

This Opinion is Not a
Precedent of the TTAB

Hearing: October 27, 2022

Mailed: November 16, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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D&P Holding SA

v.

Jose Ramon Ortiz Monasterio

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Opposition No. 91246728
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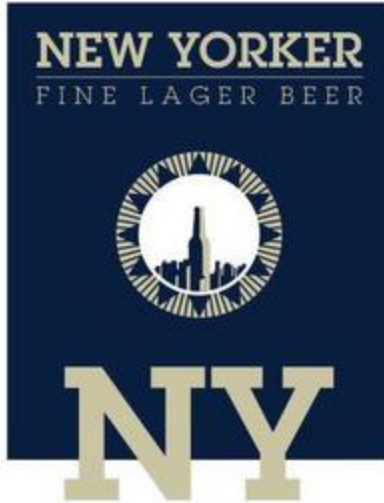
Leo M. Loughlin and Davide F. Schiavetti of Rothwell, Figg, Ernst & Manbeck, P.C.
for D&P Holding SA.

James R. Menker of Holley & Menker, P.A. for Jose Ramon Ortiz Monasterio.

—
Before Taylor, Lynch, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Jose Ramon Ortiz Monasterio (“Applicant”) seeks registration on the Principal
Register of the mark shown below



for “Beer-based cocktails; Essences used in the preparation of liqueurs; Malt extracts for making beer; Non-alcoholic rice-based beverages not being milk substitutes; Smoothies; Soy-based beverages not being milk substitutes; Soya-based beverages, other than milk substitutes; Syrups for beverages; Syrups for making beverages” in International Class 32.¹

D&P Holding SA (“Opposer”) opposes registration of Applicant’s mark on the ground that Applicant did not have a bona fide intention to use the mark in commerce in connection with the goods identified in the Opposed Application when it was filed.²

¹ Application Serial No. 87302931 (the “Opposed Application”) was filed on January 16, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

² Opposer’s Notice of Opposition also alleged that Applicant committed fraud on the United States Patent and Trademark Office (“USPTO”) in filing the Opposed Application, Not. of Opp. ¶¶ 12-13 (1 TTABVUE 6), but Opposer did not pursue its fraud claim in its brief, and we deem it to have been waived. *See, e.g., Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013), *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015)).

The case is fully briefed,³ and counsel for the parties appeared at an oral hearing before the panel on October 27, 2022. We sustain the opposition.

I. Record and Evidentiary Matters

The record consists of the pleadings;⁴ the file history of the Opposed Application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1); the Testimony Declaration of Gianluca Damiola, Opposer's President from 2014 to 2019, and Exhibits A-D thereto, 38 TTABVUE 2-16; Opposer's Notice of Reliance, and Exhibit A thereto, 39 TTABVUE 2-24; Applicant's Testimony Declaration, and Exhibits A-G thereto,⁵ 46 TTABVUE 2-68; and Mr. Damiola's Rebuttal Testimony Declaration, 50 TTABVUE 2-6. Neither witness was cross-examined.

Applicant also attached to his brief what he described as a copy of a November 14, 2019 bankruptcy decree of the District Court of Lugano in Switzerland, and an English translation thereof, through which Applicant claims Opposer was dissolved.

³ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's public online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Opposer's brief appears at 55 TTABVUE and its reply brief appears at 58 TTABVUE. Applicant's brief appears at 57 TTABVUE.

⁴ Except as discussed below, Applicant denied most of the salient allegations in Opposer's Notice of Opposition, and interposed several affirmative defenses, including that "Opposer entered into an agreement with Applicant in 2015 in which Applicant granted Opposer certain rights in its [sic] trademark, *excluding* Canada, United States of America and Mexico, where Applicant retained its [sic] trademark rights." Answ. Aff. Def. No. 1 (5 TTABVUE 2) (emphasis supplied by Applicant). Applicant pursued only this affirmative defense in his brief. 57 TTABVUE 16-21.

⁵ We will cite Applicant's declaration as the "Ortiz Decl.," as he cites it in his brief. 57 TTABVUE 7.

57 TTABVUE 11, 24-27. In its reply brief, Opposer “objects to this document as it was not properly introduced, and addressing the merit or authenticity of this screenshot is moot give that this exhibit is entirely improper.” 58 TTABVUE 6 (citing TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 704.05(b)). Opposer argues that Applicant “has not properly entered this document into the record during testimony, through either a Declaration or Notice of Reliance, thus it is improper and carries no evidentiary value.” *Id.* at 6-7. We agree. Because the purported bankruptcy decree was never made of record during Applicant’s trial period, we have given it no consideration in our decision.⁶

II. Factual Background

The background to this opposition is a business relationship gone bad, which we summarize below.

Applicant is a Spanish citizen with an address in Belgium, and has an extensive background in the marketing of beers. For almost 15 years, he was the Chairman of the Board and Chief Executive Officer of Grupo Modelo’s operation in Europe, the Middle East and Africa, Ortiz Decl. ¶ 3 (46 TTABVUE 3), and after he retired from Grupo Modelo, he formed a company called Global Premium Brands to commercialize premium drinks, including spirits and water, in Spain and other European countries. Ortiz Decl. ¶ 4 (46 TTABVUE 4). Together with some friends in Belgium, he also

⁶ As noted above, Mr. Damiola identified himself in his September 22, 2021 declaration as Opposer’s President from 2014 to 2019, Damiola Decl. ¶ 1 (38 TTABVUE 4), but Applicant never cross-examined Mr. Damiola to find out whether something happened to Opposer in 2019 when he ceased to be its President. On this record, we can find only that Opposer remains in existence and has the capacity to prosecute this opposition to judgment.

created and launched a premium beer brand called La Blonde de San Tropez that was marketed and sold successfully in the French Riviera. Ortiz Decl. ¶ 4 (46 TTABVUE 4).

Applicant testified that he “came up with the idea for the brand NEW YORKER in April or May of 2014,” Ortiz Decl. ¶ 8 (46 TTABVUE 5), and that his friend Alain Tastiel, who was the chief executive officer of the Belgian marketing company Magic S.A., helped create the graphics to be used in a logo incorporating the NEW YORKER brand. Ortiz Decl. ¶ 8 (46 TTABVUE 5). Applicant also testified that “[i]n July of 2014, Mr. Gianluca Damiola became interested in this project and approached me about developing the brand,” and that “[t]ogether, we formed opposer D&P Holding SA.” Ortiz Decl. ¶ 10 (46 TTABVUE 5).

Mr. Damiola tells a slightly different story. He testified that in 2014, “I decided to launch a new project, focused on the sale and production of beers under the mark ‘New Yorker,’” Damiola Decl. ¶ 6 (38 TTABVUE 5), and that he “entered into a business agreement with Applicant to liaise with external consultants tasked with the creation of the ‘New Yorker’ logo and, among other things, give mandate to a trademark attorney to register the ‘New Yorker’ mark for me, once created, in all main markets.” Damiola Decl. ¶ 7; Ex. A (38 TTABVUE 5, 12). He cites Exhibit A to his declaration, which appears to be a July 16, 2014 email to Applicant signed by Mr. Damiola and two others and, apparently, by Applicant as well.⁷ Applicant never discusses Exhibit A in his declaration.

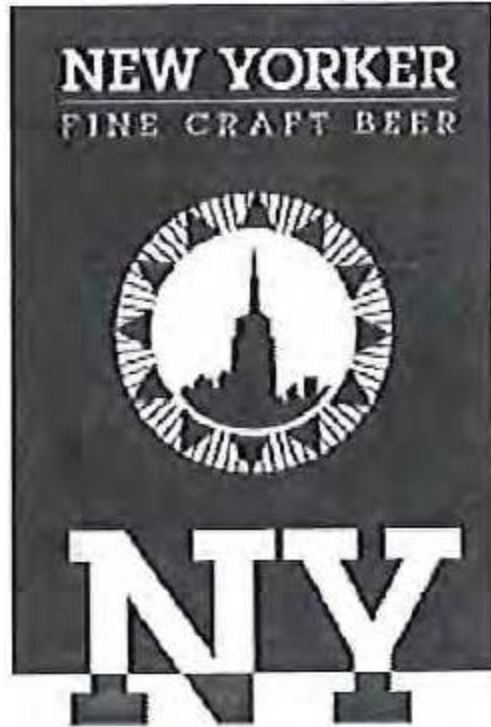
⁷ The email is barely legible for the most part, and parts of it are illegible. “Parties to Board proceedings are responsible for ensuring the documents they introduce are complete and

Exhibit A, which is written in English,⁸ begins with a reference to “meetings and discussions concerning the project of [illegible] a new beer brand potentially under the name of ‘New Yorker,’” Damiola Decl. Ex. A (38 TTABVUE 12), and to the incorporation of a company by Mr. Damiola and two others to carry on the project. Damiola Decl. Ex. A (38 TTABVUE 12). It states that the company will sustain certain start up expenses and in a second stage will raise equity necessary to commercialize and market the product. Damiola Decl. Ex. A (38 TTABVUE 12). It then lists a number of “preliminary activities which have to be carried on under your management and supervision,” including “[g]iv[ing] mandate to a trademark lawyer to register ‘New Yorker’ in [illegible] markets,” and “[m]anag[ing] with an external consultant the [illegible] for the design of the logo for the [illegible] bottle cap, etc.” Damiola Decl. Ex. A (38 TTABVUE 12). It concludes with a mostly illegible paragraph that appears to refer to a pre-incorporation fee to be paid to Applicant “[i]n return for your consulting and management services.” Damiola Decl. Ex. A (38 TTABVUE 12).

The parties agree that in August 2014, Applicant filed an application in his name in the European Union to register the mark shown below

legible,” *Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.6 (TTAB 2020), and the “Board can only review evidence that is clear and unobstructed so we have considered this evidence to the extent it is legible and we are able to read the entire context of the evidence.” *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

⁸ Although Messrs. Damiola and Ortiz are Europeans, they appear to have done their business in English, as their correspondence and all of the agreements in the record are in English, and no document is identified as an English-language translation of an original document in another language.



for “Non-alcoholic beverages; Beer and brewery products; Preparations for making beverages.” Ortiz Decl. ¶ 7 (46 TTABVUE 4); Damiola Decl. ¶ 9 (38 TTABVUE 6). Applicant testified that he filed the application “as the owner of the mark,” Ortiz Decl. ¶ 7 (46 TTABVUE 4), while Mr. Damiola testified that Applicant filed it “pursuant to the agreement in Exhibit A.” Damiola Decl. ¶ 9 (38 TTABVUE 6).

Applicant testified that the mark shown in the application was created through his collaboration with Mr. Tastiel and under a June 30, 2014 agreement between an entity called “D&P Holding” and Mr. Tastiel’s company Magic S.A. Ortiz Decl. ¶ 8; Ex. B (46 TTABVUE 5, 14-27). Mr. Damiola never discusses this agreement in his declaration or rebuttal declaration. The June 30, 2014 agreement identified “D&P Holding” as “a company incorporated under the laws of Switzerland, with registered

office at Via Canonica 5 6901 Lugano.”⁹ Ortiz Decl. Ex. B (46 TTABVUE 15). Applicant signed the agreement on behalf of “D&P Holding.” The agreement contains numerous provisions regarding, among other things, the nature and scope of the engagement, and the ownership of intellectual property rights in the results of the engagement. Ortiz Decl. Ex. B (46 TTABVUE 15-19).

Applicant testified that “[o]n April 15, 2015, Magic S.A. assigned all of its rights in the intellectual property relating to the New Yorker brand to me” under a document captioned “Copyright Assignment Agreement for All the Inherited IPRS in the Logo and Designs Related to the New Yorker Beer Trade Mark.” Ortiz Decl. ¶ 9; Ex. C (46 TTABVUE 5, 28-30).

The parties agree that the mark shown in Applicant’s European Union application was registered in Applicant’s name in the European Union under Registration No. 013192372 in January 2015 (the “CTM Registration”). Ortiz Decl. ¶ 7; Ex. A (46 TTABVUE 5, 10-13); Damiola Decl. ¶ 10 (38 TTABVUE 6). The parties also agree that Opposer was formed in 2015, Damiola Decl. ¶ 10 (38 TTABVUE 6); Ortiz Decl. ¶ 10 (46 TTABVUE 5), but they disagree about Applicant’s role(s) with Opposer.

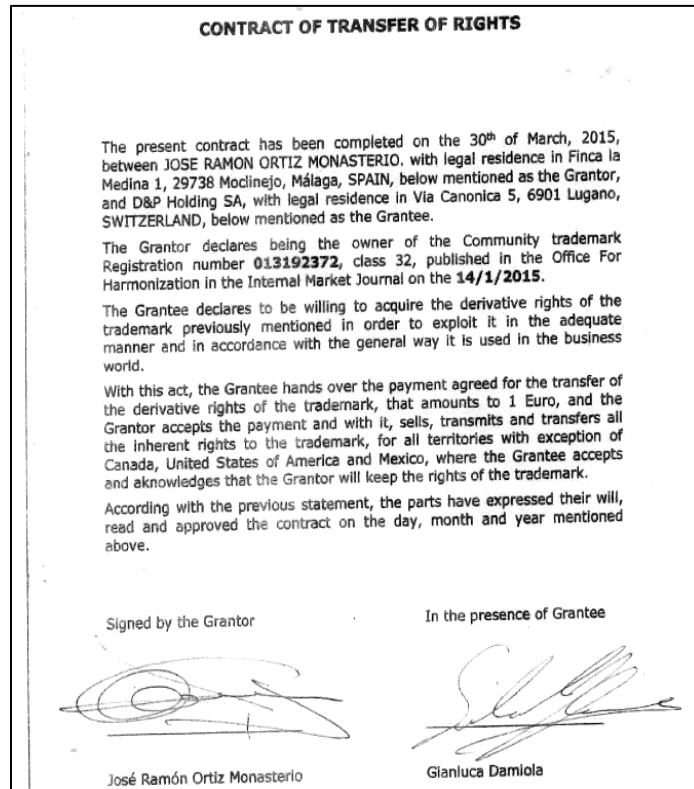
Mr. Damiola testified that Applicant filed the Opposed Application on January 16, 2017 “while still serving as D&P Europe’s Managing Director,” and that “[s]hortly

⁹ Applicant admitted Opposer’s allegations in its Notice of Opposition that “[i]n 2014, Opposer’s predecessor-in-interest launched a project of producing and selling beers and related products bearing the trademark ‘New Yorker,’ with the eventual trademark to be used still in development,” and that “Opposer’s predecessor-in-interest entered into a relationship with Applicant to assist in the registration of the mark that would be developed.” Not. of Opp. ¶ 6 (1 TTABVUE 5); Answ. ¶ 6 (5 TTABVUE 2). It is not clear whether either party was referring to the “D&P Holding” entity identified in Exhibit A to Mr. Damiola’s declaration as Opposer’s “predecessor-in-interest.”

thereafter, Applicant ceased to serve as D&P Europe's Managing Director." Damiola Decl. ¶¶ 18-19 (38 TTABVUE 9-10). Applicant testified that when he filed the Opposed Application, he "was still a shareholder in [Opposer] and in its subsidiary D&P Europe Import Export Drinks SL," but that "[i]t was only later in March 2017 that I signed an Agreement, through JROM Management Services LLP, to act as Managing Director of the subsidiary," and that when he filed the Opposed Application, he was "not an employee but a shareholder of [Opposer]." Ortiz Decl. ¶ 17 (46 TTABVUE 7). His testimony is contradicted by his admission of Opposer's allegations in its Notice of Opposition that "Applicant was formerly the Managing Director of D&P Europe (a company 100% owned by Opposer," and that "[o]n January 16, 2017, while still being Managing Director of D&P Europe (a company 100% owned by Opposer), Applicant filed Serial No. 87/302,931 for Applicant's Mark in his own name." Not. of Opp. ¶¶ 5, 9 (1 TTABVUE 4-5); Answ. ¶ 1 (5 TTABVUE 2). We find that the preponderance of the evidence, including Applicant's admission in his Answer, establishes that Applicant was the Managing Director of Opposer's subsidiary D&P Europe when he filed the Opposed Application, but merely a shareholder of Opposer. The record does not show that Applicant ever had any other role with Opposer.

In his rebuttal declaration, Mr. Damiola testified that "[i]ndividuals, irrespective of their title with D&P Holding (employee, shareholder, etc.), did not have authorization to file any trademark applications in their personal name for the" mark shown in the Opposed Application. Damiola Rebut. Decl. ¶ 7 (50 TTABVUE 6).

The parties agree that Applicant assigned the CTM Registration to Opposer on March 30, 2015 through the following document (the “2015 Contract”):¹⁰



Damiola Decl. ¶ 10; Ex. B (38 TTABVUE 6, 13); Ortiz Decl. ¶ 11; Ex. D (46 TTABVUE 5-6, 30-32).¹¹ Applicant testified that the assignment was recorded in the European

¹⁰ Applicant is silent regarding the nature and history of the entity identified as “D&P Holding” in the June 30, 2014 agreement between that entity and Magic S.A., but we note that the address of “D&P Holding” in the June 30, 2014 agreement and the address of D&P Holding S.A. in the 2015 Contract are the same.

¹¹ The pertinent exhibits to the witnesses’ respective declarations differ. Exhibit B to Mr. Damiola’s declaration is the single page shown above. Exhibit D to Applicant’s declaration includes that page as well as a page captioned “Annex,” which contains a chart that refers to Registration No. 013192372 as well as a pending application to register the word mark NEW YORKER in the European Union for various goods in International Classes 32 and 33. Ortiz Decl. Ex. D (46 TTABVUE 32). The body of the 2015 Contract makes no reference to an “Annex” or a CTM application, and Applicant does not refer to an “Annex” in his testimony about the 2015 Contract. Accordingly, we have given the mysterious “Annex” no consideration in our decision.

Union Intellectual Property Office on September 22, 2016. Ortiz Decl. ¶ 12; Ex. E (46 TTABVUE 6, 34-35). The parties agree, as Mr. Damiola testified, that “[a]s a result of this sale, D&P Holding became the formal owner of the . . . trademark in EU TM Registration 131923372 in September 2016.” Damiola Decl. ¶ 12 (38 TTABVUE 7).

Applicant testified that “[a]round this time, I decided it was time to pursue this project on my own in the United States, Mexico and Canada.” Ortiz Decl. ¶ 13 (46 TTABVUE 6). The parties agree that on September 29, 2016, Applicant filed application Serial No. 87187477 (the “’477 Application”) in the USPTO to register the mark shown in the CTM Registration for goods identified as “Beer; Beer wort; Beers; Alcohol-free beers; Brewed malt-based beers; Craft beers; Flavored beers; Ginger beer; Imitation beer; Malt beer; Pale beer; Porter.” Ortiz Decl. ¶ 14; Ex. F (46 TTABVUE 6, 36-66); Damiola Decl. ¶ 13 (38 TTABVUE 8). Mr. Damiola testified that the ’477 Application was filed in the USPTO “under instructions of D&P Holding.” Damiola Decl. ¶ 13 (46 TTABVUE 8). Applicant did not respond to that testimony in his declaration.

Shortly after the ’477 Application was filed, Applicant received a demand letter from ESRT Empire State Building, L.L.C. (“ESB”) claiming that the design in the mark shown in the ’477 Application infringed ESB’s rights in the design of the Empire State Building in New York City. Damiola Decl. ¶ 14; Ex. D (38 TTABVUE 8, 15-16); Ortiz Decl. ¶ 15 (46 TTABVUE 6-7). Mr. Damiola testified that “[a]s the initial version of the mark could not be used in the U.S., [Opposer] decided to create a new, different trademark for its project that would avoid any potential litigation with ESB

in the U.S.” Damiola Decl. ¶ 16 (38 TTABVUE 8). He further testified that the new trademark, “where the bottle replaces the skyscraper, was developed by [Opposer] for the sole use of [Opposer] and was not the subject of any agreement between [Opposer] and any third parties, including Applicant, as to its use.” Damiola Decl. ¶ 17 (38 TTABVUE 9). In his rebuttal declaration, he testified that this new mark had “been developed, under my personal instruction, by external consultants on behalf of [Opposer], and intended for use and registration of [Opposer] solely.” Damiola Rebut. Decl. ¶ 3 (50 TTABVUE 5). In his declaration, Applicant did not dispute Mr. Damiola’s testimony or otherwise discuss the circumstances of the creation of the new mark.

Applicant expressly abandoned the ’477 Application on January 16, 2017. Ortiz Decl. ¶ 15 (46 TTABVUE 6-7). Mr. Damiola testified that Opposer “instructed Applicant to withdraw [the ’477 Application] [t]o avoid litigation of any potential infringement of” the claimant’s rights. Damiola Decl. ¶ 15 (38 TTABVUE 8). Applicant did not dispute this in his declaration. Ortiz Decl. ¶ 15 (46 TTABVUE 6-7).

The parties agree that Applicant filed the Opposed Application on the same day that he abandoned the ’477 Application, Ortiz Decl. ¶ 16 (46 TTABVUE 7); Damiola Decl. ¶ 18 (38 TTABVUE 9), but they strongly disagree about his right to file it. Applicant testified that he filed the Opposed Application “to replace the abandoned [’477 Application],” Ortiz Decl. ¶ 16 (46 TTABVUE 7),¹² “which was my right

¹² The Opposed Application does not cover any of the goods identified in the ’477 Application. Instead, it covers “Beer-based cocktails; Essences used in the preparation of liqueurs; Malt extracts for making beer; Non-alcoholic rice-based beverages not being milk substitutes;

according to the Assignment Agreement I had with [Opposer].” Ortiz Decl. ¶ 17 (46 TTABVUE 7). Mr. Damiola testified that Applicant filed the Opposed Application “[d]espite knowing he did not have any rights to the new trademark or having received any instructions to proceed with the filing of this new trademark on behalf of” Opposer. Damiola Decl. ¶ 18 (38 TTABVUE 9). He further testified that “[p]ursuant to the Rules of Incorporation of D&P Holding, performance of any act of binding nature on D&P Holding (including the exploitation of its assets) requires the appropriate approval of D&P’s Board of Directors,” Damiola Rebut. Decl. ¶ 8 (50 TTABVUE 6), and that “D&P’s Board of Directors did not provide its approval to Applicant to file [the Opposed Application] in his personal name of [sic] in that of D&P Holding.” Damiola Rebut. Decl. ¶ 9 (50 TTABVUE 6). Mr. Damiola testified that shortly after the filing of the Opposed Application, Applicant ceased to serve as D&P Europe’s Managing Director. Damiola Decl. ¶ 19 (38 TTABVUE 10).

On May 28, 2018, more than a year after Applicant filed the Opposed Application, Opposer filed application Serial No. 79238674 (the “674 Application”) in the USPTO to register the mark shown in the Opposed Application for “Non-alcoholic beverages; Beer and brewing products; preparations for making beverages.” Damiola Decl. ¶ 3, 5 (38 TTABVUE 5); Not. of Opp. ¶¶ 1-2 (1 TTABVUE 4); Answ. ¶ 1 (5 TTABVUE 2). Opposer’s ’674 Application was suspended on the basis of a possible conflict with the mark shown in the Opposed Application. Damiola Decl. ¶ 4 (38 TTABVUE 5); Not. of

Smoothies; Soy-based beverages not being milk substitutes; Soya-based beverages, other than milk substitutes; Syrups for beverages; Syrups for making beverages.”

Opp. ¶ 3 (1 TTABVUE 4); Answ. ¶ 1 (5 TTABVUE 2). Opposer filed this opposition on February 27, 2019. 1 TTABVUE.

III. Opposer's Entitlement to a Statutory Cause of Action

“Entitlement to a statutory cause of action, formerly referred to as ‘standing’ by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case.” *Illyrian Import, Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at *17 (TTAB 2022) (citations omitted); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, an opposer must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2068-69 (2014)). Opposer “must maintain its entitlement to the statutory cause of action throughout the proceeding and affirmatively prove its existence at the time of trial by introducing evidence to support the allegations in its pleading that relate to such entitlement as an element of its case-in-chief.” *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *11 (TTAB 2021), *aff’d mem.*, 2022 WL 3147202 (Fed. Cir. Aug. 8, 2022).

As noted above, Opposer alleged in its Notice of Opposition that “[o]n May 28, 2018, Opposed filed [the ’674 Application] for ‘Non-alcoholic beverages; Beer and

brewing products; preparations for making beverages’ in International Class 32,” and that the ’674 Application “has been suspended based on a possible likelihood of confusion with [the Opposed Application],” Not. of Opp. ¶¶ 1, 3 (1 TTABVUE 4), and Applicant admitted those allegations in his Answer. Ans. ¶ 1 (5 TTABVUE 2). Mr. Damiola repeated these allegations verbatim in his trial testimony, Damiola Decl. ¶¶ 3-4 (38 TTABVUE 5), and Applicant did not dispute them in his declaration.

Applicant argues that “[a]lthough Opposer appears to have adequately pled an entitlement to a statutory cause of action, [m]ere allegations or arguments in support of standing are insufficient proof thereof. A plaintiff cannot rest on mere allegations in its complaint or arguments in its brief to prove standing.” 57 TTABVUE 10 (quoting *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1039 (TTAB 2018) (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ 185, 188 (CCPA 1982)). Applicant further argues that “Opposer’s basis for its entitlement to a cause of action in this case appears to be related to an application that it alleges and argues it ‘holds’ and which was ‘suspended’ based on an alleged likelihood of confusion with the [O]pposed [A]pplication,” *id.*; that “Opposer has not alleged or proven that it is the current owner of this application;” that “Opposer did not enter into evidence a copy of the application or otherwise establish its ownership of this application” and “has not proffered any evidence evidencing the reason why the trademark application it filed was ‘suspended’ by the US PTO;” and that “[a]lthough Applicant admitted the allegation that Opposer ‘filed’ application serial no. 79238674, this admission cannot be considered an admission that Opposer is the

current ‘owner’ of that application.” *Id.* at 10-11. Applicant concludes that “[g]iven the lack of evidence proffered by Opposer that it is the owner of a pending trademark application, Opposer has failed to establish its entitlement to a cause of action in this opposition.” *Id.* at 11.

In its reply brief, Opposer argues that Applicant “does not explain how [Opposer] did not meet the two requirements set out in *Lexmark*, which establish that a party must simply ‘demonstrate (i) an interest falling within the zone of interests protected by the statute, and (ii) proximate causation.’” 58 TTABVUE 6. Opposer claims that it is “curious that [Applicant] does not cite *Lexmark* in his Trial Brief, when referring to the general principal that entitlement to a statutory cause of action in a trademark opposition is a threshold issue,” but “conveniently does not provide an explanation as to how [Opposer] failed to meet the two main principles set out in the same case – yet alleging that it did.” *Id.*

The record contains sufficient evidence to establish Opposer’s entitlement to a statutory cause of action in this opposition. “As noted above, Applicant admitted in [his] answer to the notice of opposition that Opposer’s pleaded application to register the mark . . . was suspended pending disposition of the subject application, which was cited as a potential bar.” *Rapid Inc. v. Hungry Marketplace, Inc.*, 2022 USPQ2d 678, at *11 (TTAB 2022). In his brief, Applicant also implicitly acknowledged both Opposer’s filing of its application and its refusal by arguing that “Opposer has not proffered any evidence evidencing the reason why the trademark application it filed was ‘suspended’ by the US PTO.” 57 TTABVUE 11. Although Opposer did not

“introduce[] printouts of the file history for its suspended application from the USPTO’s TSDR database, including a copy of the suspension notice that issued,” *Rapid*, 2022 USPQ2d 678, at *11, Mr. Damiola testified without contradiction that Opposer filed an application to register Applicant’s mark that has been suspended by the USPTO based on the Opposed Application. “We find that [Applicant’s] admission and statements, as well as [Opposer’s] testimony, establish that [Opposer] is the owner of [the ’674 Application] and that it was refused registration based on” the Opposed Application. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *6 (TTAB 2020) (citing *WeaponX*, 126 USPQ2d at 1040).

“Proof of [entitlement to a statutory cause of action] in a Board [opposition] is a low threshold, intended only to ensure that the plaintiff has a real interest in the matter, and is not a mere intermeddler.” *Id.* (quoting *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.8 (TTAB 2009) (citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). “Under this liberal standard, [Opposer] has shown that [its] interest in [opposing] registration is squarely within the zone of interests protected by the statute,” and that it “has a reasonable belief that damage is proximately caused by [Applicant’s] registration of the mark. Thus, [Opposer] has established an entitlement to a statutory cause of action.” *Id.*

IV. Applicant’s Contractual Estoppel Defense

As discussed above, Applicant pleaded and pursued a contractual estoppel defense based on the 2015 Contract, namely, that “Applicant granted Opposer certain rights in its [sic] trademark, *excluding* Canada, United States of America and Mexico, where

Applicant retained its [sic] trademark rights,” Answ. Aff. Def. ¶ 1 (5 TTABVUE 2) (emphasis supplied by Applicant), and that “[b]ased on the plain language of the [2015 Contract], Opposer is contractually estopped from bringing the instant opposition.” 57 TTABVUE 18. We turn first to this affirmative defense because it is potentially dispositive of the opposition. *See, e.g., Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 371 (CCPA 1974) (affirming Board’s dismissal on summary judgment of opposition to registration of the applicant’s DANSHEER mark because the opposer was contractually estopped by a provision in the parties’ settlement agreement in a civil infringement case stating that the opposer “will not oppose or petition to cancel directly or indirectly any registration by [the applicant] for a ‘Dan’ mark.”).

Applicant argues that the opposition “involves issues squarely within the parameters of a valid agreement between the parties.” 57 TTABVUE 17. According to Applicant, under the 2015 Contract he “agreed to assign the rights in the trademark for all territories ‘with exception of Canada, United States of America and Mexico, where [Opposer] accepts and acknowledges that [Applicant] will keep the rights of the trademark,” *id.* at 17-18, and that he was entitled under the 2015 Contract to file the ’477 Application, and filed it without objection from Opposer. *Id.* He further argues that Opposed did not object to the filing of the Opposed Application “until the instant opposition was filed in 2019,” *id.* and that “the new version of the mark set forth in the opposed application creates the impression of being essentially the same mark as the version of the mark set forth in the ’477 Application and is thus

covered by the terms of the” 2015 Contract. *Id.* at 19. Applicant argues that the marks create the same commercial impression, citing cases discussing the “tacking” of the use of one mark onto the use of another mark for purposes of establishing priority or avoiding abandonment. *Id.* at 19-21. Applicant concludes that “[g]iven that the key elements of the mark are the same in the ‘477 Application and the Opposed Application, both versions of Applicant’s New Yorker mark are legally equivalent,” and that “Opposer’s efforts to side step the Agreement on the basis that the revised version of Applicant’s Mark is not a legal equivalent of the original version is not supported by the facts or any case law cited by Opposer.” *Id.* at 21.

In its reply brief, Opposer responds that the 2015 Contract “makes plain that the transfer of right is only limited to the trademark in ‘Community Trademark Registration Number 013192372’, and there is no indication anywhere in the document that the terms of this agreement extend to different marks, or even different versions of the same mark,” 58 TTABVUE 8, and that the “agreement is unequivocal.” *Id.* Opposer argues in the alternative that the marks in the ‘477 Application and the Opposed Application are “completely different,” *id.* at 9, and discusses those claimed differences in some detail, particularly with respect to the replacement of the image of the Empire State Building in the mark shown in the ‘477 Application with the bottle design in the mark shown in the Opposed Application. *Id.* at 9-10. Opposer concludes that “contractual estoppel does not apply.” *Id.* at 10.

Applicant correctly states that the “construction of an agreement is a question of law,” 57 TTABVUE 17, as the Board held in *Bausch & Lomb Inc. v. Karl Storz*

GmbH & Co., 87 USPQ2d 1526, 1530 (TTAB 2008), and that the 2015 Contract “lacks a choice of law clause.” 57 TTABVUE 17. These facts beg the question of what body of law applies to the interpretation of the 2015 Contract, which is in English and mentions the United States (together with Canada and Mexico), but is between a Spanish individual and a Swiss corporation, and has as its subject matter the assignment of the CTM Registration from Applicant in Spain to Opposer in Switzerland in exchange for consideration paid in Euros.

Applicant’s answer is that in the absence of a choice-of-law provision, “general principles of contract interpretation must be applied,” *id.*, and he cites the Restatement (Second) of Contracts, and a Federal Circuit case, *Novamedix, Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613 (Fed. Cir. 1999), which applied the law of the state of New York to the interpretation of a settlement agreement that the parties specified would be governed by New York law. *Id.* Opposer does not address this issue.

In *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1790 (TTAB 2006), the Board looked to Section 188 of the Restatement (Second) of Conflict of Laws (1971) to determine which state’s law applied to a settlement agreement that did not contain a “forum clause directing that the laws of any particular state apply.” Assuming, without deciding, that it would be appropriate to determine the choice-of-law question here, where the involved agreement was entered into and performed abroad by foreign parties, by reference to Section 188,¹³ the factors discussed in the

¹³ It is possible, of course, that even though we are an administrative tribunal in the United States federal government, we would need to look to foreign conflict-of-laws rules to make

Second Restatement make clear that “general principles of contract interpretation” under United States law would not have applied to the 2015 Contract at the time of its formation and performance.

Section 188 of the Second Restatement of Conflict of Laws applies the following analysis to determine what body of state law applies to a contract that does not contain an “effective choice of the applicable law by the parties”:

(1) The rights and duties of the parties with respect to an issue in contract are determined by the local law of the state which, with respect to that issue, has the most significant relationship to the transaction and the parties under the principles stated in § 6.

(2) In the absence of an effective choice of law by the parties (see § 187), the contacts to be taken into account in applying the principles of § 6 to determine the law applicable to an issue include:

- (a) the place of contracting,
- (b) the place of negotiation of the contract,
- (c) the place of performance,
- (d) the location of the subject matter of the contract, and
- (e) the domicil, residence, nationality, place of incorporation and place of business of the parties.

These contacts are to be evaluated according to their relative importance with respect to the particular issue.

(3) If the place of negotiating the contract and the place of performance are in the same state, the local law of this state will usually be applied, except as otherwise provided in §§ 189-199 and 203.

this determination, but neither party has provided evidence of foreign law pursuant to Rule 44.1 of the Federal Rules of Civil Procedure. *See Luxco, Inc. v. Consejo Regulador Del Tequila, A.C.*, 121 USPQ2d 1477, 1507 n.221 (TTAB 2017).

Restatement (Second) of Conflict of Laws § 188 (Oct. 2022 update). Factors 2(a)-(e) all suggest that the law of Spain or Switzerland, not the law of the United States or of any State, would apply to the interpretation of the 2015 Contract because when it was entered into and performed in 2015, one of those foreign countries had “the most significant relationship to the transaction and the parties.” *Id.*

Nevertheless, as discussed above, both parties have presented arguments regarding the proper interpretation of their 2015 Contract without reference to any conflict-of-laws principles, and we will deem their arguments as manifesting their assent that we may interpret the 2015 Contract as if it were governed by United States contract law principles.¹⁴

In the 2015 Contract, Applicant “declares being the owner of the Community trademark Registration number 013192372, class 32, published in the Office For Harmonization in the Internal Market Journal on the 14/1/2015,” and Opposer “declares to be willing to acquire the derivative rights of the trademark previously mentioned in order to exploit it in the adequate manner and in accordance with the general way it is used in the business world.” Opposer pays Applicant one Euro “for the transfer of the derivative rights of the trademark” and Applicant accepts that payment and “sells, transmits and transfers all the inherent rights to the trademark,

¹⁴ The record suggests that Applicant was the drafter of the 2015 Contract. The language of the 2015 Contract is very similar to the language of a 2018 “Contract of Transfer of Rights” (the “2018 Contract”), which is shown and discussed below, in which Applicant states that he assigned the mark shown in the Opposed Application to a Delaware company that he and others formed. Ortiz Decl. ¶ 20; Ex. G (46 TTABVUE 8, 67-68). If Applicant was indeed the drafter of the 2015 Contract, we would be justified in applying the maxim of contract interpretation in the United States that ambiguities in a contract are resolved against the drafter, but as discussed below, we find no ambiguities in the 2015 Contract.

for all territories with exception of Canada, United States of America, and Mexico, where the [Opposer] accepts and acknowledges that the [Applicant] will keep the rights of the trademark.”

The 2015 Contract repeatedly uses the term “the trademark” and the interpretation issue, as framed by the parties, involves the meaning of that undefined term. Applicant argues in essence that “the trademark” means not only the trademark shown in the assigned CTM Registration, but also marks that “create[] the impression of being essentially the same mark.” 57 TTABVUE 19. Opposer argues that “the trademark” does not include “different marks, or even different versions of the same mark.” 58 TTABVUE 8.

Opposer has the better of the argument based on what Applicant calls the “plain language” of the 2015 Contract. The term “the trademark” first appears in the third paragraph of the 2015 Contract, which follows the second paragraph that contains a detailed description of “the Community trademark Registration number 013192372.” In the third paragraph, Opposer “declares to be willing to acquire the derivative rights of **the trademark previously mentioned**” (emphasis added), clearly indicating that the parties understood “the trademark” to be the mark shown in the CTM Registration.¹⁵

¹⁵ We note that very similar language appears in the 2018 Contract between Applicant and New Yorker America Holding LLC, through which New Yorker America Holding LLC receives from Applicant “the previously mentioned trademark” in a paragraph that follows Applicant’s declaration that he is the “owner of the trademark NEW YORKER for the United States of America, Canada and Mexico,” and the “owner of US trademark application serial number 87302931, Class 32, Published on October 10, 2018.” Ortiz Decl. Ex. G (46 TTABVUE 68).

The 2015 Contract also refers to the “derivative rights of the trademark” in the fourth paragraph, in which Opposer “hands over the payment agreed for” their transfer to Opposer, and to “the inherent rights to the trademark,” which Applicant “sells, transmits and transfers” to Opposer in the fourth paragraph “for all territories with exception of Canada, United States of America and Mexico, where [Opposer] accepts and acknowledges that [Applicant] will keep the rights of the trademark.” In the context of the 2015 Contract as a whole, we read these phrases referencing “derivative rights” and “inherent rights” to refer not to marks other than the one shown in the CTM Registration, but rather to the “derivative” and “inherent” rights pertaining to that mark.

There is no indication in the language of the 2015 Contract that the parties intended to refer to, or divvy up rights in, not only the mark shown in the CTM Registration, but also what Applicant variously calls a “new version” of that mark, a mark that “creates the impression of being essentially the same mark,” or a mark that is “legally equivalent” to the registered mark. *Cf. Bausch & Lomb*, 87 USPQ2d at 1528-29 (granting summary judgment to the opposer on its claim that in filing the opposed application to register the mark STORZ THE WORLD OF ENDOSCOPY and design, the applicant breached a settlement agreement between the parties that set forth in detail the ways in which each party could use marks containing the word STORZ, including that the applicant could use nine specific marks and “may supplement any of the above examples with additional trademark formatives, whether by way of letters, numbers, words, syllable (sic), or designs.”). There is also

no indication in the language of the 2015 Contract that the parties contemplated a situation where a mark other than that shown in the CTM Registration would ever be used or registered anywhere by either party. We hold that under the plain language of the 2015 Contract, Opposer agreed that Applicant would have rights in the United States, Canada, and Mexico to the mark shown in the CTM Registration but nothing more. Opposer is thus not estopped from opposing Applicant's registration of the mark shown in the Opposed Application because that mark is not the mark shown in the CTM Registration.

V. Opposer's Claim That Applicant Lacked a Bona Fide Intention to Use the Mark in Commerce in Connection with the Goods Identified in the Opposed Application

“[B]ecause a bona fide intention to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under Section 1(b), the lack of such intent is a basis on which an opposer may challenge an applicant's mark.” *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *5 (TTAB 2019) (quoting *M.Z. Berger*, 114 USPQ2d at 1898). “[W]hether an applicant had a ‘bona fide intent’ to use the mark in commerce at the time of the application requires objective evidence of intent.” *M.Z. Berger*, 114 USPQ2d at 1898 (citing 15 U.S.C. § 1051(b)). “Although the evidentiary bar is not high, the circumstances must indicate that the applicant's intent to use the mark was firm and not merely intent to reserve a right in the mark.” *Id.* (citations omitted). “The Board may make such determinations on a case-by-case basis considering the totality of the circumstances.” *Id.* “[A]ll circumstances regarding an applicant's bona fide intent

must be considered, including those facts that would tend to disprove that [the applicant] had the requisite intent.” *Id.*

Opposer “has the burden of demonstrating by a preponderance of the evidence that [A]pplicant lacked a bona fide intent to use the mark on the identified goods. The absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof . . . that the applicant lacks a bona fide intention to use its mark in commerce.” *Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at *8 (TTAB 2020) (quoting *Rsch. in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1930 (TTAB 2009) (citing *Commodore Elecs. Ltd. v. CBM K.K.*, 26 USPQ2d 1503, 1507 (TTAB 1993)). “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 his intent to use his mark in commerce.” *Id.*, at *9 (quoting *Commodore Elecs.*, 26 USPQ2d 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.” *Id.* (quoting *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994)).

Opposer argues that it provided “affirmative evidence of Applicant’s lack of bona fide intent” and “satisfied its initial burden of proving that Applicant lacked bona fide intent by virtue of several documents of record showing that he was aware that [Opposer] owned the mark and that he had no right to file in his own name.” 55 TTABVUE 12. The first document cited by Opposer is the 2015 Contract, under which

Opposer claims that “Applicant transferred all rights to exploit a previous, different version of the mark in certain geographical areas to [Opposer].” *Id.* at 12-13 (citing Damiola Decl. ¶ 10; Ex. B (38 TTABVUE 6, 13)). Opposer claims that the 2015 Contract “clearly indicates that Applicant understands that trademark applications can only be filed with bona fide intent by the entity or individual that owns the rights to a particular trademark.” *Id.* at 13. Opposer elaborates that the 2015 Contract “was necessary because the trademark at issue in the Agreement had been developed by Applicant in collaboration with other companies and so, for [Opposer] to legitimately exploit the rights in this mark, there had to be a transfer of rights from those entities or individuals to [Opposer].” *Id.* Opposer claims that a “completely different scenario applied to the mark at issue in this Opposition,” *id.*, and that because Opposer hired consultants to develop this mark, “Applicant had no rights to this mark, yet Applicant filed a trademark application in his own name to exploit the rights to this mark.” *Id.*

The second document cited by Opposer is its “Rules of Incorporation[, which] require that any act of a binding nature on the company be approved by the Board of Directors.” *Id.* (citing Damiola Rebut. Decl. ¶ 8 (50 TTABVUE 6)). Opposer argues that “Applicant, in his role as D&P Holding’s Managing Director for Europe, was well aware of how D&P Holding operated and that filing a trademark application for a mark property of D&P Holding (either in the company’s or in an individual’s name) would require the approval of the Board of Directors.” *Id.*

One “way an opposer can establish its prima facie case of no bona fide intent is by proving that applicant has no documentary evidence to support its allegation in the

application of its claimed bona fide intent to use the mark in commerce as of the application filing date.” *M.Z. Berger*, 108 USPQ2d at 1471 (citing *Saul Zaentz Co. v. Blumb*, 95 USPQ2d 1723, 1727 (TTAB 2010)). Opposer’s second argument is that “[i]n addition to affirmative evidence of Applicant’s lack of bona fide intent, [Opposer] can also rely on a total absence of documents demonstrating the contrary.” 55 TTABVUE

13. Opposer argues that

Applicant failed to produce any documents that would be supporting of the statement that Applicant had a bona fide intent to use the mark at issue in commerce. During discovery, [Opposer] served document requests and interrogatories aimed at obtaining information and documents relating to a wide variety of elements that would indicate any bona fide intent of Applicant to use the mark at issue.

Id. at 14.

According to Opposer,

[a]mong other things, [Opposer’s] requests sought documents evidencing: (i) Applicant’s use of the mark; (ii) the consideration, selection, and adopting of the mark; (iii) products sold, promoted, planned to be sold or promoted; (iv) the identification of channels of trade for the products sold or planned to be sold under the mark; and (v) the origin or place of manufacture of the products to be sold under the mark. In response to these requests, Applicant has either admitted that ‘no responsive documents exist’ or stated that it would produce any representative, non-privileged documents. Contrary to its own assertions that documents would be produced, Applicant has not produced one single document in relation to any of the requests in [Opposer’s] First Set of Document Requests.

Id. at 15 (emphasis supplied by Opposer).

Opposer lists purported areas of inquiry in its document requests, *id.*, and argues that

Applicant failed to produce any documents evidencing any of the above, despite those documents being requested by [Opposer] as part of discovery. In addition to failing to produce any documents, Applicant has also not adequately explained or provided facts that would outweigh the failure to produce documents supporting Applicant's bona fide intent.

Id. Opposer concludes that “[i]n light of all this, it is evident that Applicant lacks now, and lacked at the time of filing of the Application, any bona fide intent to use the mark at issue.” *Id.*

Applicant responds that Opposer “claims that it met its initial burden by propounding interrogatories on five topics none of which required Applicant to identify or produce documentary evidence regarding Applicant's intent to use the applied-for mark.” 57 TTABVue 12-13. Applicant further argues that Opposer “claims that it requested that Applicant produce documents relating to these interrogatory topics,” but “did not make of record in these proceedings any requests for the production of documents.” *Id.* at 13.

According to Applicant,

Opposer did not ask Applicant to indicate that there were no documents upon which Applicant relied in answering the interrogatories. Opposer did not serve any additional interrogatories or object in any way to Applicant's responses. In total, Applicant's responses to Opposer's interrogatories merely establish that Applicant was not using the mark prior to responding to the interrogatories. The lack of actual use does not constitute a *prima facie* showing that Applicant lacked a bona fide intention to use the mark at the time the application was filed or establish that no documentary evidence exists to support Applicant's claim in his application that he had a bona fide intention to use the applied-for mark in commerce.

Id. at 14. Applicant argues that his “responses to Opposer’s interrogatories fail to meet the minimum threshold required to switch the burden of production to Applicant.” *Id.* at 15.

Applicant further argues that

[a]side from the facially insufficient interrogatory responses, Opposer has not made of record [a]ny evidence to substantiate its claim that Applicant lacked a bona fide intention to use his New Yorker mark in commerce. Opposer makes various allegations in the two Damiola declarations proffered by Opposer in these proceedings but none of these allegations are supported by any corroborating evidence. Mere allegations of a lack of a bona fide intention fail to shift the burden of production on an applicant.

Id.

Applicant argues in the alternative that if “Opposer has met its initial burden thereby shifting the burden of production to Applicant, Applicant has demonstrated that he had a bona fide intent to use the applied-for mark when the application was filed.” *Id.* Applicant points to his “experience and demonstrated ability to create and successfully market beverages brands and produce beverages,” *id.*, his work “with a designer to create labels and packaging for the beer to be sold under the original version of Applicant’s Mark,” *id.* at 16, and his formation of “a limited liability company, New Yorker America Holding, LLC in the State of Delaware in late 2018 to handle the marketing of beer under the applied-for mark as well as to find distributors for the beer,” and his subsequent assignment of his “rights to this limited liability company shortly after its formation.” *Id.* Applicant concludes that “[b]ased on all the circumstances as revealed by the evidence of record in this opposition,

Applicant has demonstrated that he had, and continues to have, a bona fide intention to use the applied-for mark in commerce.” *Id.*

In its reply brief, Opposer argues that Applicant “has yet to produce one single responsive document to any of Opposer’s First Set of Requests for Production of Documents.” 58 TTABVUE 7 (emphasis supplied by Opposer). With respect to Applicant’s claimed evidence of the bona fides of his intent, Opposer argues that “[i]t is unclear (and unsurprisingly [Applicant] cites to no legal authority in support thereof) how Applicant’s former employment experience, the launch of a completely different mark, or the formation of a Delaware company show that [Applicant] had the requisite bona fide intent to use the mark in [the Opposed Application].” *Id.* at 8. Opposer concludes that “[w]hat is clear, however, is that [Applicant] has not produced a single document in the span of over five years indicating that he had any plans to use this mark,” that he “still has no documents whatsoever that indicate that at any point in time he plans or has planned to use this mark,” and that “[i]t is nearly impossible to find a stronger indication that he lacked bona fide intent to do so.” *Id.* (emphasis supplied by Opposer).

Opposer’s theory that it “satisfied its initial burden of proving that Applicant lacked bona fide intent by virtue of several documents of record showing that he was aware that [Opposer] owned the mark and that he had no right to file in his own name,” 55 TTABVUE 12, misses the mark for two reasons.

First, Opposer’s theory is based on a faulty premise. “There is no statutory requirement that the filer of an intent-to-use application be the owner of the mark at

the time it files an intent-to-use application” because “the filer avers that: ‘The signatory believes that the applicant is entitled to use the mark in commerce. The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application.’” *Hole in 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *5-6 (TTAB 2020) (citing *Norris*, 2019 USPQ2d 370880, at *4). “Therefore, a claim that an applicant . . . was not the rightful ‘owner’ of the mark when the application was filed is not available when the application, as originally filed, is not based on use of the mark in commerce.” *Id.* Because the Opposed Application was not filed under Section 1(a) of the Trademark Act based on Applicant’s allegation of use in commerce, this is not an “ownership case, i.e., a situation where the parties once collaborated in using a mark but are now disputing the rights to the same underlying mark for the same [goods].” *Norris*, 2019 USPQ2d 370880, at *4 (citations omitted). “[W]here the [opposed] application is based on intent to use under Section 1(b) of the Trademark Act, and two parties are claiming superior rights based on shared circumstances, the question is which entity or individual had the bona fide intent.” *Id.*, at *5 (citation omitted). Accordingly, we need not decide whether either party “owned” the mark shown in their dueling United States applications based on their prior dealings in Europe, and Opposer’s argument that Applicant lacked a bona fide intent because he “was aware that [Opposer] owned the mark and that he had no right to file in his own name,” 55 TTABVUE 12, is meritless.

Second, the documents that Opposer cites do not support its theory of its prima facie case. Opposer claims that the 2015 Contract “clearly indicates that Applicant understands that trademark applications can only be filed with bona fide intent by the entity or individual that owns the rights to a particular trademark,” *id.* at 13, but as discussed above, “ownership” of “the rights to a particular trademark” is irrelevant to the bona fides of Applicant’s intent. There is no evidence in the record, such as a discovery deposition, that Applicant understood the significance of the 2015 Contract to be that “trademark applications can only be filed with bona fide intent by the entity or individual that owns the rights to a particular trademark,” *id.*, and Opposer’s claim is merely “attorney argument unsupported by any testimony or evidence and, therefore, it does not have any probative value.” *Performance Open Wheel Racing, Inc. v. U.S. Auto Club Inc.*, 2019 USPQ2d 208901, at *8 n.62 (TTAB 2019) (citing *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1787, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”))).

Opposer’s reliance on what Mr. Damiola describes as its “Rules of Incorporation” is equally unavailing. The “Rules of Incorporation” of Opposer, a Swiss company, are not of record, and there is also no proof of their effect under Swiss law, and no proof of what duties, if any, are owed by a shareholder of a Swiss company, or a director of the company’s subsidiary, to the company under Swiss law. Moreover, as discussed above, because under United States law, Opposer did not “own” the mark that was

the subject of Applicant's intent-to-use application in the United States, its filing did not involve the "exploitation" of an "asset" of Opposer.

Finally, Opposer's arguments regarding Applicant's failure to produce documents to support the bona fides of his intention are unsupported by any evidence of the document production requests that Opposer claims to have served and the responses (or lack thereof) that it claims to have received.¹⁶ We are baffled by Opposer's failure to make the requests and responses of record. *Cf. Bos. Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (quoting the applicant's responses to the opposer's document requests indicating that the applicant did not have any relevant documents). In the absence of Applicant's actual responses to Opposer's production requests, we can no more accept Opposer's argument of counsel about what they say than we can accept Opposer's argument of counsel about the meaning and impact of foreign agreements and corporate governance documents.

The 2015 Contract, and Opposer's arguments regarding the missing "Rules of Incorporation" and Applicant's purported responses to Opposer's document requests, do not support a prima facie case of Applicant's lack of a bona fide intention to use the mark shown in the Opposed Application as of its filing date. As noted above, however, "all circumstances regarding an applicant's bona fide intent must be

¹⁶ A number of Applicant's responses to Opposer's interrogatories object to them on the ground that they are "duplicative of Opposer's First Set of Requests for Production of Documents," Resp. Nos. 1-6, 10, 12-18, 20-25 (39 TTABVUE 9-13, 15-19, 20-22), and many of those responses state that "to the extent that any response to this interrogatory can be calculated by a review of documents, Applicant refers Opposer to Fed. R. Civ. P. 33(d) and the forthcoming document production." Resp. Nos. 1-4, 6, 10, 12, 14, 18, 22-25 (39 TTABVUE 9-13, 15-17, 19, 21-22). These responses per se do not show that Applicant stated that he had no relevant documents or that he produced none.

considered, including those facts that would tend to disprove that [the applicant] had the requisite intent,” *M.Z. Berger*, 114 USPQ2d at 1898, and we must determine whether the record establishes, prima facie, that Applicant lacked a bona fide intent when he filed the Opposed Application by “considering the totality of the circumstances.” *Id.* Thus, we will also consider the circumstances preceding and surrounding the filing of the Opposed Application, and the substance of Applicant’s responses to Opposer’s interrogatories, which Opposer made of record during its case-in-chief, to determine whether Opposer proved such a prima facie case.

As discussed above, Opposer filed the Opposed Application on the same day that he expressly abandoned the ’477 Application. Applicant’s “mere act of filing [the] intent-to-use [Opposed Application] is insufficient to establish [his] bona fide intention to use [his] mark in commerce for the identified goods,” *Société des Produits Nestlé*, 2020 USPQ2d 10893, at *11-12, and the timing of the filing of the Opposed Application supports an inference that Applicant intended the Opposed Application to “replace” the abandoned ’477 Application. As discussed above, however, the Opposed Application does not cover **any** of the goods identified in the ’477 Application, but rather an entirely new and different set of goods. We infer from Applicant’s failure to include beers, which are referred to in the verbal portions of the marks shown in the ’477 Application and in the Opposed Application discussing “Fine Lager Beer,” Damiola Decl. ¶¶ 13, 18 (38 TTABVUE 8-9), that Applicant’s “intent at the time [he] filed [his] application ‘was merely to reserve a right in a mark’ in case [he] made the firm decision to begin developing . . . associated product[s] at some

future time, rather than to use that [new] mark in commerce as defined in Section 45 of the Trademark Act on the identified goods.” *M.Z. Berger*, 108 USPQ2d at 1477.

We draw a similar inference of a lack of a bona fide intention to use from the substance of certain of Applicant’s March 20, 2020 responses to Opposer’s interrogatories, which responses were served more than three years after the filing of the Opposed Application. Applicant’s responses stated that his attorney performed a trademark search prior to filing the Opposed Application, Resp. to Int. No. 10 (39 TTABVUE 15),¹⁷ but also that (1) the mark shown in the Opposed Application “has not yet been used in commerce on the goods set forth in the [O]pposed [A]pplication,” Resp. to Int. No. 2 (39 TTABVUE 10-11); (2) “he has not yet sold or transported in commerce any of the goods in the [O]pposed [A]pplication but intends to do so,” Resp. to Int. No. 3 (39 TTABVUE 11); (3) he “is not aware of any instance in which Applicant’s Mark has been or is scheduled to be mentioned in any publications, catalogs or broadcast advertisements,” Resp. to Int. No. 5 (39 TTABVUE 12); (4) he “has neither promoted nor offered products for sale under Applicant’s Mark at any trade shows, professional shows, professional meetings, seminars, conferences, or conventions,” Resp. to Int. No. 6 (39 TTABVUE 13); (5) he “has not manufactured or caused to be manufactured any goods for sale in connection with Applicant’s Mark.” Resp. to Int. No. 11 (39 TTABVUE 15); (6) he “intends to sell and market the goods

¹⁷ “We note that in some cases, a trademark clearance search may be probative evidence of a bona fide intent to use.” *M.Z. Berger*, 108 USPQ2d at 1475. As discussed below, however, we find that “[n]either the application itself nor the unproduced trademark search suffice to establish Applicant’s intent.” *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2009 (TTAB 2015) (citing *M.Z. Berger*, 114 USPQ2d at 1898).

set forth in the [O]pposed [A]pplication through all channels of trade customary for those goods,” Resp. to Int. No. 15 (39 TTABVUE 17); and (7) he “intends to offer the goods set forth in the [O]pposed [A]pplication under Applicant’s Mark in the manner in which those goods are normally offered to the ultimate consumers of such goods.” Resp. to Int. No. 17 (39 TTABVUE 18-19). Applicant’s interrogatory responses also establish that as of March 2020, there had been no sales of goods bearing the mark shown in the Opposed Application and no advertising expenditures relating to goods bearing the mark shown in the Opposed Application. Resp. to Int. Nos. 7-8 (39 TTABVUE 13-14). Taken together, Applicant’s interrogatory responses establish that in the more than three years after the filing of the Opposed Application, he did nothing to bring any of the goods identified in the Opposed Application to market in the United States under the applied-for mark.¹⁸

In *Société des Produits Nestlé*, the Board found that the opposer had established a prima facie case that the applicant lacked a bona fide intention to use the mark when it filed the involved application in early 2016 based in part on discovery responses served in 2017 that established that there were

no product sales, no advertising or promotional expenditures, no advertising or promotional materials, no assignees, licensees or authorized users of the NESPORT mark, no agreements or communications with potential manufacturers, distributors or suppliers for his NESPORT branded products, no commitments from U.S. retailers to

¹⁸ At the oral hearing, Applicant’s counsel argued, without citing any record evidence, that Applicant ceased activities with respect to the mark after Opposer filed the opposition. Even if Applicant did so, his interrogatory responses show that he did nothing to bring products to market under the mark shown in the Opposed Application during the period of more than two years between the January 16, 2017 filing of the Opposed Applicant and the February 27, 2019 filing of the opposition.

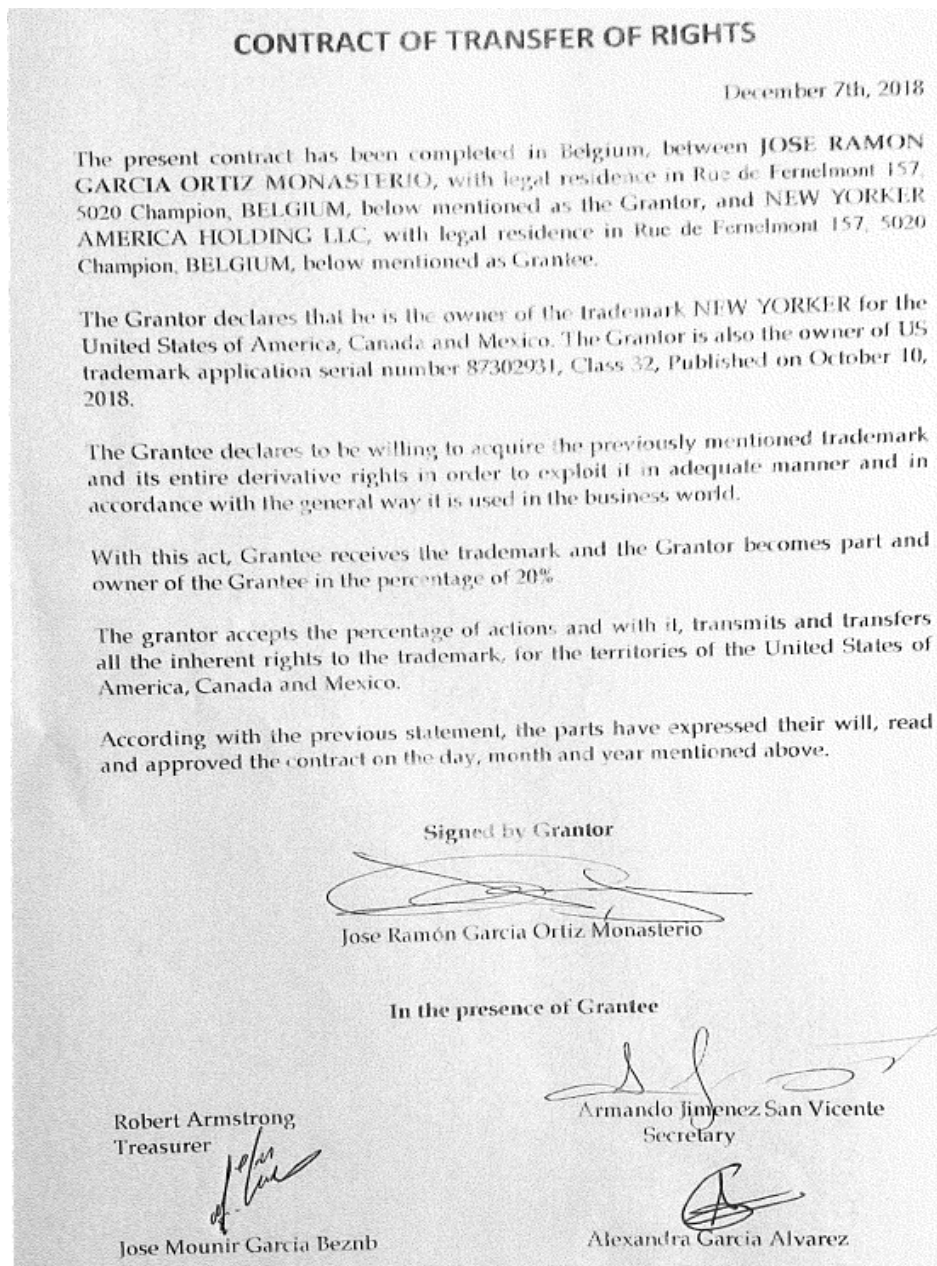
carry his products, no materials demonstrating attempts to obtain regulatory approval for his products (e.g., his pharmaceutical and alcoholic beverage products), no documentation showing his attendance at trade shows, expositions or competitions, and no materials showing designs for anticipated packaging or labeling.

Société des Produits Nestlé, 2020 USPQ2d 10893, at *13-14. Applicant’s discovery responses here are not as comprehensive as their counterparts in *Société des Produits Nestlé*, but they nevertheless “demonstrate[] nothing more than the mere filing of [the Opposed Application] without a concomitant showing of efforts to actually use the mark,” *id.*, at *12, over a period following the filing of the involved application that is longer than the counterpart period in *Société des Produits Nestlé*. A “long gap between the filing of an application and the activities asserted to demonstrate bona fide intent tends to undercut an inference that the applicant actually had a bona fide intent to use the mark,” *id.*, at *13, and Applicant’s interrogatory responses establish that he engaged in **no** activities directed to producing, promoting, advertising, or selling any of the goods identified in the Opposed Application in the United States during the three-year period following its filing.

We find that the circumstances surrounding the filing of the Opposed Application, and Applicant’s interrogatory responses establishing that he has done nothing post-filing—not even having professional meetings—to bring the identified goods to market in the United States under the applied-for mark, are sufficient to show prima facie that Applicant lacked a bona fide intention to use the applied-for mark in commerce when he filed his application, and to shift to Applicant the burden of producing “additional evidence concerning the factual circumstances bearing upon

his intent to use the mark in commerce.” *Id.*, at *9 (quoting *Commodore Elecs.*, 26 USPQ2d 1507 n.11).

Applicant’s evidence to that end boils down to his testimony (1) that “I have extensive knowledge and experience in the branding and marketing of beers,” Ortiz Decl. ¶¶ 3-6 (46 TTABVUE 3-4); (2) that “[s]ince before the filing date of [the Opposed Application], I have had and continue to have a bona fide intention to use the applied-for mark in commerce in connection with the goods set forth in the application,” Ortiz Decl. ¶ 18 (46 TTABVUE 7); (3) that “[w]ith some partners, I formed New Yorker America Holding LLC in Delaware on December 3, 2018” with the “objective to manufacture and sell New Yorker Fine Lager beer, as we did with Corona Extra, and to make it on par with a global premium brand and to make it the first truly American premier beer,” Ortiz Decl. ¶ 19 (46 TTABVUE 7-8); and (4) that “[o]n December 7, 2018, I assigned to this company the rights to the New Yorker band [sic] in the USA, Canada and Mexico” under the 2018 Contract shown below:



Ortiz Decl. ¶ 20; Ex. G (46 TTABVUE 8, 68).¹⁹

Applicant’s evidence falls short of showing his bona fide intention to use the mark for several reasons. First, his testimony that “[s]ince before the filing date of [the

¹⁹ The 2018 Contract is the only document that Applicant offered in support of the bona fides of his intention when he filed the Opposed Application in January 2017.

Opposed Application], I have had and continue to have a bona fide intention to use the applied-for mark in commerce in connection with the goods set forth in the application,” Ortiz Decl. ¶ 18 (46 TTABVUE 7), has no probative value. “Applicant’s mere statements that he intends to use the mark . . . and his denial that he lacked a bona fide intent, do not establish, in fact, that he had a bona fide intent to use the mark in commerce when he filed the involved application.” *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1444 (TTAB 2012). “Evidence bearing on bona fide intent

is “objective” in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant’s testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of applicant later testifying, “Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future.”

Id. (quoting J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, 19-14 (4th ed. 2009)). Accordingly, we have given Applicant’s self-serving profession of a bona fide intention no weight in our decision.

Second, although the Board has recognized that “an applicant’s capacity to market and/or manufacture the identified goods is evidence that weighs against a finding that an applicant lacked bona fide intent to use,” *M.Z. Berger*, 108 USPQ2d at 1477, and Applicant appears to have “extensive knowledge and experience in the branding and marketing of beers,” Ortiz Decl. ¶¶ 3-6 (46 TTABVUE 3-4), the goods identified in the Opposed Application do not include beers.²⁰ “[T]here is no record evidence that

²⁰ This fact seems to have been lost on Applicant, who testified in his December 27, 2021 declaration that the Opposed Application covers “Beer; Beer wort; Beers; Alcohol-free beers; Brewed malt-based beers; Craft beers; Flavored beers; Ginger beer; Imitation beer; Malt beer; Pale beer; Porter or Beer-based cocktails; Essences used in the preparation of liqueurs; Malt

[A]pplicant is now or ever was in the business of producing” beer-based cocktails, essences used in the preparation of liqueurs, malt extracts for making beer, non-alcoholic rice-based beverages not being milk substitutes, smoothies, soy-based beverages not being milk substitutes, soya-based beverages, other than milk substitutes, syrups for beverages, or syrups for making beverages, the goods actually identified in the Opposed Application. *L’Oreal*, 102 USPQ2d at 1443 (finding that the applicant lacked a bona fide intent to use the mark in connection with the “aloe vera drinks” identified in the involved application in part because the record showed his “lack of capacity or experience needed to manufacture or otherwise offer his identified goods.”). Nor has Applicant offered any support for the proposition that such goods are sufficiently similar to beer that his expertise in the development and marketing of the latter would enable him to develop and market the former.

Finally, the only actions that Applicant claims to have taken to commence use of the mark shown in the Opposed Application in the United States are the formation of a Delaware company to market beers,²¹ and the subsequent assignment of the mark shown in the Opposed Application to that company.²² Those steps are too little

extracts for making beer; Non-alcoholic rice-based beverages not being milk substitutes; Smoothies; Soy-based beverages not being milk substitutes; Soya-based beverages, other than milk substitutes; Syrups for beverages; Syrups for making beverages.” Ortiz Decl. ¶ 2 (46 TTABVUE 2). As discussed above, no type of beer appears in the identification of goods in the Opposed Application.

²¹ Applicant testified that he formed the company in Delaware, Ortiz Decl. ¶ 19 (46 TTABVUE 7), but the 2018 Contract recites that the company has its “legal residence” in Belgium (at Applicant’s address), not in the United States. Ortiz Decl. Ex. G (46 TTABVUE 68).

²² Because Applicant assigned the mark shown in the Opposed Application to the new company in exchange for an equity stake when no business pertaining to the mark existed, the assignment smacks of trafficking in the mark, which the intent-to-use provisions of the

and too late to establish the bona fides of Applicant's intention to use the mark when the Opposed Application was filed in January 2017. They are too little because they pertain only to the prospective manufacture and sale of "New Yorker Fine Lager beer," Ortiz Decl. ¶ 19 (46 TTABVUE 8), goods that are not covered by the Opposed Application, *see L'Oreal*, 102 USPQ2d at 1443, and there is no evidence that either Applicant or the purported assignee did anything to bring even beers to market under the applied-for mark.

These steps would be too late even if they pertained to the goods actually identified in the Opposed Application because they occurred almost two years after the filing of the Opposed Application, and, as noted above, a "long gap between the filing of an application and the activities asserted to demonstrate bona fide intent tends to undercut an inference that the applicant actually had a bona fide intent to use the mark." *Société des Produits Nestlé*, 2020 USPQ2d 10893, at *13. Applicant does not testify that he took any steps to bring products to market after the purported assignment of the mark to New Yorker America Holding LLC, either before the filing of this opposition on February 27, 2019, or in the more than three years between the December 7, 2018 assignment and Applicant's December 27, 2021 trial testimony. "Simply put, there are no concrete activities to corroborate [A]pplicant's bald

Trademark Act are designed to prevent. *See Clorox Co. v. Chem. Bank*, 40 USPQ2d 1098, 1104 (TTAB 1996); *cf.* 15 U.S.C. § 1060(a)(1) (prohibiting the assignment of an intent-to-use application prior to proof of use of the applied-for mark except to a successor of the business of the applicant if that business is ongoing and existing). The 2018 Contract also raises the issue of whether the purported assignee is actually the proper defendant in this proceeding, but Opposer did not address that issue, and on this record, we can find only that Applicant is the proper defendant.

allegation that he has a bona fide intent to use the mark in commerce.” *L’Oreal*, 102 USPQ2d at 1443. *See also Société des Produits Nestlé*, 2020 USPQ2d 10893, at *13 (citing *Swiss Grill*, 115 USPQ2d at 2009 (the applicant’s vague claims about communications, meetings or events that took place one or two years after the filing date, and which did not relate to the mark in question, were found insufficient to show bona fide intent at the time of filing)); *Bos. Red Sox*, 88 USPQ2d at 1597 (Internet searches and investigations conducted over two years after the filing of the application held to be “not even remotely contemporaneous with the filing of the application.”)).

We find, based on the record as a whole, that Opposed proved, by a preponderance of the evidence, its entitlement to a statutory cause of action for opposition and that Applicant lacked a bona fide intention to use the mark shown in the Opposed Application in connection with the goods identified therein when he filed the Opposed Application.

Decision: The opposition is sustained.