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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91220927
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HEINEKEN ASIA PACIFIC Pte. Ltd.,

Opposer,

v.

JONATHAN CLAYPOOL,

Applicant.

Opposition No. 91220927

Serial No: 86/394137

Mark: TIGER SHARK

OPPOSER’S REPLY IN SUPPORT OF SUMMARY JUDGMENT

In its opening brief, Opposer showed that Applicant has produced no documents to support his “bona fide” intent to use the mark TIGER SHARK for beer. (Dkt. No. 14 at 6-7.) Applicant admitted that “as of **March 28, 2016**—the date of his discovery responses and more than 18 months after he filed the application in September 2014—he ha[d] no “immediate plans” to market beer under the TIGER SHARK mark, and that “[n]o specifics are yet in place’ for the production or offering of beer.” (*Id.* (quoting Applicant’s discovery responses) (emphasis added).)

To avoid summary judgment, Applicant must “come forward with evidence adequately explaining or outweighing the failure to provide such documentary evidence.” *Swatch Ltd. v. M.Z. Berger & Co.*, 108 U.S.P.Q.2d 1463, 1472 (TTAB Sept. 30, 2013); *see also RIM v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 2009 TTAB LEXIS 673, *12 (TTAB 2009) (“The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof that is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce.”). Applicant must produce “**objective**” evidence of his “bona fide” intent to use the applied-for mark for the applied-for goods “in the form of **real life facts and [] actions of the**

applicant, not by the applicant's testimony as to its subjective state of mind.” *Id.* (quoting *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1444 (TTAB 2012)) (emphasis added).

Applicant has no “objective” evidence “rebutting or adequately explaining” his utter lack of documents showing a “bona fide” intent to use the TIGER SHARK mark. Instead, Applicant relies only on his own self-serving Declaration that he had “mental or memorized plans” as well as the filing and prosecution of his TIGER SHARK application to attempt to show a “bona fide” intent to use the TIGER SHARK mark. (Dkt. No. 15 at 2, ¶¶8-14.) Applicant’s self-serving, vague Declaration does not begin to show the requisite “bona fide” intent to use and in any event, conflicts with Applicant’s own sworn discovery responses served less than two months ago and the absence of documents reflecting Applicant’s “bona fide” intent to use the TIGER SHARK mark. Applicant fails to create a genuine issue of fact as to his lack of a “bona fide” intent to use TIGER SHARK and summary judgment must be awarded to Opposer as a matter of law.

I. Applicant’s Self-Serving, Vague Statements Are Not “Objective” Evidence of “Bona Fide” Intent to Use

Applicant concedes that he has no written plans concerning the manufacturing, production, distribution, or sale of beer under the TIGER SHARK mark. (Dkt. No. 15, ¶8.) Applicant has no third-party testimony that Applicant has performed any act in connection with intended use of the TIGER SHARK mark for beer. (*See generally id.*) Instead, Applicant insists in his self-serving Declaration that he has performed “research and development” on making beer. (Dkt. No. 15, Claypool Decl. ¶5.) That testimony is vague as to the timing of the alleged acts, and is not “objective” evidence that Applicant had a “bona fide” intent to use the mark in commerce at the time of filing the application. *See, e.g., Smithkline Beecham Corp. v. Omnisource DDS, LLC*, 97 U.S.P.Q.2d 1300, 1305 (TTAB Nov. 29, 2010) (general statements by applicant’s principal that he

had “contemplated whether the identified goods would be directly marketed by applicant or licensed to a third party and that he considered who would be the intended consumers of the goods fail to demonstrate that applicant possessed a bona fide intent to use [the mark] at the time the application was filed.”); *RIM*, 2009 TTAB LEXIS 673 at *14 (no “bona fide” intent to use where “the record is completely devoid of any evidence such as product design efforts, manufacturing efforts, graphic design efforts, test marketing, correspondence with prospective licenses, preparation of marketing plans or business plans, creation of labels, marketing or promotional materials, and the like.”). Further, Applicant admits that the research and development he allegedly performed was not part of a plan to “‘produce or manufacture’ applicant’s goods.” (Dkt. No. 15, Claypool Decl. ¶ 5.) Thus by Applicant’s own admission, he has taken no steps in connection with using the TIGER SHARK mark on beer in commerce.

Indeed, as Applicant candidly admits, if this alleged research and development related to beer to be sold in commerce under the TIGER SHARK mark, **Applicant would have been compelled to reveal its existence in response to Opposer’s discovery requests.** (*See id.*) For example, Opposer’s Interrogatory No. 7 asks Applicant to “identify and fully describe Applicant’s business plans for advertising, distributing and selling Applicant’s Goods.” (Dkt. No. 14, Ex. 2, No. 7.) In response, Applicant did not provide information about the alleged “research and development” referred to for the first time in his Declaration. Instead, Applicant stated that he **“does not have any immediate plans as yet to market or otherwise refer to products to be offered for sale under the Tiger Shark mark”** and that **“no . . . activities [have been] undertaken with regards to the Tiger Shark mark.”** (*See* Dkt. No. 14 at p.3 and Ex. 5 No. 7 (emphasis added).) Applicant cannot create a genuine issue of material fact by offering a vague and self-serving Declaration that contradicts his prior sworn testimony given less than two months

earlier. *See, e.g., Kabbalah Ctr. Int'l, Inc. v. Kabbalah Diet, L.L.C.*, 2009 TTAB LEXIS 159, *10-11 (TTAB Mar. 25, 2009) (“while [applicant]’s December 2008 declaration indicates that he conducted ‘a great deal of research, study and investigation’ about Kabbalah, prior to the filing of the subject application, in order to ‘develop concepts for the products,’ this declaration testimony is directly contrary to [applicant]’s prior deposition testimony in September 2007”—rejecting statements in declaration and sustaining opposition).¹

Applicant’s alleged “research and development” referred to in his Declaration also conflicts with Applicant’s abject failure to produce any documents concerning such alleged “research and development,” which was responsive to Opposer’s Document Request Nos. 6, 9, 10-13, 18, and 24-25. (*See* Dkt. No. 14 at Exs. 1, 4.) Even now, Applicant produces no documents about the alleged “research and development,” which is compelling evidence that it did not occur and that Applicant lacked a “bona fide” intent to use the TIGER SHARK mark at the time he filed his application. *See PRL USA Holdings, Inc. v. Young*, Opp. No. 91206846, 2013 TTAB LEXIS 548, *13-14 (TTAB Oct. 16, 2013) (applicant’s failure to produce objective documentary evidence in opposition to summary judgment further showed lack of “bona fide” intent to use – granting summary judgment to opposer); *Padres L.P. v. Munoz*, 2010 TTAB LEXIS 106, *9 (TTAB Apr. 15, 2010) (same).

In his Declaration, Applicant also contends that he has a “simple memorized plan” that is a “basic business plan”—but admits that the plan consists of nothing more than producing “excellent beer” with “strong trademarks” and to “finance a small brewery.” (Dkt. No. 15 at ¶6.) This testimony is not only extremely vague as to the timing and financing of the activities, it is so

¹ Applicant is an experienced intellectual property attorney (*see* Dkt. No. 15, Claypool Decl. ¶2) and thus cannot claim that he did not know his discovery obligations under the federal rules.

rudimentary that it is nothing more than Applicant's bare-bones insistence that he intends to brew beer. *See, e.g., RIM*, 2009 TTAB LEXIS 673 at *12-13 (no "bona fide" intent where applicant's discovery responses showed that "the mark has not been used and no plans have been made as to how the mark may be used []; there is no projected date of first use in commerce []; no channels of trade have been formulated or planned for the future []; the classes of consumers and geographic areas of sales have not yet been determined []; applicant has not undertaken any market studies, surveys, or focus groups []; and no documents exist regarding plans for expansion and growth of the product and service lines under the mark."). Applicant's testimony in his Declaration offered in opposition to summary judgment that he has plans to use TIGER SHARK for beer also contradicts Applicant's sworn statement, in response to Opposer's interrogatory asking Applicant to identify his business plans for TIGER SHARK for beer, that he "does not have any immediate plans as yet to market or otherwise refer to products to be offered for sale under the Tiger Shark mark." (*See* Dkt. No. 14 at p.3 and Ex. 5, No. 7.) Thus, Applicant's self-serving testimony in his Declaration submitted in opposition to Opposer's summary judgment motion must be disregarded. *See Kabbalah Ctr.*, 2009 TTAB LEXIS at *10-11.

Finally, in his Declaration, Applicant references conversations with "a former colleague" who has "contacts to [unnamed] high net worth individuals" about financing a brewery. (Dkt. No. 15, Claypool Decl. ¶8.) But Applicant provides no details about the identity of this "former colleague," when or where those conversations transpired, a potential plan for a brewery, nor does Applicant contend that he has even applied for financing. (*Id.*) Further, Applicant testifies that his "former colleague" asked him to "file a trademark for [the mark] 'Raccoon' which he has a bona fide intent to use for beer" – which is a different mark than the TIGER SHARK mark. Applicant tellingly mentions no financing for beer under the TIGER SHARK mark. (*See id.* (emphasis

added).) Applicant's testimony in his Declaration about alleged conversations with a "former colleague" is not "objective" evidence of a "bona fide" intent to use the TIGER SHARK mark in commerce and to the extent that it is, this testimony contradicts Applicant's sworn interrogatory responses and must be disregarded. (*See id.*)

In sum, Applicant has no adequate explanation for his complete lack of documents showing any preparation for using the TIGER SHARK mark in commerce. Applicant's own Declaration confirms that he no plans regarding manufacturing, production, financing, or distribution of beer under the TIGER SHARK mark. (*See* Dkt. No. 15, Claypool Decl.) The Board regularly finds a lack of "bona fide" intent to use and enters summary judgment in this situation. *See, e.g., Honda Motor Co. v. Winkelmann*, 90 U.S.P.Q.2d 1660, 2009 TTAB LEXIS 202, *14 (TTAB 2009); *PRL*, 2013 TTAB LEXIS 548 at *13-14; *Padres L.P.*, 2010 TTAB LEXIS 106 at *9; *Diageo N. Am., Inc. v. Captain Russell Corp.*, Opp. No. 91203745, 2013 TTAB LEXIS 324 at *13-14 (TTAB June 12, 2013).

II. The Filing and Prosecution of Trademark Applications Does Not Show a "Bona Fide" Intent to Use

Applicant argues that his prosecution of the TIGER SHARK trademark application is evidence of a "bona fide" intent to use the mark. (Dkt. No. 15 at 4 & Claypool Decl. ¶4.) But "[i]f the filing and prosecution of a trademark application constituted a bona fide intent to use a mark, then in effect, lack of a bona fide intent to use would never be a ground for opposition or cancellation, since an inter partes proceeding can only be brought if the defendant has filed an application." *RIM*, 2009 TTAB LEXIS 673 at *15 (sustaining opposition due to lack of a "bona fide" intent to use); *Smithkline Beecham*, 97 U.S.P.Q.2d at 1304 (same). Indeed, neither the application itself nor a trademark search conducted in the course of filing the application is

objective evidence of a “bona fide” intent to use. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 U.S.P.Q.2d 2001, 2009 (TTAB Sept. 10, 2015).

Finally, Applicant identifies his trademark applications for marks for beer other than TIGER SHARK. (Dkt. No. 15, Claypool Decl. ¶10 & Exs. 1-5.) Each of those marks is as an intent-to-use application, there is no evidence that any of the marks have been used, and Applicant has no evidence (other than his self-serving statements in his Declaration) that support a claim of a “bona fide” intent to use these other marks for beer. (*See id.*) Contrary to Applicant’s argument, the filing of many intent-to-use applications for the same product (here, beer) is evidence of a lack of “bona fide” intent to use. 3 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 19:14 at pp. 19-53 to 19-54 (4th ed. 2016) (citing Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988) (applicant’s filing of many intent to use applications for different marks for one product “may cast doubt on the bona fide nature of the intent or even disprove it entirely.”). *See also L’oreal*, 102 U.S.P.Q.2d at 1443-44 (filing many intent to use applications for different marks for the same goods was evidence of no “bona fide” intent to use—sustaining opposition); *Smithkline Beecham*, 97 U.S.P.Q.2d at 1304 (“The fact that applicant filed applications for various marks, including the one at issue herein, hardly establishes a bona fide intent to use the mark.”). Moreover, Applicant’s objective evidence of a “bona fide” intent to use a **different mark** for beer—even if such evidence existed, which it does not—is irrelevant to show a “bona fide” intent to use the **TIGER SHARK mark** for beer. *See, e.g., DC Comics & Marvel Characters, Inc. v. Silver*, Opp. No. 91176744, 2009 TTAB LEXIS 566, *17 (TTAB Aug. 21, 2009) (“Any alleged use of the TEXASTEAM mark on petroleum products has no bearing upon applicant’s intent to use SUPER HERO, a completely different mark”); *Swatch Ag*, 108 U.S.P.Q.2d at 1477 (evidence that applicant had a “bona fide” intent to use

a **different** mark was not evidence that applicant had a “bona fide” intent to use **applied-for** mark).

III. Opposer Should Not Have To Respond To Applicant’s Discovery Requests Pending the Disposition of This Motion

Applicant states that Opposer should respond to Applicant’s discovery requests because the responses will contain evidence of Applicant’s “bona fide” intent to use TIGER SHARK for beer (Dkt. No. 15 at 5). Applicant does not begin to explain how that could be so. Applicant’s discovery requests ask only about Opposer’s use of its TIGER Marks, and the likelihood of confusion due to the parties’ use of their marks. (*See* Dkt. No. 14 at Ex. 9.) Opposer’s responses to Applicant’s discovery requests obviously have absolutely no relevance to whether **Applicant** had a “bona fide” intent to use TIGER SHARK for beer at the time he filed its application. That evidence is exclusively in Applicant’s possession, custody or control, and Applicant has no such evidence.

Respectfully submitted,

HEINEKEN ASIA PACIFIC Pte. Ltd.

Dated: May 23, 2016

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CERTIFICATE OF SERVICE

Opposer HEINEKEN ASIA PACIFIC Pte. Ltd., by and through its attorneys, hereby certifies that a copy of this MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION has been served upon Applicant on this 23rd day of May, 2016, by Email at the following address:

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