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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
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WINTER

September 14, 2023

Opposition No. 91274047 (parent)  
Opposition No. 91276608

*BYLT Performance LLC*

*v.*

*BYLT, LLC*

Before Zervas, Taylor, and Wolfson,  
Administrative Trademark Judges.

By the Board:

BYLT Performance LLC (“Applicant”) seeks registration of the marks BYLT BASICS<sup>1</sup> and BYLT PREMIUM BASICS<sup>2</sup> in standard characters, each for “hoodies, jackets, pants, shirts, briefs as underwear, jogging pants, men’s underwear, short-sleeve shirts, underwear; all of the foregoing excluding motorcycle related clothing and apparel.” The applications for these marks are the subject of Opposition No. 91274047, the parent case in these proceedings.

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<sup>1</sup> Application Serial No. 88820523, filed March 4, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and alleging January 26, 2017, as the date of first use and date of first use in commerce. The term “BASICS” is disclaimed.

<sup>2</sup> Application Serial No. 88822256, filed March 5, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and alleging January 26, 2017, as the date of first use and date of first use in commerce. The term “PREMIUM BASICS” is disclaimed.

Applicant also seeks registration of the marks BYLT in standard characters for “footwear,”<sup>3</sup> and BYLT PREMIUM BASICS (stylized),<sup>4</sup> shown below, for “clothing, namely, hoodies, pullovers, jackets, sweatshirts, jogging pants, sweat pants, pants, shorts, active shorts, casual shorts, shirts, active shirts, casual shirts, henleys, tanks, short-sleeve shirts, long-sleeve shirts, polos, dress shirts, button down shirts, briefs as underwear, trunks as underwear, men’s underwear, underwear, hats, beanies, shoes, men’s shoes, socks, women’s shirts, women’s tanks, women’s leggings, leggings, women’s jogging pants, women’s crop tops, women’s body suits.”



The applications for these two marks are the subject of Opposition No. 91276608.

In both proceedings, BYLT Performance LLC (“Opposer”) opposes registration of the applied-for marks on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and in support thereof, alleges, in part, ownership

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<sup>3</sup> Application Serial No. 90758298, filed June 7, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and alleging March 8, 2021, as the date of first use and date of first use in commerce.

<sup>4</sup> Application Serial No. 90758753, filed June 7, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and alleging October 1, 2016, as the date of first use and date of first use in commerce. The mark is described as “a stylized BYLT spaced out and with broken lines in the letters B Y and L and the words PREMIUM BASICS set horizontally below the word BYLT.” The term “PREMIUM BASICS” is disclaimed.

of eight trademark registrations for the marks B.Y.L.T.,<sup>5</sup> B.Y.L.T.20,<sup>6</sup> B.Y.L.T BEYOND YOUR LIMIT TRAINING (& Design),<sup>7</sup> B.Y.L.T 20 BEYOND YOUR LIMIT TRAINING (& Design),<sup>8</sup> and BEYOND YOUR LIMIT TRAINING,<sup>9</sup> for “t-shirts, tank

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<sup>5</sup> U.S. Reg. No. 4810314, issued September 8, 2015, for the mark B.Y.L.T. in standard characters for “dietary and nutritional supplements,” claiming September 2014 as its date of first use and first use in commerce, Sections 8 & 15 Affidavits accepted and acknowledged March 11, 2021;


U.S. Reg. No. 5110265, issued December 27, 2016, for the mark B.Y.L.T. in standard characters for “sports drinks,” claiming September 30, 2016 as its date of first use and first use in commerce, Sections 8 & 15 Affidavits accepted and acknowledged February 16, 2023.

U.S. Reg. No. 6337958, issued May 4, 2021, for the mark B.Y.L.T. in standard characters for “On-line retail store services featuring clothing and sports drinks,” claiming September 18, 2018, as its date of first use and first use in commerce.

U.S. Reg. No. 6548069, issued November 2, 2021, for the mark B.Y.L.T. in standard characters for “T-shirts; Tank tops, sports bras,” and claiming September 18, 2015 as its date of first use and first use in commerce.

<sup>6</sup> U.S. Reg. No. 6464474, issued August 24, 2021, for the mark B.Y.L.T.20 in standard characters for “Bottled artesian water; Bottled drinking water; Bottled water; Drinking water with vitamins; Drinking waters; Flavored bottled water; Flavored enhanced water; Still water; Water beverages,” claiming January 14, 2021 as its date of first use and first use in commerce.

<sup>7</sup> U.S. Reg. No. 6489014, issued September 21, 2021, for the mark  for “Sports drinks,” claiming September 20, 2018, as its date of first use and first use in commerce; color is not claimed as a feature of the mark; the term “TRAINING” is disclaimed.

<sup>8</sup> U.S. Reg. No. 6323563, issued April 13, 2021, for the mark  for “Bottled artesian water; Bottled drinking water; Bottled water; Drinking water with vitamins; Drinking waters; Flavored bottled water; Flavored enhanced water; Still water; Water beverages,” claiming January 15, 2021 as its date of first use and first use in commerce. The mark consists of the stylized wording “B.Y.L.T”, with the letters in black outlined in blue and then another outer border in black, and the periods between the words consisting of a blue square outlined in black with another outer black border. Next to the “T” in “B.Y.L.T” is the stylized lettering “20” in black with a blue border, with the “2” lower than the “O”. Below the wording “B.Y.L.T” is the wording “BEYOND YOUR LIMIT TRAINING” in stylized black lettering. The color white represents the background and transparent areas and is not claimed as a feature of the mark. The colors black and blue are claimed as a feature of the mark. The term “TRAINING” is disclaimed.

<sup>9</sup> U.S. Reg. No. 6336233, issued April 27, 2021, for the mark BEYOND YOUR LIMIT TRAINING in standard characters, for “Dietary and nutritional supplements,” claiming

tops, sports bras,” sports drinks, a variety of bottled drinking water and water beverages, and on-line retail stores services featuring clothing and sports drinks. Opposer also alleges ownership of a pending application for the mark B.Y.L.T. BOOST “dietary and nutritional supplements” and “sports drinks.”<sup>10</sup>

Applicant denies the salient allegations in the Notice of Opposition and pleads, inter alia, the affirmative defense of “estoppel.”<sup>11</sup> In view of the arguments set forth in Applicant’s motion for partial summary judgment and Opposer’s response thereto, in the interest of judicial economy, we construe Applicant’s defense as contractual estoppel and consider the Answer to be amended as such.<sup>12</sup> *Cf. NPG Records, LLC v.*

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September 18, 2015, as its date of first use and first use in commerce; for “Sports drinks; Bottled artesian water; bottled drinking water; bottled water; drinking water with vitamins; drinking waters; flavored bottled water; flavored enhanced water; still water; water beverages; functional beverages, namely, sports drinks,” claiming September 20, 2018 as its date of first use and first use in commerce; and for “On-line retail store services featuring clothing and sports drinks,” claiming September 18, 2018, as its date of first use and first use in commerce. The term “TRAINING” is disclaimed.

<sup>10</sup> Application Serial No. 90758023, filed October 28, 2021, for the mark B.Y.L.T. BOOST in standard characters, for “Dietary and nutritional supplements” and “Sports drinks,” under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (intent to use). The term “BOOST” is disclaimed.

<sup>11</sup> 12 TTABVUE 5. The foregoing citation and all other TTABVUE citations in this order relate to the file history of Opp. No. 91274047, unless otherwise indicated.

Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board’s electronic docketing system. To allow the Board and readers to easily locate materials in the record, the parties should cite to facts or evidence in the proceeding record by referencing the TTABVUE entry and page number, e.g., “1 TTABVUE 2,” and not attach previously-filed evidence to their briefs. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 801.01 and 801.03 (2023). All material filed under seal must be accompanied by a redacted version for public viewing. Trademark Rule 2.126(c). For material or testimony that has been designated confidential, cite the TTABVUE docket entry number and page for the redacted version.

<sup>12</sup> We note that Opposer has not objected to Applicant’s ambiguous pleading of its affirmative defense; nor has Opposer argued that contractual estoppel is unpleaded.

*JHO Intellectual Prop. Holdings, LLC*, 2022 USPQ2d 770, at \*13 n.28 (TTAB 2022) (pleadings deemed amended where nonmoving party did not object to motion on improperly pleaded claim and treated motion on its merits); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997).; TBMP § 528.07(b).

These cases now come up for consideration of Applicant's fully briefed motion (filed June 9, 2023) for partial summary judgment<sup>13</sup> on its affirmative defense of contractual estoppel<sup>14</sup> in connection with the applications involved in Opposition No. 91274047.<sup>15</sup>

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<sup>13</sup> 15 TTABVUE.

<sup>14</sup> Applicant mistakenly refers to "judicial estoppel" several times in its motion, rather than "contractual estoppel." Judicial estoppel is "a doctrine most often applied to estop a party who has made oath to a statement of fact in a prior judicial proceeding from denying that statement of fact in a later proceeding." *Am. Hygienic Lab., Inc. v. Tiffany & Co.*, 228 USPQ 855, 858 (TTAB 1986); *see also Bos. Chicken Inc. v. Bos. Pizza Int'l Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999) ("The Court of Appeals for the Federal Circuit views judicial estoppel as an equitable principle that holds a party to a position on which it prevailed, as against later litigation arising from the same facts.") (citing *Data Gen. Corp. v. GSA*, 78 F.3d 1556 (Fed. Cir. 1996)). Given that Applicant primarily argues contractual estoppel as the basis for its motion, we construe Applicant's reference to judicial estoppel is an inadvertent error.

<sup>15</sup> Applicant's motion, as well as the parties' Settlement Agreement, discussed by both parties in connection with Applicant's motion, are specifically directed to application Serial Nos. 88820523 and 88822256, which are the involved applications in the parent proceeding. Additionally, Applicant's motion was filed in Opp. No. 91274047 before the Board consolidated these proceedings. In view of the foregoing, this order only addresses the two applications involved in the parent proceeding. In any event, given the narrow scope of the parties' agreement, any submission by Applicant of a motion for summary judgment based on contractual estoppel with respect to the applications involved in Opp. No. 91276608 would be futile because those applications are not referenced in the parties' Settlement Agreement. 15 TTABVUE 21.

We have considered the parties' briefs and evidence, but address the record on summary judgment only to the extent necessary to support our analysis and findings, and do not repeat or address all of the parties' arguments or evidence. *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at \*1 (TTAB 2022) (citing *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015)). For purposes of this order, we presume the parties' familiarity with the pleadings, and the arguments and evidence submitted in connection with the subject motion.

### **I. Preliminary Matter**

As an alternative to deciding Applicant's motion for summary judgment, on page 9 of Opposer's response to Applicant's motion,<sup>16</sup> citing to Fed. R. Civ. P. 56(d), Opposer asserts that it needs "additional discovery [regarding instances of actual confusion of which Applicant may be aware] in order to present essential facts to justify its opposition to Applicant's Motion for Summary Judgment."<sup>17</sup> In support of its putative motion under Rule 56(d), Opposer submitted copies of its Notice of Taking Deposition of Eric Mear, First Set of Requests for Admissions, First Set of Interrogatories, and First Set of Requests for Production,<sup>18</sup> all of which Opposer served on Applicant prior

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<sup>16</sup> Specifically, Opposer requests, in the alternative, that the Board "should lift the suspension in the instant case and order Applicant to answer the outstanding Discovery (defined below) and to defer decision making on the instant Motion for Summary Judgment." 19 TTABVUE 3.

<sup>17</sup> *Id.* at 9-10.

<sup>18</sup> *Id.* at 12-61.

to the filing of the motion for summary judgment and to which Applicant has not responded “due to pendency of Opposer’s Motion to Consolidate.”<sup>19</sup>

To the extent Opposer seeks additional discovery under Fed. R. Civ. P. 56(d), the Board previously advised Opposer that such a motion is not available in this instance.<sup>20</sup> Specifically, Opposer did not file its response to Applicant’s motion for summary judgment within thirty days of the service of the motion for summary judgment, but instead filed its response on July 24, 2023, in accordance with the extension of time granted by the Board. The time for filing a motion under Rule 56(d) will not be extended or reopened. *See* Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1). Furthermore, when a party files a combined response on the merits of a motion for summary judgment and a request for Fed. R. Civ. P. 56(d) discovery, as occurred here, the Board ordinarily will deem the Fed. R. Civ. P. 56(d) discovery request moot, and decide the summary judgment motion on the merits thereof. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930 (TTAB 2015) (Fed. R. Civ. P. 56(d) motion denied as moot because party filed substantive response to summary judgment motion); *Ava Ruha Corp. v. Mother’s Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015).

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<sup>19</sup> 19 TTABVUE 10. The discovery period in Opp. No. 91274047 closed the day after Opposer’s discovery was served. We note that the Board addressed Opposer’s pending discovery in its July 21, 2023 order granting both Opposer’s motions to consolidate the proceedings and to extend its time to respond to the motion for summary judgment. 18 TTABVUE 4-5, 8. In particular, the Board deemed the discovery requests and notices of deposition served by Opposer in the parent proceeding to be deemed withdrawn. 18 TTABVUE 9.

<sup>20</sup> *Id.* at 6, footnote 24.

Accordingly, because Opposer's putative motion for discovery under Rule 56(d) was both late and filed in combination with its response to Applicant's motion, Opposer's motion under Rule 56(d) is **DENIED** as both untimely and moot.<sup>21</sup>

## II. 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 with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show*

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<sup>21</sup> It was also improper for Opposer to embed its motion in its response to Applicant's motion for summary judgment. A request for Fed. R. Civ. P. 56(d) discovery should be clearly made, not buried in a responsive brief or other paper, and not be filed as a "throw away" alternative accompanying a response to the motion for summary judgment on the merits. TBMP § 528.06.

Moreover, even if Opposer's motion had been timely, Opposer did not comply with the requirement under Fed. R. Civ. P. 56(d) to support its motion by affidavit or declaration and explain why those facts would preclude summary judgment. *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) ("The Rule requires that each request for discovery be adequately supported by a showing of need."). Failure to comply with the requirements of Rule 56(d) is a proper ground for denying discovery and proceeding to summary judgment. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) ("A party may not simply assert in its brief that discovery was necessary and thereby overturn summary judgment when it failed to comply with the requirement of Rule 56[d] to set out reasons for the need for discovery in an affidavit." (citations omitted)).



*Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The burden of demonstrating the absence of a genuine dispute on summary judgment is greater than the evidentiary burden at trial, which is a preponderance of the evidence, and which permits appropriate inferences to be drawn from the evidence of record. *See, e.g., Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, 60 F.3d 770, 34 USPQ2d 1822, 1824 (Fed. Cir. 1995) (moving party must establish no genuine dispute of material fact as to each element of claim or defense for which summary judgment is sought).

Further, the evidence of record must be viewed in the light most favorable to the non-moving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the proceeding. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542; *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) (“If there is a real dispute about a material fact or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial.”).

## **B. Parties' Arguments and Evidence**

Applicant argues it is entitled to summary judgment on Opposer's likelihood of confusion claim under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because there

is no genuine dispute that the parties entered into an agreement that prohibits Opposer from opposing the trademark applications involved in Opposition No. 91274047. Specifically, Applicant explains by way of background that to resolve a prior trademark infringement action between the parties in the United States District Court for the Central District of California, Case No. 8:18-cv-02194 (JVS-KES), the parties entered into a Settlement Agreement, which explicitly states that so long as Applicant abandoned its earlier-filed trademark application Serial No. 87912445, Opposer would not oppose Applicant's other pending applications for BYLT BASICS and BYLT PREMIUM BASICS.<sup>22</sup>

In support of its motion, Applicant submitted the declaration of its CEO and founder, Eric Mear,<sup>23</sup> to which a copy of the parties' Settlement Agreement is attached.<sup>24</sup> Applicant points out, in particular, Section 2 of the parties' agreement, which states as follows (emphasis added):

**2. Express Abandonment of Trademark Application Without Prejudice.**

Upon the execution of this Agreement by the Parties, Plaintiff [BYLT, LLC] agrees to file an express abandonment with the Patent and Trademark Office of its pending trademark application serial number 87912445 for the mark BYLT without prejudice to refile the application in the future if the restrictions imposed by this Agreement are extinguished. Plaintiff has filed new trademark applications for the marks BYLT BASICS and BYLT PREMIUM BASICS in class 25

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<sup>22</sup> We note the civil action was dismissed upon settlement of the case on December 17, 2019. See Docket Report of Case No. 8:18-cv-02194 (JVS-KES), retrieved and printed from [https://ecf.cacd.uscourts.gov/cgi-bin/DktRpt.pl?904500862919887-L\\_1\\_0-1](https://ecf.cacd.uscourts.gov/cgi-bin/DktRpt.pl?904500862919887-L_1_0-1), which was accessed 11/30/22. Exh. 6 to the declaration of Applicant's counsel, Aaron L. Renfro ("Renfro dec." or "Renfro declaration") and Renfro dec. ¶ 6, 15 TTABVUE 30, 84.

<sup>23</sup> *Id.* at 17.

<sup>24</sup> *Id.* at 20-21.

covering the same clothing items set forth in the application for BYLT. **Provided Plaintiff has filed the express abandonment of its trademark application for the mark BYLT required herein in paragraph 2, Defendant [BYLT Performance LLC] agrees not to oppose, challenge, contest, or otherwise interfere with the applications for BYLT BASICS or BYLT PREMIUM BASICS** and to assist Plaintiff in obtaining a consent agreement or other documents (if necessary) as part of the applications to obtain registrations for the BYLT BASICS or BYLT PREMIUM BASICS marks and to otherwise assist as necessary in the registration of the new applications so that the trademark applications are deemed acceptable to the trademark examiner.<sup>25</sup>

Applicant points out that the parties agreed that the “Agreement constitutes the entire and final agreement between the Parties with respect to the subject matter hereof,” and “[t]he Agreement shall be binding upon ... the Parties.”<sup>26</sup> Applicant also asserts there are no terms in the agreement allowing either party to rescind, void or cancel the agreement on the grounds that there is actual confusion, or for any other reason.

In addition to submitting the parties’ Settlement Agreement, Applicant also attached to its motion the Renfro declaration, to which is attached, inter alia, a copy of Opposer’s responses to Applicant’s first set of requests for admission.<sup>27</sup> In response to Admission Request No. 2, Opposer admits that the parties’ agreement is valid.<sup>28</sup>

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<sup>25</sup> 15 TTABVUE 129-30. A fully executed copy of the parties’ Settlement Agreement was submitted by Applicant with its motion. *Id.* at 189, 201. The Agreement is attached to the declaration of Joey Firestone (“Firestone declaration”), Opposer’s managing member, which Opposer submitted previously to the Board in response to Applicant’s motion to dismiss. 8 TTABVUE 16-23.

<sup>26</sup> See Settlement Agreement ¶ 9, 15 TTABVUE 132.

<sup>27</sup> See Renfro dec. ¶ 18, 15 TTABVUE 29, 138.

<sup>28</sup> *Id.* at 139.

In opposition to Applicant's motion for summary judgment, Opposer contends that the parties' agreement is essentially a coexistence agreement, which is unenforceable because numerous instances of actual confusion have occurred since the agreement was executed. Further, Opposer alleges that Applicant has not complied with packaging requirements set forth in parties' agreement. In view thereof, Opposer argues that the Board should not enforce the agreement as a matter of public policy because the agreement is not accomplishing what it was intended to do. In particular, Opposer asserts that the Board should declare the agreement "rescinded, voided, or cancelled."<sup>29</sup>

In support of its opposition, Opposer refers the Board, in part, to paragraph 6 of the Firestone declaration submitted with Opposer's response to Applicant's motion to dismiss.<sup>30</sup> Opposer asserts, because "Applicant does not address these instances of actual confusion in its Motion for Summary Judgment or the attached declarations ... there exists disputes of material fact or at least additional facts that should be considered, requiring that Applicant's Motion for Summary Judgment be denied."<sup>31</sup>

### **C. Analysis and Order**

The equitable doctrine of contractual estoppel applies in Board proceedings where one party has agreed not to challenge registration of another's mark. *See Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974) (affirming

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<sup>29</sup> 19 TTABVUE 4.

<sup>30</sup> *See* 8 TTABVUE 11-14 or 15 TTABVUE 189-192.

<sup>31</sup> 19 TTABVUE 3.

grant of summary judgment dismissing the opposition because the terms of the parties' settlement agreement barred opposer from challenging applicant's registration of its mark); *Ron Cauldwell Jewelry Inc. v. Clothestime Clothes Inc.*, 63 USPQ2d 2009, 2013 (TTAB 2002) (Board ruling on summary judgment that the parties' agreement prevented opposer from objecting to registration of applicant's mark); *see also M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (considering whether opposer was contractually estopped from opposing registration of applicant's mark).

"Settlement agreements are a type of contract and are therefore governed by contract law." *Novamedix, Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613, 1615 (Fed. Cir. 1999) (citing *Bamerilease Capital Corp. v. Nearburg*, 958 F.2d 150, 152 (6th Cir.1992) (internal citation omitted)). While it does not lie within the jurisdiction of the Board to enforce a contract between parties, *Vaughn Russell Candy Co. v. Cookies in Bloom, Inc.*, 47 USPQ2d 1635, 1638 n.6 (TTAB 1998), whether Opposer is contractually barred from opposing registration of Applicant's involved applications clearly falls within the jurisdiction of the Board. *Cf. Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 37 (Fed. Cir. 1985) (Board has jurisdiction to consider whether an agreement between the parties constitutes an independent basis for sustaining the opposition). In particular, the Board may "consider the agreement, its construction or its validity if necessary to decide the issues properly before it ... including the issue of estoppel." *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983). The

construction of an agreement is a question of law, and the meaning and interpretation of a contract may be resolved by the Board on summary judgment. *See Interstate Gen. Gov't Contractors, Inc. v. Stone*, 980 F.2d 1433, 1434 (Fed. Cir. 1992); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co.*, 87 USPQ2d 1526, 1530 (TTAB 2008).

We must first determine which laws should be applied in interpreting the parties' Settlement Agreement. Paragraph 12 of the agreement, i.e., "Governing Law and Jurisdiction," states, "[i]ntentionally left blank."<sup>32</sup> Paragraph 7, entitled "Notice and Cure," provides, in part, that "[t]he terms of this Agreement may be enforced as a contract in any Court having jurisdiction therein without regard to conflict of law principles."<sup>33</sup> Neither party has argued for application of any particular law in interpreting the agreement. *See Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1790 (TTAB 2006).

"In interpreting a contract, 'words and phrases are given their plain meaning. Rather than rewrite an unambiguous agreement, a court should enforce the plain meaning of that agreement.'" *Novamedix Ltd. v. NDM Acquisition Corp.*, 49 USPQ2d at 1616 (internal citation omitted). With those tenets in mind, paragraph 12 indicates that the parties have not chosen any particular substantive law to apply to the agreement. Regarding the meaning of the provision in paragraph 7, i.e., "[t]he terms of this Agreement may be enforced ... without regard to conflict of law principles," according to the Restatement (Second) of Conflicts of Law, "in the absence of a

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<sup>32</sup> 15 TTABVUE 199.

<sup>33</sup> *Id.* at 198.

contrary indication, a contractual choice-of-law clause refers to the substantive law of the chosen jurisdiction and does not include that jurisdiction's conflicts-of-laws principles." *Cf. Chan v. Soc'y Expeditions, Inc.*, 123 F.3d 1287, 1297 (9th Cir. 1997) (citing RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 187(3) & cmt. h (1988)). "Applying the conflicts principles would reintroduce 'the uncertainties of choice of law' and 'defeat the basic objectives, namely those of certainty and predictability, which the choice-of-law provision was designed to achieve.'" *Id.* (citing REST. (2D) CONFL. at § 187(3) cmt. h). In view thereof, we construe the statement "without regard to conflict of law principles" in Section 7 of the agreement to mean that whichever substantive laws are applied, that state's conflicts of law provisions should not be considered. Therefore, we conclude that paragraphs 7 and 12 of the agreement, together, indicate that the parties have not designated any particular state's laws applicable to the agreement, and that no conflicts of law provisions should be applied. *See Duramax Marine*, 80 USPQ2d at 1790 ("In the agreement involved herein, the parties did not include a forum clause directing that the laws of any particular state apply. Neither party has argued for application of any particular law in interpreting the agreement. We apply the law of Louisiana.").

Accordingly, for the following reasons, pursuant to RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 188 (1971) (elec. version May 2023 update), we apply the law of the State of California to the parties' Settlement Agreement.<sup>34</sup> *See Duramax Marine*,

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<sup>34</sup> Even if we were to apply general principles of contract interpretation, rather than those of the State of California, the result of this order would be the same. *See* RESTATEMENT (SECOND) OF CONTRACTS, Section 202(3)(a) (1981) (May 2023 Update) ("Unless a different intention is manifested, ... where language has a generally prevailing meaning, it is

80 USPQ2d at 1790. Specifically, the agreement facilitated the dismissal without prejudice of a civil action between the parties in the United States District Court for the Central District of California, *see* REST. (2D) CONFL. § 188(2)(a) (place of contracting); Applicant is located in California, *see* REST. (2D) CONFL. § 188(2)(e) (place of business of the parties); and the parties expressly waived and relinquished any rights which they may have had, or which may be conferred upon either party, by the provisions of California Civil Code Section 1542 (“as well as under any other state or federal statute or common law principle of similar effect ...”).<sup>35</sup> *Cf.* RESTATEMENT (SECOND) OF CONFLICTS OF LAW § 187 cmt. a (1971) (elec. version May 2023 update) (“The rule of this Section is applicable only in situations where it is established to the satisfaction of the forum that the parties have chosen the state of the applicable law. ... But even when the contract does not refer to any state, the forum may nevertheless be able to conclude from its provisions that the parties did wish to have the law of a particular state applied. So the fact that the contract contains legal expressions, or makes reference to legal doctrines, that are peculiar to the local law of a particular state may provide persuasive evidence that the parties wished to have this law applied.”).

Here, under paragraph 16 of the agreement, the parties waived any rights under California Civil Code Section 1542, which strongly suggests that, notwithstanding

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interpreted in accordance with that meaning.”); *see also id.* at Section 202(3)(a) cmt. b (1981) (“When the parties have adopted a writing as a final expression of their agreement, interpretation is directed to the meaning of that writing in the light of the circumstances.”).

<sup>35</sup> 15 TTABVUE 26.



the absence of a forum clause, they anticipated that the law of California would govern the Settlement Agreement. *See Duramax Marine*, 80 USPQ2d at 1790. Accordingly, we turn to relevant California law on contract interpretation.<sup>36</sup>

Under California law, the intent of the parties determines the meaning of the contract. *United Commercial Ins. Serv., Inc. v. Paymaster Corp.*, 962 F.2d at 856 (citing Cal.Civ.Code §§ 1636, 1638). However, “[t]he relevant intent is ‘objective’—that is, the intent manifested in the agreement and by surrounding conduct—rather than the subjective beliefs of the parties.” *Id.* (citing in part, *Lawyer’s Title Ins. Co. v. U.S. Fidelity & Guar. Co.*, 122 F.R.D. 567, 569 (N.D.Cal. 1988)). “[W]here contract language is clear and explicit and does not lead to absurd results, we ascertain intent from the written terms and go no further.” *Breathe So. Cal. v. Am. Lung Ass’n*, 88 Cal.App.5thSupp. 1172, 1181, 305 Cal.Rptr.3d 522, 529 (2023) (citing *People ex rel. Lockyer v. R.J. Reynolds Tobacco Co.*, 107 Cal.App.4th 516, 524, 132 Cal.Rptr.2d 151 (2003)) (internal quotation marks deleted); *see also Progeny Ventures, Inc. v. W. Union Fin. Serv., Inc.*, 752 F.Supp.2d 1127, 1132 (D.C.D. Cal. 2010) (“The fundamental goal of contract interpretation is to give effect to the mutual intention of the parties, which is to be inferred, if possible solely from the written terms of the contract.”) (internal citations omitted). If the contractual language is clear and explicit, such language governs. *Id.* (citing *County of San Diego v. Ace Property & Casualty Ins. Co.*, 37 Cal.4th 406, 415, 33 Cal.Rptr.3d 583, 118 P.3d 607 (2005)). Further, the words of a

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<sup>36</sup> A settlement agreement is treated as any other contract for purposes of interpretation. *United Commercial Ins. Serv., Inc. v. Paymaster Corp.*, 962 F.2d 853, 856 (9th Cir. 1992) (citing *Adams v. Johns–Manville Corp.*, 876 F.2d 702, 704 (9th Cir.1989)).

contract are to be understood in their ordinary and popular sense. West's Ann.Cal.Civ.Code § 1644;<sup>37</sup> *see also Founding Members of the Newport Beach Country Club v. Newport Beach Country Club, Inc.*, 109 Cal.App.4th 944, 955, 135 Cal.Rptr.2d 505 (2003) (intent evidenced by the words of the contract).

The foregoing corresponds to Board practice wherein the interpretation of an agreement must be based, not on the subjective intention of the parties, but on the objective words of their agreement. *See Novamedix*, 49 USPQ2d at 1616; *see also Duramax Marine*, 80 USPQ2d at 1790 (an agreement must therefore “be discerned within its four corners, and not by reference to what might satisfy the purposes of one of the parties.”) (citing *United States v. Armour & Co.*, 402 U.S. 673, 681-82 (1971)).

We turn next to the Settlement Agreement to determine whether Opposer is contractually estopped from opposing the two applications that are the subject of Opposition No. 91274047. There is no genuine dispute that Section 2 of the parties' agreement clearly and unambiguously states that as long as Applicant files the express abandonment of its trademark application Serial No. 87912445 for the mark BYLT, Opposer agrees not to oppose, challenge, contest, or otherwise interfere with Applicant's (as Plaintiff in the civil action) pending applications for BYLT BASICS or BYLT PREMIUM BASICS.<sup>38</sup> Moreover, presuming the abandonment condition is met, Opposer has an obligation to assist Applicant as necessary to obtain registrations for the BYLT BASICS or BYLT PREMIUM BASICS marks by

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<sup>37</sup> Current with Ch. 1 of 2023-24 1st Ex.Sess, and urgency legislation through Ch. 141 of 2023 Reg.Sess. Some statute sections may be more current, see credits for details.

<sup>38</sup> 15 TTABVue 21-22.

“obtaining a consent agreement or other documents (if necessary) ... and to otherwise assist as necessary in the registration of the new applications so that the trademark applications are deemed acceptable to the trademark examiner.”<sup>39</sup> There is also no genuine dispute that there are no other conditions set forth either in Section 2, or in any other section of the agreement,<sup>40</sup> that would allow Opposer to oppose the involved applications, as long as Applicant filed the express abandonment of its trademark application Serial No. 87912445 for the mark BYLT. In view thereof, we conclude there is no genuine dispute as to the material fact that once the precondition of abandonment of application Serial No. 87912445 for the mark BYLT was met, Opposer is contractually estopped from opposing registration of BYLT BASICS and BYLT PREMIUM BASICS in applications Serial Nos. 88820523 and 88822256, which are the subject of Opposition No. 91274047.<sup>41</sup>

Applicant has submitted with the Renfro declaration a true and correct copy of its express abandonment of its application Serial No. 87912445 for the mark BYLT.<sup>42</sup>

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<sup>39</sup> 15 TTABVUE 21-22.

<sup>40</sup> *See, e.g.*, Sections 4, 5 and 6 of the agreement pertaining to use and marketing restrictions, use of the parties’ marks on clothing, and sales reports, respectively. 15 TTABVUE 22-24. These provisions are separate from the requirements set forth in Section 2 and do not impact Opposer’s ability under that section to oppose the applications involved in Opp. No. 91274047.

<sup>41</sup> The Settlement Agreement refers to Applicant’s (as Plaintiff in the civil action) “new trademark applications for the marks BYLT BASICS and BYLT PREMIUM BASICS in class 25 covering the same clothing items set forth in the application for the mark BYLT.” 15 TTABVUE 21. Given that applications Serial Nos. 88820523 and 88822256 were Applicant’s trademark applications pending at the time the agreement was executed, see notes 1-4 *supra*, there is no genuine dispute as to the material fact that the agreement refers only to those two applications.

<sup>42</sup> Renfro dec. ¶ 11 and Exh. 9, 15 TTABVUE 30, 106-108.

Although Applicant did not submit proof that the application was deemed abandoned by the Office,<sup>43</sup> Applicant submitted a copy of Opposer's consent to the abandonment, which was filed with the Board in Opposition No. 91245076 on November 9, 2020.<sup>44</sup> Further, Opposer does not dispute that Applicant withdrew application Serial No. 87912445. In view thereof, we conclude there is no genuine dispute that Applicant expressly abandoned application Serial No. 87912445, as required by the parties' agreement. Accordingly, we find that there is no genuine dispute that Opposer is contractually estopped from opposing registration of the applied-for marks BYLT BASICS and BYLT PREMIUM BASICS that are the subject of Opposition No. 91274047.

Opposer argues that public policy demands that the parties' agreement should not be enforced because its underlying goal of avoiding actual confusion has not been achieved. However, the words of the contract express the parties' objective intent, not the subjective intent of the parties, and it is the parties' objective intent that controls our interpretation of the contract. *See Founding Members*, 109 Cal.App.4th at 955 (it is the objective intent, evidenced by the words of the contract, rather than the subjective intent of the parties that controls interpretation); *see also Duramax Marine*, 80 USPQ2d at 1789 ("The question here, however, is not what public policy

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<sup>43</sup> "It is well settled that the Board does not take judicial notice of USPTO records." *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (Board refused to take judicial notice of petitioner's pleaded and rejected, application for purposes of establishing petitioner standing).

<sup>44</sup> Renfro dec. ¶ 12, 15 TTABVUE 31, 110-112.

promotes but, instead, what do the terms of the involved settlement mean.”).

Furthermore, the parties also agreed, in relevant part, as follows:

**9. Entire Agreement; No Oral Modification**

This Agreement constitutes the entire and final agreement between the Parties with respect to the subject matter hereof. Any prior oral or written or contemporaneous representations or understandings are superseded by and merged into this Agreement. ...<sup>45</sup>

In this instance, the agreement does not set forth any goal related to avoiding likelihood or actual confusion. Specifically, there is no section in the agreement allowing for “rescind[ing], void[ing], or cancel[ing]”<sup>46</sup> the agreement due to actual confusion or other circumstance, as Opposer suggests. Rather, the preamble section of the agreement states, “the Parties desire to consummate said settlement and settle all claims asserted in the [Civil] Action [pending in the United States District Court for the Central District of California, Case No. 8:18-cv-02194 (JVS) entitled BYLT, LLC v. BYLT Performance, LLC].<sup>47</sup> Further, the agreement states that the parties’ settlement conference was conducted before the federal magistrate “in which the Parties reached a settlement agreement; [and] ... an Order of Dismissal Upon Settlement of the Case was entered in the Action on the terms set forth [in the agreement] to avoid further burden and expense of litigation....”<sup>48</sup> In view of these provisions, we find that the intent of the parties was to resolve the identified civil

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<sup>45</sup> 15 TTABVUE 24.

<sup>46</sup> 19 TTABVUE 9.

<sup>47</sup> *Id.* at 20.

<sup>48</sup> 19 TTABVUE 20.

litigation by implementing the terms of the agreement, which includes allowing Applicant (as Plaintiff in the civil action) to move forward with the two applications referenced in Section 2 thereof.<sup>49</sup> *See United Commercial Ins. Serv., Inc. v. Paymaster Corp.*, 962 F.2d at 856 (“[t]he relevant intent is ... the intent manifested in the agreement and by surrounding conduct”). Further, even if Opposer were to discover more instances of actual confusion as between the parties’ respective marks that are the subject of Opposition No. 91274047, those facts (sought by Opposer by its putative Rule 56(d) motion) would not raise a genuine dispute as to any material fact related to Applicant’s contractual estoppel defense. Therefore, Opposer’s assertions and its declarant’s averments regarding the existence of actual confusion do not raise a genuine dispute of material fact that prevents entry of summary judgment on Applicant’s defense of contractual estoppel.

Likewise, with respect to Opposer’s allegations that Applicant failed to comply with labelling requirements set forth in the agreement, the agreement is clear and unambiguous that only one precondition exists to invoke the consequence that Opposer may not oppose the applications identified in the agreement; that is, Applicant’s express withdrawal of application Serial No. 87912445 is the only condition for binding Opposer’s promise not to oppose. In view thereof, Opposer’s allegations regarding Applicant’s failure to meet its labelling obligations under the agreement also do not raise any genuine dispute of material fact as to whether

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<sup>49</sup> 15 TTABVUE 21.

Opposition Nos. 91274047 and 91276608

Opposer is contractually estopped from opposing the applications involved in Opposition No. 91274047.

Accordingly, because there is no genuine dispute that Applicant complied with the terms of Section 2 of the parties' Settlement Agreement, we find that Opposer is contractually estopped from bringing Opposition No. 91274047 and that Applicant is entitled to judgment as a matter of law on Opposer's claim of likelihood of confusion as to the applications opposed in that opposition. *See Danskin, Inc. v. Dan River Inc.*, 182 USPQ at 372 (affirming granting of summary judgment dismissing the opposition due to the terms of the parties' settlement agreement); *cf. Vaughn Russell Candy*, 47 USPQ2d at 1638 (because applicant was expressly prohibited under the terms of the agreement from lawfully using in commerce the mark for which registration was sought, it could not obtain a registration for the mark).

In view thereof, it is **ORDERED** that Opposition Nos. 91274047 and 91276608 are no longer consolidated; and Applicant's motion for summary judgment on its defense of contractual estoppel is **GRANTED**, and Opposer's claim under Trademark Act Section 2(d), in Opposition No. 91274047, in connection with applications Serial Nos. 88820523 and 88822256, is **dismissed with prejudice**.

Opposition No. 91276608 shall proceed on Opposer's claim therein under Trademark Act Section 2(d). Accordingly, **Opposition No. 91276608 is resumed**. Trial dates in Opposition No. 91276608 are reset as shown in the following schedule:<sup>50</sup>

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<sup>50</sup> We note that previously consolidated Opp. No. 91276608 has been suspended since July 21, 2023. *See* 18 TTABVUE 9 in Opp. No. 91274047. Prior to the issuance of that order, the

<b>Expert Disclosures Due</b>	<b>10/14/2023</b>
<b>Discovery Closes</b>	<b>11/13/2023</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>12/28/2023</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>2/11/2024</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>2/26/2024</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>4/11/2024</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>4/26/2024</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>5/26/2024</b>
<b>Plaintiff's Opening Brief Due</b>	<b>7/25/2024</b>
<b>Defendant's Brief Due</b>	<b>8/24/2024</b>
<b>Plaintiff's Reply Brief Due</b>	<b>9/8/2024</b>
<b>Request for Oral Hearing (optional) Due</b>	<b>9/18/2024</b>

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

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discovery period in Opp. No. 91276608 was set to close on September 11, 2023. *See* 9 TTABVUE 4 in Opp. No. 91276608.



Opposition Nos. 91274047 and 91276608

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).