTABInfo@uspto.gov

LTS

October 19, 2023

Opposition No. 91268626

Monster Energy Company

v.

Cheng Shin Rubber Ind. Co., Ltd.

**Before Wellington, Greenbaum, and Dunn,
Administrative Trademark Judges.**

By the Board:

This case now comes up on: (1) Applicant's motion, filed May 25, 2023, for leave to file an amended answer (31 TTABVUE); and (2) Applicant's motion, also filed May 25, 2023, for summary judgment on Opposer's claims of likelihood of confusion, dilution, and lack of a bona fide intent to use (33 TTABVUE).¹ Both motions are fully briefed.

We have carefully considered all of the parties' arguments, presume the parties' familiarity with the bases for their filings, and do not recount the facts or arguments

¹ Citations to the record throughout the order are to TTABVUE, the Board's online docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable. The Board expects the parties to cite to the record using TTABVUE throughout this proceeding and particularly when referring to the evidentiary record in final briefs.

here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

A. The Present Proceeding

Cheng Shin Rubber Ind. Co., Ltd. (“Applicant”) seeks registration of the mark:



for “tires” in International Class 12 and “promoting sports competitions and events of others; promoting sports competitions for others; promotion of goods and services through sponsorship of sports events” in International Class 35.²

In its amended notice of opposition, Monster Energy Company (“Opposer”) alleges prior common law rights in and registration of several marks containing the following design either by itself or in conjunction with other wording and/or designs:³



² Application Serial No. 90059087 was filed on July 17, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a declaration of a bona fide intent to use the mark in commerce. The mark is described in the application as “consist[ing] of the letter ‘M’ in a stylized font with a v-shaped bar above it.”

³ 23 TTABVUE 7-31, ¶¶ 2-39. Copies of the pleaded registrations, obtained from the USPTO TESS electronic database, were submitted with the Amended Notice of Opposition (*id.* at 36-146). Thus, the registrations are properly introduced into the record pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

(hereinafter, Opposer’s “Claw Icon mark”).⁴ One of Opposer’s pleaded registrations, consisting of a colorized version of the Claw Icon mark, Reg. No. 6014229, is registered for “automotive wheels,” in International Class 12.⁵ Another of Opposer’s pleaded registrations, consisting solely of the Claw Icon mark, Reg. No. 4721432, is registered for “promoting goods and services in the sports, motorsports, electronic sports, and music industries through the distribution of printed, audio and visual promotional materials; promoting sports and music events and competitions for others,” in International Class 35.⁶ Opposer’s remaining pleaded registrations cover a variety of goods and services in International Classes 5, 9, 14, 16, 18, 12, 20, 22, 24, 25, 27, 32, and 41. 23 TTABVUE 16-21, ¶¶ 14.

As grounds for opposition in its amended notice of opposition, Opposer pleads claims of likelihood of confusion, dilution, and lack of a bona fide intent to use, with the lack of a bona fide intent to use claim limited to the International Class 35 services of the involved application. *Id.* at 31-33, ¶¶ 40-49.

Applicant, in its Answer, denies the salient allegations of the Amended Notice of Opposition. 25 TTABVUE.

⁴ We use “Claw Icon mark” to refer to this mark for sake of simplicity as this term was used to describe Opposer’s pleaded marks in the prior proceeding (*see infra* at 4). We note that it is described in several of Opposer’s pleaded registrations as “a stylized letter M in the form of a claw.”

⁵ Issued on March 17, 2020. The colors green and black are claimed as a feature of the mark.

⁶ Issued on April 14, 2015. A Section 8 declaration has been accepted.

B. The Prior Proceeding

The parties were previously involved in an opposition proceeding before the Board, captioned *Monster Energy Co. v. Cheng Shin Rubber Ind. Co., Ltd.*, Opp. No. 91244820 (TTAB May 4, 2023) (the “Prior Proceeding”). There, Applicant sought registration of the same mark:



for “clothing, namely, baseball-style caps, shirts, jackets, and jerseys” in International Class 25.⁷ 33 TTABVUE 107-08.

Opposer opposed registration of Applicant’s involved mark under Section 2(d) of the Trademark Act on the ground that the mark so resembles Opposer’s registered and previously-used marks that it is likely to cause confusion. *Id.* at 108. In the Prior Proceeding, Opposer alleged prior common law rights in and registration to the same marks pleaded in the present proceeding. *Id.* One such registration, Reg. No. 4051650, is for the Claw Icon mark on “clothing namely, t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely hats and beanies,” in International Class 25.⁸ *Id.* at 108-09.

⁷ Application Serial No. 87819877 was filed on March 5, 2018, under Section 1(b) of the Trademark Act, based on a declaration of a bona fide intent to use the mark in commerce. 33 TTABVUE 108 n.1. The mark is described in the involved application of the Prior Proceeding the same as described in the involved application of the present proceeding, namely as “consist[ing] of the letter ‘M’ in a stylized font with a v-shaped bar above it.” *Id.*

⁸ Issued on November 8, 2011; renewed. 33 TTABVUE 109 n.4.

On May 4, 2023, after the commencement of this proceeding, the Board issued a final decision in the Prior Proceeding denying Opposer’s opposition. *Id.* at 107-40. Pertinent to Applicant’s pending motions in the present proceeding, the Board found, inter alia, that “each mark is so stylized differently that they bear no resemblance to one another” (*id.* at 133) and “the [parties’] two marks are quite dissimilar” (*id.* at 137). Although acknowledging that “[s]everal factors weigh in favor of finding confusion likely,” the Board ultimately “accord[ed] a great deal of weight to the overall dissimilarity of the marks and, in conjunction with [its] finding of weakness as to the mere use of a stylized letter M in connection with clothing[,]” concluded that “confusion is unlikely.” *Id.* at 139-40.

II. Applicant’s Motion to Amend Its Answer

Applicant now seeks leave to file an amended answer to add an affirmative defense that “Opposer is collaterally estopped from relitigating the issue of similarity or dissimilarity of” the parties’ respective marks in light of the final decision in the Prior Proceeding. 31 TTABVUE 17. As noted above, Applicant has moved for summary judgment on Opposer’s likelihood of confusion and dilution claims based on Applicant’s proposed collateral estoppel defense. 33 TTABVUE. Because a party may not obtain summary judgment on an unpleaded claim or defense,⁹ we first address Applicant’s motion for leave to amend its answer.

⁹ See Fed. R. Civ. P. 56(a); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008).

Applicant argues that leave to amend its answer should be granted because, inter alia: (1) Applicant's request to amend its answer is timely; (2) Opposer will not be prejudiced by the proposed amendment; (3) Applicant has not acted in bad faith; and (4) Applicant's proposed collateral estoppel defense is not futile. 31 TTABVUE 5-7.

In response, Opposer argues that Applicant's motion for leave to amend its answer should be denied because, inter alia: (1) the Prior Proceeding has not been finally determined in that the time for filing an appeal in that proceeding has not expired (35 TTABVUE 4-5); and (2) the collateral estoppel doctrine cannot apply in this case because the involved applications in the two proceedings are for different goods and services, and therefore Applicant's proposed collateral estoppel defense is futile (*id.* at 5-7).

In reply, Applicant argues, inter alia, that: (1) Opposer has not argued that Applicant's motion for leave to amend is untimely, that Opposer would suffer prejudice from the proposed amendment, or that Applicant's motion for leave to amend has been brought in bad faith (38 TTABVUE 3); (2) Applicant's proposed collateral estoppel defense is not futile because the collateral estoppel doctrine can apply to a single likelihood of confusion factor, even where the collateral estoppel doctrine does not bar relitigation of a likelihood of confusion claim in whole (*id.* at 3-7); (3) the collateral estoppel doctrine applies to the issue of the similarity of the parties' respective marks (*id.* at 7-8); and (4) the finality of the Prior Proceeding is

irrelevant to whether Applicant should be granted leave to amend its answer (*id.* at 8-9).¹⁰

At this stage in the proceeding, Applicant may amend its answer only by written consent of Opposer or by leave of the Board. *See* Fed. R. Civ. P. 15(a)(2); Trademark Rule 2.107, 37 C.F.R. § 2.107. In general, under Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings when justice so requires. In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *See Valvoline Licensing & Intellectual Prop. LLC v. Sunpoint Int'l Grp. USA Corp.*, 2021 USPQ2d 785, at *11 (TTAB 2021) (citing, *inter alia*, *Foman v. Davis*, 371 U.S. 178, 182 (1962)).

The timing of the motion for leave to amend the pleading plays a significant role in determining whether Opposer will be unduly prejudiced by allowance of the proposed amendment. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.02(a) (2023) and cases cited therein. A long delay in filing a motion for leave to amend when there is no question of newly discovered evidence may render the amendment untimely. *Id.*; *see also Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). The granting of a motion for leave to amend a pleading is within the discretion of the Board and is allowed only when

¹⁰ We note that the deadline to file an appeal in the Prior Proceeding has passed. *See* 37 C.F.R. § 2.145(d). Applicant states in its reply brief to its motion for summary judgment that Opposer did not appeal the final decision in the Prior Proceeding. 39 TTABVUE 4 n.1. Accordingly, Opposer's argument concerning the finality of the Prior Proceeding is moot.

justice so requires. *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001).

Here, there is no evidence of undue delay, prejudice to Opposer, or any bad faith or dilatory motive, and this is the first time Applicant has moved to amend its pleading.

We further find that Applicant's proposed collateral estoppel defense is not futile. The principle of collateral estoppel (issue preclusion) may bar relitigation of the same issue in a second action. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2051 (2015). "[T]he general rule is that '[w]hen an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.'" *Id.* (quoting RESTATEMENT (SECOND) OF JUDGMENTS § 27, p. 250 (1980)).

The collateral estoppel doctrine does not apply to the Board's finding of no likelihood of confusion in the Prior Proceeding because the goods at issue in the Prior Proceeding (i.e., clothing) are different than the goods and services at issue in the present proceeding (i.e., tires and promotion of sports competitions and the like). See *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 n.1 (Fed. Cir. 1989) ("The Board correctly determined that the 'prior proceeding does not preclude this litigation under the doctrine of collateral estoppel. That is because the court did not determine the issue of likelihood of confusion with respect to any of applicant's goods or services now before us."); *Litton Indus., Inc. v. Litronix, Inc.*, 577

F.2d 709, 198 USPQ 280, 282 (CCPA 1978) (“[A]dmission that the previous proceedings involved an application to register the mark LITRONIX for different goods is fatal to the board’s reliance on collateral estoppel.”). Applicant, however, does not seek to apply the collateral estoppel doctrine to the claim of likelihood of confusion as a whole; rather, Applicant seeks to apply the collateral estoppel doctrine to the issue of the similarity (or dissimilarity) of the marks. 31 TTABVUE 17 (“Opposer is collaterally estopped from relitigating the issue of similarity or dissimilarity of Applicant’s Mark.”). The Board is not prohibited from applying the collateral estoppel doctrine to individual likelihood of confusion factors. *See, e.g., Toro Co. v. Hardigg Indus., Inc.*, 187 USPQ 689, 691 (TTAB 1975), *rev’d on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977) (“in view of the prior decision, applicant is estopped under the doctrine of collateral estoppel from denying opposer’s priority or the similarity between the marks ‘TORO’ and ‘TORO-PAD’”).

Here, Applicant has included sufficient factual detail in its proposed amended answer to provide Opposer fair notice of Applicant’s proposed collateral estoppel defense. *See* Fed. R. Civ. P. 8(b)(1) and 12(f); *see, e.g., IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *see also* TBMP § 311.02(b).

In view thereof, Applicant’s motion for leave to file an amended answer is **granted**. Applicant’s concurrently filed amended answer (31 TTABVUE 9-18) is accepted as Applicant’s operative responsive pleading.

III. Applicant's Motion for Summary Judgment

A. Legal Standard

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute as to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1987). All evidence must be viewed in a light favorable to the non-movant, which in this case is the Opposer, 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 Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

In deciding a summary judgment motion, the Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Opryland USA*, 23 USPQ2d at 1472; *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-movant. *Opryland USA*, 23 USPQ2d at 1472; *Olde Tyme Foods*, 22 USPQ2d at 1544. The evidence submitted by the non-movant, in opposition to a motion for summary judgment, is to be believed, and all justifiable inferences are to be drawn in its favor. *Opryland USA*, 23 USPQ2d at 1472.

B. Opposer’s Likelihood of Confusion and Dilution Claims

1. The Parties’ Arguments and Evidence

a) Applicant’s Arguments and Evidence

In support of its motion for summary judgment on Opposer’s likelihood of confusion and dilution claims, Applicant submits the declaration of its counsel Gregory Leipold, with accompanying exhibit, namely the final decision from the Prior Proceeding. 33 TTABVUE 104-140.

Applicant argues that the Board should grant summary judgment on Opposer’s likelihood of confusion and dilution claims because, inter alia:

- (1) The collateral estoppel doctrine “bar[s] relitigation of the issue of whether the [parties’] marks at issue are confusingly similar” because the similarity of marks issue decided in the Prior Proceeding is identical to the similarity of marks issue in the present proceeding, the similarity of marks issue was raised, litigated, and adjudged in the Prior Proceeding, the determination of the similarity of the marks (or lack thereof) was necessary and essential to the judgment in the Prior Proceeding, and Opposer had a full and fair opportunity to litigate the similarity of marks issue in the Prior Proceeding (*id.* at 11-13);
- (2) The dissimilarity of the parties’ marks dictates a finding of no likelihood of confusion (*id.* at 13-16); and
- (3) The dissimilarity of the parties’ marks dictates a finding of no dilution (*id.* at 16-17).

b) Opposer’s Arguments

In response, Opposer argues that the Board should deny Applicant’s motion for summary judgment on Opposer’s likelihood of confusion and dilution claims because, inter alia:

- (1) The collateral estoppel doctrine does not apply because the “similarity of marks” issue litigated in the Prior Proceeding is different than the “similarity of marks” issue in the present proceeding in that the goods at issue in the two proceedings are different (36 TTABVUE 6-8); and

- (2) Even if the collateral estoppel doctrine applied, summary judgment on Opposer's likelihood of confusion and dilution claims is not warranted because the alleged dissimilarity of the marks alone is not dispositive of Opposer's likelihood of confusion and dilution claims; rather, genuine issues of material facts exist as to other factors considered with respect to both claims (*id.* at 8-9).

c) Applicant's Reply Arguments

In reply, Applicant argues, inter alia, that:

- (1) Applicant is only seeking to apply the collateral estoppel doctrine with respect to the similarity of the marks (39 TTABVUE 3-4);
- (2) The dissimilarity of the marks is dispositive of Opposer's likelihood of confusion claim because Opposer did not submit any evidence in opposition to Applicant's motion for summary judgment on the likelihood of confusion claim (*id.* at 4-6); and
- (3) Opposer "fails to identify any specific dispute of fact or offer any legal authority to undermine Applicant's argument that summary judgment is appropriate as to dilution" (*id.* at 6).

2. Determination of Opposer's Likelihood of Confusion and Dilution Claims

Applicant's motion for summary judgment on Opposer's likelihood of confusion and dilution claims is based entirely upon its collateral estoppel defense. As such, a gating issue to determining Applicant's motion for summary judgment on Opposer's likelihood of confusion and dilution claims is whether Applicant has proven that there is no genuine dispute of material fact that the collateral estoppel doctrine bars relitigation of whether the parties' respective marks are similar. The application of collateral estoppel requires:

- (1) Identity of an issue in the current and prior proceeding;
- (2) Actual litigation of that issue in the prior proceeding;
- (3) Necessity of a determination of the issue in entering judgment in the prior proceeding; and

- (4) A full and fair opportunity existed, for the party with the burden of proof on that issue in the second proceeding, to have litigated the issue in the prior proceeding.

See Mayer/Berkshire Corp. v. Berkshire Fashions, Inc., 424 F.3d 1229, 76 USPQ2d 1310, 1313 (Fed. Cir. 2005) (citing *Montana v. United States*, 440 U.S. 147, 153-55 (1979)). *Accord B&B Hardware, Inc.*, 113 USPQ2d at 2051.

Opposer does not dispute that the issue of similarity of marks was actually litigated in the Prior Proceeding, that the issue of similarity of marks was necessary to the final determination of the Prior Proceeding, or that Opposer had a full and fair opportunity to litigate the issue of similarity of marks in the Prior Proceeding. The only factor that Opposer contests is whether the similarity of marks issue in the Prior Proceeding is identical to the similarity of marks issue in the present proceeding. 36 TTABVue 7-8. While we find that the analysis in comparing the parties' respective marks in appearance and sound in both proceedings is identical, there are genuine disputes of material fact whether the analysis in comparing the parties' respective marks in connotation and commercial impression is identical.¹¹ More specifically, there is a genuine dispute of material fact whether the connotation and commercial


impression of the mark



for use in connection with clothing is the same as

¹¹ In determining the similarity or dissimilarity of the marks in the dilution context, the Board uses the same test as in the likelihood of confusion analysis. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1115 (TTAB 2018).



the mark  for use in connection with tires and the promotion of sporting events and the like. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (“Opposer’s COACH mark, when applied to fashion accessories is clearly either arbitrary or suggestive of carriage or travel accommodations [e.g., stagecoach, train, motor coach, etc.] thereby engendering the commercial impression of a traveling bag [e.g., a coach or carriage bag]. On the other hand, applicant’s COACH marks call to mind a tutor who prepares a student for an examination.”).

Because Applicant has not demonstrated the absence of a genuine dispute of material fact that all elements of the collateral estoppel defense are met here, and because Applicant’s motion for summary judgment on Opposer’s likelihood of confusion and dilution claims is based entirely upon its collateral estoppel defense, Applicant’s motion for summary judgment on Opposer’s likelihood of confusion and dilution claims is **denied**.¹²

¹² The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

C. Opposer’s Lack of a Bona Fide Intent to Use Claim

1. The Parties’ Arguments and Evidence

a) Applicant’s Arguments and Evidence

In support of its motion for summary judgment on Opposer’s lack of a bona fide intent to use claim, Applicant submits the declaration of Matthew Clark, Senior Manager of the Media Management Department at Cheng Shin Rubber USA, Inc., d/b/a Maxxis International – USA (“Maxxis”), which is a wholly-owned subsidiary and licensee of Applicant, with accompanying exhibits (*id.* at 22-103). 33 TTABVUE 11-78. Mr. Clark attests, inter alia, that:

- (1) He manages the marketing and promotion of Applicant’s products in the United States by and through Maxxis under a license from Applicant (*id.* at 22-23, ¶ 2);
- (2) “Applicant’s Mark features a stylized letter ‘M’ for Applicant’s house mark MAXXIS (the ‘MAXXIS Mark’)” (*id.* at 22, ¶ 3);
- (3) “Applicant established the U.S. arm of Applicant’s business by distributing and selling bicycle tires under the MAXXIS Mark, and soon expanded its offerings under the mark to include tires for various other types of vehicles, including automobiles, light trucks, All Terrain Vehicles, motorcycles, trailers, and more” (*id.* at 23, ¶ 4);
- (4) Maxxis promotes and sponsors racing competitions and events that are organized and run by third parties, as well as athletes who compete in racing and motocross sports (*id.* at 23, ¶¶ 5-6);
- (5) “Maxxis has consistently and continuously used the MAXXIS Mark to promote and sponsor racing events, motocross sports, and athletes since well before 2016” (*id.* at 23, ¶ 7);
- (6) “Maxxis has consistently and continuously used Applicant’s Mark in connection with clothing and other promotional materials displayed and distributed at racing competition and events for motocross sports” (*id.* at 23, ¶ 8);
- (7) “Maxxis first used Applicant’s Mark to promote racing competitions and events in 2016” (*id.* at 23, ¶ 9);

- (8) “Maxxis advertises and promotes athletes and sports events in magazines that are directed to various racing communities” (*id.* at 23-24, ¶ 10);
- (9) “Applicant also advertises and promotes athletes and sports competitions and events using the MAXXIS Mark through social media platforms such as Facebook” (*id.* at 24, ¶ 11); and
- (10) “Applicant intends to use Applicant’s Mark in the same manner as the MAXXIS Mark, including for the promotion and sponsorship of athletes and sports competitions and events” (*id.* at 24, ¶ 12).

The exhibits introduced by Mr. Clark include:

- (1) A Maxxis Facebook post, dated August 13, 2016, depicting Applicant’s involved mark on a promotional cup at a racing event (33 TTABVUE 25-26);
- (2) Print advertisements for sporting events, including depictions of the MAXXIS Mark and Applicant’s involved mark, dated between May 2018 and March 2020 (*id.* at 27-34); and
- (3) Maxxis Facebook posts, dated between October 20, 2011 and February 8, 2023, advertising and promoting athletes and sports competitions and events using the MAXXIS Mark (*id.* at 35-103).

Applicant argues that the Board should grant summary judgment on Opposer’s lack of a bona fide intent to use claim because, inter alia, “Mr. Clark’s testimony, combined with Applicant’s documentary evidence of use of Applicant’s Mark and its related house mark in connection with Applicant’s Services demonstrate that Applicant had a bona fide intent to use Applicant’s Mark for Applicant’s Services when it filed the Opposed Application.” 33 TTABVUE 20-21; *see also id.* at 18-20 (summarizing Mr. Clark’s testimony and evidence submitted with Mr. Clark’s declaration).

b) Opposer's Arguments and Evidence

In response, Opposer submits the declaration of its counsel Jacob Rosenbaum, with accompanying exhibits. 36 TTABVUE 15-25. The exhibits introduced by Mr. Rosenbaum include:

- (1) Applicant's amended response to Opposer's Interrogatory No. 7, which interrogatory requested "the date that Applicant's Mark was first used in commerce in connection with each of Applicant's Goods and Services" (*id.* at 18-23);
- (2) Excerpts from the Fed. R. Civ. P. 30(b)(6) discovery deposition of Cheng Shin Rubber USA¹³ (37 TTABVUE 18-25) (filed under seal);¹⁴ and
- (3) Excerpts from Applicant's responses to Opposer's First Set of Interrogatories (Nos. 1-46), dated January 21, 2022 (*id.* at 26-33) (filed under seal).

Opposer argues that the Board should deny Applicant's motion for summary judgment on Opposer's lack of a bona fide intent to use claim because genuine disputes of material fact exist regarding Applicant's bona fide intent to use Applicant's involved mark in connection with the International Class 35 services. 36 TTABVUE 9-12. More specifically, Opposer argues that Applicant's "self-serving declaration and purported documentary evidence ... contradict[s] prior sworn

¹³ As noted *supra* at 15, Cheng Shin Rubber USA is a wholly-owned subsidiary of Applicant. Cheng Shin Rubber USA is the entity responsible for use of Applicant's Mark in the United States. 36 TTABVUE 3 n.1; *see also* 37 TTABVUE 29-30. Mr. Clark testified as the Rule 30(b)(6) witness.

¹⁴ In its reply brief to its motion for summary judgment, Applicant represents that, "[a]fter review of the [Rule 30(b)(6) deposition] transcript, Applicant determined that none of [the] deposition testimony was confidential." 39 TTABVUE 9 n.2. Accordingly, we have quoted from the transcript as needed in this order. At the end of this order, we provide time for Opposer to file a public copy of the deposition testimony on which it relied in response to Applicant's motion for summary judgment.

testimony by the Applicant's Rule 30(b)(6) witness[,]" including deposition testimony whereby Applicant admitted, inter alia, that:

- (1) Applicant "had never promoted the goods or services of any third parties through the sponsorship of an event" (36 TTABVUE 10; *see also* 37 TTABVUE 23, 305:10-19);
- (2) Applicant has never been paid for providing "promotional services" (36 TTABVUE 10; *see also* 37 TTABVUE 22, 301:15-20); and
- (3) Applicant "has no plans to expand beyond its current offerings under Applicant's Mark" (36 TTABVUE 10; *see also* 37 TTABVUE 21, 51:1-5).

c) Applicant's Reply Arguments

In reply, Applicant argues, inter alia, that:

- (1) The evidence of record demonstrates Applicant's bona fide intent to use Applicant's involved mark, including evidence showing that Applicant has already used its involved mark in connection with the identified services in 2016 and 2018 (i.e., before the involved application was filed) (39 TTABVUE 6-8);
- (2) Applicant has used the MAXXIS house mark in connection with the identified services before the filing date of the involved application (*id.* at 8-9); and
- (3) Opposer's mischaracterization of Applicant's deposition testimony does not raise a triable issue of fact (*id.* at 9-11).

2. Determination of Opposer's Lack of a Bona Fide Intent to Use Claim

Trademark Act Section 1(b)(1), 15 U.S.C. § 1051(b)(1), 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

To prevail on summary judgment on Opposer's claim of lack of bona fide intent to use, Applicant must establish that there is no genuine dispute of material fact that it had a bona fide intent to use its mark on the services identified in the application as

of the filing date of its application. *See* 15 U.S.C. §§ 1051(b). Whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on the totality of the circumstances. *See M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2009 (TTAB 2015). An “applicant’s mere statement of subjective intention, without more, would be insufficient to establish applicant’s bona fide intention to use the mark in commerce.” *Lane Ltd. v. Jackson Int’l. Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). Instead, “the focus is on the entirety of the circumstances, as revealed by the evidence of record.” *Lane Ltd.*, 33 USPQ2d at 1356.

Based on the evidence of record, we find that the following facts are not disputed:

- (1) Maxxis is a wholly-owned subsidiary and licensee of Applicant (33 TTABVUE 22, ¶ 1);
- (2) Maxxis promotes and sponsors racing competitions and events that are organized and run by third parties, as well as athletes who compete in racing and motocross sports (*id.* at 23, ¶¶ 5-6; *see also id.* at 37-103 (social media posts depicting the MAXXIS Mark and/or the MAXXIS Mark and Applicant’s Mark together on, inter alia, UTVs in racing events, advertisements for racing events, banners and boards at racing events, and cycling jerseys worn by athletes competing in racing events));
- (3) Maxxis has used the MAXXIS Mark to promote and sponsor racing events, motocross sports, and athletes since before 2016 (*id.* at 23, ¶ 7; *see also id.* at 37-103);
- (4) Maxxis has used Applicant’s Mark in connection with clothing and other promotional materials displayed and distributed at racing competitions and events for motocross sports (*id.* at 23, ¶ 8; *see also id.* at 26)
- (5) Applicant’s involved mark was displayed on a promotional cup at an event called the “Crankworx mountain biking festival,” and a picture of the cup was posted on Facebook with the hashtags “#crankworkx2016 #maxxistires #maxxis #whistler” (*id.* at 23, ¶ 9; *see also id.* at 26); and

- (6) Maxxis has advertised and promoted athletes and sports events in magazines that are directed to various racing communities, as well as on social media, and certain of the advertisements have featured the MAXXIS mark and Applicant's involved mark in the same advertisement (*id.* at 23-24, ¶¶ 10-11; *see also id.* at 29, 30, 33, and 47).

After reviewing the evidence and arguments submitted by the parties on summary judgment, we find that Applicant's testimony and documentary evidence establish that no genuine dispute of material fact exists and that, as a matter of law, Applicant had the requisite bona fide intention to use its involved mark in commerce in connection with the identified International Class 35 services as of the application filing date. While Opposer identifies certain discovery responses and deposition testimony that it contends raise genuine disputes of material fact (36 TTABVUE 9-12), we find that none of the evidence identified by Opposer raises a genuine dispute regarding Applicant's bona fide intent to use the involved mark in commerce. *See Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1664 (TTAB 2009) (mere conclusory allegations or speculation in response brief are not enough to survive summary judgment, to raise a genuine issue a party must offer some evidence of record regarding applicant's bona fide intent).

First, Applicant's use of Applicant's involved mark (in conjunction with the MAXXIS house mark) on a promotional cup at a racing event before the application filing date supports that Applicant had a bona fide intent to use Applicant's involved mark in connection with the International Class 35 services. While it is true that, "[t]o be a service, an activity must be primarily for the benefit of someone other than the applicant" (i.e., for others) (*see* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1301.01(a)(ii) (July 2022)), "an activity that goes above and beyond what is

normally expected of a manufacturer in the relevant industry may be a registrable service, even if it also serves to promote the applicant's primary product or service." See TMEP § 1301.01(b)(i); see also *In re U.S. Tobacco Co.*, 1 USPQ2d 1502 (TTAB 1986) (tobacco company's participating in auto race held to constitute an entertainment service, because participating in an auto race is not an activity that a seller of tobacco normally does); *In re Heavenly Creations, Inc.*, 168 USPQ 317 (TTAB 1971) (applicant's free hairstyling instructional parties found to be a service separate from the applicant's sale of wigs, because it goes beyond what a seller of wigs would normally do in promoting its goods); *Ex parte Handmacher-Vogel, Inc.*, 98 USPQ 413 (Comm'r Pats. 1953) (clothing manufacturer's conducting women's golf tournaments held to be a service, because it is not an activity normally expected in promoting the sale of women's clothing). Here, producing and giving away promotional cups at the Crankworkx mountain biking festival and promoting the same on social media went above and beyond what would normally be expected of a tire manufacturer by promoting the racing event for the racing event's benefit.¹⁵

Second, Applicant has produced evidence establishing that it has used the MAXXIS house mark and Applicant's involved mark together, and repeatedly used the MAXXIS house mark in connection with the sponsorship of sporting events (e.g., racing competitions) before the filing date of the involved application, both of which

¹⁵ We note that Opposer's arguments that Applicant has made only "de minimus use" of Applicant's involved mark (36 TTABVUE 11) are inapplicable in that prior use of a mark is not required for an application based on an allegation of a bona fide intention to use a mark. See 15 U.S.C. § 1051(b).

support that Applicant had a bona fide intent to use Applicant's involved mark with the identified International Class 35 services. *See Lane Ltd.*, 33 USPQ2d at 1356 ("Applicant's claim of bona fide intention to use its mark in commerce is also corroborated, in the circumstances of this case, by applicant's evidence regarding its predecessor's activities[.]").

Third, we find that the deposition testimony of Mr. Clark identified by Opposer (36 TTABVUE 9-11) does not raise a genuine dispute of material fact. To the extent Opposer argues that Mr. Clark's testimony suggests that Applicant has not promoted the goods or services of any third parties through the sponsorship of an event (36 TTABVUE 9-10), the documentary evidence of record establishes that Applicant has promoted or sponsored sporting events and competitions run by third parties.¹⁶ *See, e.g.*, 33 TTABVUE 30, 40, 42-43, 51, 56, 92, and 100. Furthermore, to the extent that Mr. Clark testified that Applicant has not been paid for providing promotional services, receipt of payment for the rendering of services is not a prerequisite to obtain a registration in connection with such services. *See Capital Speakers, Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1035 fn. 3 (TTAB 1996) (holding that the mere provision of services is sufficient for registration and that a for-profit sale is not required).

¹⁶ Although Mr. Clark testified that he is not aware of Applicant having "ever promoted goods or services of any third parties through the sponsorship of an event" (39 TTABVUE 19, 305:10-14), he subsequently testified that Applicant has "promot[ed] a sponsored athlete or event that has other sponsors" (*id.* at 19-20, 305:16-306:21).

In sum, because the evidence of record establishes that there is no genuine dispute of material fact that Applicant had the requisite bona fide intent to use the involved mark in connection with the International Class 35 services as of the application filing date, Applicant's motion for summary judgment is **granted** on Opposer's lack of a bona fide intent to use claim.

IV. Summary

Applicant's motion for leave to file an amended answer is **granted**. Applicant's concurrently filed amended answer (31 TTABVUE 9-18) is accepted as Applicant's operative responsive pleading.

Applicant's motion for summary judgment is **denied, in part**, with respect to Opposer's likelihood of confusion and dilution claims, and **granted, in part**, with respect to Opposer's claim for lack of a bona fide intent to use. Accordingly, the lack of bona fide intent to use claim is **dismissed with prejudice**.

In view of Applicant's representation that Mr. Clark's deposition testimony is not confidential (39 TTABVUE 9 n.2), and so that Mr. Clark's deposition testimony is part of the public record, Opposer is allowed until **twenty days** from the date of this order to file a public copy of Exhibit B to Opposer's response to Applicant's motion for summary judgment. *See* 36 TTABVUE 24; 37 TTABVUE 18-25.¹⁷

¹⁷ Exhibit C to Opposer's response to Applicant's motion for summary judgment is also filed under seal (36 TTABVUE 25; 37 TTABVUE 26-33), and will remain under seal. Opposer need only refile Exhibit B to its response to Applicant's motion for summary judgment.

V. Accelerated Case Resolution

Because the parties are well acquainted with the relevant facts and legal issues concerning Opposer's claims of likelihood of confusion and dilution, the parties are strongly encouraged to stipulate to resolution of this proceeding by means of the Board's Accelerated Case Resolution ("ACR") procedure, perhaps on the current record with supplementation by the parties.¹⁸

The parties are encouraged to jointly contact the assigned Interlocutory Attorney to discuss the possibility of ACR, any desire to supplement the record, and an agreed schedule for proceeding under ACR. The Board's ACR procedures can be tailored to the parties' needs, positions, and schedules. In the event that the parties agree to ACR using their summary judgment briefs and evidence, along with any supplementation they may agree would be appropriate, they will need to stipulate that the Board may resolve any genuine disputes of material fact that the Board may find to exist. *See* TBMP §§ 528.05(a)(2), 702.04 and 705.

VI. Proceedings Resumed

Proceedings are **resumed**. Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	11/14/2023
Plaintiff's 30-day Trial Period Ends	12/29/2023
Defendant's Pretrial Disclosures Due	1/13/2024
Defendant's 30-day Trial Period Ends	2/27/2024

¹⁸ Absent an agreement to proceed under ACR, the parties should note that the evidence submitted in connection with the motion for summary judgment and in opposition thereto is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981).

Plaintiff's Rebuttal Disclosures Due	3/13/2024
Plaintiff's 15-day Rebuttal Period Ends	4/12/2024
Plaintiff's Opening Brief Due	6/11/2024
Defendant's Brief Due	7/11/2024
Plaintiff's Reply Brief Due	7/26/2024
Request for Oral Hearing (optional) Due	8/5/2024

Important Trial and Briefing Instructions

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).