

**THIS ORDER IS NOT A  
PRECEDENT OF THE TTAB**

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**  
General Contact Number: 571-272-8500

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Mailed: September 26, 2016

Opposition No. **91220927**

*Heineken Asia Pacific Pte. Ltd.*

*v.*

*Jonathan A. Claypool*

**Before Wolfson, Shaw and Greenbaum,  
Administrative Trademark Judges**

**By the Board:**

On March 5, 2015, Heineken Asia Pacific Pte. Ltd. (“Opposer”) filed a notice of opposition against Application Serial No. 86394137<sup>1</sup> for the mark TIGER SHARK for “beer” on the ground of priority and likelihood of confusion. Jonathan A. Claypool (“Applicant”) answered the notice of opposition on April 11, 2015. Shortly thereafter, this matter was suspended to facilitate settlement discussions between the parties. In the absence of further stipulations to suspend, proceedings resumed on November 20, 2015.

This matter now comes up on Opposer’s motion for leave to amend its pleading to add a claim of no bona fide intent to use the mark in commerce<sup>2</sup>

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<sup>1</sup> The application was filed on September 13, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>2</sup> An amended notice of opposition was filed concurrently therewith.

and motion for summary judgment on the newly added claim (both filed April 14, 2016). Applicant filed a response to the motion for summary judgment, but as Applicant has not opposed or otherwise responded to the motion for leave to amend, the motion to amend is **GRANTED as conceded** and Opposer's amended notice of opposition will serve as the operative pleading herein.<sup>3</sup> *See* Trademark Rule 2.127(a).

Decision

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). If the moving party is able to meet this initial burden, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. The nonmoving party may not rest on mere allegations or assertions but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. Should

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<sup>3</sup> As Opposer's amendment to the notice of opposition is limited to the addition of the no bona fide intent to use claim, we have construed Applicant's response to the motion for summary judgment as a general denial of the newly added claim and have dispensed of the need for Applicant to submit an amended answer.

the nonmoving party fail to raise a genuine dispute of material fact as to an essential element of the moving party's case, and no other genuine disputes remain, judgment as a matter of law may be entered in the moving party's favor.

A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board does not resolve disputes of material fact but rather only ascertains whether disputes of material fact exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

In order for Opposer to prevail on its motion, it must establish that there is no genuine dispute of material fact, that it has standing to maintain the proceeding and that Applicant did not have a bona fide intent to use the mark TIGER SHARK on beer as of September 13, 2014, the filing date of the involved application.

Opposer, as the moving party, bears the initial burden of demonstrating that Applicant lacked a bona fide intent to use the mark in commerce on the goods identified in the subject application, such as by demonstrating the

absence of any documentary evidence regarding Applicant's bona fide intent. If Opposer meets this burden, the burden shifts to Applicant to come forward with evidence that explains or outweighs the lack of documentary evidence. A determination of whether Applicant had a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *See Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). The absence of any documentary evidence without adequate explanatory evidence regarding Applicant's bona fide intent constitutes objective proof sufficient to demonstrate that Applicant lacked a bona fide intention to use his mark in commerce at the time he filed his application. *See Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

### Standing

The question of standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case so as to prevent litigation when there is no real controversy between the parties. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). To establish standing, the plaintiff must demonstrate that it has a "real interest," i.e., a direct and personal stake, in the outcome of the proceeding and a reasonable basis for its belief of damage. *Ritchie*, 50 USPQ2d at 1025-26.

By way of the amended notice of opposition, Opposer has asserted claims of likelihood of confusion and lack of a bona fide intent to use the mark in commerce. Opposer has further pleaded ownership of Registration Nos. 3294199 and 3318461 for the mark TIGER, with and without a design, for goods including beer. Although Opposer has not submitted status and title copies of its pleaded registrations, Opposer has submitted Applicant's responses to its requests for admission wherein Applicant has admitted that Opposer owns the pleaded registrations. *See Opposer's Motion for Summary Judgment, Declaration of Katie Bukrinsky*, Exh. 6, 14 TTABVUE 57-58. We further note that as part of his responsive brief, Applicant again admitted Opposer's ownership of the pleaded registrations. *See Opposer's Motion for Summary Judgment*, 14 TTABVUE 3 and *Applicant's Response*, 15 TTABVUE 2.

In view thereof, we find no genuine dispute of material fact that Opposer has a real interest in preventing the registration of the subject application and, therefore, find standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus.*, 213 USPQ at 189.

#### Lack of a Bona Fide Intent to Use

In support of its claim that Applicant did not have a bona fide intent to use his mark in commerce at the time Applicant filed his application, Opposer points to various of Applicant's discovery responses demonstrating a

lack of documentary evidence to support Applicant's claim of a bona fide intent.

From Applicant's responses to Opposer's requests for admissions [*Opposer's First Set of Requests for Admission*, 14 TTABVUE 34-44] we note that Applicant has admitted that he has no written plans to sell beer under the subject mark [*Response to Opposer's First Request for Admissions*, 14 TTABVUE 57-64, Response No. 29] or to produce or manufacture the goods under the mark [Response No. 30], has not discussed the distribution of the goods with any distributor [Response No. 31], has done no advertising for the goods [Response No. 33], has not manufactured any type of beer and does not have a retail marketing plan [Response Nos. 37-39, 44-46, 49-50].

In response to Opposer's document requests [*Opposer's First Set of Requests for Production of Documents and Things*, 14 TTABVUE 15-23], Applicant has represented that he has no documents that go to Applicant's adoption of the mark [*Response to Opposer's First Request for Production of Documents and Things*, 14 TTABVUE 46-49, Response to Request No. 2], no labels and packaging that bear the mark [Response to Request Nos. 4-5], no advertising or marketing materials [Response to Request No. 8], and no documents concerning business plans [Response to Request Nos. 12-13], monies spent on creating the goods [Response to Request No. 15], intended consumers of the goods [Response to Request No. 17], manufacture of the

goods [Response to Request No. 24], or any persons employed in connection with the goods [Response to Request No. 25].

We further note that in response to certain interrogatories [*Opposer's First Set of Interrogatories*, 14 TTABVUE 25-32], 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,” that Applicant “intends to market and sell beer under the mark in approximately 2 to 3 years” but that “[n]o business plan has been drafted to date or other activities undertaken with regards to the Tiger Shark mark,” and that while Applicant “intends to start a small brewery and tap room system[, n]o specifics are yet in place” [*Response to Opposer's First Interrogatories*, 14 TTABVUE 52, Interrogatory Response Nos. 7-8].

Applicant, on the other hand, acknowledges that he has no formal written business plan, *Declaration of Jonathan A Claypool* (“Applicant Declaration”), ¶ 6, 15 TTABVUE 9-10, but asserts that he has “a simple mental memorized plan that is in fact a basic business plan,” *id.*, that he has been “actively performing research and development on all aspect [sic] making beer from yeast strain selection, formulation of grain and hops, and fermentation parameters, starting before the Tiger Shark application and continuing with ongoing activities including taste testing by third parties,” *id.* at ¶ 5, and that he has “selected, conducted clearance searches and then filed and actively prosecuted additional marks with a good faith bona fide intent-to-use for beer

as part [of] a collective plan.” *Id.* at ¶ 10. Nevertheless, Applicant has provided no documentary evidence to corroborate any of these activities; rather, the only documentary evidence Applicant submitted are the intent-to-use application files of Applicant’s other marks,<sup>4</sup> a copy of an intent-to-use application<sup>5</sup> Applicant filed on behalf of a third-party with whom Applicant discussed “leading financing efforts for a brewery from about December 2014 till the present,” and a TESS search report for the TIGER SHARK mark. *Id.* at ¶¶ 7-15.

The Board has consistently held that neither the filing of an application nor a trademark search is sufficient to establish an applicant’s intent. *See M. Z. Berger & Co., Inc. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2009 (TTAB 2015); *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009) (“If 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

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<sup>4</sup> Application Serial No. 86394132 for the mark SUBTERRANEAN for “beer, ale and lager” in International Class 32 filed September 13, 2014, pursuant to Section 1(b) of the Trademark Act.

Application Serial No. 86654104 for the mark COBALT for “ale; beer; lager” in International Class 32 filed June 6, 2015, under Section 1(b).

Application Serial No. 86654098 for the mark ROMAN for “beer; lager” in International Class 32 filed June 6, 2015, under Section 1(b).

Application Serial No. 86654097 for the mark SAXON for “beer” in International Class 32 filed June 6, 2015, under Section 1(b).

application.”). Moreover, the filing of applications for other marks does not establish Applicant’s bona fide intent to use the TIGER SHARK mark, especially where three of the applications were filed nearly nine months after the subject application. *See Swatch AG v. M. Z. Berger & Co., Inc.*, 108 USPQ2d 1463, 1477 (TTAB 2013) (subsequently filed application for I-KIDZ failed to establish applicant’s earlier intent to use IWATCH), *aff’d* 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015). Indeed, Applicant’s filing of numerous intent-to-use applications for a variety of marks for use on a single product, i.e., beer, combined with Applicant’s estimate that he is still two to three years from marketing and selling beer “cast[s] doubt on the bona fide nature of the intent or [may] even disprove it entirely.” *Lane Ltd.*, 33 USPQ2d at 1355, *quoting* S.Rep. No. 100-515, 100<sup>th</sup> Cong.2d Sess. at 23 (1988).

Taken as a whole, the record is devoid of any documentary evidence of business plans, marketing or promotional activities, research and development, consumer testing, financing efforts or any other documents to substantiate Applicant’s claim of a bona fide intent to use the subject mark in commerce as of the application filing date.

Accordingly, we find no genuine dispute of material fact as to Applicant’s lack of a bona fide intent to use the mark TIGER SHARK for “beer” as of the filing date and hereby **GRANT** Opposer’s motion for summary judgment on

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<sup>5</sup> Application Serial No. 86659898 for the mark RACCOON for “beer” in International Class 32 filed June 11, 2015, under Section 1(b).

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its claim of no bona fide intent. The opposition against Application Serial No. 86394137 is sustained and registration is refused.<sup>6</sup>

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<sup>6</sup> In view of the Board's grant of the motion for summary judgment on Opposer's claim of no bona fide intent to use, the Board need not reach Opposer's likelihood of confusion claim.