

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

Skoro

Mailed: April 15, 2010

Opposition No. 91187852

Padres L.P.

v.

Rene Galvan Munoz

**Before Grendel, Holtzman and Wellington,
Administrative Trademark Judges.**

By the Board:

On March 27, 2008 Rene Galvan Munoz (hereinafter "applicant") filed an application to register the mark FEAR THE FRIARS for "Golf shirts; polo shirts; T-shirts, hooded sweat shirts, sweat jackets, sweat pants, sweat shirts, hats, beanies, and sports jerseys" in Class 25.¹ Padres L.P. (hereinafter "opposer") filed a notice of opposition on December 3, 2008 alleging (1) a likelihood of confusion with its Federal Registrations for FRIARS; and (2) a false suggestion of a connection with opposer. On October 24, 2009 an amended notice of opposition was filed to add the ground that applicant lacked a bona fide intent to use the mark in commerce when the application was filed. Applicant

¹ Serial No. 77432841, claiming a bona fide intent to use the mark in commerce.

answered the amended notice of opposition by denying the salient allegations thereof.

On January 11, 2010, opposer filed the motion for summary judgment that is now before us.² Applicant has responded.

Bona Fide Intent to Use

Opposer's motion for summary judgment is based on the newly added ground that applicant lacked the requisite bona fide intent to use the mark in commerce at the time of filing his application. In support of its motion for summary judgment, opposer has submitted copies of applicant's discovery responses.³ Applicant has responded with his own declaration and a TARR database printout of third-party registrations.⁴

² To the extent that the amended notice of opposition pleads three separate grounds of opposition, they are argued in the alternative, and applicant has primarily responded to the argument directed to his bona fide intent, so that ground will be discussed first. Should the Board find that applicant lacks the required bona fide intent to use the mark in commerce, the application will be rendered void ab initio and the remaining grounds for opposition rendered moot.

³ Opposer also submitted the declaration of Ethan Orlinsky, Senior Vice-President and General Counsel of Major League Baseball Properties, Inc., which licenses the trademarks of opposer and other major and minor league clubs. Mr. Orlinsky attests to opposer's ownership of its "Swinging Friar" mascot marks. As a reply, Mr. Orlinsky attested to a TARR database printout of opposer's claimed registrations and a representative sample of opposer's FRIAR mark on a baseball cap, asserted to be sold to the public prior to applicant's constructive use date.

⁴ Applicant argues that these third-party registrations appear to be related to nicknames of professional sports teams, but not owned by those teams.

In support of its motion, as noted above, opposer has submitted applicant's written responses to opposer's discovery requests. Opposer maintains that applicant's discovery responses demonstrate a *prima facie* case that applicant lacked a bona fide intent to use the mark when it filed its application. Opposer further contends that applicant's mere statements of subjective intention, without more, are insufficient to establish applicant's bona fide intent to use the mark in commerce in the United States. Opposer concludes that the absence of any other documentary evidence prepared, created or produced prior to the filing date of the application or subsequent thereto, demonstrates applicant's lack of the requisite bona fide intent at the time of filing, rendering the application *void ab initio*, and that it is entitled to judgment in its favor as a matter of law.

Applicant contends, on the other hand, that he has not "published" any of his thoughts on how he would proceed with marketing and selling of his claimed products, until he is granted a registration, to avoid any trademark infringement actions. (Munoz Dec. ¶¶ 6, 7).

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). In considering

the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, and all justifiable inferences are to be drawn in the nonmovant'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. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a general rule, and as noted by applicant, the factual question of intent is particularly unsuited to disposition on summary judgment. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). The Board has held, however, 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,⁵ unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary

⁵ Lanham Act § 1(b) states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark.

evidence. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

At the outset, it is noted that opposer has properly pleaded its standing by its allegations that it uses the mark FRIAR, has a mascot known as the Swinging Friar, and has current registrations for the same. Further, opposer has provided evidence of its current use of its mark, FRIAR, for baseball caps as well as copies of its registrations. (Ex. A to reply). Thus, opposer has established its personal stake in this matter and there is no genuine issue of material fact as to opposer's standing to bring this opposition. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

In determining the sufficiency of documentary evidence needed to demonstrate bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994).⁶

⁶ The Board found that correspondence drafted by applicant in which it sought to license its mark and which was dated ten

In this case, opposer has proffered documents that applicant provided to opposer through discovery, which include applicant's interrogatory responses and document production (or lack thereof) which, opposer asserts, demonstrates that applicant has no current business plans, ongoing discussions, promotional activities, or anything else to corroborate his claim of a bona fide intent to use the mark in commerce in the United States. Specifically, opposer points to applicant's responses to interrogatories numbered 4, 5, 9, 10, 13, and 15-18 in which applicant states he has made no use of the mark, has no licenses; has not promoted or advertised the mark; made no trademark search before adopting the mark; has no website; no designs or logos; has no sample products and no plans to market the goods or services.⁷

Applicant has countered the motion with statements of subjective intent.⁸ Specifically, in applicant's

months after the filing of applicant's application served to corroborate applicant's bona fide intention to use its mark.

⁷ Opposer also notes that applicant's responses to opposer's requests for admissions states that he intended his goods and services "would be marketed to the fans of opposer's team"; and that his mark is a rallying cry/slogan/expression of fan support for opposer's team. (Req. for Admissions Nos. 10 and 11). These admissions go to the alternative issues of a likelihood of confusion and false suggestion of a connection.

⁸ We have considered the arguments of applicant's counsel reciting the legislative history and Congressional statements regarding "intent". However, since the passage of the legislation, the USPTO has had considerable experience in evaluating what applicants have shown to establish a bona fide

declaration filed in response to the motion for summary judgment, applicant states he "has not published any of his thoughts on how he would proceed with marketing and selling the products covered by his application to avoid a trademark infringement suit" (Munoz Dec. ¶ 6) and he has "made plans on how [he] would proceed if granted the mark, but have not put those thoughts down on paper." (Munoz Dec. ¶ 7).

Federal Rule of Civil Procedure 56(c) provides:

"...The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law."

Federal Rule of Civil Procedure 56(e) requires a nonmoving party to go beyond the pleadings and to designate "specific facts showing that there is a genuine issue for trial."

Celotex Corp. v. Catrett, 477 US 317, 324 (1986).

In his response to the motion, applicant has not provided any exhibits that provide any additional, relevant information in support of his declaration, nor identified those portions of the record before the Board that demonstrate that he manufactures or has the ability to manufacture clothing. Rather, applicant simply states that

intent to use a mark on goods in commerce. See, e.g., *Honda Motors v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).

he has not taken any steps toward use of the mark in order to avoid possible infringement.

Opposer has established that there is no genuine issue of material fact that applicant lacks documentary evidence to support his claim of bona fide intent in his application, a fact which establishes, prima facie, that applicant lacked the requisite bona fide intent when he filed his application. See *Commodore Electronics, supra*, at 1507. If unrebutted, opposer's showing suffices to establish opposer's entitlement to summary judgment on the bona fide intent claim. To raise a genuine issue of material fact to counter opposer's summary judgment showing, applicant must point to specific evidence in the summary judgment record that he might present at trial to explain or outweigh his lack of documentary evidence of bona fide intent, or which would otherwise establish that he had the requisite bona fide intent to use the mark when he filed the application. Applicant has failed to identify any such evidence here. His mere statements of subjective intent do not suffice to establish bona fide intent. Moreover, applicant has not shown that he is in the business of or capable of marketing the clothing identified in his application, a fact which weighs against a finding of bona fide intent. See *Honda Motors v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587

(TTAB 2008) (no bona fide intent found because there was no relevant business established). Finally, applicant's statement that he lacks documentary evidence because he wanted to avoid a possible infringement action does not establish that he had a bona fide intent to use the mark when he filed the application. *Cf. L.C. Licensing v. Berman*, 86 USPQ2d 1883, 1892 (TTAB 2008) ("Applicant's decision to forgo a business model until after the opposition is decided does not explain his failure to have any documents whatsoever at the time the application was filed that showed an intent to use the mark.") In short, we find that there is no genuine issue of material fact as to opposer's bona fide intent claim, and that opposer is entitled to judgment as a matter of law on that claim. Accordingly, we grant opposer's motion for summary judgment on its bona fide intent claim.

In that this decision renders the application *void ab initio*, the Board does not have to reach the issues of whether there will be a likelihood of confusion or the false suggestion of a connection with opposer. Both issues are rendered moot. The opposition is sustained, and registration is refused to applicant.

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