

This Opinion Is Not A
Precedent Of The TTAB

Mailed: March 23, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Carlo Bazan
v.
Kiren Williams

Opposition No. 91263383

Diana Mederos of Mederos Legal, PLLC
for Carlo Bazan.

Kiren Williams, pro se

Before Kuhlke, Bergsman and English,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Kiren Williams, seeks registration of the mark shown below for “Online retail store services featuring clothing and footwear,” in International Class 35:¹

¹ Serial No. 88415003, filed May 3, 2019, 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); “Clothing” disclaimed. The application includes the following description of the mark: “The mark consists of an abandoned house with the wording ‘DRIP HOUSE’ below in cursive-style lettering. The first letter of each word is capitalized and a paint splotch is above the letter ‘I’. At the bottom is the wording ‘CLOTHING’ in small uppercase letters. The mark appears in a black rectangle which represents background and is not claimed as a feature of the mark.” Color is not claimed as a feature of the mark.



Opposer, Carlo Bazan, has opposed registration of Applicant’s mark on the ground that, as used in connection with Applicant’s services, the mark so resembles Opposer’s mark DRIPHAUS, for fitness apparel and accessories, as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).² Opposer alleges it first used the mark on January 16, 2020 and that it filed application Serial No. 88606342 for the mark on September 5, 2019 for “athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic footwear; athletic jackets; athletic shoes; athletic shorts; bottoms as clothing; footwear; footwear for track and field athletics; headwear; leggings; pants; socks; sports shirts; sports shirts with short sleeves; sweat shirts; sweaters; t-shirts; tops as clothing.” In addition, Opposer alleges Applicant did not have a bona fide intent to use the mark in commerce for the services in the involved application. By his answer, Applicant generally denies the salient allegations.

² Not. of Opp., 1 TTABVUE.

As last reset, Opposer's trial period closed on June 17, 2021. However, Opposer did not file its notice of reliance until November 29, 2021, the date the main brief was due and filed. In general, the Board does not consider evidence not obtained and filed in compliance with the rules of practice. Trademark Rule 2.123(k), 37 C.F.R. § 2.123(k); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 706 (2021). However, when the issue is timeliness where a notice of reliance is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance in its entirety as untimely or by raising this ground for objection in its brief on the case. TBMP § 707.02(b)(1). Here, Applicant did not file a motion to strike or raise the issue in a brief on the case. In view of Applicant's failure to object, we consider the notice of reliance and the evidence attached thereto.

Applicant did not submit any testimony or other evidence. However, even though Applicant has filed no evidence or brief, Opposer, as plaintiff in this proceeding, must nonetheless prove its entitlement to a statutory cause of action and its claims by a preponderance of the evidence. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

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.³ In addition the record includes under Opposer's Notice of Reliance:⁴

- a copy of Opposer's pleaded Application No. 88606342 and file record;
- the testimony declaration of Diana Mederos, Opposer's attorney, testifying to Applicant's failure to respond to Opposer's discovery requests with attached exhibits consisting of Opposer's interrogatories and request for production of documents; and
- Applicant, Carlo Bazan's testimony declaration with exhibit.

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.⁵ *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

³ Because the file of Applicant's application is automatically of record, it was unnecessary for Opposer to file a copy of the file history with its notice of reliance.

⁴ 6 TTABVUE.

⁵ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, the Board's prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that 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).

Opposer's file record showing its application was suspended in view of Applicant's earlier filed application demonstrates Opposer has a reasonable belief in damage proximately caused by the registration of the mark in Applicant's pending application. See *Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1039-40 (TTAB 2018) (opposer's standing established through applicant's concessions and admissions that opposer's pending application would be refused registration should applicant's application register); *Saddlesprings Inc. v. Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012) (same); *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) (Office action suspending plaintiff's pending application pending possible refusal based on alleged likelihood of confusion with defendant's registration made of record). In view thereof, Opposer's entitlement to a statutory cause of action to oppose registration of Applicant's mark is established.

Once a plaintiff has shown entitlement 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 Regulador 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).

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). To prevail on his Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that he has priority with respect to his mark DRIPHAUS vis-à-vis Applicant’s mark DRIP HOUSE CLOTHING (and design), and that Applicant’s use of his mark in connection with the goods identified in his 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).

Applicant has not submitted any evidence so the earliest date of use on which it is entitled to rely is the filing date of its application, May 3, 2019. *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”).

Opposer testified that he filed his application on September 5, 2019 and his first use occurred on January 16, 2020. Bazan Test. Decl. ¶¶ 4, 7, 7 TTABVUE 58, 59. Opposer argues that he is the prior user and that Applicant has not used his mark; however, that is not the law. *Syngenta Crop v. Bio-Chek*, 90 USPQ2d at 1119. Applicant may rely on his filing date as “constructive use.” Because Applicant’s filing date is earlier than either of Opposer’s dates, Opposer has not established priority and his claim of likelihood of confusion under Section 2(d) fails.

Because Opposer has failed to establish his priority, which is a necessary element of any claim under Trademark Act § 2(d), we need not reach the issue of likelihood of confusion because without proof of priority, Opposer cannot prevail.

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 has never produced any documents or made any testimony evidence of record relating to or reflecting any purported bona fide intent to use the stylized DRIP HOUSE CLOTHING mark for any Online retail services featuring clothing and footwear as of the filing date of the DRIP HOUSE CLOTHING application. Applicant failed to participate in discovery and failed to answer or produce any documents in response to Bazan’s propounded Interrogatories and Requests for Production.

Opp. Brief, 8 TTABVUE 10.

Opposer points to Applicant’s failure to respond to Opposer’s interrogatories and requests for production of documents to demonstrate a lack of documentary evidence. *Id.* and *Mederos Test. Decl.* ¶¶ 2-7, 7 TTABVUE 37. Opposer references its motion to compel; however, that motion was denied for failure to satisfy the good faith effort requirement of Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1). 6 TTABVUE. Opposer also points to Applicant’s failure to submit any testimony evidence.

In view of Opposer’s failure to timely submit its evidence during its testimony period, we do not infer anything from Applicant’s failure to submit evidence during its testimony period. Indeed, the burden of proof is on Opposer so Applicant was not obligated to introduce evidence. Moreover, Applicant’s failure to respond to discovery

where there has been no good faith effort to resolve the discovery dispute does not present a circumstance to infer the absence of documentary evidence. In view thereof, Opposer has not established a prima facie case of no bona fide intent to use.

V. CONCLUSION

Because Opposer has not shown, by a preponderance of the evidence, prior use necessary to prevail on his Section 2(d) claim or that Applicant lacked a bona fide intent to use, Opposer has not established either of his claims.

DECISION: Judgment in favor of applicant dismissing the opposition as to the no bona fide intent to use claim under Section 1 is hereby entered. Judgment in favor of applicant dismissing the opposition as to the likelihood of confusion claim under Section 2(d) is hereby entered, subject to Applicant's establishment of constructive use.

The time for filing an appeal or for commencing a civil action will run from the date of this decision. See Trademark Rules 2.129(d) and 2.145, 37 C.F.R. § 2.129(d) and 2.145. When Applicant's mark registers or the application becomes abandoned, Applicant should inform the Board, so that appropriate action may be taken to terminate this proceeding.