

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

Baxley

Mailed: March 28, 2011

Cancellation No. 92052482

Jeffrey Kaplan

v.

John Brady, Jr.

Before Walters, Bucher, and Ritchie,  
Administrative Trademark Judges

By the Board:

On May 20, 2010, Jeffrey Kaplan ("petitioner") filed a petition to cancel John Brady Jr.'s ("respondent") registration for the mark FUNNY-FACE in typed form for "powder for preparing soft drinks" in International Class 32<sup>1</sup> on the ground of abandonment. Therein, petitioner bases his claim of standing to seek cancellation of respondent's involved registration on his filing an intent-to-use application to register the mark FUNNY FACE FIZZY BLAST! in standard character form for "[s]oft drinks namely, tablets made for effervescent soft drinks."<sup>2</sup> Respondent, in its

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<sup>1</sup> Registration No. 786098, issued March 2, 1965, renewed twice.

<sup>2</sup> Application Serial No. 85042190, filed on May 19, 2010, one day prior to the filing of this petition to cancel. That application was refused registration under Trademark Section 2(d), 15 U.S.C. Section 1052(d), based on likelihood of confusion with the mark in respondent's involved registration and is suspended pending the outcome of this proceeding.

answer, denied the salient allegations of the petition to cancel, but did not assert any affirmative defenses.

On October 5, 2010, the Board issued an order wherein, among other things, it granted respondent's motion to test the sufficiency of petitioner's responses to requests for admission and ordered petitioner to serve amended responses to request for admission nos. 6-14 and 16. On November 4, 2010, petitioner served amended responses to those requests for admission.

This case now comes up for consideration of the following motions: (1) respondent's motion (filed November 8, 2010) for dismissal as a sanction for petitioner's failure to serve appropriate responses to request for admission nos. 6-14 in compliance with the Board's October 5, 2010 order; (2) petitioner's motion (filed November 8, 2010) to strike respondent's motion for dismissal; (3) petitioner's motion (filed November 12, 2010) for summary judgment on the pleaded abandonment claim; and (4) respondent's cross-motion (filed December 13, 2010) for summary judgment on the ground that petitioner lacks standing to maintain this proceeding. The cross-motions for summary judgment have been fully briefed.

As an initial matter, petitioner's motion for summary judgment is not germane to respondent's motion to dismiss and petitioner's motion to strike that motion and,

therefore, the motion for summary judgment should not have been filed while the motion to dismiss and motion to strike are pending. Although the Board did not issue an order suspending this proceeding pending the Board's decision on the motion to dismiss and the motion to strike until November 15, 2010, i.e., three days after petitioner filed the motion for summary judgment, we note that respondent's attorney at the time<sup>3</sup> and petitioner, who is appearing *pro se*, have both appeared in several Board proceedings and are presumed to be familiar with the Board's practice of suspending proceedings pending decisions on potentially dispositive motions. See Trademark Rule 2.127(d). Therefore, petitioner should have expected the Board's imminent issuance of a suspension order pending the Board's decision on respondent's motion to dismiss and petitioner's motion to strike and ceased activity with regard to unrelated motions. Nonetheless, because the parties have fully briefed the cross-motions for summary judgment, the Board will consider them.

We will first consider petitioner's motion to strike respondent's motion to dismiss. In such motion, petitioner essentially argues the merits of the motion to dismiss and objects to the content of the motion to dismiss. The Board

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<sup>3</sup> Respondent's new attorney entered an appearance herein after the motions decided in this order were fully briefed.

will not strike respondent's motion merely because petitioner objects to the content thereof. Rather, petitioner should argue the merits of a motion, instead of seeking to strike that motion. The Board will consider any objections that petitioner has to the contents of respondent's motion for dismissal and will disregard any portions of that brief that it deems improper. See TBMP Section 517 (2d ed. rev. 2004). Based on the foregoing, petitioner's motion to strike respondent's motion to dismiss is denied.<sup>4</sup>

Regarding respondent's motion for dismissal as a sanction under Trademark Rule 2.120(g)(1) for petitioner's failure to comply with the Board's October 5, 2010 order, respondent contends that petitioner's amended responses to request for admission nos. 6-14, that were required in the Board's October 5, 2010 order, are "non-responsive, evasive and dilatory."

In response,<sup>5</sup> petitioner contends that he "has only limited documents to forward to respondent" and that "he has suspended all activities based on his business plan for his FUNNY FACE FIZZY BLAST! [mark] until these proceedings are completed." Petitioner further contends that the Board

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<sup>4</sup> The Board will not entertain any further motions to strike motions, briefs, or portions thereof from petitioner.

<sup>5</sup> Petitioner's arguments in response to the motion for sanctions were incorporated into his motion to strike.

should not enter sanctions against him because respondent served identical or highly similar responses to petitioner's requests for admission.

Fed. R. Civ. P. 36(a)(4) states in relevant part as follows:

If a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter; and when good faith requires that a party qualify an answer or deny only a part of a matter, the answer must specify the part admitted and qualify or deny the rest. **The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.**

(emphasis added).

Regarding petitioner's assertion that the Board should not enter sanctions against him because respondent served similar responses to petitioner's requests for admission, petitioner must respond properly to respondent's requests for admission, irrespective of respondent's responses to his requests for admission. See Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990); TBMP Section 403.03. Further, petitioner will not be heard to complain about the sufficiency of respondent's responses to requests for admission because he did not file a motion to test the sufficiency of those

responses. See *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971); TBMP Section 524.04.

In request for admission nos. 6-8, respondent asks petitioner to admit that, regarding his pleaded FUNNY FACE FIZZY BLAST! mark, he has no documentation regarding the selection, adoption or use of that mark. In request for admission nos. 9-14, respondent asks petitioner to admit that he has no product samples, advertising materials, promotional materials, marketing materials, product tags or labels, or product packaging which bear his pleaded FUNNY FACE FIZZY BLAST! mark.

In response to request for admission nos. 8, 10-12, and 14, petitioner states as follows: "Petitioner has submitted to Respondent a detailed Business Plan relating to his use of the mark FUNNY FACE FIZZY BLAST! for 'Soft drinks, namely, tablets made for effervescent soft drinks', therefore denied." We construe these responses as denying the requests at issue in view of the business plan that petitioner served upon respondent. We infer therefrom that (1) such business plan is the only documentation regarding the use of the FUNNY FACE FIZZY BLAST! mark in his possession; and (2) that such business plan constitutes the only advertising, promotional, or marketing material or product packaging which bears his pleaded FUNNY FACE FIZZY

BLAST! mark in his possession. These responses are acceptable.

In response to request for admission nos. 6, 7, 9, and 13, however, petitioner states in his amended responses as follows: "Petitioner lacks sufficient information to permit him to admit or deny this request; therefore denied." These responses are unacceptable because petitioner has not stated that he has made reasonable inquiry and that the information he knows or can readily obtain is insufficient to enable him to admit or deny. Moreover, because the requests at issue deal solely with whether or not certain documents are in his possession, petitioner cannot credibly assert in response to these requests that he "lacks sufficient information to permit him to admit or deny these requests." Petitioner either possesses the documentation at issue or he does not.

We are convinced that petitioner has deliberately sought to evade and frustrate respondent's attempts to secure discovery and that petitioner's amended responses to request for admission nos. 6, 7, 9, and 13 show a disregard for the Board's October 5, 2010 order. Petitioner's conduct tries our patience and warrants entry of a sanction, albeit one short of the dismissal sought.

In view thereof, respondent's motion for dismissal as a discovery sanction is denied. Nonetheless, in exercising our inherent authority to control the conduct of our

proceedings, we deem petitioner to have admitted request for admission nos. 6, 7, 9, and 13 as a sanction for petitioner's improper amended responses thereto. See *Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991); TBMP Section 527.03.

We turn next to the parties' cross-motions for summary judgment. In his initial motion for summary judgment, petitioner bases his claim of standing on a business plan for intended use of the pleaded FUNNY FACE FIZZY BLAST! mark and the refusal of registration of his pleaded application. By its cross-motion for summary judgment, respondent seeks dismissal of the petition to cancel on the ground that petitioner lacks standing to maintain the petition to cancel. Respondent contends that petitioner is "a frequent TTAB litigant [who, l]ike ... Leo Stoller, ... abuses USPTO rules and TTAB procedures in an effort to bully his adversaries into capitulation so that he may glom onto their legitimate trademark rights." Although petitioner bases his claim of standing on the pleaded application that he filed one day prior to the petition to cancel and the subsequent refusal of registration of the mark therein, respondent contends that the pleaded application and refusal of registration do not automatically confer standing upon petitioner. Rather, respondent contends that he is entitled



to challenge whether or not petitioner had a bona fide intent to use the pleaded FUNNY FACE FIZZY BLAST! mark when he filed his pleaded application. Respondent contends that petitioner has produced no documentation supporting his alleged bona fide intent to use such mark other than a "completely phony" and undated business plan that is merely a "slightly altered version" of a business plan for use of the mark BAKE OFF! on a "cleansing product" that petitioner submitted in Opposition No. 91186285, styled *Pillsbury Co. v. Kaplan*, and that petitioner apparently works from a "boilerplate '[b]usiness [p]lan' that he modifies slightly each time he decides to attack someone else's legitimate trademark rights." Respondent further contends that petitioner revealed his true intentions in commencing this proceeding when he sent respondent's attorney a letter on July 2, 2010 in which petitioner offered to abandon this case in exchange for a payment from respondent of \$35,000 to cover petitioner's "'outlay,'" which respondent rejected out of hand.<sup>6</sup> Based on the foregoing, respondent contends that "there is no question that" petitioner did not have a bona fide intent to use his pleaded mark in commerce when he filed his pleaded intent-to-use application and that this

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<sup>6</sup> Respondent contends that petitioner could not provide any documentation to support his supposed outlay in connection with the FUNNY FACE FIZZY BLAST! mark.

proceeding should be dismissed based on petitioner's lack of standing.

In response, petitioner reiterates his position that his business plan for intended use of the pleaded FUNNY FACE FIZZY BLAST! mark and the refusal of registration of his pleaded application provide him with standing to maintain this proceeding.

Respondent did not plead in his answer an affirmative defense that petitioner lacks standing because he does not have a bona fide intent to use the mark in his pleaded intent-to-use application. See TBMP Section 528.07(a). However, because the parties have fully briefed respondent's cross-motion for summary judgment on the merits, we will consider respondent's answer amended to assert such a defense for purposes of these cross-motions only.<sup>7</sup>

The Board shall grant summary judgment where a movant establishes that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all

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<sup>7</sup> If respondent wishes to rely at trial upon an affirmative defense that petitioner lacks standing to maintain this proceeding because he did not have a bona fide intent to use his pleaded mark when he filed the intent-to-use application to register that mark, he must seek leave to file an amended answer in which he includes such an affirmative defense. See Fed. R. Civ. P. 15(a); TBMP Section 507.02.

evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

A plaintiff can rely on refusal of its application under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on likelihood of confusion with a defendant's involved registration as a means of establishing its standing to bring a proceeding to cancel that registration. See *Continental Grain Co. v. Strongheart Products Inc.*, 9 USPQ2d 1238 (TTAB 1988). However, the fact that petitioner's intent-to-use application was refused registration based on likelihood of confusion with the mark in respondent's pleaded registration does not preclude respondent from challenging petitioner's assertion in that application that he has a bona fide intent to use his pleaded mark in commerce. See *Salacuse v. Ginger Spirits Inc.*, 44 USPQ2d 1415 (TTAB 1997). Because petitioner bears the ultimate

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burden of proof on the standing issue, petitioner may be required to go beyond the mere pendency of his applications and establish his entitlement to file the application upon which his standing claim is based. See *id.*

After reviewing the parties' arguments and evidence, we find that disposition of this proceeding by summary judgment is inappropriate.<sup>8</sup> We find that there is a genuine dispute as to the material fact of whether or not petitioner has a bona fide intent to use the mark in his pleaded intent-to-use application and thus as to whether or not petitioner has standing to maintain this proceeding. In particular, we note that the documentation of record in support of petitioner's asserted intent to use his pleaded FUNNY FACE FIZZY BLAST! mark consists of copies of documents from petitioner's pleaded application file and a business plan that is purportedly intended to raise capital necessary to commence use of the pleaded mark.<sup>9</sup> Said business plan includes many passages that appear to be lifted verbatim from a business plan regarding intended use of the mark BAKE OFF for "disposable wipes impregnated with cleansing compounds for use on hard surfaces, tiles, pot and pans"

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<sup>8</sup> To the extent that petitioner requests that Board strike any of respondent's brief in opposition to the motion for summary judgment and in support of the cross-motion for summary judgment, that request is denied. See *supra*; TBMP Section 517.

<sup>9</sup> The record does not indicate that the business plan has been sent to any prospective investors.

that petitioner submitted in Opposition No. 91186285, styled *Pillsbury Co. v. Kaplan*, and which respondent submitted as an exhibit to the brief in opposition to petitioner's motion for summary judgment and in support of the cross-motion for summary judgment.<sup>10</sup>

In addition, we note that, as exhibits to respondent's reply brief in support of his cross-motion for summary judgment, respondent submitted copies of sixteen intent-to-use applications filed by petitioner, or trusts to which petitioner is a trustee, that were subsequently abandoned for goods ranging from "computer software for the creation of firewalls" (application Serial No. 77362901) to "disposable wipes impregnated with cleansing compounds for use on hard surfaces, tiles, pot[s] and pans" (application Serial No. 77351996) to "lipsticks" (application Serial No. 77077531) to "carbonated beverages" (application Serial Nos. 78621716 and 78621729).<sup>11</sup> We further note the July 2, 2010

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<sup>10</sup> To the extent that petitioner relies upon links to websites in connection with the cross-motions for summary judgment, merely providing a link to a website is insufficient to make information from that website of record. Websites are transitory in nature and subject to change at their owners' discretion. See *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004). However, if a printout of information from a website includes date of publication or date that it was accessed and printed, and its source (e.g., the URL), a party may submit that printout in connection with a motion for summary judgment in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010); TBMP Section 528.05(e).

<sup>11</sup> Regarding whether or not an applicant has a bona fide intent to use a mark in commerce, the Senate Judiciary Committee Report

letter from petitioner to respondent's then-attorney, in which petitioner offered to withdraw the petition to cancel in exchange for \$35,000. Because there is a genuine dispute as to petitioner's standing, we need not reach the question of whether or not there is a genuine dispute as to whether respondent abandoned his involved mark.<sup>12</sup> In view thereof,

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on S. 1883, which ultimately became the Trademark Law Revision Act of 1988 (Public Law 100-667, November 16, 1988), states among other things that:

[C]ircumstances may cast doubt upon the bona fide nature of the intent or even disprove it entirely. For example, the applicant may have filed ... **an excessive number of intent-to-use applications to register marks which ultimately were not actually used,** [or] an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce under the applied-for marks during the pendency of the applications. ... In connection with this bill, 'bona fide' should be read to mean a fair, objective determination of the applicant's intent based on all the circumstances. To avoid abuse of the intent-to-use system, the committee amended the first paragraph of proposed Section 1(b) of the Act to require that applicant's bona fide intention must reflect the good-faith circumstances surrounding the intended use.

An applicant's bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing). ... In addition, an applicant's bona fide intent must reflect an intention to use the mark in the context of the legislation's revised definition of 'use in commerce,' that is, use 'in the ordinary course of trade, ... and not [made] merely to reserve a right in a mark'. This bona fide intention must be present for all the goods or services recited in the application.

Senate Judiciary Comm.Rep. on S. 1883, S.Rep. No. 515, 100th Cong., 2d Sess. 23-25 (1988), reprinted in United States Trademark Association, *The Trademark Law Revision Act of 1988* 175-77 (1989) (emphasis added).

<sup>12</sup> As an exhibit to his combined brief in opposition to petitioner's cross-motion for summary judgment and in support of his cross-motion for summary judgment, respondent submitted a

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petitioner's motion for summary judgment and respondent's cross-motion for summary judgment are both denied.<sup>13</sup>

A review of Board records indicates that, in addition to the above-captioned proceeding, petitioner has commenced nine cancellation proceedings within the last year in which he has set forth abandonment claims and has based his standing in those proceedings on recently- or concurrently-filed intent-to-use applications.<sup>14</sup> Petitioner is advised

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copy of the statement of use in connection with his application Serial No. 77756563 for the mark FUNNY FACE in standard character form for "powder for preparing soft drinks" in International Class 32. USPTO records indicate that, on March 15, 2011, that application matured into Registration No. 3932603.

<sup>13</sup> Each party is advised that he may, upon timely objection by its adversary, be precluded from using as trial evidence documents which were properly sought during discovery, but not produced. See Fed. F. Civ. P. 37(c). In addition, each party is reminded that he has an ongoing duty to supplement his document production, as necessary. See Fed. R. Civ. P. 26(e).

<sup>14</sup> Those proceedings are as follows:

- (1) Cancellation No. 92052412, styled *Kaplan v. Hanson Trading Ltd.*, filed May 4, 2010, involving the HAI KARATE mark;
  - (2) Cancellation No. 92052895 styled *Kaplan v. Schering-Plough Healthcare Products, Inc.*, filed August 15, 2010, involving the DI-GEL mark;
  - (3) Cancellation No. 92052913, styled *Kaplan v. Proctor & Gamble Co.*, filed August 19, 2010, involving the SALVO ME SALVA mark;
  - (4) Cancellation No. 92052991, styled *Kaplan v. Johnson & Johnson*, filed September 1, 2010, involving the PACQUIN and PACQUIN SKIN CREAM WITH ALOE marks;
  - (5) Cancellation No. 92052998, styled *Kaplan v. Proctor & Gamble Company*, filed September 1, 2010, involving the DASH mark;
  - (6) Cancellation No. 92053030 *Kaplan v. Insight Pharmaceuticals, LLC*, filed September 15, 2010, involving the ASPERGUM mark;
  - (7) Cancellation No. 92053710, styled *Kaplan v. Schering-Plough Healthcare Products, Inc.*, filed March 5, 2011, involving the AFTATE mark;
  - (8) Cancellation No. 92053760, styled *Kaplan v. Proctor & Gamble Company*, filed March 15, 2011, involving the BOLD mark;
- and

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of Federal Rule of Civil Procedure 11(b), which states as follows:

By presenting to the court a pleading, written motion, or other paper – whether by signing, filing, submitting, or later advocating it – an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

(1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;

(2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;

(3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

See also Patent and Trademark Office Rule 11.14. The Board will entertain a motion for entry of further sanctions, including dismissal of the petition to cancel with prejudice, should violations of the Federal Rules of Evidence or the Federal Rules of Civil Procedure be shown.

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(9) Cancellation No. 92053773, styled *Kaplan v. Del Monte Corp.*, filed March 17, 2011, involving the PUSS 'N' BOOTS mark.



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See Fed. R. Civ. P. 11(c)(3) and Patent and Trademark Office Rule 11.14.

Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	6/1/11
Discovery Closes	7/1/11
Plaintiff's Pretrial Disclosures	8/15/11
Plaintiff's 30-day Trial Period Ends	9/29/11
Defendant's Pretrial Disclosures	10/14/11
Defendant's 30-day Trial Period Ends	11/28/11
Plaintiff's Rebuttal Disclosures	12/13/11
Plaintiff's 15-day Rebuttal Period Ends	1/12/12

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.