

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: November 7, 2017

Cancellation No. 92064261

Michael Spitzbarth

v.

John Groat dba Holly Shirt!

**Before Kuhlke, Wellington, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

This case now comes up for consideration of Respondent's motion (filed June 27, 2017) for reconsideration of our June 20, 2017 order denying the parties' respective motions for partial summary judgment on whether Petitioner had a *bona fide* intent to use his mark when he filed his pleaded application, the lack of which would render the application void *ab initio* and Petitioner without standing. Although, as discussed *infra*, we deny Respondent's motion for reconsideration, we also consider the parties' cross-motions for summary judgment (filed on February 21, 2017 and March 23, 2017, respectively). In so doing, we have considered the parties' briefs on the contested motions, but we discuss only the relevant arguments. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Respondent's Motion for Reconsideration

In his motion filed February 21, 2017 (7 TTABVUE), Respondent sought partial summary judgment on whether Petitioner did not have a bona fide intent to use his mark in commerce when he filed his pleaded application and, therefore, has no standing because that application is void *ab initio*. We denied summary judgment on that issue because (1) Respondent had not asserted that affirmative defense in his answer; and (2) a party may not obtain summary judgment on an unpleaded issue (18 TTABVUE 2-3). Respondent contends the Board erred in its decision because there is no requirement to plead as an affirmative defense that the plaintiff has no standing; rather, argues Respondent, standing is an element that must be pleaded and proven at trial.

The premise underlying a motion for reconsideration is that, based on the facts before the Board at the time a party's original motion was under consideration, the Board erred in reaching the order it issued. A motion for reconsideration may not properly be used to simply reargue the points that were presented or should have been presented in a brief on the original motion. Rather, the motion for reconsideration should be limited to a demonstration that, based on the facts before it at such time and the applicable law, the Board's ruling is in error and requires appropriate change. *See Guess? IP Holder L.P.*, 116 USPQ2d at 2019; TBMP § 518 (June 2017).

Respondent's motion for reconsideration is based on a misunderstanding of the Board's order pertaining to the cross-motions for partial summary

judgment. We did not deny Respondent's motion because he failed to assert the affirmative defense of lack of standing. As noted by the Board in the prior order, "lack of standing" need not be raised as an affirmative defense. Standing is an element of the plaintiff's claim. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("The facts regarding standing, we hold, are part of a petitioner's case and must be affirmatively proved."). Rather, we stated as follows:

“. . . Respondent did not plead any affirmative defenses, much less the affirmative defense that Petitioner did not have a *bona fide* intent to use his pleaded mark in commerce when his pleaded application was filed, that said application is void *ab initio* and, therefore, Petitioner has no standing.

(18 TTABVUE 2).

Said differently, the appropriate affirmative defense would have been that "Petitioner did not have a bona fide intent to use his pleaded mark in commerce when his pleaded application was filed and, in view thereof, said application is void *ab initio*, the consequence of which is that Petitioner has no standing." *See Kaplan v. Brady*, 98 USPQ2d 1830, 1834 n.7 (TTAB 2011) (non-precedential) ("If respondent wishes to rely at trial upon an affirmative defense that petitioner lacks standing to maintain this proceeding because he did not have a bona fide intent to use his pleaded mark when he filed the intent-to-use application to register that mark, he must seek leave to file an amended answer in which he includes such an affirmative defense.").

Additionally, we specifically rejected Petitioner's argument (in his reply brief) "that standing may be an issue in any cancellation proceeding 'only if, and to the extent, affirmatively raised in the pleadings as an affirmative defense....,'" stating that the assertion was not well-founded (18 TTABVUE 2, note 3). Thus, in two instances in the order we emphasized that the reason for denying Respondent's motion for partial summary judgment and Petitioner's cross-motion on the same issue, was that Respondent had not pleaded as a defense in his answer that Petitioner lacked a bona fide intent to use his pleaded mark in commerce, and that the application for that mark is void *ab initio*. Because summary judgment may not be granted on an unpleaded claim or defense (*see Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2, 1292 (TTAB 2016)), we find no error in the June 20, 2017 order. Accordingly, Respondent's motion for reconsideration is **denied**.

Motions for Partial Summary Judgment

Although we have denied Respondent's motion for reconsideration, we note that Petitioner responded on the merits to Respondent's motion for summary judgment and did not object in his response that the motion is based on an unpleaded issue¹ (9 TTABVUE). In view thereof, for purposes of the parties' cross-motions for summary judgment only, we deem Respondent's answer to

¹ Petitioner did not mention the pleading issue until his reply brief in support of his cross-motion for summary judgment (14 TTABVUE 10 and note 7) or in the declaration of his counsel, Stephen B. Mosier (§ 7, 14 TTABVUE 16).

have been amended, by agreement of the parties, to allege the aforementioned appropriate affirmative defense, namely, that Petitioner did not have a bona fide intent to use his pleaded mark in commerce when his pleaded application was filed and, in view thereof, said application is void *ab initio*, the consequence of which is that Petitioner has no standing. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); TBMP § 528.07(a). Accordingly, we shall consider the parties' respective motions for partial summary judgment on that defense.

- **Respondent's Motions to Exclude and to Strike**

Before addressing Respondent's motion for summary judgment, we must first consider Respondent's motion to exclude Petitioner's evidence, which is set forth in his reply brief pertaining to his summary judgment motion (13 TTABVUE), and Respondent's motion to strike Petitioner's response to the motion for sanctions (14 TTABVUE).

In Respondent's reply brief, he does not argue that Petitioner failed to show that there is a genuine dispute as to whether he had a bona fide intent to use the mark BLEED in commerce when his application was filed. Rather, Respondent argues that the Board should impose the estoppel sanction by excluding the declaration of Michael Spitzbarth and the evidence referenced therein, which were submitted by Petitioner in response to Respondent's

motion for partial summary judgment. Specifically, Respondent contends that some of the content of the declaration, including the identification of a new witness, were not revealed in Petitioner's initial disclosures or in his responses to Respondent's discovery requests. Additionally, Respondent states that Petitioner never supplemented his disclosures or discovery responses and that the documents referred to in Petitioner's declaration were not served on Respondent until two days prior to the date on which Petitioner filed his response to the summary judgment motion. Respondent also points out that his first request for documents asked for "all documents ... evidencing any intentions or plans, or lack of any intention or plan, by any person or entity to use the trademark 'BLEED' in the United States in connection with any goods within GOODS" (13 TTABVUE 6). In view of the foregoing, Respondent contends that under the standard discussed in *Great Seats, Inc. v. Great Seats, Ltd.*,² the Board should exclude Petitioner's declaration and the evidence to which it refers. In support of his motion to exclude, Respondent submitted the declaration of his counsel, who attests that, *inter alia*, none of Petitioner's exhibits to Mr. Spitzbarth's declaration were produced in response to Respondent's discovery or in supplements thereto (§ 2, 13 TTABVUE 13).

○ *Motion to Strike*

Respondent moves to strike "*Petitioner's Reply Brief in Support of Petitioner's Cross-Motion for Summary Judgment, and in Opposition to*

² 100 USPQ2d 1323 (TTAB 2011).

Registrant's Motion for Summary Judgment on the Issue of Standing" (14 TTABVUE), which was filed in response to Respondent's motion to exclude. Inasmuch as Respondent did not file a response to Petitioner's cross-motion for partial summary judgment, a reply brief from Petitioner in support of his cross-motion would have been improper. Additionally, sur-replies are not permitted. See Trademark Rule 2.127(a). However, although Petitioner's submission is titled "Petitioner's Reply Brief . . . ," the brief is primarily a response to Respondent's motion to exclude. Specifically, Petitioner points out that he produced to Respondent, along with Petitioner's Initial Disclosures, Petitioner's sworn declaration affirming his intent to use the mark in commerce (14 TTABVUE 4), and that Respondent never objected to Petitioner's discovery responses (*Id.*). Petitioner also argues that discovery is not closed, that Respondent never sought to depose Petitioner, and that the cases cited by Respondent in support of the motion to exclude are inapposite (14 TTABVUE 7-11).

After carefully reviewing Petitioner's "reply brief," we find that Petitioner's submission is not a "sur-reply" to Respondent's reply brief, as Respondent argues in his motion to strike; rather, Petitioner's misidentified "reply brief" is mainly a response to Respondent's motion to exclude Petitioner's evidence. Accordingly, Respondent's motion to strike Petitioner's "reply brief" is **denied**. Nonetheless, to the extent Petitioner's submission includes arguments in support of his cross-motion for partial summary judgment or against

Respondent's motion for partial summary judgment, we will not consider such arguments.

o *Motion to Exclude Petitioner's Evidence*

A party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987). However, while such preclusion may be sought in connection with a motion for summary judgment, the Board is free to consider all relevant circumstances. *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005).

Here, Petitioner did not refuse to produce responsive information to Respondent. Rather, Petitioner responded that "all non-privileged responsive documents, if any, in Petitioner's possession, custody or control will be produced" (7 TTABVUE 76). Further, when Petitioner realized after service of Respondent's motion for summary judgment that certain business records and his declaration might be useful, he supplemented his discovery responses two days prior to the submission of his response to indicate that he intended to rely on those business records to demonstrate his bona fide intent. The following passage from *Vignette Corp. v. Marino*, is relevant here:

[D]iscovery responses may be supplemented at any time, even during trial, *or after receipt of a summary judgment motion*. To apply the preclusion sanction under Federal Rule 37(c)(1) here or in similar circumstances would amount to elevating form over substance since no practical distinction

exists between consideration of information provided as part of a responsive brief to a summary judgment motion or information provided in supplemental responses to discovery that are submitted at the same time as a responsive brief.

77 USPQ2d at 1411 (emphasis added).

In view of the foregoing, with respect to Petitioner's declaration and the exhibits referred to in the declaration (which were submitted with Petitioner's response), the Board exercises its discretion to consider them. *See Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) ("we hold that the Board did not abuse its discretion by refusing to strike Nestle's evidence"); *see also* TBMP § 527.01(e) (In instances where a party does not "unequivocally refuse" to provide information in response to discovery requests, the preclusion sanction under Fed. R. Civ. P. 37(c)(1) may not apply.). Accordingly, Respondent's motion to exclude Petitioner's evidence is **denied**.

- **Cross-Motions for Partial Summary Judgment**

- *Parties' Arguments and Evidence*

By way of background, as the basis for his standing, Petitioner alleges that Respondent's registration has been cited as a bar to the registration of Petitioner's pleaded mark, BLEED (¶ 3, pet. for canc., 1 TTABVUE 3). As discussed *supra*, in Respondent's motion for partial summary judgment, he contends that Petitioner has no standing to bring this proceeding because Petitioner did not have a bona fide intent to use his mark in commerce when he filed his pleaded application and, therefore, the application is void *ab initio*.

Because Petitioner's application is assertedly void, Respondent argues that his registration is not blocking Petitioner's registration; therefore, Petitioner has no standing.

In support of his motion, Respondent submitted the declaration of his counsel, Robert E. Purcell, along with copies of Petitioner's responses to Respondent's interrogatories and requests for production of documents. In his brief, Respondent points out that in Petitioner's initial disclosures, he neither referred to any documents regarding his bona fide intent to use his mark, nor did Petitioner serve with his responses to Respondent's discovery any such documents. Additionally, in his counsel's declaration, Mr. Purcell attests that the only documents provided by Petitioner were (i) printouts from the TESS database for Petitioner's pending application, (ii) a printout of documents from Respondent's website (hollyshirt.com), (iii) a printout of documents from Respondent's registration file, and (iv) a three-page printout from WIPO with respect to Registration No. 1,284,337 owned by Petitioner for the trademark BLEED (7 TTABVUE 18-20).

In response to Respondent's motion, Petitioner submitted his declaration (12 TTABVUE),³ which referenced the following exhibits that accompanied

³ On the day after Petitioner filed his response and cross-motion to Respondent's summary judgment motion, Petitioner filed his "Motion for Leave to Include Declaration of Michael Spitzbarth in Opposition to Registrant's Motion for Summary Judgment" (12 TTABVUE), stating that the declaration of Mr. Spitzbarth had inadvertently not been attached to Petitioner's response even though the declaration was discussed in the response. Respondent did not oppose Petitioner's motion. In view thereof, the motion is **granted**. See Trademark Rule 2.127(a).

Petitioner's response to Respondent's motion: an undated printout from ICANN WHOIS regarding the web site www.bleed-clothing.com (Exh. A, 9 TTABVUE 11), printouts from Petitioner's English language website using the mark BLEED (9 TTABVUE 16-155), and invoices for Petitioner's sales of his goods in the United States (9 TTABVUE 157-161 (redacted); 10 TTABVUE 4-8 (confidential; not redacted)).

In Petitioner's cross-motion for partial summary judgment,⁴ to which Respondent did not respond,⁵ Petitioner refers to the evidence he submitted in connection with his response to Respondent's motion for partial summary judgment, and requests that the Board grant summary judgment on the issue of standing in his favor.

o *Legal Standard*

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any

⁴ Because Petitioner's response and cross-motion for partial summary judgment involve the same issue, Petitioner should have filed a single document comprising both the response and cross-motion. *Cf. Cooper Technologies Company v. Denier Electric Co., Inc.*, 89 USPQ2d 1478, 1479 (TTAB 2008) ("one cannot subvert the limit by filing both a brief in opposition and a separate brief in support of a cross-motion, when both address the same issue."); TBMP § 528.01 ("briefs in response or cross-motions for summary judgment on the same issue are limited to 25 pages"). Because Petitioner's response and cross-motion, together, do not exceed the 25-page limit, we will consider both submissions.

⁵ We exercise our discretion to consider Petitioner's cross-motion on its merits, rather than granting the motion as conceded. *See* Trademark Rule 2.127(a).

genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the opposition or cancellation. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542; *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) (“If there is a real dispute about a material fact or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial”); *see also Metro. Life Ins. Co. v. Bancorp Servs. LLC*, 527 F.3d 1330, 87 USPQ2d 1140, 1146 (Fed. Cir. 2008) (when resolving conflicting accounts requires ruling on the weight and credibility of the evidence, summary judgment not

available); *Lemelson v. TRW, Inc.*, 760 F.2d 1254, 225 USPQ 697, 701 (Fed. Cir. 1983) (court cannot engage in fact-finding on a motion for summary judgment).

The mere fact that cross-motions for summary judgment on a claim or defense have been filed does not necessarily mean that there is no genuine dispute as to a material fact, and that trial is unnecessary. *See Wright, Miller, Kane, et al.*, 10A FED. PRAC. & PROC. CIV. § 2720 (4th ed. April 2017 update). Each party has the initial burden of demonstrating the absence of any genuine disputes as to any material fact with respect to his own motion. *See Celotex Corp. v. Catrett*, 477 U.S. at 323; *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 4 USPQ2d at 1795-96; *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

Petitioner's pleaded application is based on his request for extension of protection under Section 66(a) of the Trademark Act.⁶ Such a request must be accompanied by a declaration alleging that the applicant has a bona fide intention to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation. 37 C.F.R. §§ 2.33(e)(1) and 2.34(a)(5); 15 U.S.C. §§ 1127, 1141(5), and 1141f(a). An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and "must

⁶ Application Serial No. 79181001.

reflect an intention to use the mark . . . ‘in the ordinary course of trade, . . . and not . . . merely to reserve a right in a mark.’” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 n.7 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. § 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)).

A determination of whether a party had a bona fide intention to use the mark in commerce when its application was filed is to be a fair, objective determination based on all the circumstances. *See Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1471 (TTAB 2013); *L’Oreal S.A. and L’Oreal USA, Inc. v. Robert Victor Marcon*, 102 USPQ2d 1434, 1443 (TTAB 2012); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). “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 the applicant, not solely by applicant’s uncorroborated testimony as to its subjective state of mind.” *SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 USPQ2d 1300, 1305 (TTAB 2010).

o *Decision*

Upon consideration of the parties’ arguments and evidence, and viewing the evidence in the light most favorable to the non-moving party and drawing all justifiable inferences in favor of the non-moving party, we find that there are genuine disputes of material fact with regard to Respondent’s defense

which preclude disposition of this issue by way of summary judgment. With respect to Respondent's motion, we find that Respondent has failed to establish the absence of a genuine dispute as to whether Petitioner had a bona fide intent to use his pleaded mark BLEED in commerce on the identified goods as of the filing date of his application. In this connection, we note that the factual question of intent is unsuited to disposition on summary judgment. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). We also find Petitioner's declaration regarding his manufacturing activities in Germany sufficient to raise a genuine dispute as to his bona fide intent to use the mark at the time his pleaded application was filed (12 TTABVUE 6). *See Swatch AG (Swatch SA) (Swatch Ltd.)*, 108 USPQ2d at 1477 (an applicant's capacity to market and/or manufacture the identified goods or services is evidence that weighs against a finding that an applicant lacked bona fide intent to use) (*aff'd M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015)). As to Petitioner's cross-motion, given that Respondent had no opportunity to conduct discovery on either Mr. Spitzbarth's statements set forth in his declaration or on the exhibits referenced therein, Petitioner's evidence does not demonstrate, beyond dispute, that he is entitled to judgment as a matter of law. In view of the foregoing, the parties' respective motions for partial summary judgment are **denied**.⁷

⁷ The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any

Proceeding Remains Suspended; Amendment to Answer Allowed

Respondent is allowed until **FIFTEEN DAYS** from the mailing date of this order to submit an amended answer which includes a sufficiently pleaded defense regarding Petitioner's bona fide intent to use his mark when he filed his pleaded application.

As noted in the suspension order mailed on October 19, 2017, under Trademark Rule 2.127(d), this proceeding was automatically suspended when Respondent filed his motion for reconsideration. In view thereof, the Board declined consideration of Petitioner's motion to compel filed August 24, 2017 (30 TTABVUE 2). However, the Board also stated that for judicial efficiency, Petitioner would not need to refile his motion to compel; rather, Respondent, who had not responded on the merits of the motion, would be allowed time to submit a new response to the motion (*Id.* note 2).

Accordingly, the proceeding remains SUSPENDED. *See* Trademark Rule 2.120(f)(2). Respondent is allowed until **TWENTY DAYS** from the mailing date of this order to file a response to the motion to compel; and Petitioner may file a reply thereto, should he wish to do so, in accordance with Trademark Rule 2.127(a). The parties should not file any paper that is not germane to the motion to compel.

such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). *See* TBMP § 528.05(a).

The parties may not serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of the motion to compel disclosure or discovery shall not toll the time for a party to comply with any initial disclosure requirement, or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If the motion to compel was filed after the close of discovery, the parties need not make pretrial disclosures until directed to do so by the Board. *See* Trademark Rule 2.120(f)(2); TBMP § 523.01.

The motion to compel will be decided in due course.

