

This Opinion is Not a
Precedent of the TTAB

Mailed: November 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hard Candy Cases, LLC

v.

Hard Candy, LLC

Opposition No. 91195328
to Application Serial No. 77700557

Stuart J. West of West & Associates, PC for Hard Candy Cases, LLC.

Gabriel Groisman of Coffey Burlington for Hard Candy, LLC.

Before Bucher, Ritchie and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Hard Candy, LLC (“Applicant”) seeks registration of the mark HARD CANDY, in standard characters, for “leather goods, namely, backpacks, leather bags, suitcases, wallets, leather cases, leather handbags, leather key chains, leather pouches, traveling bags; purses.”¹ In its notice of opposition, Hard Candy Cases, LLC (“Opposer”) alleges that it is “actively engaged in the business of

¹ Application Serial No. 77700557, filed March 27, 2009 under Section 1(b) of the Trademark Act, based on Applicant’s alleged *bona fide* intent to use the mark in commerce.

manufacturing, distributing and selling computing device, mobile telephone and personal digital assistant (PDA) cases, coverings, and shells under the marks ‘Hard Candy’ and ‘Hard Candy Cases,’” and that it owns application Serial No. 77917147 for the mark HARD CANDY CASES.² Notice of Opposition (“NOO”) ¶ 1. As grounds for opposition, Opposer alleges that “at the time of filing its intent-to-use application ... Applicant did not have a bona fide intent-to-use [its] mark in connection with at least some of the goods identified” therein. *Id.* ¶ 9. Opposer more specifically alleges that “Applicant has exhibited a pattern and practice of filing multiple intent-to-use trademark applications across multiple classes of goods and subsequently abandoning the underlying applications for failure to file statements of use.” *Id.* ¶ 8. In its answer, Applicant denies the salient allegations in the NOO, and raises several affirmative defenses which it did not pursue or prove at trial, and which are accordingly waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

The Record and Evidentiary Objections³

The record consists of the pleadings, the file of the involved application and the following:

² Opposer did not make its pleaded application of record.

³ This proceeding was formerly consolidated with Opposition No. 91195327 to Applicant’s application Serial No. 77700559, but the Board sustained that opposition on February 11, 2014 after Applicant withdrew the involved application without Opposer’s consent. The parties filed certain evidence applicable to both proceedings in Opposition No. 91195327 only, and we have considered that evidence as it applies to this proceeding.

Opposer's notice of reliance ("NOR") No. 1 on the prosecution histories of a number of Applicant's uninvolved applications (TTABVue Dkt. No. 31 in Opposition No. 91195327);

Opposer's NOR No. 2 on the prosecution histories of a number of Applicant's uninvolved applications (TTABVue Dkt. No. 33 in Opposition No. 91195327);

Opposer's NOR No. 3 on the prosecution histories of a number of Applicant's uninvolved applications (TTABVue Dkt. No. 34 in Opposition No. 91195327);

Opposer's NOR No. 4 on the prosecution histories of a number of Applicant's uninvolved applications (TTABVue Dkt. No. 35 in Opposition No. 91195327);

Opposer's NOR No. 5 on the prosecution histories of a number of Applicant's uninvolved applications (TTABVue Dkt. No. 36 in Opposition No. 91195327);

Opposer's testimonial depositions of David Adam, its Vice President of Design ("Adam Tr."), and Timothy Hickman, its Chief Executive Officer ("Hickman Tr."), and the Exhibits thereto (TTABVue Dkt. No. 41 in Opposition No. 91195327); and

Applicant's testimonial deposition of Jerome Falic, its Chief Executive Officer ("Falic Tr.") and the Exhibits thereto (TTABVue Dkt. No. 15 in Opposition No. 91195328).

Each party raises a large number of objections to portions of the testimony, but for the most part the objections are inapplicable, misstated or go to the weight, rather than admissibility, of the evidence. For example, the parties object to certain questions about the contents of documents of record, but the parties appear to agree that the documents "speak for themselves," and in any event a witness's understanding of a document may be relevant, especially in this case where

Applicant's intent or lack thereof is the basis for the opposition. Each party objected to a number of questions as "lacking foundation," but in response to each other's objections point out that the witnesses' personal knowledge is established by their positions within each company and their testimony. The objections that certain questions "call for a legal conclusion," are inapposite where: (1) the witnesses were asked for their "understanding," of, for example, what types of goods are covered by certain International Classes, because a layperson's understanding of a fact is not a "legal conclusion"; or (2) witnesses were asked whether a party had an "intent" to use a mark for a certain product, because the question is not whether the intention to use qualifies as *bona fide* under the Trademark Act, but instead merely whether a party sought to do something. No questions posed during testimony were so "vague" or "ambiguous" as to warrant sustaining the objection or excluding the evidence. All questions objected to as "lacking a time frame" were sufficiently clear as to the period to which they pertained, as "is," "was" and "as of the date of this document" have well-understood meanings. And while it would certainly make for succinct testimony if we were to exclude all answers to questions that were previously "asked and answered," restating questions, particularly for the sake of clarity and probative value, is a time-honored and common examination technique and other than increasing the size of records is generally harmless and even potentially helpful if properly managed. Finally, a question such as "what did this mean as you understood it?" does not call for "speculation." In short, as to all of these objections "we simply accord the evidence whatever probative value it

deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.” *Hunt Control Systems Inc. v. Koninkijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011).

There is one objection, however, which is applicable, appropriate and goes to the admissibility of the evidence in question. Applicant introduced as Exhibit 13 to the Falic deposition a document which “shows various handbags and leather goods ... that we can produce of Hard Candy for Walmart,” but did not produce the document in discovery. Falic Tr. at 37-38 and Ex. 13. As set forth in the Board’s December 9, 2013 order denying Opposer’s motion to compel: “It is understood, therefore, that applicant has no other documents, other than those already produced to opposer, which could be used to demonstrate that at the time the subject applications were filed, applicant had a *bona fide* intent to use the mark HARD CANDY in commerce with the goods identified in the involved applications.” Order of December 9, 2013 at 7. The order specifically indicated that if Applicant were to attempt to introduce at trial such documents “which were not previously produced and should have been, opposer’s remedy lies in the filing of a motion to strike,” *id.* n.3, and here Opposer has moved to strike Exhibit 13 and all related testimony. Opposer’s Trial Brief at 16. Because Opposer requested the document in discovery and Applicant failed to produce it during discovery or following Opposer’s motion to compel,⁴ the objection

⁴ See Memorandum in Support of Opposer’s June 25, 2013 motion to compel Ex. B (Request for Production No. 31).

is sustained and the motion to strike is granted. *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); TBMP § 527.01(e) (2014). Exhibit 13 to the Falic deposition and Mr. Falic’s related testimony have been given no consideration.

The Parties

Opposer offers protective cases for consumer electronics, such as laptop computers, smartphones and other devices. It offered its first product in the Fall of 2009. Prior to Opposer’s formation, its CEO Mr. Hickman worked for high technology companies, and then gained experience with “package goods” used in connection with consumer electronics. Hickman Tr. at 4-6, 8; David Tr. at 6-7, 9.

Applicant was formed in 2008 or 2009, but Mr. Falic claims that “we” purchased the HARD CANDY trademark several years prior to that. Falic. Tr. at 5-6.⁵ Applicant “develops and licenses various products,” *id.* at 5, and “today has a very extensive cosmetic and fragrance brand in all – almost all Walmart doors throughout the U.S. and Canada. Hard Candy also has other categories such as sunglasses, cosmetic bags and apparel all across Walmart doors.” *Id.* at 7.

Evidence Related to Applicant’s Intent to Use HARD CANDY for Leather Goods

Opposer argues that the prosecution histories for a large number of Applicant’s uninvolved intent to use applications, summarized below, reveal “a pattern and

⁵ Mr. Falic did not explain the circumstances surrounding the purchase or any use of the trademark prior to Applicant’s formation.

practice of the filing of a high volume of applications with a disparate variety of goods absent a demonstrable *bona fide* intent-to-use:⁶

<u>Mark/</u>	<u>Serial No. / Filing Date</u>	<u>Goods</u>	<u>Status</u>
HC	75136497 July 19, 1996	Clothing	Abandoned for failure to file a Statement of Use
HARD CANDY	75136451 July 19, 1996	Clothing	Abandoned for failure to file a Statement of Use
	75136495 July 19, 1996	Clothing	Abandoned for failure to file a Statement of Use
	75223383 Jan. 9, 1997	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	75223386 Jan. 9, 1997	Eyeglasses	Abandoned for failure to file a Statement of Use
	76095853 July 25, 2000	Eyeglasses	Abandoned for failure to file a Statement of Use
	76095861 July 25, 2000	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	76539353 Aug. 1, 2003	Alcoholic beverages,	Abandoned for failure to file a Statement of Use
	77700557 March 27, 2009	Leather Goods	Involved Application
	78441211 June 25, 2004	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	78441342 June 25, 2004	Eyeglasses	Abandoned for failure to file a Statement of Use
	77511318 June 30, 2008	Eyeglasses	Registered ⁷ Reg. No. 4128991
	77551700 Aug. 20, 2008	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use

⁶ While some of the listed applications were filed by Hard Candy, Inc., Applicant has the same address as Hard Candy, Inc., and in many cases acquired the applications by assignment from Hard Candy, Inc. Other applications were assigned from Applicant to nonparty Urban Decay Cosmetics, LLC which apparently had or has some relationship to Applicant. In any event, Applicant does not deny that it owned or owns these applications or that most of them were ultimately abandoned.

⁷ In its NOR No. 5, Opposer indicates that the relevance of this registration is that it provides “[d]emonstrative evidence of suspect images provided in association with statement of use.” However, the allegation is not explained, and the images submitted do not appear “suspect” in and of themselves.

<u>Mark/</u>	<u>Serial No. / Filing Date</u>	<u>Goods</u>	<u>Status</u>
	77551710 Aug. 20, 2008	Eyeglasses	Expressly abandoned
	77700552 March 27, 2009	Kids' school supplies	Abandoned for failure to file a Statement of Use
	77700551 March 27, 2009	Bed linens, towels, curtains	Extension of Time to File Statement of Use Requested
	77700553 March 27, 2009	Candy	Abandoned for failure to respond to an Office Action
	77700558 March 27, 2009	Clothing	Request to Divide Indicates Mark in Use for Some of the Identified Goods; NOR Filed Prior to Submission of Any Statement of Use
	77700560 March 27, 2009	Picture frames	Abandoned for failure to file a Statement of Use
	77700562 March 27, 2009	Snack foods and desserts	Extension of Time to File Statement of Use Requested
	77700563 March 27, 2009	Toys, namely, children's dress-up accessories	Extension of Time to File Statement of Use Requested
	77700564 March 27, 2009	Beverages, water, juices, supplements	Extension of Time to File Statement of Use Requested
	77700565 March 27, 2009	Furniture	Abandoned for failure to file a Statement of Use
HARD ♡ CANDY	75223385 Jan. 9, 1997	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	75223387 Jan. 9, 1997	Eyeglasses	Abandoned for failure to file a Statement of Use
	75223384 Jan. 9, 1997	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	75223388 Jan. 9, 1997	Eyeglasses	Abandoned for failure to file a Statement of Use
	75715785 May 27, 1999	Perfume, cologne, toilet water and essential oils	Abandoned for failure to file a Statement of Use
	76095852 July 25, 2000	Eyeglasses	Abandoned for failure to file a Statement of Use
	76095857 July 25, 2000	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use

<u>Mark/</u>	<u>Serial No. / Filing Date</u>	<u>Goods</u>	<u>Status</u>
	78488630 Sept. 23, 2004	Eyeglasses	Abandoned for failure to file a Statement of Use
	77552278 Aug. 21, 2008	Eyeglasses	Abandoned for failure to file a Statement of Use
	77832682 Sept. 23, 2009	Clothing	Extension of Time to File Statement of Use Requested
HARD ♥ CANDY	76095850 July 25, 2000	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	76095855 July 25, 2000	Eyeglasses	Abandoned for failure to file a Statement of Use
	78441354 June 25, 2004	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	78481659 Sept. 10, 2004	Eyeglasses	Abandoned for failure to file a Statement of Use
	77511309 June 30, 2008	Jewelry, watches & clocks	Abandoned for failure to file a Statement of Use
	85092902 July 26, 2010	Leather goods	Application suspended ⁸
	85092904 July 26, 2010	Beverages, water, juices, supplements	Extension of Time to File Statement of Use Requested
	85092905 July 26, 2010	Kids' school supplies	Extension of Time to File Statement of Use Requested
	85092911 July 26, 2010	Consumer electronics	Application suspended
	85092915 July 26, 2010	Cosmetics; fragrances	Registered ⁹ Reg. No. 4218371
	85092917 July 26, 2010	Snack foods and desserts	Extension of Time to File Statement of Use Requested

⁸ It appears from Opposer's brief that the applications not listed here as "abandoned for failure to file a Statement of Use" may have been abandoned for that reason, but not until after Opposer submitted the file histories during its trial period. For purposes of this decision, we assume that any of the marks not listed as "registered" were abandoned for failure to file a Statement of Use.

⁹ In its NOR No. 3, Opposer indicates that the relevance of this registration is that it provides "[d]emonstrative evidence of suspect images provided in association with statement of use." However, the allegation is not explained, and the images submitted do not appear "suspect" in and of themselves.

<u>Mark/</u>	<u>Serial No. / Filing Date</u>	<u>Goods</u>	<u>Status</u>
	85092919 July 26, 2010	Toys, namely, children's dress-up accessories	Extension of Time to File Statement of Use Requested
	85093032 July 26, 2010	Clothing	Extension of Time to File Statement of Use Requested
	85093035 July 26, 2010	Jewelry, watches & clocks	Extension of Time to File Statement of Use Requested
	85093041 July 26, 2010	Furniture; picture frames	Extension of Time to File Statement of Use Requested
	85093043 July 26, 2010	Bed linens, towels, curtains	Extension of Time to File Statement of Use Requested
	85205945 Dec. 27, 2010	Cosmetic bags & cases sold empty	Registered ¹⁰ Reg. No. 4143693

Applicant argues that it had a *bona fide* intent to use the involved mark for leather goods at the time it filed its involved application and thereafter. According to Mr. Falic, while Applicant “has a very extensive cosmetic and fragrance brand in all – almost all Walmart doors throughout the U.S. and Canada,” Applicant’s product line has expanded and now “also has other categories such as sunglasses, cosmetic bags and apparel all across Walmart doors.” Falic Tr. at 7. Applicant also sells “some iPhone cases and iPad cases.” *Id.* at 8. Mr. Falic testified that Applicant first began selling its products in Walmart stores in 2008. *Id.*

With respect to leather goods specifically, Mr. Falic testified that Applicant had an intent “to create a line of leather goods and purses to sell into and add into the categories that we carry at Walmart.” *Id.* at 13-14. “Around” the time it filed the

¹⁰ In its NOR No. 4, Opposer indicates that the relevance of this registration is that it provides “[d]emonstrative evidence of suspect images provided in association with statement of use.” However, the allegation is not explained, and the images submitted do not appear “suspect” in and of themselves.

involved application, Applicant “created some diagrams, some samples [for leather goods], that we did take over to Walmart and we presented it to the various buyers at Walmart,” and Applicant has continued to take steps to use the involved mark for leather goods since the involved application’s filing date. *Id.* at 14.

Applicant relies on several documents in support of its claim that it had a *bona fide* intent to use its mark for leather goods, but only one of them predates the filing date of the involved application. Specifically:

February 3, 2009 email from Debra Restler, Director, Business Development & Marketing, The Beanstalk Group to Mr. Falic Attaching Licensing Representation Proposal

This email, which preceded Applicant’s filing of the involved application, states “It was a pleasure seeing you last week. After all of our phone calls and emails, I’m so glad we were able to schedule the meeting. Attached please find Beanstalk’s Licensing Representation Proposal for Hard Candy for your review.” Falic Tr. Ex. D. Beanstalk’s attached proposal¹¹ offers to “manage the daily complexities and demands of the [licensing] program – including licensee selection and retail coordination ...,” and states as a goal “to extend Hard Candy into a lifestyle brand,” which according to Mr. Falic “are the brands that various retailers are taking in today where they expand one of their brands into various categories and they go into leather goods, jewelry, handbags, watches, and so on.” *Id.* at 17 and Ex. D. However, as Opposer points out, the only product specifically mentioned in the proposal is cosmetics.

¹¹ While the proposal attached to the e-mail is dated February 14, 2013 on page 1, it is dated January 29, 2009 on the remaining pages.

Mr. Falic testified that prior to Beanstalk sending the February 3, 2009 email, Applicant met with Beanstalk in New York, and “had a few phone calls and e-mails in exchange regarding the Hard Candy brand.” *Id.* at 15-16. Beanstalk’s proposal was “to help us develop Hard Candy, various products of Hard Candy through a licensing program,” including handbags and purses; Applicant specifically “discussed leather handbags, purses and many other categories” with Beanstalk. *Id.* at 16-17. Ultimately, however, Applicant did not hire Beanstalk. *Id.* at 17.

October 7, 2009 email from Stu Dolleck, President Nu World Beauty to Mr. Falic Attaching “Rough Concepts” Document

This brief cover email attaches an unlabeled document which features what appear to be photographs of a variety of products bearing the HARD CANDY mark, including handbags. The email states “These are strictly for discussion to give [Walmart] a feel for the depth of the brand. We are still working on others and the overall presentation format. Just wanted you to see some of the preliminaries’ (sic).” *Id.* at 19-20 and Ex. 4.

According to Mr. Falic, Nu World is one of Applicant’s licensees that “manufactures and distributes and licenses various cosmetic products.” *Id.* at 18. Mr. Dolleck’s email was “to start work on presenting Walmart with various other accessories, such as handbags and leather goods.” Nu World prepared the product images, possibly with help from Allegro, another of Applicant’s licensees which “produced and sold into Walmart cosmetic bags at the time.” *Id.* at 19.

May 24, 2010 email from Dianna Ruth to Mr. Falic Attaching “Hard Candy Lifestyle deck”

Ms. Ruth “is from Nu World from Stu Dolleck’s office.” *Id.* at 20 and Ex. 5. According to Mr. Falic, a “lifestyle deck” is “a group of concepts, ideas. You put them together, in this case, with photographs to be able to make a presentation.” *Id.* The products in the lifestyle deck from Nu World include “bath products, fragrances, apparel, hats, shoes, handbags, leather goods, sunglasses, jewelry, watches and some candles and some stationary,” as well as “a leather case for sunglasses,” with the leather goods and handbags bearing the HARD CANDY mark. *Id.* at 21. The presentation/lifestyle deck was prepared for Walmart. *Id.* at 22.

Hard Candy Licensing Term Sheet Executed August 17, 2010

This document granted Allegro “the non-exclusive right to use” HARD CANDY trademarks for “cosmetic bags, cosmetic cases, hand bags” in the United States, with sales “limited exclusively to Walmart and/or Walmart affiliates.” *Id.* at 22 and Ex. 6.¹² The license term is from January 1, 2010 through December 31, 2013. According to Mr. Falic, Allegro “is the company that made ready cosmetic bags for Walmart and sold them; cosmetic bags, cosmetic cases and they were also interested in doing handbags as well for Walmart.” *Id.* at 22. Allegro “created samples. They made diagrams, created samples for our approval and then they showed them to – they presented them to Walmart,” including samples of leather goods and purses. *Id.* at 23.

¹² Mr. Falic testified that the document was signed by Nu World and Allegro, Falic Tr. at 22, but did not explain if Nu World was sublicensing rights granted to it by Applicant, or identify any licensor of rights in the HARD CANDY mark.

August 2 and 3 and October 19, 2011 Emails from Alberto Kamhazi to Mr. Falic

These emails include attached pictures and price estimates from Supply 26 for a leather iPad tablet case. *Id.* at 23-28 and Exs. 7-9. According to Mr. Falic, Applicant took its initial steps to produce “Hard Candy branded cell phone and iPad cases” at the time of this email, and “actually produced product in 2013.” *Id.* at 25, 28.

2012 Emails at Exs. 10-12

A series of 2012 emails establishes that Applicant engaged in similar efforts to develop and sell leather goods through 2012. In fact, Applicant met with a Walmart buyer concerning leather handbags and other products in 2012, and provided her with product samples. *Id.* at 35-37.

Standing

At the time it filed the NOO, Opposer offered, and continues to offer, protective cases for consumer electronics, under the mark HARD CANDY. Hickman Tr. at 4-11 and Exs. 1, 2. Applicant seeks registration of the same mark for related goods. Accordingly, Opposer has demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and has a reasonable basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ 1023 (Fed. Cir. 1999); *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-190 (CCPA 1982); *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1978 (TTAB 2010); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby

established his standing to bring this proceeding.”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009).

Whether Applicant Had a *Bona Fide* Intention to Use Its Mark

“[T]he determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances.” *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993). Opposer bears “the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods.” *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). Opposer may meet this burden by establishing that there is an “absence of any documentary evidence on the part of [Applicant] regarding such intent.” *Commodore*, 26 USPQ2d at 1507.

If Opposer meets its burden, Applicant may “elect to try to rebut the opposer’s prima facie case by offering additional evidence concerning the factual circumstances bearing upon its intent to use its mark in commerce.” *Id.* at 1507 n.11. However, 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.” *Lane*, 33 UPQ2d at 1355.

Here, Opposer strenuously argues that there is an absence of any documentary evidence regarding Applicant’s intent to use the mark, by which it means that there is an absence of documentary evidence which *predates Applicant’s filing date and*

*explicitly pertains to leather goods.*¹³ However, we disagree with Opposer's premise that Applicant's documentary evidence is of no probative value merely because leather goods are not mentioned specifically or because most of Applicant's documents postdate the filing of the involved application.

With respect to some of the documents not mentioning leather goods specifically, they still make clear that Applicant was considering whether to attempt to, as stated in one document, "extend HARD CANDY into a lifestyle brand." Falic Tr. Ex. D. And Mr. Falic testified that "lifestyle brands" are those which are expanded into "leather goods, jewelry, handbags, watches, and so on." Applicant's documents and this testimony are consistent with and bolster each other. The documents make clear that Applicant's intention in talking to potential licensees and representatives was to expand HARD CANDY from cosmetics to other products. They also strongly suggest that Applicant was more concerned with expanding its brand generally, rather than necessarily expanding into one or more specific categories. In fact, the testimony and documents reveal that the crux of Applicant's efforts was expansion into those product lines which Walmart would agree to purchase and sell, whether leather goods, jewelry, watches or perhaps something else. Applicant ultimately succeeded in expanding its use of HARD CANDY into "other categories such as sunglasses, cosmetic bags and apparel," Falic Tr. at 7, and that would not have happened unless Applicant intended it to happen.

¹³ Obviously, as set forth above, there are documents related to Applicant's intent to use HARD CANDY, but Opposer's focus is on whether those documents precede the filing date of the involved application and explicitly establish Applicant's intent to use HARD CANDY for leather goods.

More importantly, while the February 3, 2009 email and attached proposal do not mention leather goods specifically, Mr. Falic's testimony that Applicant and Beanstalk "discussed leather handbags, purses and many other categories," Falic Tr. at 16-17, is credible and supported by several other documents of record. For example, the October 7, 2009 e-mail from Nu World Beauty attached photographs of handbags, and the May 24, 2010 "lifestyle deck" includes leather goods. Falic Tr. Exs. 4 and 5. It is clear from this evidence that leather goods were high on the list of additional products Applicant desired to sell. While Applicant's intention to offer leather goods appears to have been largely contingent on Walmart's agreement to purchase those products, that is consistent with a *bona fide* intention to use. *See, Commodore*, 26 USPQ2d at 1507 n.7 (quoting legislative history of Trademark Law Revision Act of 1988, which states "An applicant's bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing).").

Opposer's argument that the October 7, 2009 and May 24, 2010 documents are not relevant because they postdate the involved application's filing date is not well-taken. Indeed, in *Lane*, we granted summary judgment in the applicant's favor, finding that its evidence constituted "credible, objective corroboration of its statement in the application that it had a bona fide intention to use the mark in commerce on tobacco," even though the documentary evidence postdated the filing of the application by 9-11 months.

[W]e find that this correspondence, which occurred in October – December 1992, was sufficiently

contemporaneous to the application filing date in January 1992 to serve as corroboration of the applicant's declaration in the application ... Neither the statute nor the Board's decision in *Commodore Electronics* expressly imposes any specific requirement as to the contemporaneousness of an applicant's documentary evidence

Lane, 33 USPQ2d at 1356.

Furthermore, in *Lane* we recognized that whether an applicant's intention to use is legitimate "will vary depending on the practices of the industry involved, and should be determined based on the standards of that particular industry." *Id.* at 1355 (citing legislative history of the Trademark Law Revision Act of 1988). Here, Mr. Falic's uncontradicted testimony strongly suggests that in the "lifestyle brand" industry, developing and expanding the brand is more important than focusing on any particular product at a particular time. While Applicant's focus at the time it filed its application may have been more on expansion generally than on leather goods specifically, that does not mean that Applicant's intent to use its mark on leather goods (and other products) was not *bona fide*. To the contrary, the evidence establishes that Applicant had a *bona fide* intention to use HARD CANDY for leather as well as other goods.

Here, as in *Lane*, Applicant's experience and demonstrated ability to produce consumer products under the HARD CANDY mark weigh in favor of finding that it had a *bona fide* intention to use the mark for leather goods. This is especially so where Applicant's products, starting with cosmetics and expanding more recently into sunglasses, cosmetic bags and apparel, have been sold in the large, national

chain of Walmart stores.¹⁴ *See id.* at 1356. It is entirely credible, and the evidence indicates, that Applicant did not just seek to expand into sunglasses, cosmetic bags and apparel, but also other products, including leather goods.¹⁵

We recognize that the abandonment of multiple intent to use applications for failure to file a statement of use may, in certain circumstances, be evidence that an applicant lacked a *bona fide* intent to use. *See, Lane*, 33 USPQ2d 1355 (quoting legislative history of Trademark Law Revision Act of 1988). However, we do not find Applicant's evidence of a *bona fide* intent to use HARD CANDY for leather goods outweighed by the admittedly long list of its abandoned intent to use applications for other products. Indeed, under the circumstances of this case, even if Applicant did not have a *bona fide* intention to use its HARD CANDY marks for alcoholic or other beverages, furniture or food, it would not necessarily follow that Applicant also did not have a *bona fide* intent to use HARD CANDY for leather goods, which are more similar to Applicant's existing products. And even if Applicant ultimately abandons the involved application as well, that would not mean that Applicant did not have a *bona fide* intent to use the mark at the time it filed the application. *See generally, Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007) (“Merely because applicant may not have taken steps to actually launch or introduce a particular product does not mean that applicant otherwise had no

¹⁴ Opposer's evidence reveals that Applicant owns registrations for its HARD CANDY marks for cosmetics and fragrances (Reg. No. 4218371), cosmetic bags and cases (Reg. No. 4143693) and eyeglasses (Reg. No. 4128991).

¹⁵ Even if Opposer was found to have established a *prima facie* case of no *bona fide* intent to use, we would find that case rebutted by Applicant's evidence.

intention to develop or market the product.”). Intent to use applications are often abandoned, for a variety of legitimate reasons. The point, however, is that here it is clear (and undisputed) that Applicant sought to (and in fact did) expand its use of HARD CANDY from cosmetics to other products, and at the time it filed its involved application and for months or years thereafter it intended for its product expansion to include leather goods.

Conclusion

Opposer’s affirmative evidence is limited to abandoned applications for registration of Applicant’s mark for goods other than those at issue here, and to the extent that evidence suggests that Applicant lacked a *bona fide* intent to use its mark for the goods in the abandoned applications, it is outweighed by Applicant’s testimony and documentary evidence which establish its *bona fide* intention to use its mark for the leather goods at issue in this case.

Decision: The opposition is dismissed.