

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: November 9, 2015

Opposition No. 91215976


Carl Walther GmbH, Umarex Sportwaffen
GmbH & Co., KG

v.

Catharina Herriger

Before Seeherman, Quinn, and Shaw,
Administrative Trademark Judges.




By the Board:

Catharina Herriger (“Applicant”) filed, on June 20, 2013, intent-to-use applications to register the mark WALTHER in standard character form¹ (“Applicant’s word mark”) and the following design mark, , (“Applicant’s design mark”),² both for “[j]ewellery and watches” in International Class 14.

Carl Walther GmbH (“Walther”) and its asserted “related party,” Umarex Sportwaffen GmbH & Co. KG (“Umarex”), (collectively “Opposers”), filed a notice of opposition to registration of Applicant’s marks on the grounds of likelihood of confusion and dilution. In particular, Opposers have alleged previous use and registration of several WALTHER marks, including Walther’s design mark

¹ Application Serial No. 85965933.

² Application Serial No. 85965968.

 for “[t]oy weapons, namely, toy replicas of weapons” in International Class 28 and its mark WALTHER and design in the following form, , for “[s]port knives, knives for use in hunting and fishing, pocket knives” in International Class 8, “[t]elescopes, telescopic gun and lens sights, night glasses for use in hunting” in International Class 9, and “[w]eapons for self defense, namely, pistols” in International Class 13; and Umarex’s mark WALTHER in typed form for “hunting and sport rifles, pistols, revolvers and shot guns” in International Class 13 and for “[t]oy weapons; toy replicas of weapons” in International Class 28 and WALTHER and design in the following form, , for “[t]oy weapons; toy replicas of weapons” in International Class 28. Applicant in her answer denied the salient allegations of the notice of opposition.

In a June 22, 2015 order, the Board: (1) granted Opposers’ motion for leave to file an amended notice of opposition in which they sought to add a claim that Applicant had no bona fide intent to use the marks when she filed her applications; and (2) denied Opposers’ motion for summary judgment on the grounds of likelihood of confusion with regard to Applicant’s design mark and no bona fide intent to use the involved marks as of the applications’ filing date, but (3) granted Opposers’ motion for summary judgment on the ground of likelihood of confusion with regard to Applicant’s word mark.

On July 6, 2015, Opposers filed a request for reconsideration of the June 22, 2015 order with regard to the Board’s denial of the motion for summary judgment

on the ground that Applicant did not have a bona fide intent to use the mark in commerce when she filed the involved applications. The request for reconsideration has been fully briefed.

In the June 22, 2015 order, we found that, because Applicant failed to produce, in response to discovery requests, documents that would support her asserted bona fide intent to use, Opposers had made a *prima facie* showing that Applicant did not have a bona fide intent to use the involved marks when she filed her applications. However, we found that Applicant's response to Opposers' interrogatory no. 15, wherein she states that she "is a trained gemologist and has worked for several Swiss watch and jewelry manufacturers, including Rolex, and as a result has experience in watch and jewelry manufacture," was sufficient to raise a genuine dispute as to whether Applicant had a bona fide intent to use the marks on the identified goods at the time of the filing of the applications. *See Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007). In view thereof, we denied Opposers' motion for summary judgment on their no bona fide intent to use claim.

In support of the request for reconsideration, Opposers contend that the aforementioned interrogatory response was an insufficient basis for finding that there remained a genuine dispute as to whether Applicant had a bona fide intent to use the marks at issue when she filed her involved applications. By so finding, Opposers contend that, by relying on that response, the Board is effectively suggesting that such response may be sufficient to establish at trial a bona fide intent to use the design mark when the involved applications were filed. Opposers

further contend that allowing this proceeding to go forward to trial would be “unduly harsh on Opposers and would establish an incredibly permissive standard for future applicants.”

The Board notes initially that Opposers rely in support of their request for reconsideration upon cases in which final decisions were rendered after trial and do not rely upon decisions in which the Board entered summary judgment for a plaintiff on a claim that the applicant lacked a bona fide intent to use the mark as of the filing date of the application at issue. To prevail at trial, Opposers need only establish lack of a bona fide intent to use by a preponderance of the evidence, whereas, for the Board to grant a motion for summary judgment, Opposers must establish that there is no genuine dispute that Applicant lacked such bona fide intent and that they are entitled to entry of judgment as a matter of law. *Compare SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 USPQ2d 1300 (TTAB 2010), with *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1661 (TTAB 2009). *Cf. Copelands’ Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991) (“As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment.”). Indeed, the Board infrequently grants motions for summary judgment on no bona fide intent to use claims. *But see Honda Motor Co. v. Winkelmann*, 90 USPQ2d at 1664 (motion for summary judgment on no bona fide intent to use claim granted where identified goods were “vehicles for transportation,” but evidence showed, at most, an intent to use the mark in connection with “promotional services for [automobile] dealerships”).

Although Opposers have relied upon our primary reviewing court's recent decision in *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015), in support of the request for reconsideration, the *M.Z. Berger* decision was based in large part on testimony from the applicant's owner and CEO, who "all but conceded that [the applicant] had not yet made a firm decision to use the mark in commerce at the time of its application." *M.Z. Berger & Co.*, 114 USPQ2d at 1899. In the present case, we have no such concession from Applicant.

While admittedly scant, Applicant's statement in response to Opposers' interrogatory no. 15 that she "is a trained gemologist and has worked for several Swiss watch and jewelry manufacturers, including Rolex, and as a result has experience in watch and jewelry manufacture" goes to her capacity to market and/or manufacture the identified goods. Such statement weighs against a finding that an applicant lacked a bona fide intent to use. *See Swatch AG (Swatch SA) (Swatch Ltd.) v. M. Z. Berger & Co.*, 108 USPQ2d 1463, 1477 (TTAB 2013), *aff'd M.Z. Berger & Co. v. Swatch AG*, 114 USPQ2d 1892 (Fed. Cir. 2015); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1443 (TTAB 2012); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007). To find that there is no genuine dispute as to any material fact regarding the no bona fide intent to use claim notwithstanding this statement would essentially be making a finding of fact, which the Board cannot make in deciding motions for summary judgment. *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).

We further note that, in considering the propriety of summary judgment, all evidence must be viewed in a light most favorable to Applicant, as the nonmovant, and all justifiable inferences are to be drawn in favor of Applicant, as the nonmovant. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992). Based on the foregoing, Opposers have failed to persuade us that our denial of the motion for summary judgment on the ground of no bona fide intent to use was in error, and the request for reconsideration is therefore denied.³

Proceedings are resumed. Remaining dates are reset as follows.

Plaintiff's 30-day Trial Period Ends	12/22/2015
Defendant's Pretrial Disclosures Due	1/6/2016
Defendant's 30-day Trial Period Ends	2/20/2016
Plaintiff's Rebuttal Disclosures Due	3/6/2016
Plaintiff's 15-day Rebuttal Period Ends	4/5/2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.

³ The Board will not entertain any further arguments concerning the denial of Opposers' motion for summary judgment on the no bona fide intent to use claim. *See* TBMP § 518.