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

Proceeding	91255383
Party	Plaintiff Atlas Antibodies AB
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF TRADEMARK
APPLICATION SERIAL NO. 87/927523**

ATLAS ANTIBODIES AB)	
)	
Opposer)	
)	
v.)	Opposition No. 91255383
)	
AENEAS GMBH & CO. KG)	
)	
Applicant)	

REPLY IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56 and 37 C.F.R. § 2.127, Opposer Atlas Antibodies AB (hereinafter “Opposer”), through its counsel of record, respectfully submits its Reply in Support of Opposer’s Motion for Summary Judgment (“Opposer’s Motion”) in the above-captioned proceeding.

Opposer’s Motion for Summary Judgment is based on its amended claim that at the time Applicant Aeneas GmbH & Co. KG (“Applicant”) filed its application Serial No. 87/927,523 (“the Application”) for registration of “ATLAS” it lacked a bona fide intent to use the mark shown for the goods identified in the Application.

Opposer’s Motion shows that Applicant’s Responses to Opposer’s Interrogatories and Opposer’s Document Production Requests alone leave no issue of material fact as to Applicant’s lack of good faith intent to use the ATLAS mark at the time the Application was filed. Motion pp. 8-12. Taylor Dec. Exs. A and B.

However, Opposer's Motion further showed that Applicant's counsel, who filed the application for registration of the "ATLAS" mark for preparations in class 5, himself admitted unequivocally that "Aeneas does not intend to use the term 'ATLAS' for products in classes 1 and 5" and that the application was filed to block others from obtaining registration in class 5. Motion, pp. 12-13. Taylor Dec. ¶ 5; Ex D.

In its brief responding to Opposer's Motion ("Applicant's Response"), Applicant has responded largely by arguing that its counsel's admissions in Exhibit D are excluded from evidence under Rule 408 (Applicant's Response, pp. 3-4, 6-12).

Applicant has only briefly argued that it has a good faith intent to use the mark (Applicant's Response, pp. 1-3, 12-13), and that there are issues of fact that prevent Summary Judgement (Applicant's Response, pp. 13-14).

A. Applicant Has Raised No Genuine Issue of Material Fact As To Its Lack of Good Faith Intent to Use Its Mark For Goods In Class 5 At the Time It Filed Its Application

Applicant's argument that it has a good faith intent to use the mark and that there are issues of fact which prevent summary judgement is that a related company called Aesku Group made an ATLAS diagnostic machine which it advertised at a trade show in March of 2021 and that the Applicant, Aeneas GmbH, intends to sell products in class 5 to purchasers after it has sold the machines to them and inquired as to what chemical/biological products the purchasers want to use with the machines (Applicant's Response, pp. 1-3 and 12-14).

While there is no logical basis for Applicant claiming that it is not possible to sell biological products to owners of diagnostic machines unless and until it has first sold them its own machines and while no connection is made in the argument between the evidence pertaining

to Aesku Group's diagnostic machines and Aeneas GmbH intending to use the mark even for diagnostic machines (much less biological products for use with the machines), since all that Applicant has to show is advertising of diagnostic machines by Aesku Group, it has now contradicted its sworn answers that it had taken no steps towards use of the mark for goods in class 5 and no plans for the advertising or sale of such goods (Opposer's Motion, p. 9; Exhibit A) to now claim that the advertising of diagnostic machines by Aesku Group is somehow a step towards its own use of the mark for diagnostic machines and then for products in its application in class 5.

To make this claim, Applicant has relied on the Declaration of Dr. Torsten Matthias ("Matthias Dec.") and four exhibits submitted with the declaration as well as an Exhibit C (Applicant's Response, pp. 3-4 and 12-13; Matthias Dec. Exs. 1-4, Taylor Dec. ¶ 4, Ex. C), which was the only other document provided by Applicant. To the extent that objective facts are stated in the Matthias Declaration they relate to the "HELIOS" diagnostic machine and a trade show on March 29-31, 2021, attended by the Aesku Group in which it advertised that machine or another as an "ATLAS" machine (Matthias Dec. ¶¶ 8-15).

Though this trade show occurred more than three years after the application for registration in class 5 was filed on March 18, 2018 in the name of Aeneas GmbH, there is no document or statement which shows advertising or any mention whatsoever to anyone concerning the Aeneas Group or any goods in class 5 then or at any time. There is no indication of any statement to anyone at the trade show or at any time of any intent by anyone to sell products in class 5 (Id. ¶¶ 16-17).

There is no objective evidence in the record whatsoever which shows (1) any activity by Applicant, Aeneas GmbH in connection with diagnostic machines or with goods in class 5, other than filing the opposed application or (2) any intent to use the mark for goods in class 5 by either Aesku Group or Aeneas GmbH even three years after the application was filed, much less at the time of filing the application.

The documents submitted and referred to in the Matthias Declaration relied on by Applicant relate only to Aesku Group diagnostic machines. Exhibit 1 shows wash and waste bottles which may be sold with the Aesku HELIOS diagnostic sample processing system, which is discussed in the product brochure for the machine in Exhibit C. Matthias Dec. ¶¶ 8,9; Ex. 1. Exhibit 2 shows a sample processing machine bearing an apparent decal with the mark ATLAS, which was created by Aesku, not Applicant. Matthias Dec. ¶ 11. There is no explanation as to whether this is simply the HELIOS machine with an applied new “ATLAS” mark decal or a new machine developed by Aesku, and no indication as to when the photograph was created. (It is, in fact, not clear what was shown to customers since paragraph 13 in the Matthias Declaration refers to “[t]he flyer in Exhibit 2”. Exhibit 2 is the photograph.) Exhibit 3 is the descriptive flyer for the “ATLAS” machine, and, as with Exhibit 2, there is no indication as to when it was created. Exhibit 4 shows a screen shot from the virtual conference taking place March 29-31, 2021 with a reference to “AESKU GROUP presents ATLAS”. See Matthias Declaration ¶¶ 11-14.

Applicant neither produced nor offered to produce a single document in response to Opposer’s requests for production of documents. Taylor Dec. Ex. B. Ex C above was sent with an earlier e-mail by counsel. Taylor Dec. ¶ 4. Thus, for example, in response to Opposer’s request to produce all documents

reflecting steps taken by Applicant to begin use of Applicant's Mark in the U.S. (document request no. 8) that "[t]here are no such documents". *Id.* The five documents referred to in the Matthias declaration constitute the entire extent of documents relied on by Applicant Aeneas GmbH to show its intent to use the "ATLAS" mark on goods in class 5 even though, at most, they show the Aesku Group's intent to use the mark for diagnostic machines.

Even assuming *arguendo* that the "ATLAS" diagnostic machines of Aesku Group could somehow reflect an intent to use of the mark for diagnostic machines in class 9 by Applicant, Aeneas GmbH, they could not raise a genuine issue of fact as whether Aeneas GmbH intended to use the mark for goods in class 5 in the face of its sworn statements in Exhibit A, its responses to discovery requests, its counsel's admission that it had no such intent and the complete inconsistency of such an intent with the total absence of any objective evidence three and half years after the application was filed of any specific intent to use the mark for goods in class 5.

Rather, even assuming *arguendo* that Aeneas GmbH had an intent to use the mark for diagnostic machines, the evidence relied upon is consistent (other than bare assertions by Dr. Matthias of Applicant's intent to use the mark for goods in class 5) with Dr. Matthias's sworn answer to Interrogatory No. 15 that "[n]o steps have been taken towards any use of Applicant's Mark in the United States for the goods identified in U.S. Application Serial No. 87/927,523" (Taylor Dec.; Ex. A) and with the statement by Applicant's counsel that Applicant did not intend to use the mark for goods in class 5 but was rather filing the application as a blocking application to protect a planned use for a diagnostic machine in class 9. Taylor Dec. ¶ 5, Ex. D.

B. There Is No Support for Applicant’s Argument That Its Counsel’s E-mail Is Inadmissible Under Rule 408

Applicant’s first argument on inadmissibility is misleadingly entitled “Opposer’s Motion for Summary Judgment is Based on Inadmissible Evidence” (Response, p. 6). In fact, the issue as to inadmissibility pertains solely to its counsel’s e-mail of December 20, 2020. Taylor Dec.¶ 5; Ex. D.

Applicant’s responses to discovery requests and document production to date (including the Exhibits attached to the declaration filed with Applicant’s response) and the total lack of any objective evidence of Applicant’s intent to use the mark for class 5 goods are alone sufficient evidence to remove any genuine issue of fact as to Applicant’s lack of good faith intent to use its mark for the class 5 goods in its application at the time of application.

Applicant’s first argument for exclusion of the e-mail is that under Rule 408(a)(2) i.e. “(a) “Evidence of the following is not admissible...either to prove or disprove the validity or amount of a disputed claim...(2) conduct or a statement made during compromise negotiations about the claim “). This argument is based on a false characterization of the “disputed claim” in this proceeding and reliance on two inapplicable cases, *Macsherry v. Sparrows Point, LLC*, 973 F.3d 212 (4th Cir. 2020) (Applicant’s Response, pp. 7-8) and *Weems v. Tyson Foods, Inc.*, 665 F.3d 958 8th Cir. 2011) (Applicant’s Response, p.9).

Applicant has in error identified the “disputed claim” in this proceeding at the time of the e-mail as being broadly “whether Applicant is entitled to a federal registration for the trademark ATLAS when used for the goods in the opposed application”. Applicant’s Response, p. 8 ll. 12-15. If this characterization of “disputed claim” were to be accepted, there could never be an

issue in any proceeding under Rule 408 in any opposition or cancellation proceeding as to whether a statement made during compromise negotiations concerned a “disputed claim” even though there are many possible “disputed claims” in a Board proceeding (fraud, dilution, descriptiveness, abandonment etc.).

In this case, the “disputed claim” at the time the e-mail was sent on December 20 was the issue of “likelihood of confusion”. The December 20 e-mail admission by Applicant’s counsel is conclusive evidence of an entirely new claim – Applicant’s lack of bona fide intent to use the mark for the goods in the application at the time of filing. Taylor Dec.¶ 5; Ex. D.

In the *Macsherry* case relied on by Applicant, a former employee brought action against former employers, alleging violations of the Maryland Wage Payment and Collection Law, breach of contract, promissory estoppel, and quantum meruit and “enhanced damages”, all related to the non-payment of a commission on the sale of an industrial property. *Id.* at 219. The “compromise statements” in question were the alleged statement by the employer that “I know I owe you a commission. I don’t believe you deserve a commission as big. What will take?” *Id.* (Id. at 225).

On appeal, the Fourth Circuit found the statement inadmissible to prove liability for the for MacSherry’s claims to a disputed commission, stating that the compromise negotiations were being used “to prove the validity of the claim that ‘the compromise offer was meant to settle’. *Id.* at 225. The statement could likewise not be used to show “bad faith” in connection with the claim for “enhanced damages” because bad faith was inseparable from that claim. *Id.* This case is clearly inapplicable since the statement made by Applicant’s counsel in Exhibit D is not being

relied upon to prove the validity of the claim of likelihood of confusion but rather to support an entirely new claim.- the issue of “good faith intent to use” is completely separable and distinct from the issue of likelihood of confusion.

Applicant’s reliance on *Weems* is equally misplaced. Applicant’s Response, p. 9. The issue in dispute in *Weems* was workplace gender discrimination under Title VII. The 8th Circuit found that the employment separation agreement at issue under Rule 408 was clearly an offer of compromise of Weems’s “gender discrimination concerns” (the claim in dispute) within the meaning of Rule 408. *Id.* 965-67. Again, Opposer is offering Exhibit D to support an entirely new claim.

Applicant’s second argument (Applicant’s Response, pp. 9-12) consists of misrepresentations of two of the cases relied upon by Opposer. First, Applicant acknowledges that *Zinner v. Olenych*, 108 F. Supp. 3d 369, 2015 U.S. Dist. LEXIS 73280 (E.D. Va. 2015), “states the plain language of Rule 408 and applies the rule to a voicemail left by defendant’s attorney” but then it contradicts itself by claiming that “the voicemail message in *Zinner* was not left during settlement negotiations” (Applicant’s Response, p. 10).

The text in the court’s decision is unequivocal: “the Court finds that Plaintiff is not offering the voicemail...’to prove or disprove the validity or amount of a disputed claim’ See Fed. R. Evid. 408(a). Rather, Plaintiff offers it for ‘another purpose’, Fed. R. Evid. 408(b), namely to prove an element at the core of Plaintiff’s claim [Lanham Act action under 15 U.S.C. §§ 1125(d) and 8131 against Defendants]: whether Defendant possessed the bad faith intent to profit from registering or using the ...domain name”, citing *Johnson v. Hugo’s Skateway*, 949 -8-

F.2d 1338, 1346 (4th Cir. 1991) (affirming admission of consent decree to show intent of parties); *Domain Name Clearing Co. v. F.C.F. Inc.*, 16 F. App'x 108, 111 n.3 (4th Cir. 2001) (unpublished) (finding that district court did not abuse discretion in admitting a demand for payment for a domain name in part because it “spoke directly to the bad faith determination” in a section 1125(d) action). *See also McAllister Olivarius v. Mermel*, 298 F.Supp.3d 661, 673, n. 4 (SDNY April 2, 2018) (citing Fed. R. Evid. 408(a); *see also* Fed R. Evid. 408(b) (“The court may admit this evidence for another purpose.”). 108 F.Supp at 390-91.

This case relied upon by Opposer shows that a statement can be admitted to show “intent” even if the “intent” relied upon is at “the core of Plaintiff’s claim”. However, again, Opposer is not relying on the statement of “intent” made by counsel for Applicant in Exhibit D to support its claim of likelihood of confusion. Rather, Opposer is relying on counsel’s statement to support an entirely new claim and is relying on it for a purpose other than to prove the disputed claim. *See also e.g. United States v. Hauert*, 40 F.3d 197, 200 (7th Cir. 1994) (evidence in question was admitted for another purpose, to show whether the defendant knew what the law was and his legal duty thereunder); *Catullo v. Metzner*, 834 F. 2d 1085, 1079 (1st Cir. 1987) (District Court erred in excluding testimony concerning terms of settlement agreement to establish intent of the parties since it was not part of the original disputed claim).

Applicant’s attempt to distinguish *Bankcard Am., Inc. v. Universal Bancard Sys.*, 203 F. 3d 477 (7th Cir. 2000) (Applicant’s Response, pp. 10-11) is based on the statement that the settlement evidence under Rule 408 was not admitted to show a “general intent” but rather to show intent “outside of the settlement negotiations”. Applicant’s claim is a false distinction and

is misleading. As admitted by Applicant (*Id.*), the statements made to the executive in settlement negotiations were admitted to show the intent of a participant in acting on those statements under Rule 408 in actions taken outside of the negotiations just as Applicant's counsel's e-mail shows his intent in filing the opposed application.

C. Conclusion

In view of the well-established case law concerning the insufficiency of "subjective belief" and the requirement for "objective evidence" and the sufficiency of a lack of documentary evidence of bona fide intent to use to show lack of intent (Opposer's Motion, p. 7) and the incontrovertible facts stated in Opposer's Motion (pp. 8 – 15), Opposer requests that the Board grant its motion for summary judgment.

November 19, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Reply in Support of Opposer's Motion for Summary Judgment was served on Lynn Alstadt, counsel for Applicant, this 19th day of November, by sending it via electronic mail to lynn.alstadt@bipc.com.

/s/ Brewster Taylor
Brewster Taylor

