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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92070823
Party	Plaintiff ICware Systems, Inc. dba BatchTest Corporation and BatchTest Corporation
Correspondence Address	DINESH PATEL BATCATEST CORPORATION 2118 WALSH AVE SUITE 240 SANTA CLARA, CA 95050 UNITED STATES Primary Email: BatchTest_TM@batchtest.com Secondary Email(s): btcroot@gmail.com 408-454-8378
Submission	Reply in Support of Motion
Filer's Name	Dinesh Patel
Filer's email	batchtest_tm@batchtest.com
Signature	/Dinesh Patel/
Date	08/16/2021
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ICware Systems, Inc. dba BatchTest Corporation and BatchTest Corporation)	Cancellation No.:	92070823
)		
Petitioner,)	Registration No.:	4499170
)		
v.)	Mark:	BATCHTEST
)		
Ikonix USA LLC)	International Class:	9
Registrant.)		

PETITIONER'S REPLY IN SUPPORT OF MOTION FOR LEAVE TO AMEND

PLEADINGS AND FOR SUMMARY JUDGMENT

BatchTest Corporation (“Petitioner”) respectfully submits this Reply in support of its MOTION FOR LEAVE TO AMEND PLEADINGS AND FOR SUMMARY JUDGMENT (the “Motion”). Ikonix USA LLC (“Registrant”) did not assert any prejudice due to Petitioner’s proposed new claims, and it submitted no evidence creating any genuine dispute of material fact as to Petitioner’s claims in RESPONDENT’S COMBINED BRIEF IN OPPOSITION TO PETITIONER’S MOTION TO AMEND PLEADINGS AND FOR SUMMARY JUDGMENT (the “Opposition.”)

1. REPLY IN SUPPORT OF MOTION FOR LEAVE TO AMEND

Registrant does not allege any prejudice due to Petitioner’s proposed additional claims, instead it mischaracterizes the Motion as “dilatatory” even though Petitioner’s proposed additional claims are undisputedly based on information Petitioner recently discovered through discovery which is still on-going. Petitioner categorically objects to Registrant’s mischaracterization, and respectfully submits to the Board that Registrant cannot rely on bare bone assertions or on mere conclusory statements in order to avoid summary judgment on the proposed additional claims.

Petitioner promptly filed the Motion after the very limited scope of Registrant’s activities under its BATCHTEST mark (“Registrant’s Mark”) was brought to its attention during discovery. Given that the current proceeding is still in discovery stage and that Registrant has not yet served any

discovery request whatsoever to Petitioner, the timeline of the Motion is hardly dilatory, and in no way prejudicial to Registrant. Additionally, there is no need for Registrant to conduct discovery on the proposed new claims inasmuch as any evidence regarding Registrant's actual use in commerce of its mark would be in Registrant's own possession, custody, or control. Further, the Board regularly views motions to amend as timely even when filed months after newly discovered information is initially revealed or when information is obtained well after the close of discovery. *See Karsten Mfg. Corp. v. Editoy*, 79 USPQ2d 1793 (TTAB 2006) (permitting opposer to amend notice of opposition in May after learning facts that gave rise to a new claim in February during the discovery period); *see also PRL USA Holdings, Inc. v. Young*, 2013 WL 5820849, Proceeding No. 91206846 (TTAB 2013) and *Mitek Corp. v. Woods Industries, Inc.*, 41 USPQ2d 1307 (TTAB 1996). In the current case, discovery period has not yet closed and the period to take any testimony has not yet started. *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to amend filed prior to opening of testimony period permitted.)

Registrant falsely alleges that proposed claim of abandonment does not contain allegation that Registrant has not used its mark for more than three years with no intent to resume its use; see 40 TTABVUE 32. Registrant also mischaracterizes Petitioner's allegation on Registrant's goods (47 TTABVUE 3); Petitioner's allegation is on how "Registrant's goods are used for testing tangible electrical safety products during production," it does not acknowledged Registrant's "use of the registered mark"; Registrant also misses entirely that it does not address Petitioner's allegation that Registrant has not continuously used its mark in commerce. Further, Registrant has failed to produce any evidence to show actual use of its registered mark in commerce; Registrant merely presenting an undated catalog is not evidence that Registrant's was ever used in commerce; the said catalog does not show any evidence of a sale or transport of Registrant's goods in interstate commerce. "Mere advertising of a product and documentary use of a symbol apart from the goods does not constitute

trademark use for those goods. That is, advertising material is not use within the meaning of the statute and therefore it is insufficient to support federal registration. [Footnote omitted.] *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 1098 (Fed. Cir. 1985)

Registrant also alleges that it had submitted a “substitute specimen filed on August 22, 2019”, however the said record is not evidence of actual use in commerce of Registrant’s mark, and there is no evidence that the USPTO conducted any audit to verify use in commerce of Registrant’s Mark. “Rights to a trademark are acquired by use and not by registration.” *See Toytrackerz LLC v. Koehler*, No. 08-2297-GLR, 2009 WL 2591329, at *4 (D. Kan. Aug. 21, 2009.)

Registrant alleges that “[t]he mark and goods of the registration have not changed” since initiation of the current proceeding, while responding to Petitioner’s claim that Registrant’s Mark is merely descriptive. Registrant is misguided because the Board’s analysis of mere descriptiveness of a mark also considers the manner in which a mark is used, and not limited strictly to the description of goods in the registration. “[O]ur analysis regarding whether wording is merely descriptive is not determined in the abstract, but in relation to the goods and services for which registration is sought and the context in which it is being used on or in connection with the goods and services.” *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). The manner of Registrant’s alleged use of the mark was not clear to Petitioner until Registrant produced very limited discovery responses, including the email string of its employees which further supports that Registrant’s Mark is merely descriptive on its goods. As such, Registrant has not raised any valid opposition to the said claim.

Lastly, it is Registrant and not Petitioner, who has all along attempted in various ways to “buy more time.” Registrant alleges that based on “discovery responses by Respondent”, Petitioner “has now come up with a new theory of the case.” However, it was Registrant who had filed the motion for amended Standard Protective Order (33 TTABVUE) on its deadline to produce discovery responses while categorically refusing to provide any discovery response whatsoever. The Board’s

February 10, 2021 order stated “the Board finds that Respondent failed to make a good faith effort” (37 TTABVUE 2) and ordered Registrant to “provide discovery regarding its use of the involved mark on the goods identified in its involved registration and its use of the involved mark on any of Opposer’s additional pleaded goods not identified in that registration” (Id. 4.) And yet, Registrant further harassed Petitioner and frustrated Petitioner’s every effort to secure discovery. See DECLARATION OF DINESH PATEL IN SUPPORT OF PETITIONER’S MOTION FOR SANCTIONS AND MOTION FOR LEAVE TO AMEND PLEADINGS AND FOR SUMMARY JUDGMENT (“Patel Decl.”; 39 TTABVUE) ¶¶ 37, 39-43.

While Registrant attempts to mislead the Board on facts related to discovery and apparently takes pride in its unprofessional conduct of frustrating Petitioner’s efforts, Registrant does not allege any real prejudice due to Petitioner’s proposed amendments. For all of the reasons stated above, the Board should grant Petitioner leave to amend because it is in the interests of justice to do so, and Registrant will suffer no unfair prejudice.

2. REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

This case is ripe for summary judgment. Registrant was unable to identify any issues of material fact which would overcome Petitioner’s Motion. To the contrary, in its Opposition brief, Registrant did not challenge – and in fact ignored – all but one of the *du Pont* factors and each and every one of the undisputed material facts requiring summary judgment for Petitioner. It is well settled that “[t]he nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. See Fed. R. Civ. P. 56(c); *Celotex*, 477 U.S. at 324.” *Freki Corporation N.V. d.b.a. Pinnacle Sports Worldwide v. Pinnacle Entertainment, Inc.*, 126 USPQ2d 1697 (TTAB 2018); *see also Octocom Systems Inc. v. Houston Computer Services Inc.*, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990.) “[T]o establish the existence of disputed facts requiring trial,

the nonmoving party ‘must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.’ *Id.* Registrant has failed to meet this burden. Registrant failed to address, let alone refute by affidavit or argument, any of the material facts at issue in this proceeding including that:

(1) Petitioner has standing in the current proceeding.

(2) Petitioner’s BATCHTEST mark is arbitrary on its Class 9 and 42 goods and services.

(3) Petitioner has priority of right as to Registrant by virtue of Petitioner’s prior and continuous use of the BATCHTEST mark (“Petitioner’s Mark”) in commerce on its Class 9 and 42 goods and services, in “BatchTest Corporation” as its trade name, and through use of “batchtest.com” as its internet domain and a channel of trade since prior to November 21, 2012 (“Registrant’s Appl. Date.”)

(4) Both parties’ standard-character BATCHTEST marks are identical.

(5) Petitioner’s trademark application No. 88723304 (the “ ‘304 Application”) and Registrant’s trademark registration No. 4499170 (the “ ‘170 Registration”) both cover identical Class 9 industrial automation and data-logging software, and there are no restrictions in the identification of goods in Petitioner’s ‘304 Application that exclude “electrical safety products.”

(6) Both parties’ channels of trade and target consumers are the same.

(7) There was actual consumer confusion in the marketplace.

(8) Registrant’s BATCHTEST mark is merely descriptive on its Class 9 goods.

(9) Registrant has never used BATCHTEST as a trademark in commerce.

Accordingly, these facts should be deemed conceded, entitling Petitioner to summary judgment as a matter of law. *See Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) (granting a motion for summary judgment based in part upon the “absence of any contravening evidence from applicant.”)

ARGUMENT

At the outset, Petitioner should be granted summary judgment on all issues except for those expressly contested by Registrant in its Opposition brief. *See Hopkins v. Women's Div., General Bd. of Global Ministries*, 284 F. Supp. 2d 15, 25 (D.D.C. 2003) (“It is well understood in this Circuit that when a plaintiff files an opposition to a dispositive motion and addresses only certain arguments raised by the defendant, a court may treat those arguments that the plaintiff failed to address as conceded.”), *aff'd*, 98 F. App'x 8 (D.C. Cir. 2004.)

A. Priority And Likelihood Of Confusion

Registrant does not establish any genuine dispute of material facts; instead, it relies on conclusory statements of its counsel, devoid of any evidence or affidavit, in an attempt to raise pointless and false disputes on immaterial matter, which are undisputed as well.

Registrant itself established Petitioner's superior priority by introducing as a fact that “On February 9, 2011, BatchTest Corporation filed trademark application 85237986 ...” (28 TTABVUE 2 and Patel Decl. ¶ 12.) And yet now Registrant wants to rely on conclusory statements of its counsel to claim that there is a dispute in Petitioner's priority. Attorney conclusory statements and arguments do not substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (citation omitted.) In addition to Registrant's judicial admission, several undisputed facts support Petitioner's superior priority, including Petitioner's Fictitious Business Name filing record dated February 20, 2012 (Patel Decl. Ex. E), Petitioner's invoices dated between July 6, 2005 and April 26, 2012 (Patel Decl. ¶ 4 and Ex. B 1-11) establishing over 7 years of prior actual and continuous use in commerce of the BATCHTEST mark in Class 9, and Petitioner's invoices dated between March 18, 2011 and September 17, 2012 (Patel Decl. ¶ 4 and Ex. C 1-2, 4-5.) which establish its priority in Class 42. As such, Petitioner has met its burden of establishing its superior priority of use in its trade name, and in its BATCHTEST mark in classes 9 and 42, but Registrant has failed to raise any genuine dispute of material fact regarding Petitioner's priority.

Registrant asserts that “[h]owever, the most recent invoice in Petitioner’s Declaration appears to be Invoice No. 2311-3 dated November 30, 2017, over three years ago” (47 TTABVUE 9), Petitioner is only required to show prior use, not continuous use of its mark in order to establish priority because Registrant has not asserted the affirmative defense of abandonment. *See West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Even if Registrant had, Petitioner’s undisputed evidences show continuous use of its trademark until the current proceeding was initiated, including an invoice dated October 24, 2018 (Patel Decl. Ex. B 19-20) for Class 9, and an invoice dated November 30, 2017 for its related Class 42 engineering services. Additionally, all evidences also show continued use of “BatchTest Corporation” as Petitioner’s trade name until now. This time period is insufficient to support a prima facie case of abandonment inasmuch as it is less than three years before the current proceeding was instituted.

1. Likelihood of confusion

Registrant does not challenge any of Petitioner’s alleged *du Pont* factors, instead it attempts to challenge that one of Petitioner’s old Class 9 invoices does not show that Petitioner’s automation software was sold for testing “an electrical safety product.” In doing so, however, Registrant disregards well-established case law unequivocally holding that when, as here in Petitioner’s ‘304 Application, there are no restrictions in a party’s registration or application, it is presumed that the party’s goods will be marketed to all relevant consumers for those goods. Further, it is undisputed that both parties’ goods are industrial automation software under the BATCHTEST mark, and both of which also contain data-logging software. Thus, as a matter of law, the parties’ goods are identical.

Registrant attempts to mitigate the identical nature of the parties’ goods, by claiming that some invoices of Petitioner’s Class 42 engineering services (Patel Decl. Ex. C) do not show goods identical to Registrant’s goods. However, Registrant utterly misses the point and runs afoul of the well-settled principle of law – set forth in greater detail in Petitioner’s moving papers – that the analysis of the

parties' goods is confined to the four corners of their respective applications and registration. *See Octocom Sys., Inc. v. Houston Computers Svcs, Inc.*, 918 F.2d 937, 942 Fed. Cir. 1990). Registrant also misses entirely that the Board may find that there is a likelihood of confusion when only one item in a class of goods of Registrant is commercially similar to one of Petitioner's goods. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application). *See also Research in Motion Limited v. Defining Presence Marketing Group, Inc. et al*, 102 USPQ2d 1187 (TTAB 2012.) To that end, any alleged differences in Petitioner's Class 42 engineering services cannot be considered unless they are inherent in the nature of the goods themselves or are expressly set forth in the application. *See Gilmar S.p.A. V. Mizumo Kabushiki Kaisha*, 2008 WL 4572607 at *4 (TTAB Oct. 10, 2008) ("Applicant ineffectively focuses its arguments on the sports-related goods in its identification and does not address the identical goods, without any limitation, listed in its identification of goods. The fact that applicant's actual use is limited is not a factor in our decision, which is solely concerned with the four corners of the application and the rights to be accorded it by registration on the Principal Register."); *Squirtco v. Tomy Corp.*, 697 F.2d 1038 (Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations in to the registration.") Clearly, there are no limitations in Petitioner's '304 Application that exclude use of Petitioner's goods on "electrical safety products." As such bare assertions of Registrant's counsel based on several of Petitioner's presented invoices for Class 42 engineering services (Patel Decl. Ex. C) and an email (*Id.* Ex. B 5) from 3 years prior to Registrant's Appl. Date do not raise a genuine dispute of material fact that both parties offer identical Class 9 automation software and data-logging software.

Although Registrant attempts to dispute that an Insulin Patch Delivery System (commonly known as an insulin pump) is not an “electrical safety product”, while relying on unsupported bare assertions of its counsel, page 22 of Registrant’s Exhibit A (47 TTABVUE 35) shows that its Autoware3 software is utilized with Registrant’s test systems for providing “a complete test solution for medical device manufacturers”; Registrant has admitted that it uses BATCHTEST mark with Autoware3 software (Interrogatory No. 4; Patel Decl. Ex. T 5.) As such Registrant’s own evidence establishes that “electrical safety products” are inclusive of medical devices.

Registrant falsely alleges that “Exhibit B on page 33 of Petitioner’s Declaration does not contain ‘BatchTest,’ but only ‘SKYNET’”; the referenced exhibit clearly states “QR code scans with BatchTest” under the description of sold software; actual image of the said goods also shows “BatchTest” on two locations on its front-panel. Patel Decl. Ex. B 1-2. Registrant also falsely asserts that Petitioner’s SAT2011 (Patel Decl. Ex. F 7) is for “testing ‘processor & microcontroller based boards and systems,’ not for testing ‘electrical safety products.’” Full text of the referenced exhibit shows that the goods was “for automated full testing of manufactured devices including processor and microcontroller based boards and systems”, and it does not exclude “electrical safety products.”

As a junior user, Registrant had the responsibility to ensure that its mark did not infringe a prior user. Registrant did the exact opposite – it chose a mark that is identical to Petitioner’s trademark, trade name, and internet domain name, and intended to use on the same goods sold by Petitioner. These facts are undisputable. Accordingly, summary judgment on Petitioner’s claim of priority and likelihood of confusion must be granted.

B. Registrant’s Mark Is Merely Descriptive and Registrant Has Abandoned Its Mark With No Intent To Resume Its Use

Registrant is misguided in relying on bare statements of its counsel that “there is no burden on Respondent to respond to Petitioner’s summary judgment motion.” *Guarino v. Brookfield Tp.*

Trustees, 980 F.2d 399, 405 (6 Cir. 1992)(on a motion for summary judgment, the non-moving party's burden to respond by showing that there is a genuine issue for trial "is really an opportunity to assist the court in understanding the facts. But if the non-moving party fails to discharge that burden - for example, by remaining silent - its opportunity is waived and its case is wagered.") Registrant's failure to oppose that its mark is merely descriptive on its goods, and that Registrant has abandoned its mark with no intent to resume its use, constitutes a concession on Registrant's part that the said matters are undisputed, as such summary judgment must be granted on those claims in Petitioner's favor. Conclusory statements in the affidavit of Adam Braverman (Registrant's Exhibit A) with support of a product catalog do not suffice to defeat summary judgment. *See Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 4 USPQ2d 1793, 833 F.2d 1560, 1564 (Fed. Cir. 1987) ("Mere conclusory statements and denials do not take on dignity by placing them in affidavit form"). As asserted above, a product catalog is not evidence of actual use in commerce of Registrant's Mark per *Avakoff* decision; it contains no evidence that any goods bearing Registrant's Mark was actually sold or transported in interstate commerce. Since there is no genuine dispute of material facts, summary judgment on Petitioner's claims must be granted and the '170 Registration must be cancelled.

I. CONCLUSION

For all of the reasons discussed above and in Petitioner's initial moving papers, Petitioner's Motion for leave to amend pleadings and for summary judgment cancelling Registrant's '170 Registration should be granted.

Respectfully submitted,

Dated: August 16, 2021

/Dinesh Patel/

President, BatchTest Corporation

2118 Walsh Ave, Suite 240

Santa Clara, CA 95050

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document “PETITIONER'S REPLY IN SUPPORT OF MOTION FOR LEAVE TO AMEND PLEADINGS AND FOR SUMMARY JUDGMENT” was served upon the attorney for the other party by email on August 16, 2021 at the following email address(es):

THOMAS J MOORE
BACON & THOMAS PLLC
201 N. UNION ST., STE. 430
ALEXANDRIA, VA 22314-2649
UNITED STATES
tjmoore@baconthomas.com, jmiller@baconthomas.com, mail@baconthomas.com
Phone: 703-683-0500

By: BatchTest Corporation

Signature: /Dinesh Patel/

Name: Dinesh Patel, President, BatchTest Corporation

2118 Walsh Ave, Suite 240, Santa Clara, CA 95050

Date: August 16, 2021

Email: BatchTest_TM@BatchTest.com