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LTS

January 30, 2024

Opposition No. 91272712

BlackBerry Limited

v.

Hotberry LLC

**Before Taylor, Greenbaum, and Dunn,
Administrative Trademark Judges.**

By the Board:

Hotberry LLC (“Applicant”) seeks registration of the mark HOTBERRY, in standard characters, for “planning, design and management of information technology systems” in International Class 41.¹

In its amended notice of opposition, BlackBerry Limited (“Opposer”) alleges prior common law use of BLACKBERRY-formative marks in connection with the following goods and services:

mobile devices and accessories, including batteries, telecommunications services; computer/device/Internet security and connectivity solutions; embedded software, operating systems and middleware; cloud computing software; software for use in managing device-to-device, device-to-cloud and cloud-to-device communications; computer software for machine-to-machine (M2M) communication; Internet of Things (IoT)

¹ Application Serial No. 90060618; filed July 19, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use of January 1, 2014 and date of first use in commerce of July 1, 2020.

communication integration; software development platforms; Enterprise Mobility Management; Mobile Device Management; Mobile Applications Management; automation and process control solutions; and retail store services in connection with same

18 TTABVUE 10-11, ¶¶ 5-7. Opposer also pleads ownership of a number of registered marks consisting of, or comprising, the term BLACKBERRY for use in connection with a variety of goods and services in International Classes 9, 16, 35, 37, 38, 41, 42, and 45. *Id.* at 11, ¶ 8. Opposer opposes registration of the involved mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), and nonuse of the mark in commerce prior to the filing date of the application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). 18 TTABVUE 10-15, ¶¶ 4-47. In its answer to the amended notice of opposition, Applicant admits that Opposer's "BLACKBERRY Marks are famous in the United States and throughout the world" (24 TTABVUE 4, ¶ 17; *id.* at 5, ¶ 34) and that "Opposer commenced use of the BLACKBERRY Marks well before Applicant filed the Application and/or commenced use of Applicant's Mark in commerce" (*id.* at 4, ¶ 18). Applicant otherwise denies the salient allegations in the amended notice of opposition. 24 TTABVUE.

This case now comes up for consideration of Opposer’s motion, filed September 21, 2023, for summary judgment solely on its claim of nonuse. 25 TTABVUE. The motion for summary judgment is fully briefed.²

I. The Parties’ Arguments and Evidence

A. Opposer’s Arguments and Evidence

In support of its motion for summary judgment, Opposer relies on Applicant’s responses to Opposer’s discovery requests, Applicant’s document production, and the deposition testimony of Applicant’s Fed. R. Civ. P. 30(b)(6) designee, Karen Montgomery. 25 TTABVUE 19-91. Opposer argues, inter alia, that:

- (1) Applicant was not rendering any services under the HOTBERRY mark in U.S. commerce when the involved application was filed (*id.* at 13-16);
- (2) Applicant has not identified any customers and instead has only “vaguely responded it was using the HOTBERRY Mark to solicit and obtain clients who are leading providers in the retail space” and that its consumers consisted of “[r]etailers, original equipment manufacturers, fulfillment center operators, and distributors” (*id.* at 13-14, quoting

² We note that counsel filed a notice of appearance on behalf of Applicant on November 26, 2021. 4 TTABVUE. Applicant’s response to the motion for summary judgment, however, was filed and served by Karen Montgomery, who is listed on the application as Applicant’s “owner.” On January 24, 2024, the Board issued an order noting that, “[p]ursuant to Trademark Rule 2.18(a)(2), the Board will communicate and conduct business only with Applicant’s recognized counsel, not Applicant (or Applicant’s corporate representative Ms. Montgomery)” and that “Applicant’s counsel has not withdrawn from representation, and Applicant did not file a revocation of the appointment of its counsel with a statement that it intends to represent itself in these proceedings before filing Applicant’s response to Opposer’s motion for summary judgment.” 29 TTABVUE 1. In view thereof, the Board allowed Applicant time to file a revocation of the appointment of counsel and change of correspondence address, failing which Applicant’s response to the motion for summary judgment would receive no consideration. *Id.* at 1-2. On January 25, 2024, Applicant filed a revocation of the appointment of its counsel and a statement that it intends to represent itself with its updated correspondence address. 30 TTABVUE. Proceeding records have been updated accordingly. In view of the revocation of the appointment of Applicant’s counsel and Applicant’s undertaking to represent itself, the Board has considered Applicant’s response to Opposer’s motion for summary judgment.

Applicant's responses to Opposer's Interrogatory Nos. 6-7; *see also id.* at 51);

- (3) Applicant has failed to produce any documents showing use of its HOTBERRY mark, despite its undertaking to do so (*id.* at 14, citing Applicant's responses to Request for Production Nos. 3-6, 10, 14, 15; *see also id.* at 45-47);
- (4) The documentary evidence that Applicant produced, including an event badge and tickets to two retail shows, a company brochure titled "The New Online Grocery Store," a 15-page pitch deck concerning Applicant's "future hybrid grocery stores," and an email with a link to two YouTube videos titled "Have you ever been shopping with robots before?" and "Automated Grocery Shelving and Picking System," "offers no indication ... Applicant was rendering Applicant's Services in connection with the HOTBERRY Mark when it filed its Application" (*id.* at 14, 56-77);
- (5) Applicant's documentary evidence at best "evidences sporadic, preparatory steps" (*id.* at 14);
- (6) During her deposition, Ms. Montgomery admitted, inter alia, that Applicant has not hired an "integrator" to "select the manufacturers or the equipment that would go in the system" (*id.* at 87-88, Montgomery Tr. at 29:25-30:11); Applicant has no customers (*id.* at 81, Montgomery Tr. at 9:18-20), no revenue (*id.* at 81, Montgomery Tr. at 9:21-23), and no business plan (*id.* at 89, Montgomery Tr. at 32:18); and Applicant's first claimed use of the HOTBERRY mark in the Application—as early as 2014—was actually based on use of the HOTBERRY mark on goods, namely software for "home financing products" (*id.* at 82-83, Montgomery Tr. at 10:14-11:17); and
- (7) In addition to not using the HOTBERRY mark when Applicant filed the involved application, Applicant was not even advertising its services, as evidenced by the fact that Applicant could only produce a single flyer related to its services and links to two YouTube videos (published online after the filing date of the involved application), even though Applicant claimed to spend "approximately \$10,000 per year to date" on advertising and claimed to advertise via "[d]irect mail, trade shows, Internet, social media, public relations, media, [and] email marketing campaigns" (*id.* at 16, citing Applicant's responses to Interrogatory Nos. 10 and 17; *see also id.* at 52, 55).

B. Applicant's Arguments and Evidence

In response, Applicant details the many steps it took to launch its company and brand, including:

- (1) Creating a “technology platform” in 2015 “to distribute residential financing to new homebuyers” (27 TTABVUE 3);
- (2) Securing a residential property to sell through an investor in an effort to begin its “A/B testing of the new financing plan” (*id.*);
- (3) Gathering interest from investors “by advertising its financial plan” (*id.*);
- (4) Participating in a startup competition in 2015 and 2016, whereby Applicant “presented information regarding its information technology platform” (*id.*);
- (5) Pivoting in 2016 to the development of technology that Applicant “designed for retail and distribution spaces or warehouses” after Applicant failed to secure financing for its residential financing platform (*id.* at 4);
- (6) Seeking patent and copyright protection for Applicant’s automated fulfillment technology (*id.* at 4-5);
- (7) Seeking trademark protection for the HOTBERRY mark after Applicant’s patent application was allowed (*id.*);
- (8) Taking the “step to use the mark at the time of filing the trademark application by contacting investors in an effort to obtain financing to market its services to the marketplace” (*id.* at 5);
- (9) Preparing a pitch deck for an investment group presentation on or around April 22, 2020 (*id.*);
- (10) Hiring a patent broker to broker deals concerning Applicant’s patent rights (*id.*); and
- (11) Creating “a website and other materials ... in an effort to assist the patent brokerage firm’s marketing efforts,” including the creation of a flyer to be left with retail managers on site (*id.*).

Applicant argues that there is a genuine dispute of material fact concerning Opposer's nonuse claim because, inter alia:

- (1) "Applicant established intent to utilize the mark commercially" (27 TTABVUE 6);
- (2) "Applicant's lack of revenue does not indicate a lack of bona fide intent to use the mark commercially" (*id.* at 7);
- (3) "Applicant publically [sic] used the mark in 2015 and 2016" on its website (*id.* 8);
- (4) Applicant's residential financing "technology platform was fully functional," as evidenced by a printout of its website from 2016 (*id.*); and
- (5) "Unsuccessful efforts to collect licensing fees from the marketplace have no reflection on the Applicant's bona fide intent at the time of filing of the trademark application" (*id.*).

C. Opposer's Reply Arguments

In reply, Opposer argues, inter alia, that:

- (1) Applicant's assertion that it used the HOTBERRY mark in connection with a "technology platform to distribute residential financing to new homebuyers" is different than the recited services of the involved application and, in any event, there is no evidence of such use (28 TTABVUE 2-3);
- (2) Use of the HOTBERRY mark on Applicant's website is not sufficient to show use in commerce (*id.* at 3);
- (3) The "steps" that Applicant identifies it took prove that Applicant never used the HOTBERRY mark in connection with the recited services of the involved application (*id.*); and
- (4) Applicant's intent to use its involved mark does not equate with use in commerce of that mark (*id.* at 3-4).

II. Legal Standard

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute as to any material fact, thus allowing the case to be resolved as

a matter of law. *See* Fed. R. Civ. P. 56(a). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1987). All evidence must be viewed in a light favorable to the non-movant, in this case Applicant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). In deciding a summary judgment motion, the Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Opryland USA*, 23 USPQ2d at 1472; *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Only when the movant has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact and that the moving party is entitled to judgment as a matter of law, does the burden then shift to the non-movant to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Freki Corp. N.V. v. Pinnacle Entm't, Inc.*, 126 USPQ2d 1697, 1700 (TTAB 2018); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). The non-movant may not rest on the mere allegations of its pleadings and assertions of it or its counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. *See* Fed. R. Civ. P. 56(c); *Celotex*, 477 U.S. at 324; *Freki Corp.*,

126 USPQ2d at 1700. In general, to establish the existence of disputed facts requiring trial, the non-movant “must point to an evidentiary conflict created on the record[,] at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” *Octocom Sys., Inc. v. Hous. Computs. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990); *see also Freki Corp.*, 126 USPQ2d at 1700. A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the disputed matter in favor of the non-movant. *Opryland USA*, 23 USPQ2d at 1472; *Olde Tyme Foods*, 22 USPQ2d at 1544; *Venture Out Props. LLC v Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1890-91 (TTAB 2007).

To prevail on summary judgment here, Opposer must demonstrate that the record shows no genuine dispute as to any material fact and that, as a matter of law, Opposer has an entitlement to a statutory cause of action and Applicant made no bona fide use of the mark HOTBERRY in commerce on or in connection with the services recited in the involved application, as of the application’s July 19, 2020 filing date.

III. Analysis

A. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action (formerly known as standing) must be established in every inter partes proceeding. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)), *cert. denied*, 142 S. Ct. 82 (2021). To establish entitlement to a statutory cause

of action under Section 13 of the Trademark Act, 15 U.S.C. § 1063, a plaintiff must demonstrate the absence of a genuine dispute of material fact that it has (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020) (citing *Lexmark*, 109 USPQ2d at 2067-70), *cert. denied*, 141 S. Ct. 2671 (2021); *see also Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

Applicant does not contest Opposer's entitlement to a statutory cause of action, and we find that there is no genuine dispute of material fact with respect to Opposer's entitlement to a statutory cause of action. More specifically, Applicant admits that "Opposer commenced use of the BLACKBERRY Marks well before Applicant filed the Application and/or commenced use of Applicant's Mark in commerce" (24 TTABVUE 4, ¶ 18) and Opposer has asserted "[a] claim of likelihood of confusion that 'is not wholly without merit[.]'"³ *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *2 (TTAB 2020);

³ We note that Opposer pleads ownership of several registrations for its pleaded BLACKBERRY marks. 18 TTABVUE 11, ¶ 8; *see also* 1 TTABVUE 18-24. Opposer, however, did not submit status and title copies of its pleaded registrations with its original notice of opposition or amended notice of opposition. While Opposer purports to attach current status and title copies of its pleaded registrations to its motion for summary judgment (25 TTABVUE 7; *id.* at 20, ¶ 6), no status and title copies were filed. Accordingly, Opposer's pleaded registrations are not part of the record. Nevertheless, Opposer's failure to submit its pleaded registrations is not fatal to its entitlement to a statutory cause of action because its claim for likelihood of confusion under Section 2(d) of the Trademark Act is also based on its alleged common law rights in its pleaded BLACKBERRY marks. 18 TTABVUE 10-11, ¶¶ 5-7.

see also Performance Prods. Ltd. v. Weapon X Motorsports, Inc., 126 USPQ2d 1034, 1039-40 (TTAB 2018) (standing established through applicant's concessions and admissions); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 & n.2 (TTAB 1991) (standing established by defendant's admission in its answer). Once Opposer has proven its entitlement to a statutory cause of action on one pleaded ground, it has established its entitlement for any other ground. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) (“[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”); *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing shown on one ground, plaintiff has right to assert any other ground in proceeding).

Accordingly, we find that Opposer has demonstrated the absence of a genuine dispute of material fact as to its entitlement to a statutory cause of action.

B. Opposer's Nonuse Claim

An application based on use of the mark in commerce under Section 1(a) of the Trademark Act, as in this case, is void ab initio if the mark was not in use in commerce in connection with the goods or services identified in the application at the time the application was filed. *See* 15 U.S.C. § 1051(a); Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i); *see, e.g., Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009) (“The registration of a mark that does not meet the use requirement is void ab initio.”) (“*Aycock*”); *Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013) (discussing summary judgment motion on claim that applicant

had not made bona fide use of its mark in commerce as of the filing date of applicant's use-based application); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (nonuse by respondent at the time of filing the underlying use-based application; cancellation granted).

To prevail on its nonuse claim at summary judgment, Opposer must establish that there is no genuine dispute as to any material fact regarding whether Applicant was using the HOTBERRY mark in commerce in connection with the recited services of the involved application (i.e., "planning, design and management of information technology systems") when it filed the application on July 19, 2020. *See United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1044-45 (TTAB 2014). Under Section 45 of the Trademark Act:

[A] mark shall be deemed to be in use in commerce –

...

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127. *See Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015) ("On its face, the statute is clear that a mark for services is used in commerce only when both [1] 'it is used or displayed in the sale or advertising of services and [2] the services are rendered'").

Having considered the evidence and arguments submitted by the parties, and viewing the evidence in the light most favorable to Applicant, we find that Opposer has satisfied its burden of setting forth a prima facie showing that there are no

genuine disputes of material fact remaining for trial and that it is entitled to judgment as a matter of law as to its claim that Applicant had not made bona fide use of its mark in commerce as of the filing date of Applicant's use-based application (July 19, 2020) in connection with "planning, design and management of information technology systems." By introducing evidence showing no dispute as to the fact that Applicant had not used the mark in commerce in connection with the recited services of the involved application before it filed its use-based application, it was incumbent upon Applicant to supply evidence sufficient to demonstrate that there is at least one genuine dispute of material fact to be determined at trial. Applicant has failed to do so.

The only actual use of the HOTBERRY mark that Applicant contends was made before the filing date of the involved application is use of the mark in connection with "a technology platform to distribute residential financing to new homebuyers." 27 TTABVUE 3. The evidence of such use, however, is limited to Applicant securing a residential property to sell through an investor in an effort to begin its "A/B testing of the new financing plan" (27 TTABVUE 3, 71-72), Applicant gauging interest in the residential financing concept via a Craigslist ad in 2014 (*id.*), Applicant's participation in a start-up competition in 2015 and 2016 (*id.* at 12-18), and Applicant's publication of a website in 2016 promoting the residential financing services (*id.* at 61-70). This evidence does not support that Applicant ever provided such services. *See Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *6 (TTAB 2020) ("Respondent's video describes no more than 'the basic concepts'

behind the ... platform. The invitation to contact Respondent is part of Respondent's development of the goods and services, and is not an indication that the goods or services are available."); *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008) (website evidence "is not evidence that opposer is using its mark on any goods or services displayed or discussed on the site"); *Intermed Commc'ns, Inc. v. Chaney*, 197 USPQ 501, 507 (TTAB 1977) (solicitation to prospective donors not evidence or use).

Nevertheless, even if Applicant did provide residential financing, Ms. Montgomery's testimony confirms that the "technology platform to distribute residential financing to new homebuyers" is different than the services recited in the involved application, as she testified that Applicant's use of the mark for residential financing was in connection with "software" that Applicant built "from scratch" "to facilitate application for the home financing product" (25 TTABVUE 82-83, Montgomery Tr. 10:14- 11:21), whereas the services recited in the involved application are "planning, design and management of information technology systems." *See* 27 TTABVUE 61-66 (images of Applicant's website describing the residential financing program).

After Applicant failed to obtain financing for the residential financing concept in 2016, Applicant "pivoted" to "technology [it] designed for retail and distribution spaces or warehouses." 27 TTABVUE 4; *see also* 25 TTABVUE 81-82, Montgomery Tr. 9:12-10:21 (describing Applicant's "micro fulfillment technology" as "[w]arehouse automation solutions that use AI basically and robotics to automate fulfillment

services”). The evidence of record, however, does not support Applicant’s use of the HOTBERRY mark in connection with its “micro fulfillment technology” or any other services encompassed by the recitation of services in the involved application. Rather, the evidence, at best, demonstrates Applicant’s bona fide intent to use the HOTBERRY mark via the many steps Applicant took to launch its micro fulfillment technology, including “pursuing expensive patent protection, pursuing copyright protection, engaging artists, engaging brokers, and publishing a website.” 27 TTABVUE 10.

Applicant did not, however, file an intent to use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Instead, Applicant filed a use-based application under Section 1(a) of the Trademark Act. “[A]n applicant’s preparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the mark must be actually used in conjunction with the services described in the application for the mark.” *Couture*, 113 USPQ2d at 2043 (quoting *Aycock*, 90 USPQ2d at 1308). “Without question, advertising or publicizing a service that the applicant intends to perform in the future will not support registration”; the advertising must instead “relate to an **existing service** which has already been offered to the public.” *Id.* (quoting *Aycock*, 90 USPQ2d at 1307) (emphasis in original).

Here, there is no evidence in the record showing that Applicant rendered any services encompassed by the recitation of services in its involved application before the application filing date. Accordingly, Opposer’s motion for summary judgment on its nonuse claim is **granted**, judgment is entered in its favor on that claim, the

opposition is sustained on the ground of nonuse, and registration to Applicant is refused.⁴

⁴ We need not reach Opposer's remaining claims of likelihood of confusion, dilution, and false suggestion of a connection, which are not the subject of Opposer's motion. *See Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (Board has the "discretion to decide only those claims necessary to enter judgment and dispose of the case"); *Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim). Accordingly, these claims are dismissed without prejudice.