

THIS OPINION  
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OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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coggins

Mailed: August 21, 2015

Concurrent Use No. 94002552

Bad Boys Bail Bonds, Inc.

v.

William Lee Yowell

**Before Quinn, Wolfson, and Masiello,  
Administrative Trademark Judges.**

**By the Board:**

Now before the Board is registrant William Lee Yowell's ("Yowell") motion for summary judgment (filed January 21, 2014) on the ground that concurrent use applicant Bad Boys Bail Bonds, Inc. ("Bad Boys") cannot at trial satisfy one of the two conditions precedent to issuance of a concurrent use registration, namely, that Bad Boys used the applied-for mark in commerce prior to the filing date of the application underlying Yowell's registration. The motion is fully briefed.

Relevant Background

On August 27, 2008, Bad Boys filed a geographically unrestricted, intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. §

1051(b), to register the composite mark BAD BOYS BAIL BONDS (shown at right) for goods and services ultimately identified as:<sup>1</sup>



Air fresheners, in Class 5;

Metal key chains; Metal rings and chains for keys, in Class 6;

Refrigerator magnets, in Class 9;

Advertising pamphlets; Advertising signs of paper or cardboard; Ball point pens; Business cards; Calendars; Coloured pens; Desk stands and holders for pens, pencils, and ink; Envelopes; Felt pens; Felt writing pens; Felt-tip pens; Fibertip pens; Folders; Highlighter pens; Informational sheets about Bail Bonds; Ink pens; Leaflets about Bail Bonds; Letterhead paper; Marking pens; Note pads; Pen and pencil cases and boxes; Pen and pencil holders; Pen and pencil trays; Pen cases; Pen clips; Pen holders; Pen ink cartridges; Pen ink refills; Pens; Presentation folders, in Class 16;

Imitation leather key chains; Leather key chains, in Class 18;

Advertising balloons; Non-metal and non-leather key chains; Plastic key chains; Plastic key tags, in Class 20;

Lanyards for holding eyeglasses, badges and keys, in Class 22;

Bandanas; Hats; Leather jackets; Polo shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; Tank-tops, in Class 25;

Match boxes; Matches, in Class 34;

Advertising and marketing; Advertising and promotional services; Advertising and publicity services; Advertising flyer distribution; Advertising through all public communication

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<sup>1</sup> Application Serial No. 77557387. The following statements appear in the application: "The mark consists of a picture of a frowning, muscular man behind bent bars with the words BAD BOYS on the top of him and the bars and BAIL BONDS on the bottom. No claim is made to the exclusive right to use BAIL BONDS apart from the mark as shown. Color is not claimed as a feature of the mark."

means; Advertising via electronic media and specifically the Internet; Advertising, marketing and promotion services; Developing promotional campaigns for business; Dissemination of advertisements and of advertising material; Dissemination of advertising material; Dissemination of advertising matter; Distribution and dissemination of advertising materials; Distribution of products for advertising purposes; Internet advertising services; Modeling services for advertising or sales promotion; Preparing and placing of advertisements; Specialty merchandising services, namely, promoting the goods and services of others through the distribution of customized advertising materials, namely, vehicles, lanyards, hats, key chains, folders, clothing, balloons, matches, air fresheners, bandanas, pens, note pads, calendars, magnets, flyers, signs, print ads, website information, television and radio commercials, Telephone directory information, in Class 35; and

Bail bonding; Bonding services, in Class 36.

In the first Office Action, the Examining Attorney refused registration in each class of goods and services under Section 2(d) of the Act, 15 U.S.C. § 1052(d), based on Yowell's Registration No. 2942303.<sup>2</sup> The application was abandoned for failure to respond to the Office Action, but was eventually revived by Bad Boy's Petition to the Director, which was accompanied by a response to the first Office Action in which Bad Boys attempted, *inter alia*, to amend its application to seek concurrent use registration claiming California, Arizona, and Nevada as its territory. The Examining Attorney continued the refusal in each class under § 2(d) and advised Bad Boys that, as an intent-to-use applicant, it could not seek concurrent use registration until it filed an acceptable allegation of use.

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<sup>2</sup> Registration No. 2942303, issued to William Lee Yowell, for the mark "BAD BOYZ BAIL BONDS 'IN JAIL, WE BAIL'" (in typed format) for services identified as "providing bail bonds for persons under arrest in the state of Missouri" in Class 42. Registered on April 19, 2005, from an application filed December 29, 1999.

Bad Boys responded to the Office Action and filed an Amendment to Allege Use which claimed August 2, 1998, as its date of first use in commerce for Class 36, and August 28, 2008, as its date of first use in commerce for all other classes. Bad Boys stated in the Amendment to Allege Use, filed December 14, 2010:

Please note that although “08/28/2008” is noted as the first date in commerce and first date of use for the items listed in most of the classes, all items in the Classes listed were in continuous use from 1998 through the present with the words “Bad Boys Bail Bonds” and a nearly identical version of the logo. In August 2008, just before filing this trademark application, the picture portion of the logo depicting a man in jail was minimally revised. However, the words “Bad Boys Bail Bonds” were never changed and have been in continuous use on all of the company’s products, services and promotional items since August 1998. Moreover, a virtually identical logo has also been in continuous use since August 1998 (emphasis added).

The Amendment to Allege Use was accompanied by a signed declaration attesting to the truth of the statements made therein. Bad Boys similarly stated in the corresponding Response to Office Action (without a declaration), filed December 15, 2010, that:

Applicant’s first use of the words “BAD BOYS BAIL BONDS” (which are causing the alleged “confusion” between the marks) in commerce was in August 1998 which is prior to the filing date of #2942303. Trademark Application [sic] #2942303 was filed on 12/29/99. Similarly, a logo virtually identical to the one presently used by Applicant was in use from August 1998 through August 2008 on all items in all classes listed in Applicant’s Allegation of Use. In August 2008, just before filing the instant trademark application, the picture portion of the logo depicting a man in jail was minimally revised. However, the words “Bad Boys Bail Bonds” were never changed and have been in continuous use on all of the company’s products, services and promotional items since August 1998 and the logo or one

substantially similar have [sic] also been in continuous use since August 1998 (emphasis added).

The Examining Attorney again continued the refusal under § 2(d) and advised Bad Boys that its dates of first use in commerce (for each class<sup>3</sup>) must be prior to the December 29, 1999 filing date of the application underlying Yowell's registration. The Examining Attorney also noted that Bad Boys' August 2008 "dates of use [in the Amendment to Allege Use] appear to contain a typographical error because the applicant indicated in the [corresponding] response to office action that the first use in commerce of its mark was August 1998," and required Bad Boys to "confirm that [its] dates of use are accurate." See March 9, 2011 Office Action. In response, Bad Boys amended the Amendment to Allege Use to claim August 30, 1998, as its date of first use in commerce for each class. The Examining Attorney then accepted the Amendment to Allege Use (as amended), prepared the application for publication as one seeking concurrent registration, and approved the application for publication. The application was published for

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<sup>3</sup> Trademark Manual of Examining Procedure ("TMEP") § 1403 (July 2015) provides that "[a] multiple-class application may be viewed as a group of applications for registration of one mark in connection with goods [and/or] services ... in particular classes, all combined into one application. Generally an applicant is in the same position that [it] would have been if [it] had filed several single-class applications instead." Likewise, the Board views a multiple-class application as a series of individual applications (i.e., one for each class) combined into a single application. See *G & W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009), citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1101-02, 192 USPQ 24, 28 (CCPA 1976). Therefore, a multiple-class application seeking concurrent registration must claim for each class a date of first use in commerce that is prior to the applicable date specified in § 2(d).

opposition, and, after the opposition period closed without the application having been opposed, the Board instituted this concurrent use proceeding.

Relevant Statute

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), provides:

That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the ... place of use of the marks ... concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of ... any registration issued under this chapter ....

Thus, § 2(d) sets out two conditions precedent to issuance of a concurrent use registration. A concurrent use applicant must meet the requirement of showing use in commerce prior to the applicable date specified in § 2(d), and must show that use of the mark, in the limited territory for which it seeks a concurrent registration, will not result in a likelihood of confusion. *See* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1101.01 (2015). *See also* *America’s Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1548 (TTAB 2013), *quoting In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970).

To establish its entitlement to registration as a concurrent user in California, Arizona, and Nevada, Bad Boys must demonstrate, for each class of goods and services claimed in its application, (1) that it made lawful concurrent use of the applied-for mark in commerce prior to the December 29, 1999 filing date of the application underlying Yowell’s registration, and (2)

that confusion, mistake, or deception is not likely to result from its continued use of the applied-for mark in the limited territory of California, Arizona, and Nevada. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477-78 (TTAB 2014).

Motion for Summary Judgment

Yowell moves for summary judgment on the basis that Bad Boys' use in commerce of the applied-for mark was not prior to the December 29, 1999 filing date of the application underlying Yowell's registration. Yowell supports his motion with the declaration of his counsel Morris E. Turek. Attached to the declaration are three exhibits: a letter from Bad Boys to Yowell transmitting 29 pages of evidence purporting to evince<sup>4</sup> Bad Boys' use of its mark in commerce prior to the December 29, 1999 filing date (Exhibit 1); the 29 pages of evidence enclosed with the letter (Exhibit 2); and Yowell's follow-up email asking for additional documents because, in Yowell's opinion,<sup>5</sup> the original documents do not show any use of the composite mark at issue (Exhibit 3). Yowell attached to his reply brief (as Exhibit A) a copy of Bad Boys' initial disclosures.

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<sup>4</sup> The first sentence of the letter states: "Pursuant to our discussion during our initial discovery conference, we are enclosing evidence (29 pages) of Plaintiff's use of the name/mark 'Bad Boys Bail Bonds' in commerce prior to December 1999." 17 TTABVUE 14.

<sup>5</sup> The email states, in part, that "I do not see any use of the mark that your client applied to register .... Your client applied to register a logo .... I don't see that logo (or anything even resembling that logo) in any of the documents. ... I ask that you voluntarily provide me with documents showing use of the applied-for mark by your client prior to December 29, 1999." 17 TTABVUE 46.

In opposition to the motion, Bad Boys argues that Yowell may not rely on the 29 documents because they were provided during settlement negotiations; and that it is only the words in the mark that are at issue in this proceeding, and the design portion of Bad Boys' mark is irrelevant. Bad Boys requests that if the Board is inclined to grant Yowell's motion for summary judgment, Bad Boys be granted a continuance in order to conduct discovery under Fed. R. Civ. P. 56(d). Bad Boys supports its brief in opposition with the declaration of its owner Clifford Jeffrey Stanley, and the declaration of its counsel Kristina S. Keller. Attached to the Stanley declaration is a "C-Area Report" listing certain bonds that were posted in Nevada and Arizona in 2013 (Exhibit A); and attached to the Keller declaration are copies of USPTO records relating to the subject application and registration (Exhibits B-D), a copy of a TSDR<sup>6</sup> print-out relating to Bad Boys' design-only mark<sup>7</sup> (Exhibit E), and a print-out of Yowell's web site (Exhibit F). Notably, Bad Boys did not include any documentary evidence showing use of the applied-for, composite mark.

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<sup>6</sup> TSDR is an acronym for the "Trademark Status and Document Retrieval" system (at <http://tsdr.uspto.gov/>), an official database of the USPTO which provides detailed information about the status and prosecution history of trademark applications and registrations.

<sup>7</sup> Registration No. 4473526, issued to Clifford Jeffrey Stanley DBA Bad Boys Bail Bonds, for "bail bonding" services in Class 36. Registered on January 28, 2014, from an application filed October 27, 2012. The registration includes the following statements: "The mark consists of a circle with the upper half of a frowning, muscular man in a plain T-shirt behind bars in the middle. Color is not claimed as a feature of the mark." We note that the mark in this registration is nearly identical to the central design element contained within the composite mark of subject application Serial No. 77557387.



Standard

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes 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 regarding any material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A party asserting that a material fact cannot be genuinely disputed may support its assertion by either citing to particular materials in the record or by showing that an adverse party cannot produce admissible evidence to support a countervailing fact. Fed. R. Civ. P. 56(c). *See also Celotex Corp. v. Catrett*, 477 U.S. at 325 (when party moving for summary judgment does not bear the ultimate burden of proof on an issue, moving party may satisfy its initial burden as movant “by ‘showing’ – that is, pointing out to the [Board] – that there is an absence of evidence to support the nonmoving party’s case.”). When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the nonmoving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Shum v. Intel Corp.*, 633 F.3d 1067, 97 USPQ2d 1513, 1519 (Fed. Cir. 2010); *Enbridge, Inc. v.*

*Excellerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F. 2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). The Board may not resolve disputes of material fact on summary judgment; 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, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1476; *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Rule 56(d) discovery

Federal R. Civ. P. 56(d) contemplates allowing discovery in situations “when facts are unavailable to the nonmovant” that are “essential to justify its opposition” to a motion for summary judgment. The rule provides that “[i]f a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may (1) defer considering the motion or deny it, (2) allow time to obtain affidavits or declarations or to take discovery, or (3) issue any other appropriate order.” A request for time to conduct additional discovery under Rule 56(d) is proper only when the non-movant believes it cannot present facts essential to justify its opposition to the motion for summary judgment.

To the extent that Bad Boys' brief in opposition includes an embedded motion seeking Rule 56(d) discovery, the motion is denied as moot inasmuch as Bad Boys has responded to the motion for summary judgment on its merits. *See Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (motion for Rule 56(d) discovery denied as moot because party filed substantive response to summary judgment motion). *See also* TBMP § 528.06 (request for Rule 56(d) discovery "should not be filed as a 'throw away' alternative accompanying a response to the motion for summary judgment on the merits.").

Moreover, the declaration accompanying the request does not show that Bad Boys cannot present facts essential to justify its opposition to the motion for summary judgment. *See Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2081 (TTAB 1989) (motion for Rule 56(d) discovery not well-taken since party failed to show by affidavit that it could not present facts essential to justify its opposition to motion for summary judgment). Paragraph 8 of the Keller declaration (19 TTABVUE 17-18) asserts that Bad Boys served discovery requests upon Yowell, the parties agreed to postpone Yowell's deadline to respond to discovery while the parties attempted to informally resolve the case, Yowell used the agreement to postpone discovery to his advantage, Yowell filed the motion for summary judgment based on documents obtained during informal settlement negotiations, and Yowell refused to provide any discovery responses to Bad Boys. Bad Boys explains

that it would like a continuance of the motion for summary judgment so that it may compel Yowell to respond to the outstanding discovery and so that it may obtain additional declarations and affidavits in support of its opposition to summary judgment. To the extent Bad Boys may want discovery from Yowell, we note the essence of Yowell's motion focuses on the asserted non-use of the applied-for mark by Bad Boys, and any evidence related to Bad Boys' use of its mark would be in its own possession, custody, or control, not in Yowell's. Indeed, a review of Bad Boys' initial disclosures reveals that Bad Boys disclosed six categories of documents in its own possession, custody, or control which might support its claim that it is entitled to a concurrent use registration. *See Reply, Exhibit A (20 TTABVUE 8-12)*. Bad Boys makes no argument as to why facts are unavailable to it or why it cannot otherwise present facts essential to its opposition to Yowell's motion. Nothing in the Keller declaration explains why Yowell would be in possession of evidence of Bad Boys' early use of its own mark. To the extent Bad Boys seeks third-party declarations or affidavits, Bad Boys failed to name any person from whom it would obtain one of the additional declarations or affidavits, or provide any reason why that person was previously unavailable. In view thereof, even if the motion seeking Rule 56(d) discovery were not deemed moot, it would be denied because Bad Boys failed to specify any reason why it cannot present facts essential to justify its opposition to the motion for summary judgment.

Evidence Issue

Bad Boys argues that Yowell inappropriately divulged settlement negotiations and documents provided during those negotiations; and that Yowell has not served any formal discovery requests to Bad Boys, but supported the motion with materials and correspondence obtained during settlement discussions which, pursuant to Fed. R. Evid. 408(a), are inadmissible.

While Fed. R. Evid. 408(a) makes inadmissible evidence of certain conduct or statements made during settlement negotiations, it does not render inadmissible all materials produced during settlement discussions. *See, e.g., Bankcard Am., Inc. v. Universal Bancard Sys., Inc.*, 203 F.3d 477, 484 (7th Cir.). The rule prohibits, in relevant part, the admissibility of evidence of “a statement made during compromise negotiations about the claim.” Fed. R. Evid. 408(a)(2). “By its terms Rule 408(a)(2) does not immunize from proof the establishment of facts learned during settlement discussions other than information specifically regarding compromise negotiations.” *Hallmark v. Cohen & Slamowitz, LLP*, 283 F.R.D. 136, 139-40 (W.D.N.Y. 2012). As explained in the notes to Rule 408, “evidence, such as documents, is not rendered inadmissible merely because it is presented in the course of compromise negotiations if the evidence is otherwise discoverable. A party should not be able to immunize from admissibility documents otherwise discoverable merely by offering them in a compromise negotiation.” Notes of

Committee on the Judiciary, Senate Report No. 93-1277. “[T]he Rule cannot be read to protect pre-existing information simply because it was presented to the adversary in compromise negotiations.” Fed. R. Evid. 408 Committee Notes on Rules—2006 Amendment. The 2006 amendment was made with the intent to retain the exception of evidence that is “otherwise discoverable.” *See id.*, citing, *Ramada Development Co. v. Rauch*, 644 F.2d 1097 (5th Cir. 1981).

Yowell relies on 29 pages of documents provided by Bad Boys and purporting to show, in Bad Boys’ own words, “evidence ... of [Bad Boys] use of the name/mark BAD BOYS BAIL BONDS in commerce prior to December 1999.” *See* Motion, Exhibit 1 (17 TTABVUE 14)). A review of the documents reveals that they comprise, *inter alia*, a Bail License issued to Stanley from the California Department of Insurance, receipts, a telephone directory advertisement, an advertising contract, a church directory advertisement, and a bail bond underwriting agreement. *See* Motion, Exhibit 2 (17 TTABVUE 15-44). The documents constitute pre-existing information — much of it already made public — which appears to be readily ascertainable through discovery of Bad Boys within the context of this proceeding. *See generally* TBMP § 414 and cases cited therein. Indeed, Bad Boys does not argue that the documents are not discoverable; instead, it argues only that the documents were produced during or as the result of settlement discussions. Inasmuch as the 29 pages of pre-existing documents exist independently of any statement made by Bad Boys to Yowell specifically

regarding compromise negotiations, are otherwise discoverable, and were supported by the Turek declaration, they fall outside the restrictions of Evid. Rule 408(a)(2), and Yowell may rely on them to support his motion for summary judgment. Fed. R. Civ. P. 56(c)(1)(A).

Analysis

Bad Boys' mark at issue in this case is the composite mark (shown at right) consisting of both words and a design. To be clear, although Bad Boys argues to the contrary, this case does not concern the right, if any, to



register only the word mark BAD BOYS BAIL BONDS. The applied-for mark is neither the words alone nor is it merely the design of a frowning, muscular man behind bent bars; it is a composite of words and design. This is the mark Bad Boys submitted in the drawing of its application, and we note that an application must be limited to only one mark. Trademark Rule 2.52. *See In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999). *See also* TMEP § 807.01.

Bad Boys argues that Yowell has not shown that documents showing Bad Boys' use of the mark prior to Yowell's filing date do not exist, and that Yowell cannot move to dispose of this case under a theory that no pertinent documents exist just because none were informally provided to Yowell. Yowell, on the other hand, asserts that Bad Boys cannot produce any evidence to establish a genuine dispute regarding the material fact that Bad

Boys did not use the applied-for mark in commerce prior to the December 29, 1999 filing date of the application underlying Yowell's registration. Yowell supports this assertion regarding the applied-for mark by pointing to Bad Boys' letter, the 29 pages of evidence transmitted therewith, Yowell's follow-up email requesting additional documents, and a statement that Bad Boys failed to provide any additional documents. *See* Motion, Exhibits 1-3 (17 TTABVUE 13-46); and Turek Declaration, para. 7 (*id.* at 17). We must, therefore, look to the documents to determine if Yowell has sufficiently supported his assertion.

Bad Boys' letter states that it is providing to Yowell 29 pages of "evidence" of Bad Boys' "use of the name/mark 'Bad Boys Bail Bonds' in commerce prior to" Yowell's filing date. We note, as did Yowell, that the documents do not show use of the applied-for mark; they show use only of the words "Bad Boys Bail Bonds." Moreover, the documents appear to relate only to Bad Boys' bail bonding services in Class 36 and do not appear to relate to any of the other goods or services identified in the subject application.

Bad Boys argues in its brief in opposition to Yowell's motion that only the words in its composite mark are relevant to this proceeding because the Examining Attorney focused the § 2(d) refusal on the wording in Bad Boys' composite mark and not on the design element of the composite mark; the "design is entirely irrelevant to this case"; the design element has been separately registered as a design mark without the words BAD BOYS BAIL



BONDS; and the “entire basis for [the] motion for summary judgment is flawed because [Bad Boys] need not show the logo in use before December 29, 1999, but only the words since it is only the words that are at issue in this proceeding.” *See* Brief in Opp., pp. 6-8 (19 TTABVUE 7-9). We reiterate, however, that the applied-for mark is a composite mark consisting of words combined with a design, and a determination of the right to concurrent registration must be made on the basis of the composite mark as a whole as it appears in the concurrent use application.<sup>8</sup>

Although Bad Boys argues that the documents show use of the word mark BAD BOYS BAIL BONDS prior to the December 29, 1999 filing date of the application underlying Yowell’s registration, that is not a question presented by the current application and this proceeding, and Bad Boys appears to concede that it did not use the applied-for, composite mark prior to that date. Specifically, Bad Boys did not submit with its brief in opposition any documentary evidence of use of the applied-for, composite mark, and the sole evidence of any relevance that we can find is paragraph 4 of the Stanley declaration which reads: “Bad Boys has operated with the mark BAD BOYS BAIL BONDS since 1998, both with and without a logo/design.” 19

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<sup>8</sup> It was not improper for the Examining Attorney, in her likelihood of confusion analysis, to accord greater weight to the word component of Bad Boys’ mark. *See, e.g., Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1197 (TTAB 1994); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Nonetheless, there is nothing in the record indicating either that the refusal related to the words alone or that the Examining Attorney’s analysis did not consider the design portion of Bad Boys’ composite mark or the mark as a whole.

TTABVUE 14. This statement, however, does not claim that the specific composite mark in the application was in use since 1998, an evidentiary gap that is particularly significant in light of Bad Boys' previous statement that it changed "the picture portion of the logo" "in August 2008, just before filing the instant trademark application." Moreover, the statement fails to confirm that Bad Boys' use of the words with the unspecified logo applies to all of the classes in the application. *See* Amendment to Allege Use and December 15, 2010 Response to Office Action, which are in evidence pursuant to Trademark Rule 2.122(b)(1).

The documents and declaration submitted by Yowell in support of summary judgment are sufficient under Fed. R. Civ. P. 56(c) to make out a *prima facie* case that Bad Boys did not use the applied-for mark in commerce prior to the December 29, 1999 filing date of the application underlying Yowell's registration, and that Bad Boys "cannot produce admissible evidence to support" that it did. Fed. R. Civ. P. 56(c)(1)(B). In view thereof, it is incumbent upon Bad Boys to refute this showing by proffering countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine dispute about this material fact for trial. *See Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d at 1540. Instead, Bad Boys responded only with inapposite argument, unhelpful documents, and indirect statements. Bad Boys, as the nonmoving party, may not rest on the mere allegations of its pleadings and assertions, but must either cite to

particular portions of the record running counter to Yowell's motion or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. Factual assertions without evidentiary support are insufficient to defend against a motion for summary judgment. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001) ("applicant has produced no evidence, or raised any expectation that at trial it could produce evidence"). The declarations and exhibits attached thereto submitted with Bad Boys' brief in opposition have no relevance to the mark at issue, i.e., the composite mark shown in the drawing of application Serial No. 77557387. We therefore consider undisputed the fact that Bad Boys did not use the applied-for, composite mark in commerce with respect to the goods or services in any of the classes in the application prior to December 29, 1999. Fed. R. Civ. P. 56(e)(2) (When a party fails to properly address another party's assertion of fact as required by Rule 56(c), the Board may consider the fact undisputed for purposes of the motion).

Even when Bad Boys is given the benefit of all reasonable doubt and all inferences are viewed in the light most favorable to it, we find that, based on the record and the applicable law, there is no genuine dispute of material fact that Bad Boys did not use the mark shown in the drawing of application Serial No. 77557387 in commerce prior to the December 29, 1999 filing date of the application underlying Yowell's registration. Inasmuch as Yowell has shown that he is entitled to summary judgment, and Bad Boys failed to

produce evidence sufficient to show a genuine dispute and failed to show that the materials cited by Yowell are insufficient to establish the absence of a genuine dispute, we may proceed under Fed. R. Civ. P. 56(e)(3) to grant summary judgment.<sup>9</sup>

Accordingly, Yowell's motion for summary judgment is granted, concurrent registration to Bad Boys is refused, and this concurrent use proceeding is dissolved.

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<sup>9</sup> Inasmuch as Bad Boys failed to make a showing sufficient to establish the existence of an element essential to its case and on which it would bear the burden of proof at trial, namely, the condition precedent that it used the applied-for mark in commerce prior to the applicable date specified in § 2(d), we need not reach the issue of whether Bad Boys' use of the mark in the limited territory for which it seeks a concurrent registration would result in a likelihood of confusion. *See Celotex Corp. v. Catrett*, 477 U.S. at 323 (when nonmoving party will bear burden of proof at trial, "...a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.").