

This Opinion is Not a  
Precedent of the TTAB

Mailed: December 21, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
—

*Fruit of the Loom, Inc.*

*v.*

*David Neal Sellers*

—  
Opposition No. 91268870  
—

Carrie A. Shufflebarger and Louis K. Ebling of Thompson Hine LLP, for Fruit of the Loom, Inc.

David Neal Sellers, *pro se*.

—  
Before Larkin, Coggins, and English,  
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Applicant has applied to register on the Principal Register the proposed composite word-and-design mark shown below

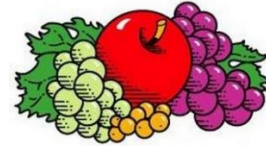
JUICY FRUIT



for “body suits for adults; bottoms as clothing for adults; coats for adults; dresses for adults; headwear for adults; hooded sweatshirts for adults; jackets for adults; pajamas for adults; pants for adults; shirts for adults; shoes for adults; shorts for adults; sweaters for adults; sweatpants for adults; sweatshirts for adults; t-shirts for adults; tops as clothing for

adults; trousers for adults; woven shirts for adults” in International Class 25.<sup>1</sup>

In its notice of opposition, Fruit of the Loom, Inc. (“Opposer”), alleges prior common law use and registration of a number of marks, including: (1) marks consisting of or incorporating FRUIT OF THE LOOM for goods including clothing



and related retail store services;<sup>2</sup> (2) the design mark (with and without claims of color) for goods including clothing and related online retail store services;<sup>3</sup> and (3) the mark FRUIT INK for “custom imprinting of clothing; screen printing.”<sup>4</sup> Opposer further alleges prior common law rights in the mark FRUIT for “clothing and textile goods, including T-shirts, underwear, sweatshirts, sweatpants, and socks, as well as in connection with retail store services.”<sup>5</sup>

As grounds for opposition, Opposer alleges likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); dilution by blurring under Trademark Act Section 43(c), 15 U.S.C. § 1125(c);<sup>6</sup> and Applicant’s lack of bona fide intent to use the mark under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

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<sup>1</sup> Application Serial No. 90125416, filed August 19, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application includes the following description of the mark: “The mark consists of [a] [f]inger pointing down with the words ‘Juicy Fruit’ above the finger.”

<sup>2</sup> Registration Nos. 174998, 1234708, 1876708, 4146754, 4372394, 4491448, 5961944, 6309283, 6049301 and 6049305.

<sup>3</sup> Registration Nos. 913838, 4372395, 4485501, and 6309284.

<sup>4</sup> Registration No. 4408550. 1 TTABVUE 11-12, ¶ 2.

<sup>5</sup> 1 TTABVUE 10-11, 13 ¶¶ 1, 7, 11.

<sup>6</sup> In its brief, Opposer also argues dilution by tarnishment but it did not plead such a claim. 30 TTABVUE 33-34. Applicant did not expressly consent to trial of a dilution by tarnishment

In his answer, Applicant denied the salient allegations in the Notice of Opposition.<sup>7</sup>

On May 15, 2022, the Board issued an order granting partial summary judgment to Opposer on its: (1) entitlement to bring a statutory cause of action based on printouts from the Trademark Search and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO) showing Opposer's ownership and the current status of the pleaded registrations; and (2) claim that when Applicant filed the involved intent-to-use application he had no bona fide intent to use his mark for most of the goods in his application, namely:

body suits for adults; bottoms as clothing for adults; coats for adults; dresses for adults; headwear for adults; hooded sweatshirts for adults; jackets for adults; pajamas for adults; pants for adults; shirts for adults; shoes for adults; shorts for adults; sweaters for adults; sweatpants for adults; sweatshirts for adults; tops as clothing for adults; trousers for adults; woven shirts for adults.<sup>8</sup>

We entered judgment against Applicant on the lack of bona fide intent to use claim as to the foregoing goods.<sup>9</sup>

We denied Opposer's motion for summary judgment, in part, as to the lack of bona fide intent to use claim with respect to the goods identified as "t-shirts for adults,"

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claim and no such claim was tried by implied consent because Opposer did not clearly identify any of its evidence as pertinent to such a claim. *JNF LLC v. Harwood Int'l Inc.*, 2022 USPQ2d 862, at \*31 (TTAB 2022) ("Implied consent can only be found where the non-offering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue."). Accordingly, we give no consideration to this unpleaded claim.

<sup>7</sup> 4 TTABVUE.

<sup>8</sup> Board's Corrected Summary Judgment Order, 11 TTABVUE 6, 13-14.

<sup>9</sup> *Id.* at 14.

and the claims of likelihood of confusion and dilution.<sup>10</sup> We resumed proceedings and advised the parties that the case would “move forward on Opposer’s claims of lack of bona fide intent to use the mark in commerce, likelihood of confusion, and dilution, with respect only to t-shirts for adults.”<sup>11</sup>

For the reasons explained below, we find that Opposer has proven that Applicant also lacked a bona fide intent to use his mark for “t-shirts for adults” when he filed the involved application, and therefore, we sustain the opposition on that claim. We do not reach Opposer’s likelihood of confusion and dilution by blurring claims. *See, e.g., Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (Board has “discretion to decide only those claims necessary to enter judgment and dispose of the case”) (quoting *Multisorb Tech., Inc. v. Pactive Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013)).

## **I. The Record**

The record includes the pleadings, and by operation of law, the file of the involved application. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). In addition, the parties introduced evidence.

Opposer introduced the declaration of its Vice President of Marketing and Merchandising, Angela Minton Dennison, and accompanying exhibits,<sup>12</sup> as well as notices of reliance on:

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<sup>10</sup> *Id.* at 15-16.

<sup>11</sup> *Id.* at 16.

<sup>12</sup> 17 TTABVUE (redacted); 16 TTABVUE (confidential).

- printouts from the TSDR database for its pleaded registrations<sup>13</sup> and an unpleaded registration for the standard-character mark ART OF FRUIT;<sup>14</sup>
- Applicant’s initial disclosures and responses to Opposer’s interrogatories, document requests and requests for admission as well as a document that Applicant produced in response to document requests 8 and 11;<sup>15</sup>
- “a copy of the file history for U.S. Registration No. 6598850 owned by Applicant,” printed from the TSDR database;<sup>16</sup> and
- printed publications<sup>17</sup> and Internet printouts.<sup>18</sup>

Applicant introduced a single notice of reliance on:<sup>19</sup>

- Applicant’s brief in opposition to Opposer’s motion for summary judgment;<sup>20</sup>
- certificates of registration for third-party registrations;<sup>21</sup>
- a notice of allowance for a third-party application;<sup>22</sup>

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<sup>13</sup> Opposer’s Notice of Reliance, 15 TTABVUE 8-46.

<sup>14</sup> *Id.* at 47-51.

<sup>15</sup> *Id.* at 52-84.

<sup>16</sup> *Id.* at 3, 85-122.

<sup>17</sup> *Id.* at 123-275.

<sup>18</sup> Opposer’s Rebuttal Notice of Reliance, 28 TTABVUE.

<sup>19</sup> Opposer objects to some of Applicant’s evidence. Because none of Applicant’s evidence is pertinent to Opposer’s lack of bona fide intent to use claim, on which we sustain the opposition, we do not address Opposer’s evidentiary objections.

<sup>20</sup> Applicant’s Notice of Reliance, 26 TTABVUE 4-11.

<sup>21</sup> *Id.* at 15-22, 26-27, 32-33, 36-38.

<sup>22</sup> *Id.* at 23-25.

- search results from the USPTO's Trademark Electronic Search System (TESS) database, dated February 25, 2022 and August 23, 2022;<sup>23</sup> and
- a filing receipt from the Board's ESTTA filing system reflecting an extension of time to oppose that Opposer filed against a third-party application.<sup>24</sup>

## II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021) (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 when such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \* 6-7 (Fed. Cir. 2020).

As discussed, we granted summary judgment to Opposer as to its entitlement to bring this statutory cause of action based on proof that it owned the pleaded

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<sup>23</sup> *Id.* at 12-14, 28-31.

<sup>24</sup> *Id.* at 34-35.

registrations, which were then active.<sup>25</sup> During trial, Opposer introduced printouts from the TSDR database showing that it still owns the pleaded registrations, which remain active.<sup>26</sup> Opposer therefore has maintained its entitlement to bring this statutory cause of action. *Made in Nature, LLC v. Pharmavite, LLC*, 2022 USPQ2d 557, at \*7 (TTAB 2022) (pleaded registrations demonstrated entitlement to bring a statutory cause of action); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (same); *see also AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at \*5-6 (TTAB 2020) (once an opposer meets the requirements for entitlement on one claim, it can rely on any available statutory ground for opposition set forth in the Trademark Act).

### **III. Lack of Bona Fide Intent to Use**

#### **A. Applicable Law**

The Trademark Law Revision Act of 1988 (“TRLA”), effective November 16, 1989, amended the Trademark Act to add Section 1(b) as a new basis for filing a trademark application. Under Trademark Act Section 1(b)(1), “[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....” In enacting the TRLA, Congress acknowledged that “[d]espite its numerous virtues, a registration system based on intent also carries some potential for abuse. A single business or individual might, for instance, attempt to monopolize

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<sup>25</sup> Board’s Corrected Summary Judgment Order, 11 TTABVUE 6.

<sup>26</sup> Opposer’s Notice of Reliance, 15 TTABVUE 8-46.

a vast number of potential marks on the basis or a mere statement of intent to use the marks in the future. To minimize such risks, [Trademark Act Section 1(b)] requires the specified intent to be bona fide. This bona fide requirement focuses on an objective good-faith test to establish that the intent is genuine.” S. Rep. No. 100-515, 100th Cong. 2d Sess. at 6 (1988) (“S. Rep.”). Thus, the central inquiry in a lack of bona fide intent to use claim is whether at the time of filing the application “the applicant’s intent to use the mark was firm and not merely intent to reserve a right in a mark.” *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at \*10 (Fed. Cir. 2022) (quoting *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897-98 (Fed. Cir. 2015)) (internal quotation marks omitted); *see also* S. Rep. at 25 (“[A]n applicant’s bona fide intent must reflect an intention to use the mark in the context of the legislation’s revised definition of ‘use in commerce’ that is, use ‘in the ordinary course of trade, commensurate with the circumstances and not [made] merely to reserve a right in a mark.’ This bona fide intent to use must be present for all goods or services recited in the application.”).

In assessing whether an applicant had a bona fide intent to use a mark in commerce or merely an intent to reserve a right in a mark, the Board considers “objective evidence of intent, ‘on a case-by-case basis considering the totality of the circumstances.’” *Tiger Lily Ventures*, 2022 USPQ2d 513, at \*10 (quoting *M.Z. Berger*, 114 USPQ2d at 1898); *see also Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at \*12 (TTAB 2020) (“The particular facts of each case must be carefully considered in their totality[.]”); *Lane Ltd. v. Jackson Int’l Trading*



Co., 33 USPQ2d 1351, 1355 (TTAB 1994) (“[T]he focus is on the entirety of the circumstances, as revealed by the evidence of record.”). “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 applicant, not by the applicant’s testimony as to its subjective state of mind.” *Rsch. in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009) (quoting J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:14 (5th ed.)) (internal quotation marks omitted). “Under our case law, ‘the evidentiary bar is not high,’ and the circumstances must simply indicate ‘that the applicant’s intent to use the mark was firm and not merely intent to reserve a right in a mark.’” *Tiger Lily Ventures*, 2022 USPQ2d 513, at \*10 (quoting *M.Z. Berger*, 114 USPQ2d at 1898); *see also A&H Sportswear Co. v. Yedor*, 2019 USPQ2d 111513, at \*3 (TTAB 2019); *Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 11581, 1587 (TTAB 2008).

Opposer bears the “burden of demonstrating by a preponderance of the evidence that [A]pplicant lacked a bona fide intent to use the mark on [‘t-shirts for adults’]” when he filed the involved application on August 19, 2020. *Société des Produits Nestlé*, 2020 USPQ2d 10893, at \*8 (quoting *Rsch. in Motion*, 92 USPQ2d at 1930). An opposer can establish a prima facie case by proving that an applicant has no documentary evidence to support the allegation in its application of a bona fide intent to use the mark in commerce as of the application filing date. *See, e.g., A&H Sportswear*, 2019 USPQ2d 111513, at \*23; *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1197 (TTAB 2011), *judgment vacated as moot*, 107 USPQ2d 1626 (TTAB 2013).

If an opposer establishes a prima facie case, the burden shifts to the applicant to rebut that prima facie case by producing evidence which would establish that it had the requisite bona fide intent to use the mark when it filed its application. *See, e.g., A&H Sportswear*, 2019 USPQ2d 111513, at \*3; *Rolex Watch*, 101 USPQ2d at 1197.

## B. Analysis

Opposer argues that Applicant “admitted in his initial disclosures that he lacks even a single document that would evidence his intent to use the opposed mark” and he admitted during discovery that “he has not hired any consulting or advertising agencies to advertise goods bearing the mark; has not disseminated any promotional materials that reference the Opposed Mark; and has not disseminated any documents to customers prospective customers, trade organizations or members of the press relating to [his] intended use of the Opposed Mark.”<sup>27</sup>

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<sup>27</sup> Opposer’s Brief, 30 TTABVUE 15-16. In its brief, Opposer raises for the first time an alternate factual theory for its lack of bona fide intent to use claim: Applicant did not intend

JUICY FRUIT



to use the mark “as a trademark, *i.e.*, as a source identifier, at the time he filed the application, or any time thereafter. Rather, the evidence clearly shows [Applicant’s] intent was to use the applied for mark as mere ornamentation, which is not entitled to registration.”<sup>27</sup> Because the record supports that Applicant did not have a firm and demonstrable intent to use the involved mark for “t-shirts for adults” when he filed the application, we do not address this new theory for relief.

In support of its claim, Opposer introduced the requests for admission it served on Applicant on July 21, 2021, and Applicant's untimely responses, served on August 30, 2021. Opposer's Requests for Admission are deemed admitted by operation of law because Applicant responded more than 30 days after the requests were served and did not move to reopen his time to respond to the requests or move to withdraw or amend the automatic admissions. *See* Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007).

Federal R. Civ. P 36(b) provides that “[a] matter admitted under this rule is conclusively established . . . .” Pertinent to Opposer's lack of bona fide intent to use claim, the following facts have been conclusively established through Applicant's deemed admissions:

- “Applicant has not sold any of the goods listed in the Application bearing the Applicant's [proposed] Mark”;<sup>28</sup>
- “Applicant has not disseminated any promotional materials that reference Applicant's Mark”;<sup>29</sup>
- “Applicant has not disseminated documents to customers, prospective customers, trade organizations, or members of the press relating to Applicant's use or intended use of Applicant's Mark”;<sup>30</sup>

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<sup>28</sup> Opposer's Notice of Reliance, 15 TTABVUE 69 (Request for Admission No. 20).

<sup>29</sup> *Id.* at 70 (Request for Admission No. 25).

<sup>30</sup> *Id.* at 71 (Request for Admission No. 26).

- “Applicant has no marketing or business plans evidencing his intent to use the Opposed Mark in connection with the goods listed in the Application”;<sup>31</sup>
- “Applicant has not established any customer or potential customer contacts for goods identified in the Application bearing the Opposed Mark”;<sup>32</sup>
- “Applicant has not hired or established any contacts with manufacturers for the manufacture of goods identified in the Application bearing Applicant’s Mark”;<sup>33</sup> and
- “Applicant has not hired any consultants or advertising or marketing agencies to advertise [the] goods identified in the Application bearing Applicant’s Mark.”<sup>34</sup>

In his initial disclosures, Applicant represented that he did “not have any documents germane to these proceedings stored in any outside facility, nor documents outside of documents submitted for trademark consideration of the Juicy Fruit mark to the USPTO.”<sup>35</sup> Applicant also responded that he did not have any documents responsive to document requests related to the following:

- the structure and function of Applicant’s businesses, including any corporate filings, business licenses, and organizational charts;<sup>36</sup>

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<sup>31</sup> *Id.* at 69 (Request for Admission No. 21).

<sup>32</sup> *Id.* at 70 (Request for Admission No. 22).

<sup>33</sup> *Id.* (Request for Admission No. 23).

<sup>34</sup> *Id.* (Request for Admission No. 24).

<sup>35</sup> *Id.* at 54.

<sup>36</sup> *Id.* at 77 (Document Request No. 1).

- Applicant’s decision to adopt and use Applicant’s mark, including any investigation or search related to his intended use of the mark;<sup>37</sup>
- Applicant’s decision to apply for registration of Applicant’s mark;<sup>38</sup>
- the first use or intended first use of Applicant’s mark;<sup>39</sup>
- Applicant’s business or marketing plans for the sale of goods in connection with Applicant’s mark;<sup>40</sup>
- Applicant’s advertising or contemplated advertising of goods in connection with Applicant’s mark and related actual or projected advertising expenditures;<sup>41</sup>
- each website, social media site or other online locations that display Applicant’s mark from January 20, 2020 to present;<sup>42</sup> and
- Applicant’s consumers, intended consumers, and trade channels.<sup>43</sup>

Applicant’s deemed admissions, initial disclosures, and responses to document requests support that Applicant has no objective, documentary evidence to substantiate his allegation of a bona fide intent to use the proposed mark in commerce for “t-shirts for adults” when he filed the application. Generally, the absence of documentary evidence is sufficient to demonstrate a prima facie case that an

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<sup>37</sup> *Id.* (Document Request No. 2).

<sup>38</sup> *Id.* at 78 (Document Request No. 4).

<sup>39</sup> *Id.* (Document Request No. 5).

<sup>40</sup> *Id.* (Document Request No. 6).

<sup>41</sup> *Id.* at 78-80 (Document Request Nos. 7, 10, 14).

<sup>42</sup> *Id.* at 79 (Document Request No. 9).

<sup>43</sup> *Id.* at 80 (Document Request Nos. 12, 13).

applicant lacked a bona fide intent to use as of the application filing date. *See, e.g., A&H Sportswear*, 2019 USPQ2d 111513, at \*23; *Rolex Watch*, 101 USPQ2d at 1197. We must, however, consider the totality of the evidence of record, including evidence that may support or undercut a finding of a bona fide intent to use. *Société des Produits Nestlé*, 2020 USPQ2d 10893, at \*15; *Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1471 (TTAB 2013), *aff'd*, 114 USPQ2d 1892 (“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. The absence of any documentary evidence regarding an applicant’s bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks the intention required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant’s failure to provide such documentary evidence.”) (internal citation omitted). Here, Opposer introduced additional evidence and made statements in its brief<sup>44</sup> and rebuttal notice of reliance pertinent to its lack

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<sup>44</sup> In arguing the alternative theory for relief discussed in n.27 above, Opposer states that “evidence of [Applicant’s] post filing conduct further demonstrates that [Applicant] never had a bona fide intent to use the applied-for-mark as a trademark for apparel, but rather he merely intended it to be an ornamental design placed on t-shirts that originate from sources other than [Applicant].” Opposer’s Brief, 30 TTABVUE 16. We do not construe this as a statement against interest; rather we construe it as an alternative (albeit unpleaded) theory for relief, which is permissible. *Cf.* Fed. R. Civ. P. 8(d)(3) (“A party may state as many separate claims or defenses as it has, regardless of consistency.”). The following statement in Opposer’s brief underscores that Opposer’s argument is in the alternative and not a statement against interest: “At most, [Applicant] had a subjective intent to display the applied-for mark on the front of a t-shirt in an ornamental matter.” 30 TTABVUE 18.

of bona fide intent to use claim that we consider in assessing whether Opposer has established a prima facie case.

Specifically, Opposer introduced a TSDR printout for “Sellers U.S. Registration No. 6598850”<sup>45</sup> reflecting that on August 19, 2020, the same day Applicant filed the involved application, Applicant filed intent-to-use application Serial No. 90125388 for



the mark DOUBLE STUFF, for clothing, including “t-shirts for adults.”<sup>46</sup> Four months later, on December 29, 2021, both the involved application and application Serial No. 90125388 were published for opposition.<sup>47</sup> No oppositions were filed against application Serial No. 90125388 and a notice of allowance issued on February 23, 2021.<sup>48</sup> On August 4, 2021, approximately one year after Applicant filed the applications, he filed a statement of use in connection with application Serial No. 90125388 supported by the specimen below:<sup>49</sup>

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<sup>45</sup> Opposer’s Brief, 30 TTABVUE 16.

<sup>46</sup> Opposer’s Notice of Reliance, 15 TTABVUE 86.

<sup>47</sup> *Id.* at 87.

<sup>48</sup> *Id.* at 87, 107.

<sup>49</sup> *Id.* at 87, 99-106.



On December 21, 2021, application Serial No. 90125388 for the mark <sup>DOUBLE STUFF</sup> matured into use-based Registration No. 6598850.<sup>50</sup>

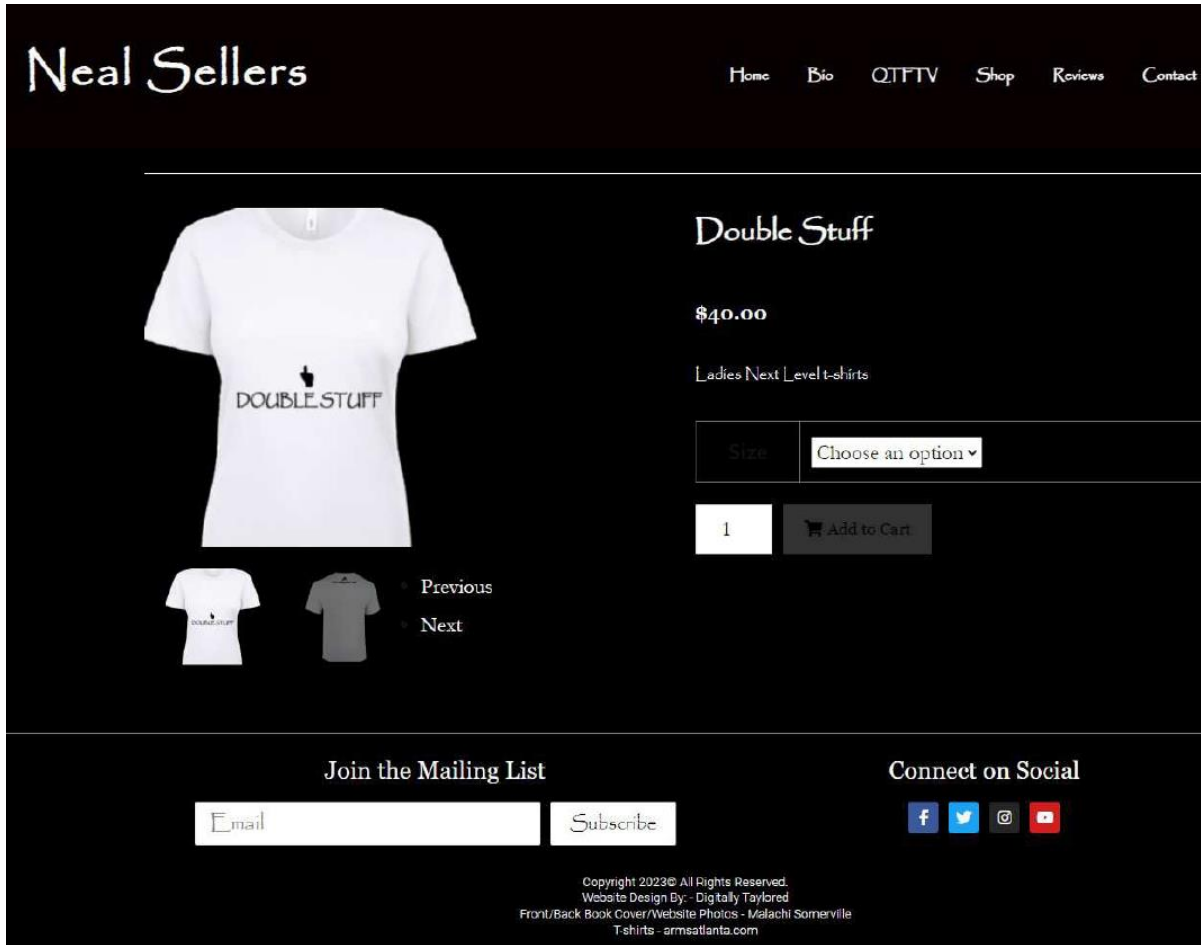
Opposer also introduced the following Internet screenshots, dated February 1, 2023, that Opposer represents are from “Applicant’s web page”:<sup>51</sup>

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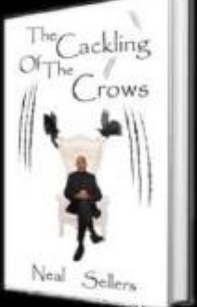
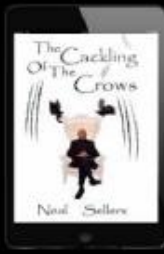







<sup>50</sup> *Id.* at 86-88.

<sup>51</sup> We give no consideration to the Internet screenshot at 28 TTABVUE 14 to the extent it shows Applicant’s website listing a t-shirt for sale bearing the involved mark. Nor do we consider the two February 1, 2023 Facebook posts, *id.* at 6-9, showing an image of what appears to be a digital mockup of a t-shirt bearing the involved mark. Applicant’s admissions conclusively establish that he has not “not disseminated any promotional materials that reference Applicant’s Mark” nor “disseminated documents to customers, prospective customers, trade organizations, or members of the press relating to Applicant’s use or intended use of Applicant’s Mark.” Opposer’s Notice of Reliance, 15 TTABVUE 69 (Request for Admission Nos. 25 and 26). Fed. R. Civ. P. 36(b). “An admission that is not withdrawn or amended cannot be rebutted by contrary testimony or ignored by the district court . . .” *Am. Auto Ass’n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991); *see also Tex. Dep’t of Transp. v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010) (admission established party’s priority notwithstanding argument that evidence failed to show actual date of first use). In any event, as discussed below, evidence from February 1,





2023 is too long after the August 19, 2020 filing date of the application to be probative of whether Applicant had a bona fide intent to use the mark when he filed the application.

		
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Opposer further acknowledges that Applicant “offers for sale on his website eight t-shirts” bearing ornamental matter “as well as t-shirts that include the ‘DOUBLE STUFF’ and upward finger pointing design depicted” in Applicant’s registration for the DOUBLE STUFF & Design mark.<sup>52</sup> In addition, in its rebuttal notice of reliance, Opposer identified ARMS Atlanta Apparel as “Applicant’s service provider for screen printing shirts” and introduced an Internet screenshot from ARMS Atlanta Apparel’s website dated February 1, 2023.<sup>53</sup>

Finally, Opposer introduced Applicant’s interrogatory responses including the following responses:<sup>54</sup>

**Interrogatory No. 9:** Identify and describe with specificity all facts and steps, preliminary and otherwise, taken in connection with the advertising, marketing or promotion of goods bearing the JUICY FRUIT Mark.

**Answer:** There was an idea to create t-shirts bearing the Juicy Fruit mark. There are ideas to advertise, market, and promote t-shirts.

**Interrogatory No. 10:** Identify each and every separate product bearing the JUICY FRUIT Mark that Applicant, at any time, has sold, now sells, intends to sell, or has offered for sale in the United States.

**Answer:** There was an idea to create t-shirts bearing the Juicy Fruit Mark.

“Evidence of a party’s bona fide intent need not pre-date the filing date of the application.” *Lane*, 33 USPQ2d at 1355. We have found evidence dated nine to eleven

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<sup>52</sup> Opposer’s Brief, 30 TTABVUE 16.

<sup>53</sup> Opposer’s Rebuttal Notice of Reliance, 28 TTABVUE 3.

<sup>54</sup> Opposer’s Notice of Reliance, 15 TTABVUE 60.

months after the filing date of an application to be sufficiently contemporaneous with filing “to serve as corroboration of the applicant’s declaration in the application of a bona fide intention to use the mark in commerce.” *Id.* In addition, evidence that an “applicant has the capacity to market and manufacture the goods identified in its application” may support a finding that the applicant had the requisite bona fide intent to use required under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). *Rolex Watch*, 101 USPQ2d at 1198 (evidence of applicant’s capacity to market and manufacture the goods in the application further suggested that applicant filed the involved application in good faith and not merely to reserve a right in the mark); *Wet Seal Inc. v. FD Mgt. Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007) (finding applicant’s capacity to market and/or manufacture goods, having produced them in the past under different marks, rebutted the ambiguous testimony of the sole witness on the matter).

The record shows that Applicant filed his application for the DOUBLE STUFF & Design mark on the same day he filed the application involved in this proceeding, and that approximately one year later, Applicant filed a statement of use in connection with the DOUBLE STUFF & Design mark. Even if we treat the filing of the statement of use in connection with the DOUBLE STUFF & Design mark as an act sufficiently contemporaneous with the filing date of the involved application to be potentially probative of Applicant’s intent with respect to the involved mark, the fact remains that the filing pertains to a **different** mark, which, as discussed below, does not

establish that Applicant also intended to use its “other” mark when he filed the involved application to register it.

The facts here also are distinguishable from the facts in *Rolex* and *Wet Seal*, where we found the applicant’s capacity to market the goods in the application supported that the applicant had a bona fide intent to use its mark when it filed the intent-to-use application. In *Rolex*, the applicant filed an intent to use application for the mark ROLL-X for “x-ray tables for medical and dental use.” 101 USPQ2d at 1191. The record showed that the applicant registered the mark DENT-X for goods including “x-ray machines” more than a decade before filing its application for the ROLL-X mark. *Id.* at 1197. The applicant’s witness further testified that the applicant “advertise[d] its mark DENT-X for its human dental x-ray business.” *Id.* Based on this evidence, we concluded that “the filing of the application for the ROLL-X mark” was “consistent with an extension of [the applicant’s] current product line” and rebutted the absence of documentary evidence supporting applicant’s intent to use the ROLL-X mark. *Id.*

In contrast here, Applicant filed applications for the involved mark and the DOUBLE STUFF & Design mark on the same day for identical goods. Rather than reflecting an extension of Applicant’s existing product line, Applicant’s simultaneous filing of two applications for the same goods supports an inference that when Applicant filed the applications, he intended to go to market with goods bearing only one of the marks. Applicant did not introduce testimony or other evidence to show that we should infer that his intention was to go to market with the mark involved in

this proceeding. Moreover, Applicant's initial disclosures and discovery responses indicating the lack of documentary evidence to substantiate his allegation of a bona fide intent to use the proposed mark in commerce for "t-shirts for adults" further support an inference that Applicant intended to go to market with goods bearing only one of the marks.

In *Wet Seal*, there was no evidence that the applicant lacked documentary evidence to support its claim of a bona fide intent to use the mark. Instead, the opposer relied solely on the testimony of applicant's executive vice president and chief marketing officer. 82 USPQ2d at 1642-43. The opposer did not establish that this witness "would be the sole person in the company responsible for making decisions" regarding the applicant's marketing plans. *Id.* at 1643. The opposer failed to ask the witness questions "which fully explored the applicant's actual intent" and some of the witness's testimony was "ambiguous." *Id.* We found the evidence that applicant had the capacity to manufacture or market the goods outweighed the ambiguous testimony of the sole witness testifying to applicant's bona fide intent to use. *Id.*

The *Rolex* and *Wet Seal* cases underscore that "[t]he particular facts of each [lack of bona fide intent to use] case must be carefully considered in their totality." *Société des Produits Nestlé*, 2020 USPQ2d 10893, at \*12. Accordingly, even if we were to presume that Applicant had the capacity to market and source "t-shirts for adults" approximately one year after he filed the application, that evidence cannot be considered in a vacuum and does not support that Applicant intended to use the involved mark when he filed the application to register it. We must consider the

record as a whole, including Applicant's initial disclosures and discovery responses indicating the absence of any documentary evidence to support an intent to use the involved mark for "t-shirts for adults."

Further, while Opposer has acknowledged that Applicant was offering t-shirts for sale and had the capacity to source t-shirts for sale as of February 2023, this is two and a half years after Applicant filed the involved application **and** after the Board granted partial summary judgment to Opposer on its lack of bona fide intent to use claim with respect to all goods in the application except "t-shirts for adults." We find that Applicant's activities, occurring so long after Applicant filed his application and after we granted partial summary judgment to Opposer, fail to support that Applicant actually had a bona fide intent to use the mark on "t-shirts for adults" when he filed his application. "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 \*14 (finding unpersuasive applicant's business plans to use his mark documented more than two years after the application was filed and after Opposer moved for summary judgment); *Bos. Red Sox*, 88 USPQ2d at 1587 (finding Internet searches and investigations conducted more than two years after the filing date of the application "not even remotely contemporaneous with" the application filing date).

Finally, Applicant's interrogatory responses indicating Applicant had "an idea" to use the involved mark for "t-shirts" merely reflect a subjective, speculative intent to

use the mark “insufficient to establish applicant’s bona fide intent to use the mark in commerce.” *Lane*, 33 USPQ2d at 1355.

In sum, Opposer has introduced Applicant’s initial disclosures and discovery responses demonstrating the absence of any documents to support that Applicant had a bona fide intent to use the involved mark for “t-shirts for adults” when he filed his application. Applicant’s offer to sell t-shirts and ability to source t-shirts from ARMS Atlanta Apparel as of February 1, 2023 is too far removed from the August 19, 2020 filing date of the application to be probative of Applicant’s intent. The statement of use Applicant filed on August 4, 2021 to support registration of the DOUBLE STUFF & Design mark is more contemporaneous with the filing date of the involved application, but it is not sufficient to demonstrate that Applicant actually had the intent to use the involved mark in connection with “t-shirts for adults” when he filed the involved application. Further, the simultaneous filing of applications for the involved mark and the mark DOUBLE STUFF & Design for identical goods supports a reasonable inference that Applicant intended to use only one of the marks, as opposed to both marks. Finally, Applicant’s “idea” to sell t-shirts reflects a speculative, subjective intent.

For all of these reasons, we find that Opposer established a prima facie case that Applicant lacked a bona fide intent to use the involved mark for “t-shirts for adults” when he filed the application and that Applicant did not introduce any evidence to rebut Opposer’s prima facie case to show that he had a “firm” and “demonstrable”



intent to use the mark for “t-shirts for adults” when he filed his application, as required under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Upon careful consideration of the totality of the specific circumstances of this case, we find that Opposer has proven its lack of bona fide intent to use claim by a preponderance of the evidence.

#### **IV. Conclusion**

Opposer has maintained its entitlement to a statutory cause of action, as established on summary judgment, and has proven that Applicant lacked a bona fide intent to use his mark for “t-shirts for adults” when he filed his application. Accordingly, we do not reach Opposer’s likelihood of confusion and dilution claims.

**Decision:** The opposition is sustained as to the goods identified in the application as “t-shirts for adults.” As explained, we previously sustained the opposition as to all of the other goods in the application in our summary judgment order.<sup>55</sup> Accordingly, registration to Applicant is refused on the lack of bona fide intent claim for all of the goods identified in the application.

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<sup>55</sup> Board’s Corrected Summary Judgment Order, 11 TTABVUE 13-14.