

<p>This Opinion is Not a Precedent of the TTAB</p>
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Mailed: September 1, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Jason Green

v.

*Institut Allergosan Pharmazeutische Produkte
Forschungs- und Vertriebs GmbH*

Cancellation No. 92069600

Erik M. Pelton of Erik M. Pelton & Associates, PLLC for Jason Green.

Randolph E. Digges, III of Rankin, Hill & Clark LLP for Institut Allergosan
Pharmazeutische Produkte Forschungs- und Vertriebs GmbH.

Before Wellington, Larkin, and Hudis,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Institut Allergosan Pharmazeutische Produkte Forschungs- und Vertriebs GmbH
("Respondent" or "IAP") owns Registration No. 5243392 of the standard character
mark OMNI BIOTIC (BIOTIC disclaimed) for the following goods and services:

Cosmetics for use on the skin; cosmetic products relating to
health care, namely body lotions, shower gel, cuticle cream,
shampoo, conditioner, non-medicated lip balm, body polish,
body and foot scrub and non-medicated foot cream, baby

powder, baby shampoo, baby wipes, bath and shower gels and salts not for medical purposes, bath salts, not for medical purposes, body emulsions for cosmetic use, cleansing and polishing preparations, cosmetic preparations for bath, face and beauty creams, hair care preparations, hand cleaning preparations, non-medicated lip balm, lip glosses, shampoos, shaving gels, non-medicated skin-serum, skin cleansers, skin conditioners, skin creams, skin lotions, sun care lotions; bleaching preparations and other substances for laundry use; liquid soaps for hands, face and body, solid hand and body soaps; hair lotions; dentifrices, in International Class 3;

Food supplements, in particular antioxidants, adapted for medical use; dietetic preparations, namely, powder mix adapted for medical use and food supplements for medical use; dietetic preparations, namely powder mixes for the preparation of beverages for medical use; dietetic preparations for specific medical purposes or balanced diets, namely nutritional supplements, allergy relief medication, bacterial preparations for medical purposes, bacterial culture mediums, natural dietary supplements; food for babies in particular milk powder for babies, food supplements and dietetic nutritional supplements for sports and enhancing performance for medical purposes; mineral food supplements, starch for dietetic or pharmaceutical purposes; food supplements, mainly consisting of vitamins, amino acids, minerals and trace elements for medical purposes; herbal teas for medicinal purposes; pharmaceutical, veterinary and dietetic preparations, as well as preparations for health care, namely dietary supplements and dietary supplements for animals; infant formula; nutritive substances for microorganism cultures; vitamin preparations; medical preparations for weight losing purposes; appetite suppressants for medical purposes; bacterial preparations for medical and veterinary use; bacteriological preparations for medical and veterinary use; biological preparations for medical purposes for the treatment of constipation and intestine disorder; dietetic substances adapted for medical use; dietetic foods adapted for medical use; enzyme preparations for medical purposes; capsules for medical purposes for the treatment of constipation and intestine disorder; bouillons and nutritive substances for bacteriological cultures; digestives for pharmaceutical

purposes; pharmaceutical health care preparations and medicinal health care preparations for the treatment of constipation and intestine disorder, in International Class 5, and

Licensing of industrial or intellectual property rights and copyright, in International Class 45.¹

Jason Green (“Petitioner” or “Green”) seeks cancellation of Respondent’s registration, as to Class 5 only, on the grounds that (1) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), Petitioner claims that he is the prior user of the mark OMNIBIOTIC for dietary and nutritional supplements in the United States, and Respondent’s use of the OMNI BIOTIC mark in connection with the Class 5 goods identified in the registration is likely to cause confusion, to cause mistake, or to deceive, and (2) Respondent obtained its registration by fraud on the United States Patent and Trademark Office (“USPTO”), by falsely stating in the application that matured into the registration that Respondent had a bona fide intention to use the mark in commerce in connection with the identified goods and services.

The case is fully briefed.² We deny the Petition for Cancellation on both asserted grounds.

¹ Respondent’s registration issued on July 18, 2017 from Application Serial No. 79191487, filed on December 22, 2015 under Section 66 of the Trademark Act, 15 U.S.C. § 1141f, seeking extension of protection to the United States of International Registration No. 1308443 and claiming a priority filing date under the Madrid Protocol of July 2, 2015.

² Citations in this opinion to the briefs and other docket entries refer to TTABVUE, the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Petitioner’s main brief appears at 30 TTABVUE and his reply brief appears at 33 TTABVUE. Respondent’s brief appears at 31 TTABVUE. Respondent designated certain materials attached to its brief as Confidential under the Board’s Standard

I. Procedural History, Record, and Evidentiary Issues

A. Procedural History

Petitioner's Petition for Cancellation pleaded claims of likelihood of confusion, non-use, abandonment, and fraud. 1 TTABVUE 3-15. Respondent moved to dismiss the non-use and fraud claims, 7 TTABVUE, and the Board granted the motion as to the non-use claim, finding that Petitioner failed to state a claim upon which relief could be granted with respect to an application filed under Section 66(a) of the Trademark Act. 13 TTABVUE 6-8. Respondent then answered the Petition for Cancellation and denied its salient allegations. 14 TTABVUE 2-7.³

B. Record

The record consists of the pleadings, the file history of Respondent's registration, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Petitioner's Testimony Declaration of Jason Green ("Green Decl.") and Exhibits A-AE thereto (19 TTABVUE 2-133, 20 TTABVUE 1-54),⁴ Respondent's Testimony Declaration of Anita Frauwallner ("Frauwallner Decl.") and Exhibits 1-35 thereto (25 TTABVUE 2-121),⁵

Protective Order, and filed a non-public version of its brief with those materials attached at 32 TTABVUE. We discuss Respondent's confidentiality designations below.

³ Petitioner did not pursue its abandonment claim in its main brief. 30 TTABVUE 9 ("the OMNI BIOTIC Registration should be cancelled in part on grounds of fraud, based on a lack of bona fide intent to use the mark in commerce, or in the alternative due to a likelihood of confusion with Petitioner's OMNIBIOTICS mark"). Accordingly, the abandonment claim is deemed waived. *See, e.g., Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1029 n.4 (TTAB 2017).

⁴ We will cite the Green Declaration by paragraph and exhibit number (e.g., "Green Decl. ¶ 8; Ex. C") and, where helpful in following our discussion, by TTABVUE page number(s) as well.

⁵ We will cite the Frauwallner Declaration in the same manner as the Green Declaration. Multiple exhibits to the Frauwallner Declaration were designated as Confidential under the Board's Standard Protective Order and are redacted in the publicly available version of the

and Respondent's Notice of Reliance and Exhibits 36-48 thereto (27 TTABVUE 2-261).

C. Evidentiary Issues

Petitioner objects that "Respondent attempts to make of record documents that are entirely in German, with no English translation," 30 TTABVUE 10, and argues that "Applicant's evidence should be excluded or ignored." *Id.* The referenced documents are exhibits to the Frauwallner Declaration or to Respondent's Notice of Reliance.

In an Appendix to his brief, Petitioner argues that this evidence "is unusable and/or immaterial as it is almost entirely in German, not in English." *Id.* at 37 (citing TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") Section 104; *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731 (TTAB 2012); *Johnson & Johnson v. Obschestvo s Ogranitchennoy; Otvetstvennostiu "WDS"*, 95 USPQ2d 1567 (TTAB 2010)). Petitioner objects on this ground to four specific types of documents.

First, Petitioner objects to three invoices attached to the Frauwallner Declaration, *id.* (citing Frauwallner Decl. ¶¶ 18-19, 21, and 23; Exs. 13-14, 16-17),⁶ because

Declaration at 25 TTABVUE. The unredacted Declaration and exhibits were filed under seal at 26 TTABVUE.

⁶ Exhibit 14 is referenced in paragraph 19 of the Frauwallner Declaration, which discusses a sale to a customer in the United States in 2009. Exhibit 14 is not an invoice, however, but appears to be a duplicate of Exhibit 15, which Ms. Frauwallner described as the product packaging for the OMNI BIOTIC 6 product involved in the transaction discussed in paragraph 19, and a screenshot of the product. Frauwallner Decl. ¶ 20; Ex. 15. These materials are also in German and are attached to the publicly accessible Frauwallner Declaration. Frauwallner Decl. ¶¶ 19-20; Exs. 14-15 (25 TTABVUE 42-49).

“[t]hese business records are written entirely in German, with the quantity and type of sale being indeterminable,” and it “is unclear as to whether these invoices represent legitimate sales that could potentially establish trademark use.” *Id.* Petitioner argues that “[t]he invoices, one of which is missing from the record entirely,⁷ should therefore be given little to no probative value in the determination of use and/or priority.” *Id.*⁸

Second, Petitioner objects to “screenshots that supposedly demonstrate [Petitioner’s] website traffic.” *Id.* at 38 (citing Frauwallner Decl. ¶¶ 30-32; Exs. 21-23). Petitioner separately objects to this evidence on the ground that it is “irrelevant, in that it does not show purchases of the product; rather, it only shows passive visitors to the website.” *Id.*⁹

⁷ This appears to be a reference to Exhibit 14, which, as noted above, is not an invoice.

⁸ The three invoices were designated as Confidential and were filed under seal at 26 TTABVue. We are not bound by Respondent’s confidentiality designations. *See, e.g., Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475-76 (TTAB 2017). “[T]he Board must be able to discuss the record evidence in its opinions, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board’s decisions,” *id.* at 1475 (quoting *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016)), and we “may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.” Trademark Rule 2.116(g), 37 C.F.R. § 2.116(a). Respondent designated the three invoices as Confidential in their entirety even though, as discussed below, Ms. Frauwallner disclosed significant information contained in them in her publicly accessible testimony. Frauwallner Decl. ¶¶ 18, 21, 23. Given her testimony, the fact that any commercial sensitivity of the information on the invoices has dissipated considerably, if not disappeared entirely, in the many years since 2009 and 2014, and the significance of the invoices to our analysis of the priority issue, we will disregard Respondent’s confidentiality designations, and we will discuss the contents of the invoices to the extent necessary to explain the basis for our decision. As discussed below, however, we have taken steps in this opinion to protect the names and street addresses of the United States customers from additional disclosure.

⁹ We do not reach the relevance objection because we do not rely on the screenshots per se in reaching our decision.

Third, Petitioner objects to “examples of [Petitioner’s] advertisements and product packaging,” *id.*, specifically Frauwallner Decl. Exs. 14 and 15 discussed above, because “all of the words featured on these advertisements and packaging, including what appears to be nutritional information, are in German,” and “[t]his evidence is not probative in demonstrating Respondent’s use of the OMNI BIOTIC mark, as an English-speaking consumer would not be able to understand that the products are dietary supplements, how many to take, or what their purpose is.” *Id.*

Finally, Petitioner objects to screenshots from Respondent’s website because they are “solely in German and it is therefore indecipherable as to how to buy the product—it is unclear that there is a way to add it to an online cart or otherwise begin a purchase.” *Id.* (citing Respondent’s Notice of Reliance Exs. 42-43 (27 TTABVUE 245-48)).¹⁰

Respondent addresses Petitioner’s objections in Appendix A to Respondent’s brief, 31 TTABVUE 25-28, and also attaches to that Appendix “a certified English language translation of the three invoices in question” to “show that there is nothing in the German language in such invoices that would have any bearing on the issue of priority” and that “Petitioner’s objections are much ado about nothing.” *Id.*¹¹

With respect to the three invoices, Respondent argues that “the relevant information set forth in the invoices is translated into English” in the Frauwallner

¹⁰ The two referenced exhibits are not “solely in German,” as Petitioner claims, 31 TTABVUE 38, as Exhibit 42, a screenshot from archive.org captured on March 26, 2009, is in English. 27 TTABVUE 245-46.

¹¹ The English translations are attached to the Confidential (non-public) version of Respondent’s brief at 32 TTABVUE.

Declaration. *Id.* at 25. Respondent argues that she “identifies that they are invoices corroborating her testimony regarding specific sales,” *id.*, and “identifies, in English, who the purchasers were in each instance, what goods were sold and identifies the packaging bearing the OMNI BIOTIC mark in which they were sold, the address in the United States where the goods were shipped by Respondent, and the date of the sales.” *Id.* Respondent claims that “[t]here is no other information in the invoices that is relevant to the determination of priority.” *Id.*

Respondent also “point[s] out that copies of the three invoices in question (with the purchaser’s name and address redacted) and other invoices showing sales of OMNI BIOTIC goods classified in International Class 005 were voluntarily provided by IAP’s counsel to Petitioner’s counsel on August 17, 2019, nearly two months before discovery opened on October 14, 2019.” *Id.* Respondent relies on correspondence with Petitioner’s counsel that is attached to Respondent’s Appendix in the non-public version of its brief. Respondent also argues that “Petitioner could have had the invoices translated into English and brought this information to the attention of the Board if there was some relevant information relating to the issue of priority to glean from them.” *Id.* at 26. Respondent further argues that Petitioner should have filed a motion to strike the referenced exhibits to the Frauwallner Declaration, which Respondent claims “would have provided Respondent with an opportunity to cure the alleged procedural defect,” which Respondent “believes in this instance is procedural rather than substantive.” *Id.*

According to Respondent, the invoices “merely corroborate the testimony of [Ms.] Frauwallner[] that Respondent engaged in commerce using the OMNI BIOTIC mark long before an unidentified company formed in March of 2015 by Petitioner started using the OMNIBIOTICS mark for similar goods,” and “have been provided solely to corroborate that the sales in commerce that [Ms.] Frauwallner testified to in her Declaration did, in fact, occur.” *Id.* Respondent argues that “[i]t is not surprising that the invoices are in the German language inasmuch as Respondent is an Austrian company,” and that “there is nothing in the German language in the invoices on which Respondent's priority claims rely that was not already translated into English, as evidenced by the English translations accompanying this Response. Petitioner's objections, if not deemed to have been waived, should be overruled.” *Id.*

With respect to the website traffic screenshots, Respondent notes that it “has not referenced the website traffic in its Trial Brief,” and that Petitioner has admitted in any event that the screenshots “show thousands of passive visitors [from the United States] to Respondent’s website during the relevant period of time” *Id.* at 26-27.

Respondent argues that its advertising and product packaging have

been submitted to show the OMNI BIOTIC mark appeared on the product packaging. If there was any other information on the product packaging that was relevant to priority, Petitioner could have had it translated (or moved to strike it as noted above). But there is nothing to be gleaned from an English translation of the product packaging. It has been provided in its original form simply to show that the mark OMNI BIOTIC appeared on the product packaging of the goods sold by Respondent in commerce years before Petitioner started using a confusingly similar mark for virtually identical goods.

Id. at 27.

Finally, Respondent argues that the archived screen captures from its website “were not provided to show how consumers could buy a product or otherwise establish priority, but rather to show the appearance of Respondent's website as of the dates in question, which the Exhibits in question certainly do.” *Id.* Respondent concludes “that Petitioner’s objections are not timely, are not rational and should be overruled.” *Id.* at 28.¹²

In his reply brief, Petitioner argues that the English-language translations of the German-language invoices provided by Respondent with its brief are “suspicious” and “jarring” because “the September 16, 2014, invoice no longer contains the wording ‘sample delivery,’ which was originally noted in the initial, German invoice made of record in the Frauwallner Declaration,” 33 TTABVUE 11, and “[s]omehow Respondent’s translation conveniently left out the portion that read ‘sample delivery’ in the September 16, 2014 invoice.” *Id.* at 11-12. Respondent argues that this “exclusion is suspicious, self-serving, and calls into question the integrity of the other German invoices and evidence submitted by Respondent in the Frauwallner Declaration.” *Id.* at 12.

¹² Respondent argues that “if the evidence is excluded and the Petition for partial cancellation is granted, then Respondent will simply have to file an Opposition against Petitioner’s mark when it publishes and then introduce the same evidence plus the requested English language translations so that they can be considered by the Board,” and that “[s]uch an exercise seems inexpedient and unnecessary in view of the clear record of priority in this case.” 31 TTABVUE 28. Respondent is mistaken if it believes that it would simply be able to re-litigate the issue of priority and likelihood of confusion in a subsequent opposition if defects in its evidence in this cancellation resulted in the entry of judgment against it. *Cf. SynQor, Inc. v. Vicor Corp.*, 988 F.3d 1341, 2021 USPQ2d 208, at *12 (Fed. Cir. 2021) (“A losing party does not get a second bite at the apple simply because” it can present more persuasive evidence in a second proceeding; “this is precisely the type of rematch that collateral estoppel is intended to foreclose to serve the interests of repose and finality.”).

Petitioner also challenges the correspondence and enclosures attached to the non-public version of Respondent's brief, including what Petitioner describes as an October 3, 2014 invoice "that includes the wording 'sample delivery' for a total of 0.00 Euros." *Id.* Petitioner argues that the "fact that the wording 'sample delivery' appears in a couple of the invoices, not in others, and was conveniently deleted in the English translation invoice underscores the lack of overall validity of the other invoices, namely the 2009, 2011 (initially not in the record), and March 3, 2014 invoices." *Id.* Petitioner does not address Respondent's arguments regarding the German-language screenshots, advertising, and packaging.

Petitioner also argues that "the evidence attached to Respondent's trial brief is moot and should not be considered by the Board as the evidence was not properly made of record during the testimony period." *Id.* Petitioner concludes with following summary of his position:

To the extent that the Board does consider Respondent's additional evidence submitted in connection with Respondent's Trial Brief and not properly made of record, the Board should note the discrepancies in the language featured in the invoices, namely (1) the wording "sample delivery" appearing in the German copy of the September 14, 2016, invoice, but not in the English translation for the same invoice, and (2) the fact that the newly submitted October 3, 2014, invoice also contains the wording "sample delivery" and is for the sum of 0,00 Euros. If admitted, the evidence is not favorable for Respondent as it calls into question the content of the original invoices (i.e., whether any of the invoices demonstrate legitimate sales).

Id. at 12-13.

In ruling on Petitioner's objections, we must distinguish between two types of attachments to the non-public version of Respondent's brief: (1) the English-language

translations of the German-language invoices already in the record, 32 TTABVUE 30-36, and (2) an August 17, 2019 letter from Respondent's counsel to Petitioner's counsel, in which Respondent's counsel stated that he was enclosing "exemplary (and partially redacted) invoices evidencing sales of OMNI BIOTIC products in U.S. commerce prior to the filing date of your client's U.S. App. Serial No. 87/091,028," *id.* at 37, three of which invoices are not already in the record. *Id.* at 40, 43-44. We agree with Petitioner that the 2019 correspondence and the three additional invoices are untimely because they were not made of record during Respondent's trial period, and we **sustain** Petitioner's objection to them and have given them no consideration in our decision.

We **overrule** Petitioner's objections to the German-language materials attached to the Frauwallner Declaration and to Respondent's Notice of Reliance without an accompanying English-language translation for two reasons. First, we agree with Respondent that Petitioner's objections are untimely. "Objections to testimony or to a notice of reliance grounded in asserted procedural defects are waived unless raised promptly, when there is an opportunity to cure." *Philanthropist.com, Inc. v. Gen'l Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *1 (Appendix B) (TTAB 2021), *appeal docketed* (Fed. Cir. Aug. 5, 2021), (quoting *Barclays Cap. Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017)).

In *Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 (TTAB 2020), the opposer introduced sales records of its alleged predecessor-in-interest as exhibits to a testimony declaration to establish its priority. The applicant objected in its brief to

the admissibility of the records on the ground that the declarant had failed to lay a proper foundation for their introduction under the business records exception to the rule against hearsay. *Id.*, at *4. The Board held that this objection was procedural in nature and had been waived because it was not timely asserted in one of the ways in which an adverse party can object to testimony by declaration or affidavit. *Id.*, at *5-7. We find that Petitioner's objection to the absence of translations of the German-language exhibits to the Frauwallner Declaration and Respondent's Notice of Reliance is similarly a claimed procedural defect. If Petitioner had objected promptly to the inclusion of the German-language exhibits to the Frauwallner Declaration and Respondent's Notice of Reliance, Respondent could have cured that claimed deficiency by submitting translations of the sort that it submitted with its trial brief.¹³ Because Petitioner "did not promptly raise these objections by way of a motion to strike, they are **forfeited**." *Philanthropist.com*, 2021 USPQ2d 643, at *1 (Appendix B) (emphasis in original).

Second, although "[m]aterial in foreign languages which has not been translated into English has limited probative value," *Int'l Dairy Foods Ass'n v. Interprofession Du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *7 (TTAB 2020), *appeal docketed* (E.D. Va. Oct. 6, 2020), the failure to provide a translation of a document in a foreign language does not invariably require its exclusion. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE

¹³ Contrary to Respondent's argument, the burden is on the proponent of evidence in a foreign language to provide a translation, not on the recipient.

(“TBMP”) Section 104 (noting that “[i]f a translation is not filed, the submissions may not be considered.”). We find that it would be inappropriate to exclude the German-language invoices and packaging from the record even if Petitioner’s objections had been timely asserted, and translations had never been provided, because the failure to provide translations does not completely negate the probative value of the invoices and the packaging.

The invoices and packaging are not offered in isolation, but rather as documentary corroboration of Ms. Frauwallner’s testimony regarding specific transactions. Frauwallner Decl. ¶¶ 18-24; Exs. 13-19. She testified that a sale was made in April 2009 “under invoice number 2092883,” Frauwallner Decl. ¶ 18; Ex. 13, that a sale in March 2014 “is reflected in Invoice 326308 Exhibit 16,” Frauwallner Decl. ¶ 21; Ex. 16, and that a sale in September 2014 involved “Invoice 333396 Exhibit 18,” Frauwallner Decl. ¶ 23; Ex. 18,¹⁴ and she authenticated the pertinent packaging. Frauwallner Decl. ¶¶ 19-20, 22, 24; Exs. 15, 17, 19. It appears from her testimony that each buyer in the United States received the pertinent German-language invoice the purchase, without an English-language translation, as well as goods in the German-language packaging. Even if the purchaser could not read German, the relevant details of the purchase, including the name and address of the purchaser,

¹⁴ This invoice includes the English words “sample delivery” in the original German-language version. Petitioner makes much of the fact that the translation of this invoice does not include the words “sample delivery,” attributing a sinister motive to Respondent or its translator, but there is an equally plausible explanation for the omission. The translator’s self-described task was to translate “German into English,” 32 TTABVue 30, and in doing so, there was no need to translate words already appearing on the invoice in English. In any event, we have taken into account Respondent’s description of this shipment as a “sample delivery” in our analysis of the probative value of this invoice in connection with the accompanying testimony.

the date of the transaction, the OMNI BIOTIC good sold, the quantity sold, and the amount owed in Euros, are all discernable, either because they appear in English (“OMNI-BIOTIC 6,” Frauwallner Decl. ¶ 18; Ex. 13 (27 TTABVUE 41) and “OMNI-BIOTIC Stress Repair,” Frauwallner Decl. ¶¶ 21, 23; Exs. 17-18 (27 TTABVUE 51, 58)), or because they are self-evident from the invoice itself. Moreover, as noted by Respondent, Ms. Frauwallner testified in English about the relevant details of each transaction, including the date, the address of the purchaser, and the goods sold under the OMNI BIOTIC mark. As discussed below, priority can be established on the basis of oral testimony alone, and the rationale behind requiring a translation of foreign-language documents has relatively little force here, where the transactions that the German-language invoices reflect have been explained by a witness in English.

II. Entitlement to a Statutory Cause of Action¹⁵

A plaintiff’s entitlement to a statutory cause of action for opposition or cancellation is a threshold issue 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), *reh’ en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *petition for cert. filed*, (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*,

¹⁵ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act under the rubric of “standing,” and the parties here have done so as well. 30 TTABVUE 14 (arguing that “Petitioner Has Standing for its Request for Cancellation”); 31 TTABVUE 16 (stating that “Petitioner’s Standing is Not Contested”). Despite the change in nomenclature, the substance of the analysis of this issue in our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remains applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). Petitioner may seek cancellation of Respondent's registration if such cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1064, and Petitioner has a reasonable belief in damage that is proximately caused by the continued registration of Respondent's mark in International Class 5. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021).

As noted above, Respondent does not dispute Petitioner's "standing," and we find that Petitioner is entitled to a statutory cause of action because he proved his ownership of a pending application to register his claimed OMNIBIOTICS mark, Green Decl. ¶¶ 2, 12, and Respondent admitted in its brief that Petitioner's application "has been refused registration on grounds of a likelihood of confusion with Respondent's registered OMNI BIOTIC mark," 31 TTABVUE 16, and made of record a copy of the application file history containing the refusal. 27 TTABVUE 114-17. *Australian Therapeutic Supplies*, 2020 USPQ2d 10837, at *4 ("A petitioner may demonstrate a real interest and reasonable belief of damage where the petitioner has filed a trademark application that is refused registration based on a likelihood of confusion with the mark subject to cancellation.").

Because Petitioner has shown his entitlement to a statutory cause of action on his Section 2(d) claim, he "may assert any other grounds that would bar" the continued registration of Respondent's mark, including his fraud claim. *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *1 (TTAB 2020) (citing *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011)).

III. Petitioner's Section 2(d) Claim

A. Applicable Law

“Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), provides a ground for cancellation of a registration that has been on the Principal Register for fewer than five years on the basis of a petitioner's ownership of ‘a mark or trade name previously used in the United States . . . and not abandoned,’” *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018) (quoting *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (quoting 15 U.S.C. § 1052(d)), “and a likelihood of confusion.” *Id.* Respondent concedes that “there is a likelihood of confusion,” 31 TTABVue 17, because “the parties are using essentially the same mark for essentially identical goods in International Class 005,” *id.* at 16, and that “[t]his case is therefore, in essence, a priority dispute.” *Id.* at 17. Accordingly, the only issue on Petitioner's Section 2(d) claim is whether Petitioner established “proprietary rights in its pleaded common-law mark that precede [Respondent's] actual or constructive use of its involved mark.” *Exec. Coach Builders*, 123 USPQ2d at 1180; *see also Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981) (plaintiff must establish proprietary rights, either inherent in or by acquisition of secondary meaning in, pleaded common-law mark). Petitioner must overcome the presumption of validity of Respondent's registration and establish his priority by a preponderance of the evidence. *West Fla. Seafood, Inc., v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994).

B. Petitioner's Earliest Use of His Claimed Mark

Petitioner claims that he “has introduced evidence showing that since March of 2015, before Respondent’s application filing date, Petitioner has made sales of OMNIBIOTICS goods in commerce.” 30 TTABVUE 24 (citing Green Decl. ¶ 22; Ex. J).¹⁶ Mr. Green testified that he has “been the owner of Omnibiotics since its formation in March of 2015,” Green Decl. ¶ 3, and that “Omnibiotics has manufactured and sold dietary and nutritional supplements continuously and without interruption since March of 2015.” Green Decl. ¶ 6.¹⁷ Exhibit J to Mr. Green’s Declaration contains several invoices from “Omnibiotics” in Campbell, California, prepared by “Jason” and addressed to customers in the United States, the earliest of which bears a shipping date of March 31, 2015 to a customer named “Dhiren” in California. Green Decl. ¶ 22; Ex. J (19 TTABVUE 48).¹⁸ Respondent does not challenge the bona fides of these sales, and we find that Petitioner’s earliest use of the OMNIBIOTICS mark was on March 31, 2015.

¹⁶ Mr. Green testified that his application “stated a first use in commerce of March 2015.” Green Decl. ¶ 12.

¹⁷ Mr. Green did not specify the form of the “Omnibiotics” business, and Respondent argues that the “identity of the actual user of the OMNIBIOTICS mark is not clear from the record.” 31 TTABVUE 12. Respondent made of record evidence of the formation of a Wyoming limited liability company, with an address in Wyoming, called OmniBiotics LLC by Jason Green in August 2016, 27 TTABVUE 236-40, shortly after the filing of Petitioner’s application, and argues that there is no evidence of a transfer of the OMNIBIOTICS mark from Mr. Green to the limited liability company. 31 TTABVUE 13-14. We need not address the possible ownership issues, however, because Respondent argues that “even if those sales can be attributed to Green, based on the evidence of record, IAP clearly has priority based on its first use of the OMNI BIOTIC mark at common law” *Id.* at 18.

¹⁸ The last names and mailing addresses of the customers are redacted, and Petitioner did not file unredacted versions of the invoices.

C. Respondent's Earliest Use of the Registered Mark

“For priority purposes, a respondent may rely upon the filing date of the underlying application that matured into its involved registration.” *Kemi Organics*, 126 USPQ2d at 1604 (citing 15 U.S.C. § 1057(c); *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140-41 (TTAB 2013)). Respondent's July 2, 2015 convention priority date post-dates Petitioner's March 31, 2015 date of first use, so Respondent “has elected to rely on an earlier priority date based on its common law rights, which precede the July 2, 2015 filing/priority date of the Austrian base application for its International Registration.” 31 TTABVue 18.

To establish its common law rights, Respondent relies solely on the Frauwallner Declaration and accompanying exhibits. *Id.* at 8-12, 17-18. “[I]t is well-settled that the ‘oral testimony even of a single witness may be adequate to establish priority, but only if it is sufficiently probative.’” *Kemi Organics*, 126 USPQ2d at 1607 (quoting *Exec. Coach Builders*, 123 USPQ2d at 1184). “Such testimony ‘should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.’” *Id.* (quoting *Exec. Coach Builders*, 123 USPQ2d at 1184). “Oral testimony is, of course, always ‘strengthened by corroborating documentary evidence,’” *id.* at 1608 (quoting *Exec. Coach Builders*, 123 USPQ2d at 1184), but such corroboration is not required. *Id.* (citing *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011)). In evaluating Respondent's evidence of priority, we bear in mind the Federal Circuit's admonition to “look at the evidence as a whole, as if each piece of evidence

were part of a puzzle which, when fitted together, establishes prior use.” *West Fla. Seafood*, 31 USPQ2d at 1663.

1. Ms. Frauwallner’s Testimony and Exhibits

Respondent was formed in 2006 through a merger, Frauwallner Decl. ¶ 2, and Respondent and its predecessors have been in the business of developing and marketing probiotic food supplements since 1991. Frauwallner Decl. ¶ 3. Respondent and its predecessors have used the mark OMNI BIOTICS in connection with such products since 2004. Frauwallner Decl. ¶ 4. The goods are available in powder form, and are packaged in glass containers, plastic containers or individual sachets. Frauwallner Decl. ¶ 16.

Ms. Frauwallner testified that Respondent’s “first sale of OMNI BIOTIC branded food supplements in the U.S. occurred on August 27, 2009, when IAP shipped food supplement products, namely for OMNI BIOTIC 6, under invoice number 2092883 in packaging bearing the OMNIBIOTIC mark to [a customer] in Potomac, Maryland 20854 in response to an order placed by her **Exhibit 13**.” Frauwallner Decl. ¶ 18 (emphasis in original).¹⁹ We reproduce Exhibit 13 below:

¹⁹ Although Ms. Frauwallner testified about the name and street address of the customer in each of the pre-2015 transactions, we have elected in this opinion to identify the customers only by their city, state, and zip code, and we have redacted other information regarding the customer from the invoices displayed below.



Potomac, MD 20854

Seite 1 / 1

RECHNUNG
 Nummer 2092883
 Datum 27.08.2009 00:00
 Kundennummer 2036938
 Ihre UID-Nr.:
 Unsere UID-Nr.: ATU63000558
 Telefonnummer
 Sachbearbeiter
 Telefonnummer

ARTIKELBEZEICHNUNG	MENGE	EH	EINZELPREIS	UC	GESAMTPREIS
40222 OMNI - BIOTIC 6, 7 x 3 G Wochenpackung 43	3,00	Stk	12,36	2	37,08
90203 VERSANDKOSTEN Post bis 1 kg	1,00	Stk	11,84	1	11,84
NB-DIFFERENZ Netto/Brutto-Differenz	1,00	Stk	0,01	1	0,01
NETTOSUMME				EUR	48,93
USt Gesamt				EUR	6,08
GESAMTBETRAG				EUR	55,01

Zahlungsbedingung Zahlung binnen 10 Tagen ohne Abzug
 Ware bleibt bis zur vollständigen Bezahlung unser Eigentum. Verzugszinsen, Mahn- und Inkassospesen gehen bei Zahlungsverzug zu Lasten des Rechnungsempfängers.

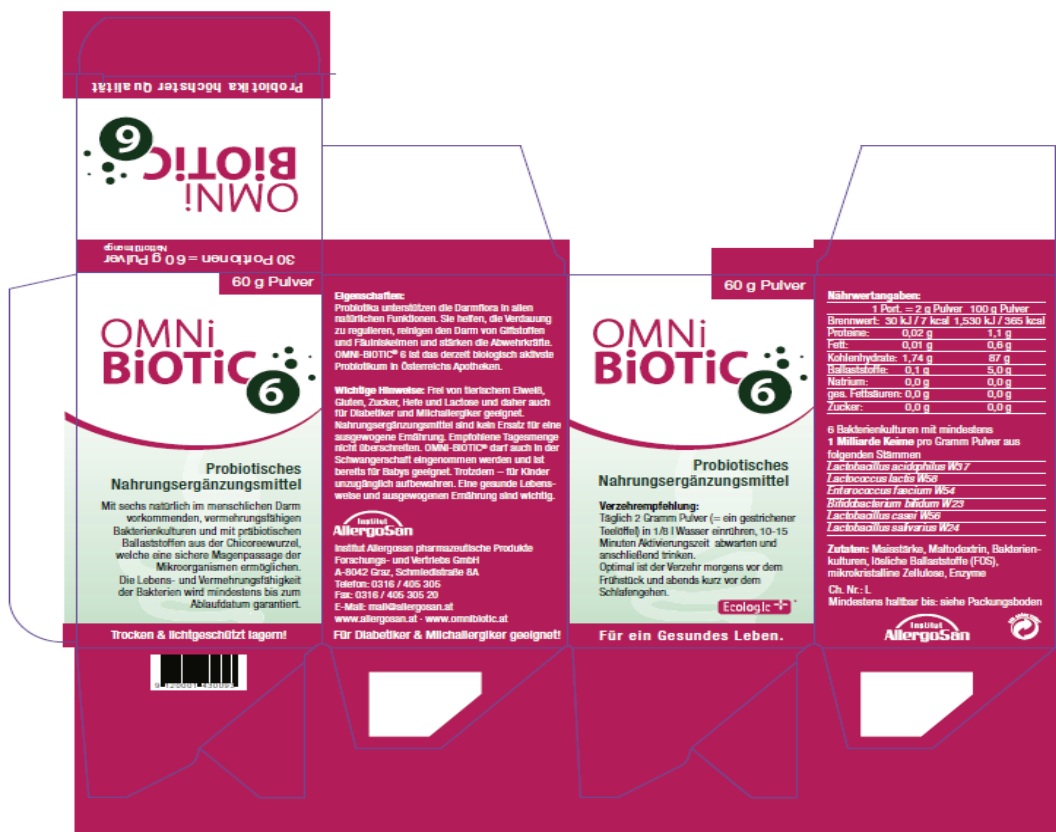
 Die gelieferten Produkte sind ausschließlichen für den Vertrieb im Zielland dieser Lieferung bestimmt. Die Verkehrsfähigkeit der Produkte in anderen Ländern als dem Bestimmungsland wird nicht gewährleistet

 Unser Handel mit Bioprodukten wird kontrolliert durch: AT-BIO-301

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 Tel. +43 (0)316 405 305 | Fax +43 (0)316 405 305 20 | info@allergosan.at | www.allergosan.net
 UID: ATU63000558 | FN285497z | Sitz Graz | Geschäftsführung: Mag. Anita Frauwallner
 Bankverbindung: Landes-Hypo Steiermark | BLZ 56000 | Konto Nr. 20541031368 | IBAN AT585600020541031368 | Swift-Code: HYSTAT2G

Ms. Frauwallner testified that “additional sales were made to other customers in the U.S. after this first sale.” Frauwallner Decl. ¶ 18. She gave as one example a shipment of “OMNI BIOTIC 6 and OMNI BIOTIC METABOLIC APFELPEKTIN on September 12, 2011, under invoice number 2112967 in packaging bearing the OMNI BIOTIC mark, to [a customer in] Santa Clara, California 95054 in response to an

order placed by her **Exhibit 14.**” Frauwallner Decl. ¶ 19 (emphasis in original).²⁰ She testified that the “product packaging used for the good OMNI BIOTIC 6, product item number 40001, sold on September 12, 2011, are [sic] provided in **Exhibit 15.**” Frauwallner Decl. ¶ 20 (emphasis in original).²¹ We reproduce Exhibit 15 below:



Ms. Frauwallner further testified that Respondent “also made several sales in 2014 of OMNI BIOTIC branded food supplement products in the U.S. before Petitioner even purchased his omnibiotics.me domain name.” Frauwallner Decl. ¶ 21.

²⁰ Ms. Frauwallner referenced Exhibit 14 in connection with this sale, but as discussed above, Exhibit 14 is not an invoice, but rather a duplicate of the packaging shown in Exhibit 15.

²¹ We understand Ms. Frauwallner’s testimony to be that the apparent mock-ups of the product packaging attached to her declaration accurately depict the packaging as it appeared at the time of the particular transactions.

She gave as an example that “on March 3, 2014 food supplement products, namely for OMNI BIOTIC Stress Repair, were sold and shipped to [a customer in] Philadelphia, Pennsylvania 19106, which is reflected in Invoice 326308 **Exhibit 16.**”

Frauwallner Decl. ¶ 21 (emphasis in original). We reproduce Exhibit 16 below:



19106 PA Philadelphia

Seite 1 / 1

RECHNUNG

Nummer	326308
Datum	03.03.2014 00:00
Kundennummer	2081248
Ihre UID-Nr.:	
Unsere UID-Nr.:	ATU63000558
Telefonnummer	
Sachbearbeiter	Sabine Macher
Telefonnummer	+43 (0) 316 405 305 - 23

ARTIKELBEZEICHNUNG	MENGE	EH	EINZELPREIS	GESAMTPREIS
Lieferscheinnummer 343685 Lieferdatum 03.03.2014				
40688 OMNI - BIOTIC STRESS REPAIR 28er 153	1,00	Stk	36,90	36,90
80071 PRIORITY Versand	1,00	Stk	18,50	18,50
GESAMTBETRAG inkl. USt.				EUR 55,40

beinhaltete USt.

(2) 10,00 % MWST (50,36)= 5,04

Zahlungsbedingung Vorauskassa

Ware bleibt bis zur vollständigen Bezahlung unser Eigentum. Verzugszinsen, Mahn- und Inkassospesen gehen bei Zahlungsverzug zu Lasten des Rechnungsempfängers.

Die gelieferten Produkte sind ausschließlichen für den Vertrieb im Zielland dieser Lieferung bestimmt. Die Verkehrsfähigkeit der Produkte in anderen Ländern als dem Bestimmungsland wird nicht gewährleistet

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Tel. +43 (0)316 405 305 | Fax +43 (0)316 405 305 29 | info@allergosan.at | www.allergosan.net
UID: ATU63000558 | FN285497z | Sitz Graz | Geschäftsführung: Mag. Anita Frauwallner
Bankverbindung: Landes-Hypo Steiermark | BLZ 56000 | Konto Nr. 20541031368 | IBAN AT585600020541031368 | Swift-Code: HYSTAT2G

Ms. Frauwallner further testified that “[a]n image showing the product packaging used for the OMNI BIOTIC STRESS REPAIR, product item number 40688, sold on March 3, 2014 sold and shipped in U.S. commerce to [the customer] is provided in

Exhibit 17.” Frauwallner Decl. ¶ 22 (emphasis in original). We reproduce Exhibit 17 below:²²



Deur goedkeuring van dit bestand accepteert u de specificaties vermeld in dit kader.		Deze gegevens en uw afname besteld worden gebruikt om uw order te produceren. LET OP!	
Artikelnummer klant:	60275	Truikleur:	zwart
Formaat:	125 x 70 x 95	Verpakkingskleur:	cyaan
Stanslijnen referentie:	5433Bn	Verpakkingskleur:	magenta
Materiaal:	Artika	Verpakkingskleur:	geel
Gewicht:	350	Datum:	
Versie nr. ruitje:	Coen	Proefnummer:	
Versie gebuikt:	Dispense	Datum:	
Braille:	Coen	Datum:	17-04-2014
Opmerkingen:			

De afname van deze proef is een goede indicatie. Bevestig de afname op het vermeld staat of de PMS-verstelt. Het is niet toegestaan de afname te gebruiken voor andere doeleinden. Het gebruik van deze afname is niet toegestaan.



²² As noted above, we understand these pictures to show how the packaging appeared at the time of the transaction.

Ms. Frauwallner testified that “[o]n September 16, 2014, more food supplement products, namely for OMNI BIOTIC Stress Repair, were sold and shipped to [a customer in] Sandy, Utah 84070, Invoice 333396 **Exhibit 18.**” Frauwallner Decl. ¶ 23 (emphasis in original). We reproduce Exhibit 18 below:



84070 Sandy, Utah

Seite 1 / 1

RECHNUNG
Nummer 333396
Datum 16.09.2014 00:00
Kundennummer 2093604
Ihre UID-Nr.:
Unsere UID-Nr.: ATU63000558
Telefonnummer
Sachbearbeiter Michaela Springer
Telefonnummer +43 (0) 316 405 305 - 14

sample delivery

ARTIKELBEZEICHNUNG	MENGE	EH	EINZELPREIS	GESAMTPREIS
Lieferscheinnummer 354629 Lieferdatum 16.09.2014				
Versandart GLS				
40688				
OMNI-BIOTIC Stress Repair, Sachets 28x3g	8,00	Stk	24,35	194,80
GESAMTBETRAG inkl. USt.				EUR 194,80

beinhaltete USt.
(2) 10,00 % MWSt (177,09)= 17,71

Zahlungsbedingung Zahlung binnen 10 Tagen ohne Abzug

Ware bleibt bis zur vollständigen Bezahlung unser Eigentum. Verzugszinsen, Mahn- und Inkassospesen gehen bei Zahlungsverzug zu Lasten des Rechnungsempfängers.

Zoll EORI Nr. EOS1000008151

Die gelieferten Produkte sind ausschließlichen für den Vertrieb im Zielland dieser Lieferung bestimmt. Die Verkehrsfähigkeit der Produkte in anderen Ländern als dem Bestimmungsland wird nicht gewährleistet

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UID: ATU63000558 | FN285497z | Sitz Graz | Geschäftsführung: Mag. Anita Frauwallner
Bankverbindung: Landes-Hypo Steiermark | BLZ 56000 | Konto Nr. 20541031368 | IBAN AT585600020541031368 | Swift-Code: HYSTAT2G

Ms. Frauwallner testified that the “product packaging used for the goods OMNI BIOTIC STRESS REPAIR, product item number 40688, sold on September 16, 2014 is shown in **Exhibit 19**.” Frauwallner Decl. ¶ 24 (emphasis in original).²³

Ms. Frauwallner testified that the “sales listed in paragraphs 18-24 above are only recited as representative samples of OMNI BIOTIC branded food supplement goods sold and shipped by IAP to customers in the U.S. In other words, these sales do not identify all of the sales of OMNI BIOTIC branded products sold in the U.S. prior to the priority date of the registration that the Petitioner is attempting to cancel.” Frauwallner Decl. ¶ 25. She further testified that “[s]ales of OMNI BIOTIC branded food supplement products by IAP continue in the U.S. to this date,” Frauwallner Decl. ¶ 27, that “[s]ales to U.S. customers have mostly [sic] made via orders placed to IAP’s websites, which are accessible worldwide including in the U.S., as well as through direct contacts from word-of-mouth advertising,” Frauwallner Decl. ¶ 29, and that on October 24, 2014, Respondent purchased the domain omnibiotics.us, “which since that time has and continues to be used to direct U.S. consumers to websites promoting IAP’s probiotic supplements.” Frauwallner Decl. ¶ 8, 8.1. She testified that over 4,000 people from the United States visited Respondent’s omnibiotic.com website between January 1, 2009 and December 31, 2016, Frauwallner Decl. ¶ 31, and she authenticated an English-language brochure regarding the OMNI BIOTIC Stress

²³ The packaging shown in Exhibit 19 appears to be substantially the same as, if not identical to, the packaging shown in Exhibit 17 and reproduced above

Repair product that she testified was first sent to customers in the United States in 2016. Frauwallner Decl. ¶ 28; Ex. 20.

2. The Parties' Arguments Regarding Ms. Frauwallner's Testimony

a. Petitioner

"No depositions were conducted by either side," 30 TTABVUE 12, and thus Petitioner did not cross-examine Ms. Frauwallner about the transactions discussed above. Instead, Petitioner all but concedes that all, or at least some, of the transactions occurred, but argues that they were insufficient to give Respondent prior rights. Petitioner argues generally that

Respondent's four invoices do not prove that Respondent's priority extends to any date prior to its Paris Convention priority date. Rather, Respondent's earliest priority date is the Paris Convention date of July 2, 2015. . . . The four invoices, without further context, documents, and information regarding the alleged sporadic sales to three different individuals and one entity, show nothing more than *de minimis* use of Respondent's OMNI BIOTIC mark. This *de minimis* use is not sufficient to establish an earlier priority date than that of July 2, 2015.

Id. at 25.

Petitioner further argues that

[e]ven if any of these alleged sales had occurred and were supported by documentary evidence, the singular alleged sales in 2009 and 2011, along with the two alleged sales in 2014, were sporadic, *de minimis*, and/or constitute token use, which is insufficient. A "mere token sale or shipment of the goods does not constitute 'use' under the Trademark Act."

Id.

Petitioner claims that “Respondent does not allege any fact or circumstance that would tend to establish that the sporadic shipments of products to four different alleged consumers over the course of six years demonstrates use in commerce,” *id.* at 26, and that the “evidence of record, therefore, reflects more of a preliminary outreach for general feedback on Respondent’s OMNI BIOTIC products, rather than bona fide use in commerce.” *Id.*

With respect to the August 27, 2009 transaction, Petitioner argues that “[a]t best, the 2009 sale is *de minimis* and/or sporadic, and therefore is no evidence that the product was marketed or available to consumers in the United States in 2009, generally.” *Id.* at 27. Petitioner similarly argues that “[a]t best, the alleged September 12, 2011, sale is *de minimis* and/or sporadic, and there is no evidence that the OMNI BIOTIC product was promoted or available to consumers in the United States at the time.” *Id.* at 28.

With respect to the March 3, 2014 transaction, Petitioner argues that the accompanying invoice contains the English wording “‘sample delivery,’ which indicates that the sale may have just been a sample of the product to the consumer and not a legitimate sale,” and that it “is well-established that giveaways do not constitute bona fide use of a mark.” *Id.* Petitioner argues that there “is no evidence that . . . the recipient of the ‘sample delivery,’ ever purchased an OMNI BIOTIC product,” *id.* at 29, and that the “distribution or offer of free samples does not establish that the product was available for sale and does not support bona fide use of a mark, and therefore cannot give a party prior use rights of a mark.” *Id.* at 28.

With respect to the other transaction in 2014, Petitioner acknowledges that it “does appear (based on the English wording on the invoice) as a bona fide sale,” *id.* at 29, but that “[a]t best, the two 2014 sales are *de minimis* and/or sporadic, and there is no evidence that Respondent’s food supplement products were marketed or available to consumers in the United States at that time.” *Id.*

In the portion of his main brief discussing his fraud claim, Petitioner argues that Respondent’s website at the time of the alleged transactions did not display the referenced goods or permit United States consumers to order them online, and that there is insufficient information from the screenshots to determine whether the OMNI BIOTIC products were offered to consumers in the United States. *Id.* at 19-20.

In his reply brief, Petitioner complains that Respondent’s invoices regarding the transactions were made of record “without any context as to how such sales were even made to the alleged customers.” 33 TTABVue 6. Petitioner also argues that “there is a huge gap in sales between the corresponding invoices included in the Frauwallner Declaration – approximately two years between the 2009 invoice and the 2011 invoice and about three years between the 2011 invoice and the two 2014 invoices,” *id.* at 7, and that Petitioner’s focus is “not regarding the *quantity* of the invoices produced, but rather relates to the *legitimacy* and *gaps in sales* inherently evident from the dates of sales and content (or lack thereof) of the invoices.” *Id.* (emphasis in original). According to Petitioner, “[t]he absence of any sales between 2009 and 2011, and again between 2011 and 2014, signify that Respondent’s sales were sporadic and *de minimis*” *id.*, and the “invoices submitted by Respondent, therefore, lack any

supporting documentation that caters to a narrative that Respondent did in fact advertise, market, and sell OMNI BIOTIC branded products to consumers in the United States during the corresponding dates of the invoices.” *Id.* at 8.

Petitioner also argues in his reply brief that

It is also telling that Respondent filed the underlying application on December 22, 2015, asserting a basis under Section 66(a) and priority regarding its July 2, 2015, trademark application filing date in Austria. Respondent did not assert use in commerce as an additional or alternative basis to its application filing, even though Respondent now claims that the mark had been used in commerce in the United States for several years prior to the United States trademark filing.

Id. at 10.

b. Respondent

Respondent argues that

There is competent evidence of record showing that IAP made its first sale of supplement goods classified in International Class 005 bearing its registered OMNI BIOTIC mark in the United States on August 29, 2009. The evidence further shows that additional sales of such goods were made in the United States at intervals of less than three years in length (specifically on September 12, 2011, March 3, 2014, and September 16, 2014) leading up to the July 2, 2015 constructive use date, and that sales have continued to be made in the U.S. since that time.

31 TTABVUE 18 (emphasis in original).

Respondent further argues that Petitioner

admits in its [sic] Trial Brief that there is evidence of record that IAP made sales of food supplement goods in the U.S. bearing the OMNI BIOTIC mark beginning in 2009, and that IAP entered copies of invoices for such sales from 2009 and 2014 (the invoice for the sale referenced in 2011 was inadvertently omitted from the Frauwallner Declaration

by IAP's counsel of record) into the record. But Green attempts to dismiss these sales as “sporadic” and “de minimis” at various points in his Trial Brief. This is incorrect as a matter of law.

Id. at 21. Respondent claims that it “has provided competent evidence that it made sales of food supplement goods classified in International Class 005 bearing the OMNI BIOTIC from Austria to customers in Maryland in 2009, California in 2011, Pennsylvania in 2014 and in Utah in 2014,” and that this “is evidence of actual use of the OMNI BIOTIC mark by IAP in commerce, and Green’s attempt to dismiss such sales on grounds that they are sporadic or de minimis is contrary to law.” *Id.* at 22. Respondent also notes in that regard that Petitioner’s own claimed priority “relies on testimony from Green corroborated by copies of five representative invoices.” *Id.*

3. Analysis of Ms. Frauwallner’s Testimony

In *Kemi Organics*, the Board found that the petitioner had established priority even though the testimony affidavit of its President and founder was “far from being a model of clarity or completeness,” and his testimony was “not accompanied by the type or quantity of documentary evidence that one would expect to be readily available to show the use of a mark” that the petitioner claimed to have become famous before the respondent commenced use of, or filed an application to register, his mark. *Kemi Organics*, 126 USPQ2d at 1608. Ms. Frauwallner’s testimony does not suffer from such flaws. She identified four specific transactions between Respondent and persons in the United States that occurred in 2009, 2011, and 2014, and her testimony is corroborated by corresponding invoices bearing the OMNI BIOTIC mark, or examples of the packaging for the involved goods bearing the OMNI

BIOTIC mark, or both. She explained that these transactions are “representative samples of OMNI BIOTIC branded food supplement goods sold and shipped by IAP to customers in the U.S.,” that these specific “sales do not identify all of the sales of OMNI BIOTIC branded products sold in the U.S. prior to the priority date of the registration that the Petitioner is attempting to cancel,” Frauwallner Decl. ¶ 25, and that “[s]ales of OMNI BIOTIC branded food supplement products by IAP continue in the U.S. to this date.” Frauwallner Decl. ¶ 27.

“[I]n the absence of any contrary testimony from a discovery deposition of [Ms. Frauwallner], any contrary fruits of discovery [or] any documentary evidence establishing non-use of the [OMNI BIOTIC] mark or impeaching the [Frauwallner] testimony,” her testimony “stands un rebutted.” *Kemi Organics*, 126 USPQ2d at 1609. We find that Ms. Frauwallner’s testimony regarding Respondent’s sales of goods bearing the OMNI BIOTIC mark to purchasers in the United States prior to March 31, 2015 is not “characterized by contradictions, inconsistencies, and indefiniteness,” *id.* at 1607 (quoting *Exec. Coach Builders*, 123 USPQ2d at 1184), but rather “carr[ies] with it conviction of its accuracy and applicability.” *Id.* (quoting *Exec. Coach Builders*, 123 USPQ2d at 1184). As noted above, Petitioner essentially concedes as much and argues instead that these sales did not give Respondent prior rights. Petitioner’s arguments to that end are all unavailing.

Petitioner argues repeatedly that Respondent did not make “use in commerce” through its sales to customers in the United States in 2009, 2011, and 2014. *See, e.g.*, 31 TTABVUE 26 (“Respondent does not allege any fact or circumstance that would

tend to establish that the sporadic shipments of products to four different alleged consumers over the course of six years demonstrates use in commerce.”); 33 TTABVUE 8 (“[T]he lack of evidence in the record corroborating, explaining, connecting, or detailing the *four* invoices in the Frauwallner Declaration suggest [sic] that Respondent’s alleged sales do not demonstrate bona fide use in commerce sufficient to establish priority in the United States.”) (emphasis in original). “Use in commerce prior to registration is not required for registrations issued pursuant to Trademark Act Section 66(a),” *Wirecard AG v. Striaturn Ventures B.V.*, 2020 USPQ2d 10086, at *3 (TTAB 2020) and, more importantly, it is not required to prove priority. *See First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Grp., Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (citing *Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.4 (Fed. Cir. 1991)).²⁴ It is possible, of course, that Respondent’s sales to the United States qualified as use in commerce, but Respondent can show priority even if those sales did not involve “use in commerce” sufficient to support a use-based application for registration.²⁵

²⁴ Respondent also mistakenly addresses whether it made use in commerce. *See, e.g.*, 31 TTABVUE 22 (Respondent’s evidence regarding sales to Americans “is evidence of actual use of the OMNI BIOTIC mark by IAP in commerce.”). Even though both parties mistakenly discuss use in commerce, we will apply the correct test for proof of priority, following the approach of the Federal Circuit in *First Niagara*, where both parties discussed use in commerce, but the court “believe[d] it would be imprudent to render a decision predicated upon a hypothetical reading of Section 2(d), *i.e.*, as if it requires ‘use in commerce’ instead of ‘use in the United States.’” *First Niagara*, 81 USPQ2d at 1378.

²⁵ As discussed above, Petitioner finds significance in the fact that Respondent did not claim use in commerce as a filing basis for the application that matured into its registration. 33 TTABVUE 10. We do not. It is perfectly understandable why Respondent would seek registration under Section 66 because doing so gave Respondent a path to securing a registration extending the protection of its International Registration without having to allege or prove use in commerce. *See Wirecard AG*, 2020 USPQ2d 10086, at *3.

Petitioner's argument that Respondent's 2009, 2011, and 2014 sales are *de minimis* similarly misses the mark. Petitioner cites *Connors v. Perfect Partners, Inc.*, Canc. No. 92043707, 2007 WL 1620078, *3 (TTAB June 1, 2007), for the proposition that a "mere token sale or shipment of the goods does not constitute 'use' under the Trademark Act." 30 TTABVUE 25. *Connors* is a non-precedential decision that does not bind us, *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *3 n.23 (TTAB 2020), but it is distinguishable in any event and actually undercuts Petitioner's argument.

The issue in *Connors* was not priority, but rather whether the "respondent's use was sufficient to support a registration." 39 TTABVUE 4 (Canc. No. 92043707).²⁶ The Board found that the respondent's sale "of a single bottle of vodka [] clearly is not sufficient technical trademark use to support a registration." *Id.* at 5-6. The Board noted, however, that the respondent's "list of sporadic activities after the January 29, 2000 'sale' are more in the nature of evidence to support analogous use in a priority battle, which is not relevant here inasmuch as no such claim is at issue," *id.* at 6, and that "[w]hile use analogous to trademark use is sufficient to establish priority rights against subsequent users of a mark, it is not sufficient to establish use as a basis for an application to register." *Id.* Here, unlike in *Connors*, the issue is priority, not whether Respondent's sales would support the issuance of a use-based registration.

Petitioner also argues that Respondent's September 16, 2014 transaction with the customer in Utah, which was described on the accompanying invoice as a "sample

²⁶ We cite to the Board's decision in the TTABVUE docket for the case for the benefit of readers who do not have access to the Westlaw database.

delivery,” Frauwallner Decl. ¶ 24; Ex. 19, created no rights because “[i]t is well-established that giveaways do not constitute bona fide use of a mark,” 30 TTABVUE 28, and the “distribution or offer of free samples does not establish that the product was available for sale and does not support bona fide use of a mark, and therefore cannot give a party prior use rights of a mark.” *Id.* In support of these arguments, Petitioner cites *Jaffe v. Simon & Schuster Inc.*, 3 USPQ2d 1047 (S.D.N.Y. 1987), *Times Mirror Mags., Inc. v. Sutcliffe*, 205 USPQ 656 (TTAB 1979), *Future Domain Corp. v. Trantor Sys., Ltd.*, 27 USPQ2d 1289 (N.D. Cal. 1993), and *Duffy v. Charles Schwab & Co.*, 54 USPQ2d 1820 (D.N.J. 2000). These cases are inapposite.

The September 16, 2014 transaction does not appear to be what Petitioner describes as a “giveaway,” 30 TTABVUE 28, because the accompanying invoice expresses a total price in Euros, and the invoice does not describe the delivery as involving a “free” sample. Frauwallner Decl. ¶ 24; Ex. 19. But even if it were a “giveaway,” it could serve as one piece in the “puzzle which, when fitted together, establishes prior use,” *West Fla. Seafood*, 31 USPQ2d at 1663, because, as the Board recently reiterated, the trademark “statute does not require that goods or services be sold for purposes of establishing priority,” and “priority can be shown for marks for goods given away as promotional items . . . and for goods given away as part of educational outreach efforts.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *10 (TTAB 2020) (citing *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1298 n.3 (TTAB 2010); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996); *Tiberghien Freres S.A. v. Miguel*

Gil, S.A., 185 USPQ 183, 184 (TTAB 1974); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 n.6 (TTAB 1989)).

The several cases cited by Petitioner do not trump *DeVivo* and the earlier Board cases that it cites. Three of Petitioner's four cases are federal district court cases. We give such cases respectful consideration, but they do not bind us, and we must reject their analysis to the extent that it conflicts with that in our own precedents or those of the Federal Circuit. The three district court cases are distinguishable in any event.

Jaffe did not involve "giveaways," but rather found that the plaintiffs' "early transactions consist[ing] solely of nominal or token sales to personal friends and relatives" did not give it priority because "[f]ederal trademark laws are not invoked by a small, isolated shipment of goods between business associates" or "early sales to friends and relatives" *Jaffe*, 3 USPQ2d at 1049. There is no evidence that the 2014 sale, or any other pre-2015 sale discussed by Ms. Frauwallner, was to one of her business associates, friends, or relatives.

In *Future Domain*, the court found that the plaintiff's distribution of 200 free samples in connection with the COMDEX trade show, coupled with other activities, was insufficient to show prior analogous use under the Ninth Circuit's decision in *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 202 USPQ 643 (9th Cir. 1979). *Future Domain*, 27 USPQ2d at 1294-96. The issue here is not analogous use, but even if it were, we would not apply Ninth Circuit law in deciding that issue.

Finally, *Duffy* held that the "distribution of samples to a few companies without more does not constitute a sufficient bona fide use in commerce," *Duffy*, 54 USPQ2d

at 1824, but as discussed above, the issue here under Federal Circuit priority law is whether Respondent made prior use “in the United States,” not whether Respondent made prior “use in commerce.”

Like *Connors*, the lone Board case cited by Petitioner, *Times Mirror Mags.*, addressed the issue of “whether applicant’s use of the mark ‘OUTDOOR SPORT’ was sufficient to support the subject application.” *Times Mirror Mags.*, 205 USPQ at 662. The Board found that “there was no trade under the mark ‘OUTDOOR SPORT’ at the time of the filing of the subject application” because the applicant admitted that goods bearing the mark did not then exist. *Id.* at 663. The testimonial and documentary evidence here shows that the products bearing the OMNI BIOTIC mark existed when sales were made to purchasers in the United States.²⁷

At most, there is a question as to whether one of the shipments of goods to consumers in the United States made by Respondent involved a free sample, but our

²⁷ Petitioner also cites *Hydro-Dynamics* and *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033 (TTAB 1981), 30 TTABVUE 26, in support of its arguments that Respondent’s sales did not create rights. These decisions are also distinguishable. As Petitioner itself notes, *Hydro-Dynamics* “held that sending a box of samples to obtain the opinion of an independent distributor did not qualify as use in commerce, even though the distributor sold the samples to customers, because the purpose of the shipment was ‘advisory consultation on the merits of a proposed trademark.’” 30 TTABVUE 26 (quoting *Hydro-Dynamics*, 1 USPQ2d at 1774). There is no evidence here that any of the sales discussed by Ms. Frauwallner were for the purpose of obtaining “advisory consultation” on the use of OMNI BIOTICS as a “proposed trademark,” and, as discussed above, use in commerce is not required to establish priority. *Smith Int’l* similarly found that a shipment of a prototype of a tool, which was admittedly “not a commercially feasible product,” from an inventor to a manufacturer, rather than to “a purchaser or prospective purchaser,” and for purposes of “testing and experimentation,” did not create prior trademark rights where the product was not commercialized for another six years. *Smith Int’l*, 209 USPQ at 1046. There is no evidence here that the goods sold by Respondent were prototypes or that they were sold for purposes of testing or experimentation.

precedents make clear that the distribution of free samples can establish priority in an inter partes case.

Petitioner also argues that Respondent's "sporadic shipments of products to four different alleged consumers over the course of six years" do not show prior use. 30 TTABVUE 26. In his reply brief, Petitioner argues that his discussion regarding Respondent's invoices "relates to the legitimacy and gaps in sales inherently evident from the dates of sales and content (or lack thereof) of the invoices." 33 TTABVUE 7. Petitioner quotes from *Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043 (TTAB 2017), in which the Board held that "[t]he absence of any sales whatsoever under the mark for more than 2 years following [the respondent's] sample-related activities underscores their preliminary nature." 33 TTABVUE 7 (quoting *Tao Licensing*, 125 USPQ2d at 1055). *Tao Licensing* does not aid Petitioner because the language quoted by Petitioner appears in the section of the Board's opinion discussing whether the applicant had made use in commerce when it filed its statement of use in support of its use-based application. *Tao Licensing*, 125 USPQ2d at 1051-55.

As noted above, Ms. Frauwallner testified that the specific sales referenced in her declaration were only "representative samples of OMNI BIOTIC branded food supplement goods sold and shipped by IAP to customers in the U.S." and "do not identify all of the sales of OMNI BIOTIC branded products sold in the U.S. prior to the priority date of the registration that Petitioner is attempting to cancel," Frauwallner Decl. ¶ 25, but even "sporadic" sales may be sufficient to support a

finding of priority because Respondent “is only required to show ‘proprietary rights in its [OMNI BIOTIC] mark that precede [Petitioner’s] actual or constructive use of [his] involved mark.” *Kemi Organics*, 126 USPQ2d at 1607 (quoting *Exec. Coach Builders*, 123 USPQ2d at 1180). For purposes of priority, “Section 2(d) ‘does not speak of ‘continuous use,’ but rather of whether the mark or trade name has been ‘previously used in the United States by another and not abandoned.’” *Id.* (quoting *West Fla. Seafood*, 31 USPQ2d at 1665 (holding that Board erred in finding that the petitioner failed to prove priority under Section 2(d) because the petitioner did not prove use during the period prior to the filing of its petition for cancellation and thereafter, where the petitioner proved use prior to the filing date of the application that matured into the subject registration)).

“[L]ooking at the evidence as a whole, as if each piece of evidence were a part of a puzzle [to be] fitted together,” *id.* at 1609 (quoting *West Fla. Seafood*, 31 USPQ2d at 1663), we find that Petitioner did not show, by a preponderance of the evidence, that he used the OMNIBIOTICS mark prior to Respondent’s first use of its OMNI BIOTIC mark in the United States in 2009, 2011, and 2014. “Prior use is a necessary element of any claim of likelihood of confusion under Section 2(d) of the Trademark Act [and] without proof of priority, [Petitioner] cannot prevail.” *Moke*, 2020 USPQ2d 10400, at *9-10. Accordingly, Petitioner’s Section 2(d) claim is dismissed.

IV. Petitioner’s Fraud Claim

As noted above, Petitioner’s fraud claim survived Respondent’s motion to dismiss, 13 TTABVUE 8-10, and Petitioner pursued it in his main brief. 30 TTABVUE 16-22.

“Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled.” *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *19 (TTAB 2021) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila A.C.*, 121 USPQ2d 1477, 1501 (TTAB 2017) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009)). “A party alleging fraud in the procurement of a registration bears the heavy burden of proving fraud with clear and convincing evidence.” *Id.* “There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Id.* (quoting *Bose*, 91 USPQ2d at 1939).

To show fraud, Petitioner must prove that (1) Respondent made a false representation to the USPTO, (2) the false representation was material to the registrability of the mark, (3) Respondent had knowledge of the falsity of the representation, and (4) Respondent made the representation with intent to deceive the USPTO. *40-0*, 2021 USPQ2d 253, at *20. “[S]ubjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis,” *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361, 1375 (TTAB 2014) (quoting *Bose*, 91 USPQ2d at 1941), and “[a]bsent proof of the requisite intent to mislead the PTO, ‘even a material misrepresentation would not qualify as fraud under the Lanham Act.’” *40-0*, 2021 USPQ2d 253, at *24 (quoting *Bose*, 91 USPQ2d at 1940). “The standard for finding intent to deceive is stricter than the standard for negligence or gross negligence, and evidence of deceptive intent must be clear and convincing.” *Id.*, at

*21 (quoting *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *27 (TTAB 2019)).

As pleaded, and as argued in his main brief, Petitioner’s fraud claim is that Respondent’s registration is void because Respondent did not have a bona fide intent to use the OMNI BIOTIC mark when it filed the application that matured into its registration, and that Respondent “therefore committed fraud on the USPTO.” 30 TTABVUE 16. Petitioner spends multiple pages arguing that Respondent lacked a bona fide intention to use the OMNI BIOTIC mark in commerce, citing multiple Board cases on that issue and arguing that Respondent had no such bona fide intention because it has made of record no “documentary evidence to show any intention of [sic] plans for using its mark in the United States at the time of filing the OMNI BIOTIC mark.” *Id.* at 18.²⁸ Petitioner focuses on portions of the Frauwallner Declaration that discuss Respondent’s multiple foreign registrations of the mark, its domain name registrations, and its website, *id.* at 18-19, and argues that

[u]nder the circumstances of this case, and considering the totality of evidence, Respondent’s activities were not adequately contemporaneous with the filing of its application, and not extensive or focused enough to show that Respondent had an actual bona fide intent to use the OMNI BIOTIC mark in the United States in 2015 when its application was filed. . . . Respondent has not submitted any evidence of sales into the record after its 2015 application filing date [and] there does not appear [sic] any documentary evidence that U.S. consumers were able to purchase OMNI BIOTIC products. Petitioner, therefore,

²⁸ An applicant for extension of protection of an International Registration under Section 66 “must declare its intention to use the mark in the United States. . . .” *Wirecard AG*, 2020 USPQ2d 10086, at *3 n.7 (quoting *Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012)).

has met his burden of establishing that Respondent did not have a bona fide intent to use the OMNI BIOTIC mark in commerce by proving that there is an absence of any documentary evidence on the part of [Respondent] regarding such intent.

Id. at 21-22 (quotation omitted).

We need not decide whether Petitioner proved that Respondent lacked a bona fide intention to use the OMNI BIOTIC mark in commerce when it filed its application because that is not the claim before us. Petitioner has asserted a fraud claim, and even if Respondent materially misrepresented to the USPTO that it had a bona fide intention to use the mark in commerce, Petitioner must show that the false representation was made with a “knowing intent to deceive.” 40-0, 2021 USPQ2d 253, at *21. Petitioner makes no effort to do so, instead arguing that “the submitted OMNI BIOTIC application contained knowingly false material representations of fact with the intent to deceive the USPTO regarding use of food supplement products in International Class 5, and therefore constitutes fraud.” 30 TTABVue 22. Petitioner essentially assumes the existence of a “knowing intent to deceive” from the fact that a misrepresentation was made.

Ms. Frauwallner testified that “[s]ince at least as early as 2009, IAP has steadfastly intended to use the OMNI BIOTIC mark in U.S. commerce in connection with the goods identified in the registration under attack in this proceeding,” Frauwallner Decl. ¶ 26, and that Respondent “has in fact actually used the OMNI BIOTIC mark in U.S. commerce in connection with food supplement products during that time.” Frauwallner Decl. ¶ 26. Petitioner did not cross-examine Ms. Frauwallner or otherwise impeach her testimony, and the “record reveals no meaningful inquiry

into the state of mind of any person who signed [the] application . . . relating to the challenged registration,” and “[n]o showing of a subjective intent to deceive (an essential elements of a fraud claim) arises from this record.” *40-0*, 2021 USPQ2d 253, at *23 (quoting *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1432 n.69 (TTAB 2014)). *Cf. Nationstar Mortg.*, 112 USPQ2d at 1374 (finding that the applicant’s false representations regarding his use of the NATIONSTAR mark in connection with all of the services identified in his use-based application “were made knowingly and with the intent to deceive the PTO” based on the “manifest lack of credibility of applicant’s testimony”). “Absent proof of the requisite intent to mislead the PTO, ‘even a material misrepresentation would not qualify as fraud under the Lanham Act,’” *40-0*, 2021 USPQ2d 253, at *24 (quoting *Bose*, 91 USPQ2d at 1940), and Petitioner’s “fraud claim fails and is dismissed.” *Id.*

Decision: The Petition for Cancellation is denied on both grounds asserted by Petitioner.