

THIS DISPOSITION  
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OF THE TTAB

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

WINTER

Mailed: September 29, 2009

Opposition No. 91185637

Montblanc-Simplo GmbH

v.

United Brands International,  
Inc.

Before Bucher, Kuhlke, and Taylor,  
Administrative Trademark Judges.

By the Board:

United Brands International, Inc. (hereafter "applicant") seeks to register the mark MONT BLANC for one hundred thirty-two goods classified in International Class 9, encompassing a broad range of items, including blank discs for computers, micro computers, personal computers, carrying cases for cell phones, and video phones.<sup>1</sup>

Montblanc-Simplo GmbH (hereafter "opposer") opposes registration of the applied-for mark on the grounds of likelihood of confusion and dilution. In support of its claims, opposer (i) alleges priority based on common law

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<sup>1</sup> Application Serial No. 77306457, filed October 17, 2007, based on applicant's alleged *bona fide* intent to use the mark in commerce. The application includes the following translation of the mark: "The foreign wording in the mark translates into English as white mountain."

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rights accruing from use of the mark MONTBLANC in connection with writing instruments since at least 1913; (ii) pleads ownership of eight trademark registrations<sup>2</sup> for the marks MONTBLANC and MONTBLANC and design for, respectively, various goods and services including, *inter alia*, fountain pens, ball point cartridges, sunglasses, jewelry, luggage, toiletries, clothing accessories, stationery, design and retail services for luxury items, business consulting and management, and education and training services in the fields of arts, education, literacy, musicianship and related activities; and (iii) alleges that the mark MONTBLANC is both famous and distinctive and has been so since prior to the filing date of the involved application.

In its answer, applicant denies the salient allegations set forth in the notice of opposition.

This case now comes up on opposer's fully-briefed combined motion (filed on May 21, 2009) for leave to amend the notice of opposition to add an additional ground for opposition, *viz.* that applicant lacked a *bona fide* intent to use the mark MONT BLANC in commerce for the described goods at

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<sup>2</sup> Opposer's pleaded registrations for the marks MONTBLANC and MONTBLANC and design are: Reg. No. 777208, issued September 1, 1964; Reg. No. 1825001, issued March 8, 1994; Reg. No. 1884842, issued March 21, 1995; Reg. No. 2202465 issued November 10, 1998; Reg. No. 2415189, issued December 26, 2000; Reg. No. 2820561, issued March 9, 2004; Reg. No. 2515092, issued December 4, 2001; and Reg. No. 3021081, issued November 29, 2005.

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the time the application was filed, and for summary judgment on the newly-asserted ground.<sup>3</sup>

Motion to Amend Notice of Opposition

Opposer seeks to amend the notice of opposition to include a claim that applicant did not have a *bona fide* intent to use the MONT BLANC mark in commerce in connection with the recited goods as of the filing date of the application. The new, additional paragraph in the proposed pleading reads as follows:

10. As for a separate and additional ground, Applicant lacked a bona fide intention to use Applicant's mark in commerce for the goods specified in the Application at the time of filing as shown by the fact that he [*sic*] has no documents that evidence such intent either at or around the time of filing the Application or to date.

In support of its motion, opposer has provided a proposed amended notice of opposition and the declaration of counsel for opposer, Shadaia M. Gooden of Kalow & Springut LLP, to support opposer's submission of its exhibits, which include, *inter alia*, a copy of applicant's responses (including documents produced) to opposer's first request for the production of documents and things, and a copy of the

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<sup>3</sup> Opposer also requests that this proceeding be suspended and that testimony periods be extended, if necessary. This proceeding was suspended on May 28, 2009; therefore, the motion to suspend is moot. In view of our decision regarding the subject motion for summary judgment, the motion for an extension to the testimony periods is also moot. Opposer's motion (filed April 13, 2009) to extend the discovery period and remaining dates in the trial schedule is granted as conceded. See Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a).

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transcript of the discovery deposition of applicant's CEO and President, Seirous Ghalati, which occurred on May 1, 2009.

Opposer argues that the Board should grant its motion for leave to amend because opposer learned the information to support the new claim during recent discovery and because the proposed amendment will not prejudice applicant inasmuch as no new discovery is required. Opposer specifically contends that "all relevant information to support Applicant's intent to use the mark rests solely in the possession of Applicant" (motion, p. 4).

In opposition, applicant essentially argues the merits of the claim, *viz.* that it has had and continues to have an uninterrupted *bona fide* intent to use the MONT BLANC mark in commerce, but that opposer's opposition has interfered with applicant's business plans and that it has been unwilling to bring products to market until this proceeding is resolved (response, p. 2). Applicant also contends that opposer's motion "provides no basis for why Opposer's request should be granted and would unfairly prejudice Applicant" (response, p. 5).

The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or parties, would violate settled law, or would serve no useful purpose. Fed. R. Civ. P. 15(a).

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See, e.g., *Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000); and *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998); TBMP § 507.02 (2d ed. rev. 2004). This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (allowing opposer to add the claim that applicant did not have a bona fide intention to use the mark in commerce on the specified goods and services when it filed several applications); and *Marmark, Ltd. v. Nutrexp, S.A.*, 12 USPQ2d 1843 (TTAB 1989).

We find that opposer's motion for leave to amend to add the additional claim was timely inasmuch as the proposed new claim is based primarily on information discovered during the deposition of applicant's representative on May 1, 2009 and opposer's motion to amend was filed less than three weeks later. As to whether applicant will be prejudiced by the amendment, applicant does not indicate how it will be prejudiced; it only asserts that it will be prejudiced. Inasmuch as the motion herein was filed prior to the close of discovery and we have granted as conceded opposer's motion to extend the close of discovery, we find that allowance of the proposed amendment would not be prejudicial to applicant.

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As to whether opposer's proposed claim is sufficient, opposer need only allege in its amended pleading a further statutory ground for opposition to the application. We find that the allegation set forth in paragraph 10 of the amended notice of opposition constitutes adequate notice pleading of a claim that applicant had no *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), on the filing date of the application. See, e.g., *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536 (TTAB 2007); and *Commodore Electronics Ltd. V. CMB Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Finally, entry of the new claim would not violate settled law. See *Id.*

In view of the foregoing, opposer's motion for leave to amend its pleading is granted. Accordingly, opposer's Amended Notice of Opposition filed on May 21, 2009 (as an exhibit to the subject combined motion) is considered opposer's operative pleading in this proceeding.

Motion for Summary Judgment

Opposer has moved for summary judgment on the newly-asserted ground that applicant had no *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b) on the filing date of the involved application.

In support of its motion, opposer has submitted exhibits comprising a copy of opposer's first request for production of documents and things, a copy of applicant's responses thereto,

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a copy of the deposition transcript of Mr. Ghalati, and the declaration of Ms. Gooden, which states that the attached exhibits are true and correct copies of the documents referenced therein.

Opposer essentially argues the merits of its claim that applicant had no *bona fide* intent to use the mark MONT BLANC in commerce on the filing date of the involved application. Specifically, opposer argues that applicant has produced no documents during the course of discovery demonstrating any preparation for using the mark in commerce (motion, pp. 7-9); that applicant lacks experience with the various "high-tech" computer-related and technical goods described in the involved application (motion, p. 9); and that applicant has filed multiple applications for famous marks which share many of the same goods (motion, pp. 9-10). Opposer asserts that despite its written requests for documents such as business and marketing plans, documents "referring ... to Applicant's business," documents with market projections of applicant's future sales of applicant's goods with the mark MONT BLANC, correspondence with advertising agencies or public relations firms regarding the promotion of applicant's products bearing the mark MONT BLANC, exemplars for advertising or packaging materials created by or for applicant for use with the mark MONT BLANC, and the like, applicant has not provided any such documents or materials. Further, opposer points out that

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opposer's representative, Mr. Seirous Ghalati, testified during his deposition that applicant's only preparation to date to use the MONT BLANC mark in commerce was to create mock-up web pages for a website, but that applicant had not yet even secured a web address and that such mock-up web pages had been destroyed and proof thereof was not available (Gooden declaration, Exh. D; motion, p. 8). Opposer mentions that Mr. Ghalati also testified that he has no experience working with the goods identified in the involved application (*Id.* at p. 9). We also note opposer's Exhibit E, which is comprised of copies of applicant's applications for other marks previously filed by applicant for largely the same goods classified in International Class 9 that are described in the involved application.<sup>4</sup>

In response to the motion, applicant contends that its *bona fide* intent to use the mark is a material fact in dispute (response, p. 3); yet, applicant also argues the merits of opposer's claim. Applicant specifically asserts, *inter alia*, that opposer's motion "is based solely on the unsupported allegation that Applicant did not have the *bona fide* intent to use the mark MONT BLANC in commerce at the time the application was filed" (response, p. 1); that applicant had at

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<sup>4</sup> Opposer's Exhibit E is comprised of copies of the applications for the marks BOSS (application Serial No. 77303107); CATERPILLAR (application Serial No. 77383896); DIESEL (application Serial No. 77303519); and PUMA (application Serial No. 77303544).

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the time of filing the involved application, "which intent continues uninterrupted," a *bona fide* intent to use the mark MONT BLANC in connection with the "electronics based items" identified in the involved application (response, p. 1); that applicant has been unwilling to bring products to market pending resolution of these proceedings (response, p. 2); that applicant continues to take steps, including the building of a website that contains the MONT BLANC mark; that Mr. Ghalati does have experience with marketing and manufacturing; that applicant will hire technical individuals as needed; that opposer has failed to ask applicant "why no such documentation exists" (response, p. 3; Ghalati declaration, ¶9); and that opposer's motion for summary judgment is filed for the purpose of delaying "Applicant's marketing plan, and stop Applicant from using the mark" (response, p. 4). In support of its opposition to the motion, applicant has submitted the declaration of Mr. Ghaliti.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could

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not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues 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. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Further, when a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine issue of material fact and the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of at least one genuine issue of material facts that requires resolution at trial. The nonmoving party, however, may not rest on the mere allegations of its pleadings and assertions, but must

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designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. Consequently, 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"); and *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987).

In regard to opposer's claim that applicant lacks the *bona fide* intent to use the mark MONT BLANC in commerce with the identified goods, as a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. See *Copeland's Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). However, the Board has held that the absence of any documentary evidence regarding an applicant's *bona fide* intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993), cited in *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB

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2009). See also *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008). The determination of whether an applicant has a *bona fide* intention to use the mark in commerce is an objective determination based on all the circumstances as revealed by the evidence of record. See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355-1356 (TTAB 1994) ("Applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's *bona fide* intention to use the mark in commerce").

Before we consider the merits of the motion for summary judgment, we must first consider the question of whether opposer has the proper standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Industries*, 213 USPQ at 189.

We note that opposer attached to the notice of opposition a current printout of information from the TARR electronic database records of the USPTO showing the current status and

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title of its pleaded registration for the mark MONTBLANC (see footnote 2, *supra*). See Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). We find this evidence of opposer's long-standing registration sufficient to establish that opposer has a real interest in the outcome of this proceeding; that is, opposer has a direct and personal stake in preventing the registration of applicant's mark for the identified goods.<sup>5</sup> Thus, there is no genuine issue of material fact regarding opposer's standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*. See also *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (standing established; opposition sustained on grounds of lack of a bona fide intention to use the mark in commerce and likelihood of confusion).

Turning to the merits of opposer's motion for summary judgment, based on the submissions of the parties, we find that opposer has satisfied its initial burden of showing the absence of any documentary evidence regarding applicant's *bona fide* intention to use the mark, and that applicant has failed

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<sup>5</sup> We also note that applicant has not challenged opposer's standing to oppose the involved application.

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to come forward with evidence that would adequately explain or outweigh its failure to provide such documentary evidence.

The documentary evidence submitted by opposer shows that applicant has no documents or other objective proof that it had a *bona fide* intent to use the mark MONT BLANC in commerce when the involved application was filed. We note, in particular, that only corporate formation documents<sup>6</sup> were produced by applicant during discovery; that during Mr. Ghalati's discovery deposition, in response to the query of opposer's counsel as to whether applicant would produce the web pages that Mr. Ghalati "tried to create for Mont Blanc," Mr. Ghalati responded "I destroyed it" (motion, Exh. D; discovery deposition of Mr. Ghalati, p. 47, lines 8-21); and that Mr. Ghalati affirmed repeatedly during his discovery deposition that he had no documents, "nothing in writing," and/or no documents responsive to opposer's numerous discovery requests. For instance, Mr. Ghalati answered some of the deposition questions of opposer's counsel as follows:

"Q: So you told us you did two things in preparation for using these trademarks; you have tried to create a website and you gathered information about the products you wanted to use the mark in connection with. Right?"

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<sup>6</sup> Applicant has produced only a copy of its articles of incorporation, a copy of its "Statement of Information" for the State of California Secretary of State, which states that the type of business of the corporation is "import and export," a copy of applicant's "Application for Employer Identification Number" [Form SS-4], which indicates that applicant's principal line of merchandise is "communication accessories," and a copy of the minutes of applicant's first meeting of its Board of Directors.

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A: Yes, sort of, yes.

Q: Anything else that you've done in preparation for using the Mont Blanc name ...?

A: No, not - not more than that.

Q: Nothing else?

A: No.

Q: Have you prepared any type of marketing plan?

A: I thought of something, but I have not put it in writing.

Q: Nothing in writing?

A: No."

(*Id.* at p. 50, lines 9 through 25, and p. 51, line 1).

...

"Q: Do you have any documents responsive to request No. 18 [*i.e.* evidencing or referring to market projections of applicant's future sales of any products or services under applicant's mark]?

A: No."

(*Id.* at p. 58, lines 18 through 20).

...

"Q: How about document request 20, do you have any documents responsive to that request [*i.e.* correspondence with advertising or public relations firms regarding promotion of applicant's products or services bearing the word MONT BLANC]?

A: Not yet.

(*Id.* at p. 59, lines 3 through 5)."

...

"Q: What activities have you completed since you filed this application?

A: I started, as as I said, producing the website for marketing the product, and which is not - was not successful and took me time, and also I did some search to see how can I market it with - concerning the suppliers.

Q: Nothing else?

A: Yes, nothing else."

(*Id.* at p. 62, lines 24 through 25, and p. 63, lines 1 through 5).

...

"Q: Have you created any paperwork that reflects your attempt to identify any suppliers for the goods that are identified Opposer's Exhibit 3?

A: What do you mean?

Q: Is there any documentation that reflects your efforts in that regard??

A: What sort of documentation?

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Q: Any document that reflects your efforts in trying to identify suppliers of the goods?

A: As I said, I made a search to identify the product and, of course, that included the suppliers, too.

Q: Do you have any papers that show that?

A: I don't have with me.

Q: Do you have it anywhere else?

A: Maybe I should check my computer."

(*Id.* at p. 51, lines 4 through 23).

Applicant has countered the motion and the documentary evidence produced by opposer with statements of subjective intent and unsupported statements that applicant "has taken steps and continues to take steps ... pending resolution of this proceeding" (see ¶¶ 3-5, 7, Ghalati declaration). This is not sufficient to raise a genuine issue of material fact. See *Sinskey v. Pharmacia Ophthalmics Inc.*, 982 F.2d 494, 25 USPQ2d 1290, 1293 (Fed. Cir. 1992) ("A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity"). Further, applicant has not demonstrated that it has any experience in the field of electronics manufacturing or sales, despite the listing of 132 goods in that field. See, e.g., *Honda Motor Co.*, 90 USPQ2d at 1664.

Having considered the evidence and arguments submitted by the parties, and viewing that evidence in the light most favorable to applicant, we find that there is no evidence of applicant's *bona fide* intent to use the mark MONT BLANC in commerce with the goods identified in the involved

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application. That is, there is no genuine issue that applicant did not at the time it filed its application, nor does it now, have a *bona fide* intention to use the mark MONT BLANC.

We therefore conclude that opposer has demonstrated, as a matter of law, that it is entitled to summary judgment on the ground that applicant did not have at the time the application was filed (nor does it continue to have), the required *bona fide* intent to use the mark in commerce with the goods described in the involved application.

Accordingly, opposer's motion for summary judgment is **GRANTED** on its claim that applicant lacked a *bona fide* intent to use the mark MONT BLANC in commerce on the application filing date. Opposer is allowed until **TWENTY DAYS** from the mailing date of this order to inform the Board whether it wishes to go forward on its likelihood of confusion and dilution claims. If opposer fails to so advise the Board, or advises the Board that it does not wish to go forward with either of those claims, the opposition will be sustained as to the claim that applicant lacked a *bona fide* intent to use its mark in commerce and will be dismissed as to the Section 2(d) and dilution claims.

This proceeding remains otherwise SUSPENDED.

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