

This Opinion Is Not A
Precedent Of The TTAB

Mailed: July 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Monster Energy Company
v.
Tom & Martha LLC
—

Opposition No. 91250710
—

Alexander D. Zeng of Knobbe Martens, Olson & Bear LLP
for Monster Energy Company

Jeffrey C. Joyce of Eaton Peabody
for Tom & Martha LLC
—

Before Kuhlke, Cataldo and Pologeorgis,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Tom & Martha LLC, seeks registration of the mark LOCH MOOSE

MONSTAH in standard characters for:¹

Canvas tote bags; all-purpose sport bags; all-purpose
carrying bags; backpacks; wallets; handbags; travel cases;
brief cases; key cases; business card cases, International
Class 18;

¹ Serial No. 87860965, filed April 30, 2018, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Cups; mugs; containers for household use; beverageware, International Class 21;

Headwear; shirts, t-shirts; sweat shirts; hooded sweat shirts; sweat bands; sweat suits; sweat jackets; socks; shorts; tank tops; tube tops; halter tops; footwear; jackets; coats, gloves; belts, International Class 25;

Online retail store services featuring bags, wallets, beverageware, and clothes; online wholesale store services featuring bags, wallets, beverageware, and clothes, International Class 35.

Opposer, Monster Energy Company, has opposed registration of Applicant's mark on the ground that, as used in connection with Applicant's goods and services, the mark so resembles Opposer's various MONSTER marks, for a variety of goods, including MONSTER ENERGY for beverageware, clothing and golf bags, as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).² Opposer also alleges the several marks comprise a family of marks. In addition, Opposer alleges Applicant did not have a bona fide intent to use the mark in commerce for the goods and services in the involved application. By its answer, Applicant generally denies the salient allegations.

I. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the application subject to the notice of opposition. In addition the record includes:

- Opposer's Notices of Reliance on Opposer's several pleaded registrations showing status and title, Applicant's responses to various discovery requests, Opposer's 10-K reports; excerpts from various

² Not. of Opp., 1 TTABVUE.

printed publications, excerpts from the discovery depositions of Thomas J. Byrne and Martha Huestis and corresponding exhibits, printouts of Opposer's website, Facebook, Twitter, Instagram and YouTube pages, and printouts of third-party webpages;³

- Opposer's Testimony Declaration of Rodney Sacks, Opposer's Chairman and Co-Chief Executive Officer, with exhibits (Sacks Decl.);⁴
- Applicant's Testimony Declaration of Thomas J. Byrne, Applicant's member and manager, with exhibits (Byrne Decl.);⁵
- Applicant's Notices of Reliance on third-party registrations and printouts of Opposer's website;⁶
- Opposer's Cross Examination Deposition of Thomas J. Byrne, with exhibits (Byrne Oral Cross Exam);⁷
- Opposer's Rebuttal Notice of Reliance on Applicant's registrations for other marks.⁸

II. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Opposer's entitlement to a statutory cause of action is a requirement that must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that

³ 25-38 TTABVUE.

⁴ 39-44 TTABVUE.

⁵ 46 TTABVUE.

⁶ 45 TTABVUE.

⁷ 51 TTABVUE.

⁸ 48 TTABVUE.

is proximately caused by the prospective registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Once a plaintiff has shown entitlement, previously discussed as “standing,” on one ground, it has the right to assert any other ground in an opposition proceeding. *See Poly-Am., L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground); *Luxco, Inc. v. Consejo Regulator del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its standing as to genericness ground of certification mark and was entitled to assert any other ground).

As listed above, the record includes status and title copies of Opposer’s pleaded registrations. In view thereof, Opposer’s entitlement to a statutory cause of action to oppose registration of Applicant’s mark is established. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ... direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at *7 (TTAB 2022) (pleaded registrations demonstrated entitlement to bring a statutory cause of action); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition).

III. SECTION 2(d) CLAIM

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). Opposer pleaded several MONSTER-formative marks. While we consider all of the pleaded registrations and proven common law uses, we focus our analysis on Opposer’s registered mark MONSTER ENERGY and the goods in International Classes 18, 21 and 25 in Registration No. 5,820,689 and common law use for online retail and promotional services, because these goods and services are, in part, identical, legally identical and otherwise closely related to Applicant’s goods and services. If we do not find a likelihood of confusion with respect to this mark and its goods and services, then there would be no likelihood of confusion with the mark and goods and services in Opposer’s other registrations and common law uses. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority with respect to its mark MONSTER ENERGY and Applicant’s mark LOCH MOOSE MONSTAH, and that Applicant’s use of its mark in connection with the goods and services identified in its application is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

A. PRIORITY

Applicant's earliest date of use on which it is entitled to rely is the filing date of its application, April 3, 2018. See *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) ("applicant may rely without further proof upon the filing date of its application as a 'constructive use' date for purposes of priority"); *Zirco Corp. v. American Tel. and Tel. Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

Because the pleaded registrations are not the subject of counterclaims, priority is not in issue with respect to the marks, and goods and services in the registrations. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer has also proven prior common law use of the marks MONSTER ENERGY, MONSTER ENERGY with M claw design and M claw design in connection with a variety of goods.⁹

⁹ The record does not clearly establish use of the MONSTER mark by itself in connection with goods; however, even if it did, it would not change the result based on the differences in Applicant's mark in comparison with the word MONSTER by itself.

In the pleading and in the “Introduction” section of its brief, Opposer refers to its “family of MONSTER-inclusive marks.” As support for finding a family of marks Opposer argues:

The family of MONSTER Marks share the term MONSTER as a common characteristic, and the MONSTER Marks appear together in the same advertisements and at the point-of-sale (e.g., store displays, refrigerator racks, etc.). (Dkt. 39, Sacks Decl., Exs. 6, 11; Dkt. 36, Opp.’s 4th NOR, Exs. 74-82, 110-112); *McDonald’s Corp. v. McSweet LLC*, 112 U.S.P.Q.2d 1268, 2014 WL 5282256, at *10 and *19 (T.T.A.B. 2014) (family of marks established when marks with shared characteristic appear in the same advertisement or at point of sale).

Opp. Brief, 54 TTABVUE 9.

“Although the USPTO may register several individual marks comprising a family element together with one or more other elements, it does not register ‘families’ of prefixes, suffixes, or other components of a mark.” *New Era Cap Co. v. Pro Era LLC*, 2020 USPQ2d 10596, *6-7 (TTAB 2020). “Thus, an opposer relying on a family of marks is relying on common law rights in the alleged family.” *Id.* at *7. “The burden of proving a family of marks falls with Opposer, the party asserting the existence of the family.” *Id.*

As defined in *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

[a] family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a

recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin. “Neither the mere intention to create a family of marks, nor ownership of multiple registrations containing the family term, is sufficient in and of itself to establish that a party owns a family of marks.” *New Era*, 2020 USPQ2d 10596 at *7 (citations omitted). In order to prove ownership of a family of marks, Opposer must establish:

“[F]irst, that prior to the entry into the field of the opponent’s mark, the marks containing the claimed ‘family’ feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the ‘family’ feature; and second, that the ‘family’ feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party’s mark).”

Id. (quoting *Marion Labs. Inc. v. Biochemical Diagnostics Inc.*, 6 USPQ2d 1215, 1218-19 (TTAB 1988) (internal quotations omitted)). *See also TPI Holdings Inc. v. Trailertrader.com, LLC*, 126 USPQ2d 1409, 1420 (TTAB 2018) (proof of a family of marks requires proof of prior use of marks that share the common characteristic or family “surname,” that the family surname is distinctive, and that the “marks were used in advertising or sales so as to create common exposure to and recognition by purchasers of the common characteristic as indicating origin.”) (citing *Wise F & I, LLC. v. Allstate Insurance Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016)). Opposer “must

prove the existence of [a MONSTER] family of marks prior to any date Applicant can rely upon for purposes of priority.” *New Era*, 2020 USPQ2d 10596 at *7.

While Opposer asserts in its brief common law rights in its various “MONSTER marks,” Opposer makes no effort to prove priority based on a family of marks other than to state in the introduction section “the MONSTER Marks appear together in the same advertisements and at the point-of-sale (e.g., store displays, refrigerator racks, etc.)” Opp. Brief, 54 TTABVUE 9. This alone is not sufficient to find a family of marks, there is no evidence or testimony to establish that the use was done in a way “so as to create common exposure and recognition by purchasers of the common characteristic as indicating origin.” *TPI Holdings*, 126 USPQ2d at 1420. Opposer’s reliance on *McDonald’s Corp. v. McSweet LLC*, 112 USPQ2d 1268 does not provide it legal support. In that case, it was not merely that the various marks appeared together, but rather based on its use and promotion of its family with evidence that the marks were used in a way to create recognition of a family consisting of a “MC” prefix combined with a generic or descriptive term and evidence of that recognition. The decision also references MCDONALDS and MCFLURRY as not being a member of the family because they do not follow the family structure. Here, not only is there no evidence upon which to establish consumer recognition of the family, it is unclear what the family is, Opposer’s various marks have many different structures with the word MONSTER in various relation to the other elements. *Id.* at 1276. Moreover,

there is no particular evidence or testimony about the timing of when such a family was established.¹⁰

B. Likelihood of Confusion Factors

We turn to consider the likelihood of confusion factors for which we have evidence and argument. Ultimately, we find the *DuPont* factor considering the similarity or dissimilarity of the marks to be dispositive in this case as the dissimilarity points to no likely confusion, even weighing the other relevant *DuPont* factors in Opposer's favor. Nonetheless for completeness we make findings for all of the relevant *DuPont* factors.

1. Relatedness of Goods and Services, Channels of Trade, Conditions of Purchase

Opposer's MONSTER ENERGY mark is registered for legally identical and identical goods to Applicant's goods in Classes 18 (golf bags), 21 (beverageware), 25 (tops, t-shirts, sweat shirts, headwear) and Opposer has used its MONSTER ENERGY and MONSTER ARMY marks in connection with online retail or promotional services in connection with clothing items. Sacks Test. ¶¶ 20-23, Exhs. 8-10, 39 TTABVUE 9-11, 239-322. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

¹⁰ Even if a family were established, it would not change the outcome based on the differences between the marks.

Further, where, as here, the goods and services are identical and legally identical and there are no limitations as to channels of trade or classes of purchasers in either the application or Opposer's registration, we must presume that Applicant's and Opposer's goods and services will be sold in the same channels of trade and will be bought by the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

We consider "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing," *DuPont*, 177 USPQ at 567, also based on the identifications of goods in the pleaded Registration and subject Application, as that determines the scope of the benefit of registration. *Stone Lion Capital v. Lion Capital*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The identifications of goods in the application and registration include all goods of the type identified, without limitation as to their nature or price. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). Thus, the goods are presumed to include products that are relatively inexpensive. "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000), *cited in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1673 (TTAB 2018). Because the

buyers to whom sales are made are all general consumers, and the goods at issue include relatively low-priced products, the goods are subject to a lower level of purchaser care. In addition, the online retail services offer such goods that are relatively low priced. In view thereof, these *DuPont* factors weigh in favor of finding a likelihood of confusion.

2. Fame of Opposer's Mark MONSTER ENERGY

Based on the evidence of record, we find Opposer's Mark MONSTER ENERGY conceptually strong for beverageware, clothing, and bags. In addition, the record establishes that the mark MONSTER ENERGY has great commercial strength to the level of fame for energy drinks. As to the mark MONSTER by itself, because most of the public use of the word MONSTER is in combination with ENERGY and other uses are with the M claw logo or other wording (JAVA, JUICE, REHAB, MUSCLE) we cannot find on this record that the single word MONSTER is famous for energy drinks. Overall the fame of MONSTER ENERGY weighs in favor of Opposer.

3. Similarity or Dissimilarity of the Marks

Considering the similarity or dissimilarity of the parties' marks, we compare them in their entireties in terms of appearance, sound, connotation and commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). "The proper test is not a side-by-side comparison of the

marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted). The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

Opposer asserts Applicant’s LOCH MOOSE MONSTAH mark is “highly similar to Monster’s MONSTER marks” in view of the respective terms MONSTER and MONSTAH which are phonetically similar and “MONSTAH’ is merely an alternative spelling of ‘MONSTER’ and both words have the same meaning.” Opp. Brief, 54 TTABVUE 38. Opposer also asserts that MONSTAH as the object noun which LOCH MOOSE modify “is the dominant portion” of Applicant’s Mark. *Id.* at 39; Opp. Reply Brief, 57 TTABVUE 6.

Applicant argues that the marks are so dissimilar that such lack of similarity in the marks is dispositive and there is no likelihood of confusion.

It is obvious the stark dissimilarities between the marks: Applicant’s begins with LOCH MOOSE, a play on LOCH NESS, utterly different in all respects from Opposer’s mark MONSTER ENERGY (or indeed even MONSTER by itself). *Palm*

Bay Imps., 73 USPQ2d at 1692 (“VEUVE nevertheless remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label.”). Applicant uses the word MONSTAH as a play on the New England accent which further emphasizes the word MOOSE in its mark, parts of New England being known for moose. The word MONSTAH is in no way independently dominant in Applicant’s mark, at most, it has equal impact as it is simply part of the message about what type of monster and its regional location.

We find these facts similar to those presented in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL and CRYSTAL CREEK are different in appearance and sound and evoke different connotations and commercial impressions). The only similarity is the word MONSTER in Opposer’s marks and MONSTAH in Applicant’s mark, although Applicant’s mark is misspelled to evoke a particular regional dialect, MONSTAH is phonetically and connotatively similar to MONSTER. However, the overall commercial impression of Applicant’s mark is a play on the name of a legendary creature, the loch ness monster, but presenting it with a regional flair referencing moose and spelling monster to reflect the local pronunciation, monstah. Opposer’s marks MONSTER ENERGY etc., predominantly connotes something large when used in connection with the other wording ENERGY, MUSCLE, REHAB etc. It can, of course, also connote the shared meaning of a creature in general - a monster; in particular, when MONSTER ENERGY is used in its short form MONSTER; however,

this is not sufficient to find likely confusion given all the dissimilarities in Applicant's mark. We find this factor strongly favors no likelihood of confusion.

4. Balancing the Factors

We have carefully considered all arguments and evidence properly of record, including any not specifically discussed herein, as they pertain to the relevant likelihood of confusion factors.

Any of the *DuPont* factors may play a dominant role in our analysis, and in some cases, a single factor is dispositive. *Champagne Louis Roederer v. Delicato*, 47 USPQ2d at 1460 (holding that the Board did not err in deciding likelihood of confusion based solely on dissimilarity of marks, noting that “we have previously upheld Board determinations that one *DuPont* factor may be **dispositive** in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). We find this to be such a case.

We have found that the parties' goods and services, customers, and channels of trade are identical or related; that the goods and services are inexpensive and subject to impulse purchase; and that Opposer's mark MONSTER ENERGY is famous for energy drinks affording it a broad scope of protection. Nonetheless, on the record before us, we find that the dissimilarity of the marks MONSTER ENERGY and LOCH MOOSE MONSTAH in appearance, sound, connotation, and overall commercial impression outweighs the other *DuPont* factors. For that reason, we find the first *DuPont* factor to be outcome-determinative.

Considering the record evidence as a whole, we find that Opposer has not carried its burden to establish by a preponderance of the evidence that Applicant's mark LOCH MOOSE MONSTAH is likely to cause consumer confusion with Opposer's mark MONSTER ENERGY in association with its identified goods and services.

IV. LACK OF BONA FIDE INTENT

Trademark Act Section 1(b)(1) provides:

A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

15 U.S.C. § 1051(b)(1).

“[W]hether an applicant has a bona fide intent to use a mark in commerce is an objective inquiry based on the totality of the circumstances.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1900 (Fed. Cir. 2015) (affirming *Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d 1463 (TTAB 2013)). “Opposer has the burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods [and services] at the time it filed its application.” *Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d at 1471. It may carry this burden, at least prima facie, by demonstrating that Applicant lacks documentary evidence of its intent. *Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at *8 (TTAB 2020).

Opposer argues:

Applicant did not produce any documents indicating that it made any efforts (e.g., market research, product testing, etc.) prior to or at the time of filing the Application to use or plan to use Applicant's Mark with any of the applied-for-goods or services. ...Applicant states that its intent-to-use was contingent on the "continued success and growth" of its business. However, this type of contingency is insufficient to support an alleged bona fide intent-to-use.

Opp. Brief, 54 TTABVue 46-47.

Applicant argues:

Tom & Martha's design efforts began before it filed the application, its sales of certain goods commenced shortly after the application was filed, and it has continued to expand its product line into additional goods recited in the Application, Byrne Decl. ¶8; all of which supports the contention that Tom & Martha did in fact have a bona fide intent to use the mark as recited in the Application at the time of filing. The goods listed in the Application were the goods Tom & Martha intended to pursue at the time of filing and over time as the brand grew. *Id.* Tom & Martha had a plan for each of the goods listed in the Application, some of which were near term and some of which were part of a longer vision that would likely require a measure of success. *Id.* But, all of the goods were the types of goods that Tom & Martha had the means to produce, and all were natural paths of expansions from one another. *Id.* Were it not for this proceeding Tom & Martha would surely have introduced more of its recited goods.

Conversely, Tom & Martha cannot be said to have demonstrated any of the characteristics that typically demonstrate a lack of intent. Tom & Martha's listing of intended goods was reasonably targeted towards related products that would be sold through the same channels and were natural expansions of one another. Tom & Martha does not have a history of filing applications but not alleging use, in fact the contrary is true. *See* Application No. 87644846. And, Tom & Martha has demonstrated the experience and capacity to bring such products to market. Byrne Decl. ¶3-6, 11-12; *See also* Application No. 87644846, declaration of use.

Understandably, the expansion of Tom & Martha's offerings has been slowed as it has chosen not to aggressively expand during the pendency of this proceeding, and in light of the pandemic. Byrne Decl. ¶10. However, this approach of starting small and expanding over time is, of course, not only permissible but envisioned and supported by the Trademark Act. ...

Tom & Martha's actual use of the mark, its history of bringing other products to market in a similar manner pursuant to the regulations implementing Section 1(b) of the Act, and the surrounding circumstances clearly demonstrate that Tom & Martha did have a bona fide intent to use the mark when it filed the application and Tom & Martha's continued bona fide intent to use the mark. Tom & Martha's history and product development activities both illustrate an intent to use the mark as claimed and actual use of the mark as claimed.

App. Brief 56 TTABVUE 25-27.

With regard to Applicant's last point, its history of other products, Opposer points to Applicant's failure to answer questions regarding Applicant's use of its other marks WHAT THE and THE CAT HOUSE on goods and argues that Applicant cannot rely on those marks or use of those marks to support the assertion that Applicant "had the capacity and infrastructure, or the intent, to bring Applicant's Goods and Services under the LOCK MOOSE MONSTAH mark to market." Opp. Brief, 54 TTABVUE 47. In view thereof, we have not considered Applicant's use in connection with those marks in making our determination.

Applicant has begun use of its mark on t-shirts, sweatshirts, hooded sweatshirts, hats, coffee cups, canvas bags and an online retail store. Byrne Decl. ¶¶ 8-12, 46 TTABVUE 4-6; Byrne Oral Cross Exam, 51 TTABVUE 118, Exh. 2 (Byrne Disc. Depo.

pp. 18, 20). Applicant has not used the mark on any of the other identified goods and explains:

[E]verything that I told you is what we've made. I was told – and I could be wrong here, but I was told that it's easier to apply for it initially than to go back and reapply for it. So a lot of that stuff we weren't even going to do anyway. But if it had taken off, or if it does take off, then we could do it. ... So all we're doing is T-shirts, sweatshirts, hats, coffee cups, and my wife did make some bags, canvas bags. So we applied for it. It's easier to get a trademark for it than to get it for one thing, and try to add it on later. That's just the way that we did it.

Byrne Decl., 46 TTABVUE 18-19.

More specifically with regard to Applicant's intent, the following testimony provides some insight:

Q. Now, you mentioned you applied for your application, at that time you only had intentions to sell shirts, cups, sweatshirts and bags. For those other goods,...did you have any intent in selling those products, at that time?

A. If it takes off and they were going to sell, sure. If not, no.

Q. But at that time—but at that time, did you have any intention to move forward with those products? Or like you said, you just wanted to list them on the application?

A. Like I told you originally, the people who were trademarking it for me said its easier to do it initially than to come back and do it a second time. Most of them things I can't picture ever selling, like wallets and stuff like that. That's – I just don't picture it happening. But its easier to – I was told it's easier to put it in initially, than to go back and do it. So I tried to cover all the bases, whether we do any things or not.

Q. So for [the other goods] at the time when you applied for that application, you didn't believe none of these goods would take off. Did you have any intent of actually creating those goods with that mark, at that point in time?

A. I doubt it. I doubt that we would proceed to do that. But I'm not going to rule it out if it was going to take off. I'm not going to say well, I'll never do that. Can't say never to anything. I can't picture ever doing a wallet. I can't picture ever doing a handbag.

... If we were given this trademark, and then when it comes time to pay all the hundred or whatever for every use, I'm sure we would eliminate a lot of them.

Byrne Oral Cross Exam, 51 TTABVUE 126-127.

As to the online retail and wholesale services, Applicant testifies:

In class 35, we were preparing our online retail store when the application was filed and it launched shortly thereafter, offering all of our available goods for sale. The online wholesale store was the expansion plan for when the brand continued to grow, and is another area that is a natural path of expansion that is within our capabilities.

We also have an online retail store from which we sell our products.

Byrne Decl. ¶¶ 8d, 12, Exh. A, 46 TTABVUE 5-6, 22.

We find this sufficient to show Applicant's bona fide intent to use the mark in connection with "canvas tote bags, all purposes carrying bags, cups, mugs, beverage ware, headwear, t-shirts, sweat shirts, hooded sweat shirts; online retail store services featuring bags, beverage ware, and clothes; online wholesale store services featuring bags, beverage ware, and clothes."

Given Applicant's testimony on cross examination, on this record, we find that Applicant did not have a bona fide intention to use the mark on "all-purpose sport bags; backpacks; wallets; handbags; travel cases; brief cases; key cases; business card cases containers for household use; sweat bands; sweat suits; sweat jackets; socks; shorts; tank tops; tube tops; halter tops; footwear; jackets; coats, gloves; belts; online

retail store services featuring wallets; online wholesale store services featuring wallets.”

V. CONCLUSION

Opposer has not shown, by a preponderance of the evidence, likelihood of confusion as to any of Applicant’s recited goods. Opposer has established Applicant lacked a bona fide intent to use its mark on “all-purpose sport bags; backpacks; wallets; handbags; travel cases; brief cases; key cases; business card cases; containers for household use; sweat bands; sweat suits; sweat jackets; socks; shorts; tank tops; tube tops; halter tops; footwear; jackets; coats, gloves; belts; online retail store services featuring wallets; online wholesale store services featuring wallets.” However, Opposer has not established no bona fide intent to use for the remaining goods and services.

DECISION: The opposition is dismissed as to the likelihood of confusion claim.

The opposition is dismissed as to the no bona fide intent to use claim for the following goods “canvas tote bags, all purposes carrying bags, cups, mugs, beverage ware, headwear, t-shirts, sweat shirts, hooded sweat shirts; Online retail store services featuring bags, beverage ware, and clothes; online wholesale store services featuring bags, beverage ware, and clothes.”

The opposition is sustained on the no bona fide intent to use claim for the following goods “all-purpose sport bags; backpacks; wallets; handbags; travel cases; brief cases; key cases; business card cases containers for household use; sweat bands; sweat suits; sweat jackets; socks; shorts; tank tops; tube tops; halter tops; footwear; jackets; coats,

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gloves; belts; online retail store services featuring wallets; online wholesale store services featuring wallets.”

The following goods and services “all-purpose sport bags; backpacks; wallets; handbags; travel cases; brief cases; key cases; business card cases containers for household use; sweat bands; sweat suits; sweat jackets; socks; shorts; tank tops; tube tops; halter tops; footwear; jackets; coats, gloves; belts; online retail and wholesale services featuring wallets” will be deleted and the application will proceed.