

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Intel Corporation

v.

Steven Emeny

Opposition No. 91123312
against Serial No. 75825218

Bobby A. Ghajar, Katherine M. Basile and Mike Yaghmai of
Howrey LLP for Intel Corporation.

Steven Emeny, *pro se*.

Before Hairston, Bucher and Wellington, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Steven Emeny, a Canadian citizen, seeks registration
on the Principal Register of the mark **IDEAS INSIDE** for
services recited in the application, as amended, as
follows:


"computerized on line ordering service
featuring the wholesale and retail
distribution of books, music, motion
pictures, multimedia products and computer
software in the form of printed books,
audiocassettes, videocassettes, compact
disks, floppy disks, CD ROM's; clothing

items, namely, anoraks; aprons; ascots, baby bibs; badminton pants; badminton shirts; bandannas; baseball shirts; baseball stockings; baseball uniforms; baseball caps; basketball uniforms; basketball singlets; basketball jerseys; basketball socks; basketball shorts; basketball pants; basketball shirts; bath wraps; bathrobes; beach coats; beach cover ups; bed jackets; belts; berets; bib ties; bibs; bikinis; blazers; blouses, body suits; booties; boots; bowling shirts; boxing trunks; brassieres; briefs; camisoles; capes; cardigans; coats; collars; costumes; coveralls; cravats; cummerbunds; diaper covers; diaper liners; dickies; dress skirts; dresses; dressing gowns, fencing uniforms; fencing jackets; football shirts; football pants; football jackets; footwear; foundation garments; fur coats; garter belts; garters; gloves; golf pants, golf shirts; golf vests; golf jackets; golf socks; golf hats; golf shorts; golf caps; gym shirts; gym shorts; gym pants; halters, handball shirts; handball pants; hosiery, housecoats; jackets; jeans; jerseys; jodhpurs; jogging suits; judo uniforms; jumpers; jumpsuits; karate uniforms; kimonos; knickers; knit shirts; ladies' panties; leg warmers; leggings; leotards; lingerie; lounge wear robes; mantles; masquerade costumes; mittens; muffs; neckties; neck warmers; negligees; night shirts; night gowns; one-piece jumpsuits; overalls; pants; panty hose; parkas; play suits; polo shirts; polo pajamas; rain ponchos; raincoats; rain suits; rainwear; robes; rugby pants; rugby shirts; running suits; sandals; sashes; scarves; scrub pants; shawls; shells; shirts; shorts; skirts; slacks; sleep wear; slips; smocks; snow suits; snowmobile suits; soccer pants; soccer shirts; socks; sport caps; sport shirts; stockings; storm suits; storm coats; straw hats; suits; sun suits; suspenders; sweat shirts; sweatband wristlets; sweaters;

sweat jackets; sweatpants; sweat shorts; sweat suits; swim pants; swim wear; T-shirts; tank tops; tennis caps; tennis pants; tennis shirts; tennis jackets; tennis shorts; thermal underwear; ties; tights; topcoats; tops; track and field shirts; track and field pants; trousers; tunics; turtlenecks; tuxedos; underwear, uniforms; vestees; vests; volleyball pants; volleyball jackets; volleyball shirts; waistcoats; warm-up tops; warm-up suits; warm-up pants; wash suits; wind protection jackets; wraparounds; wraps; wrestling uniforms; footwear, footwear accessories, namely, basketball shoes; boots, court shoes; football shoes; jogging shoes; overshoes; pumps; rain boots; running shoes; sandals; shoes; slip-ons; slippers; thongs; toe rubbers; headwear, namely, beanie caps; bonnets; caps; ear muffs; fur hats; hats; head bands; sun visors; swim caps; toques; visors" in International Class 35;

"electronic direct digital transmission of messages and data via computer terminals" in International Class 38; and

"computer services, namely, providing on line search engines for obtaining data on a global computer network" in International Class 42.¹

In 2001, Intel Corporation opposed this application on the basis that it resulted in a likelihood of confusion and that it diluted Intel's rights in **INTEL INSIDE** (*in standard character format*) and , and also alleged confusion with its family of marks incorporating therein the word

¹ Application Serial No. 75825218 was filed on November 5, 1999 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

"Inside," including INTEL INSIDE, THE COMPUTER INSIDE and THE JOURNEY INSIDE.

After taking discovery, opposer amended its original notice of opposition to assert that applicant lacked a *bona fide* intention to use the mark in commerce at the time he filed this application. Shortly before the due date for final briefs, opposer sought to delete the claims of likelihood of confusion and dilution. In its decision of September 25, 2006, the Board dismissed the notice of opposition with prejudice as to the claims of likelihood of confusion and dilution. Accordingly, the sole remaining issue before the Board in this opposition proceeding is whether opposer has demonstrated that applicant lacked a *bona fide* intention to use the mark **IDEAS INSIDE** as required by Section 1(b) of the Lanham Act.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. In support of its case, opposer made of record, via its Notice of Reliance filed November 29, 2002, *inter alia*, the Affidavit of Leslie Skinner, dated November 29, 2002; applicant's deposition transcript and attachments; and

applicant's responses to opposer's Interrogatories and opposer's Requests for Admissions.

Factual Findings

Opposer

Intel is the leading developer and manufacturer in the world of computer microprocessors. Its products and services span the fields of computers, communications, networking, consumer electronics and the Internet. Intel is the owner of the **INTEL INSIDE** trademark seen the world-over by many millions of consumers.

With regard to Intel's standing in this opposition proceeding, opposer has alleged and proven at trial a real commercial interest, as well as a reasonable basis for the belief that opposer would be damaged by the registration of applicant's **IDEAS INSIDE** mark. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Intel has presented evidence of its ownership and validity of its pleaded registration for the mark **INTEL INSIDE**, and that it has spent millions of dollars advertising and promoting these marks. Accordingly, opposer's earlier allegation of likelihood of confusion is accepted as a proper allegation of opposer's standing with respect to the


pleaded ground that applicant lacked a *bona fide* intention to use his mark at the time he filed this application.²

Applicant

Steven Emeny, a resident of Toronto, Canada, alleges that for the past decade he has been pursuing a home business, Baced Communications. In addition to the instant applicant, Mr. Emeny filed eight other trademark applications with the United States Patent and Trademark Office during a three-year period (1997 - 2000) surrounding this filing:

Serial No.	Mark	Comments
75885374	INTERNET SURF SUIT	225 items of clothing, listed alphabetically
75885342	MULTIMEDIA POCKET	same 225 items of clothing, listed alphabetically
75825226	CYBERSPACE ESSENTIALS	on-line wholesale and retail store services featuring computers, software, books, etc.
75815571	BYTE SIZE CLOTHING	24 items of children's clothing
75415374	WHEN YOU'RE GOING PLACES!	225 items of clothing, listed alphabetically; and promoting the goods and services of others

² See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1209 (TTAB 1993); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 1326, 217 USPQ 641, 648 (Fed. Cir. 1983); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); *The Nestle Company Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1087 (TTAB 1987); and *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (allegation of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

Serial No.	Mark	Comments
75415363		182 items listed in Int. Cl. 25, including duplicate items and products not in Int. Cl. 25; as well as a broad array of online services
75263386	ROOKIESAURUS	30 disparate items in Int. Cl. 9; 225 items of clothing, listed alphabetically; and promoting the goods and services of others
75263382	INTERNET SURFWEAR	225 items of clothing, listed alphabetically; and promoting the goods and services of others

As noted by opposer, all eight of these other applications have now gone abandoned.

Preliminary matters

Before analyzing the merits of this case, we turn to applicant’s contention that Intel has embraced a new “brand architecture” as part of a recent “makeover,” and no longer uses the **INTEL INSIDE** mark on its microprocessors.

We cannot entertain a defense in which applicant attacks the validity of opposer’s pleaded registrations where applicant has failed to file in a timely manner a counterclaim or a separate petition to cancel those registrations.³ Applicant has not done so, and hence, we

³ See 37 CFR §§ 2.106(b) and 2.114(b); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. “42” Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) [allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration]; and TBMP § 311.02(b) (2d ed. rev. 2004).

have given no further consideration to applicant's contention in this regard.

Applicant's bona fide intent to use this mark

We turn then to the sole remaining issue of whether applicant lacks the required *bona fide* intention to use his mark on or in connection with the services recited in his application. Opposer argues in its initial brief that:

... [T]he evidence in this case unequivocally shows that Applicant's behavior - concurrently filing for multiple ITU-based applications without ever developing or using them; filing unrealistically broad identification of goods and/or services; abandoning all but one of his U.S. trademark applications after requesting multiple extensions of time; and lacking any objective proof of his *bona fide* intent to use the IDEAS INSIDE mark - is exactly what the legislature intended to prevent when it required that ITU applicants attest to a *bona fide* intent to use marks. Given the complete absence of evidence to corroborate Applicant's declaration that he possessed a *bona fide* intent to use the IDEAS INSIDE mark at the time of its filing, the Board should sustain Intel's opposition and refuse registration of Applicant's IDEAS INSIDE mark.

Opposer's burden

In order to prevail on this allegation, opposer has the burden of proof of establishing, by a preponderance of the evidence, its claim of a lack by applicant of the requisite *bona fide* intention to use its mark on or in

connection with the services recited in the involved application. We look at the evidence relied upon by opposer and then determine whether or not opposer has made a persuasive argument on behalf of its position herein. If we determine that opposer has established a *prima facie* case that applicant's application is invalid for lack of the requisite *bona fide* intention to use its mark, the burden then shifts to applicant to come forward with evidence to refute such case. While the burden to produce evidence shifts, the burden of persuasion by a preponderance of the evidence remains with the party asserting a lack of a *bona fide* intention to use.

The Trademark Law Revision Act: *bona fide* intent to use

Opposer is correct in noting that Section 1(b) of the Trademark Act requires that an applicant filing an intent-to-use (ITU) application verify that it has a "*bona fide* intention" to use the mark in commerce. 15 U.S.C. § 1051(b)(1). If an applicant lacks a *bona fide* intent to use an ITU-based mark in commerce at the time of its filing, the application is invalid.⁴ While it is

⁴ See TBMP § 309.03(c)(5) (2d ed. rev. 2004) [defendant's lack of a *bona fide* intent to use a mark in commerce is an appropriate ground for an opposition or cancellation].

practically impossible for an Trademark Examining Attorney to explore this in the *ex parte* context, an alleged trademark owner's *bona fide* intentions can be fully tested in the context of an *inter partes* proceeding.

Although the term "*bona fide*" is not defined within the Act itself, the legislative history of the Trademark Law Revision Act of 1988 ("TLRA") reveals that Congress intended the test of "*bona fide*" intent to be shown by "objective"⁵ evidence of "circumstances" showing "good faith." Building on the recommendations of the Trademark Review Commission,⁶ Congress chose this new statutory language very carefully:

Despite its numerous virtues, a registration system based on intent also carries some potential for abuse. A single business or individual might, for instance, attempt to monopolize a vast number of potential marks on the basis of a mere statement of intent

⁵ The evidence is "objective" in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of the applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."

See J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:14, at p. 19-40. (4th ed. 2004)

⁶ See Report of the Trademark Review Commission. 77 Trademark Rep. 375, 397 (1987), USTA, "The Trademark Law Rev. Act of 1988." P. 37 (1989) ("By '*bona fide*,' we mean no mere hope, but an intention that is firm The term '*bona fide*' should be expressly stated in the statute to make clear such intent must be genuine.").

to use the marks in the future. To minimize such risks, S.1883 requires the specified intent to be *bona fide*. This *bona fide* requirement focuses on an *objective good-faith test* to establish that the intent is genuine.

Senate Judiciary Committee Report on S.1883 ("Senate Report"), S. Rep. No. 100-515, p. 6 (Sept. 15, 1988).

From this history, we agree with opposer that applicant's showing should be "objective" in the sense that it is evidence in the form of real life facts measured by the actions of the applicant, not by the applicant's later arguments about his subjective state of mind.⁷

Hence, where an applicant has no documentation evidencing his plans to use the mark on the goods or services claimed, such an absence of clear, objective evidence is sufficient for an opposer to prove that the applicant lacked the requisite *bona fide* intention, unless the applicant can outweigh that absence with an adequate explanation of why no such documentation exists. In

⁷ An ITU applicant must be prepared to support his *bona fide* intention to use the mark by objective means inasmuch as "an applicant's mere statement of subjective intention, without more, would be insufficient to establish [the] applicant's *bona fide* intention to use the mark in commerce," Lane Ltd. v. Jackson International Trading Co., 33 USPQ2d 1351 (TTAB 1994) [applicant's evidence of its business plan and licensing program constitutes credible, objective corroboration of application claim that it had a *bona fide* intention to use the mark in commerce on tobacco].

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993), the Board concluded that the opposer therein would be entitled to prevail on its claim that the applicant lacked the *bona fide* intention to use its mark in commerce required by Section 1(b) of the Act if the opposer were to plead and prove that the applicant is unable to present any evidence, documentary or otherwise, supportive of or bearing on the applicant's claimed *bona fide* intention to use the mark in commerce. In Commodore Electronics, the Board also dismissed the applicant's contention that defending an opposition proceeding, in itself, demonstrates applicant's *bona fide* intent - an argument also advanced by applicant herein.

The Senate Report in the legislative history of the TLRA provides an illustrative list of circumstances that may cast doubt on the *bona fide* nature of an applicant's stated intention, or even disprove it entirely.⁸

Accordingly, we find that a number of these circumstances apply in the instant case, supporting the conclusion that applicant lacks the requisite *bona fide* intention to use the IDEAS INSIDE mark in commerce.

⁸ "Senate Judiciary Committee Report on S.1883," *S. Rep. No. 100-515*, pp. 23-24 (Sept. 15. 1988).

Lists of hundreds of items

For example, opposer argues that Congress recognized that filing an ITU application for many products raises serious doubt as to the applicant's intention to use the mark for each of the products.

In the instant application, as in most of applicant's other now-abandoned ITU applications, the recitation of services reveals an unreasonably broad listing of goods and services, *supra*, pp. 1 - 3. In this case, applicant's recitation of services covers the online sale of nearly every type of article of clothing - more than two-hundred items of apparel, listed alphabetically (and drawn from the Office's listing of acceptable identifications of goods in International Class 25) from "anoraks, aprons, ascots" to "lingerie" and "wrestling uniforms"; book distribution services; search engine services; and digital transmission services.

Yet in spite of the breadth of applicant's recitation of services, there is no evidence of record that applicant has advanced any business plans. Nor would we be able to discern from this record that he has initiated a single contact, in the United States or in his home country of Canada, with any of the companies with whom he likely would

have to partner in order to offer the services covered in his trademark application (e.g., apparel makers, publishers, and Internet service providers, etc.).

In fact, the record shows that applicant's strategy may well fit the type of potential abuses that Congress anticipated with concern almost twenty years ago. On cross-examination, applicant conceded that he wanted to "make sure that nobody else [can] take advantage of those marks. [Therefore] there [is] a long list of wares implemented into the trade-mark applications at the time of submission." [Emeny Dep. at pp. 33, 38-39, attached as Exhibit F to Intel's Notice of Reliance].

We view this as an admission by applicant that he wanted more to preclude the acquisition of rights by others than to use the mark himself in connection with these services and goods. We find this defensive motivation to be totally inconsistent with applicant's claim in his application concerning his intentions to use the mark in commerce.

Applicant's filing history in the United States Patent and Trademark Office

The Senate report also suggests that the filing of numerous ITU trademark applications with the United States

Patent and Trademark Office for a variety of marks covering the same goods and services might well cast doubt on applicant's *bona fide* intention to use any one of those marks.

As shown above, within a three-year period, applicant filed nine ITU applications for various marks for use in connection with the sale of a wide range of apparel and other services. The pattern reveals enumerations of quite similar listings of more than two-hundred items of clothing, a broad array of online store services including the sale of computers, software, books, etc., as well as applicant's promoting the goods and services of others.

Applicant eventually abandoned all of his U.S. applications, except for the IDEAS INSIDE application, and he has never proven use of any of the marks involved in these applications.⁹

⁹ Opposer argues that many of these same marks were the subject of approximately twenty applications in applicant's home country of Canada that have similarly failed to mature into registrations, while applicant counters that at least three have matured into registrations in the Canadian Intellectual Property Office. However, even if this latter contention were properly of record, it would not change the outcome of this proceeding in the United States Patent and Trademark Office.

Applicant has failed to rebut opposer's *prima facie* case

As seen above, opposer has satisfied its initial burden with respect to applicant's absence of a *bona fide* intention to use his mark in commerce. As seen in Commodore Electronics, *supra*, the absence of documentary support for the applicant's ITU application was sufficient to establish that the applicant lacked the requisite *bona fide* intent. Just as the applicant in Commodore Electronics could not point to any specific documents demonstrating its intent to use the mark, applicant herein has failed to produce any documents that objectively prove his *bona fide* intent to use the IDEAS INSIDE mark in commerce. In spite of several discovery requests that called for applicant's marketing plans, discussions, or business plans for the IDEAS INSIDE mark, none were divulged. [See applicant's response to interrogatories 7, 9, 10, 12 and 18 (Exhibit D to Intel's Notice of Reliance)]. Applicant further admitted that he has never conducted any specific planning for the use of the IDEAS INSIDE mark and has not promoted or sold any goods or services using this mark. [*Id.*; see also applicant's responses to opposer's second set of requests for admissions, at Responses 34 and 36]. Applicant conceded that "the term IDEAS INSIDE has not

been developed in the United States since the filing of the []trademark..." Even after Intel moved for summary judgment on the specific issue of applicant's *bona fide* intent to use his mark in commerce, he failed to cite to any evidence or testimony in support of his *bona fide* intent to use the IDEAS INSIDE mark on the recited services including the sale of an extensive listing of clothing items.

Hence, the record remains void of any evidence in support of applicant's alleged *bona fide* intent. Under Commodore Electronics, applicant's failure to produce any objective evidence of an intent to use the IDEAS INSIDE mark is sufficient basis for ruling in Intel's favor on the *bona fide* intent issue. See Commodore Electronics, *supra* at 1508.

Decision: The opposition is sustained and registration to applicant is hereby refused.