

THIS DECISION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: 8/31/2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mandarin Music Pty Ltd.  
v.  
Joseph Alan Kalman Greenbaum

Opposition No. 91118664  
to application Serial No. 75655561  
filed on March 8, 1999

Richard Lehv and Michael Chiappetta of Fross Zelnick Lehrman  
& Zissu for Mandarin Music Pty Ltd.

Joseph Alan Kalman Greenbaum, pro se.

Before Seeherman, Hanak and Quinn, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed to register the mark shown  
below

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for "prerecorded compact discs, audio cassettes and audio  
tapes all featuring music and other sound recording devices,

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namely audio discs, video discs, and video cassettes all featuring music."<sup>1</sup>

Mandarin Music Pty Ltd. opposed registration on the ground that applicant failed to have a bona fide intention to use the mark in commerce. More specifically, opposer alleged, in pertinent part, that it is the owner of the mark TAXIRIDE used in connection with entertainment services in the nature of live musical performances, and for musical sound recordings and musical video recordings featuring a musical group, and for clothing "and other goods and services"; that it has filed application serial no. 75758060 to register the mark TAXIRIDE for such goods and services; that applicant's original application listed both goods and services, but that at the time he filed his application, "Applicant did not have a bona fide intent to use the mark in commerce on the foregoing goods and services"; that applicant later deleted the services from the application, but that at the time of the amendment, "Applicant did not have a bona fide intent to use the mark in commerce on such goods"; and that "[u]nder Section 1(b) of the Lanham Act, 15 U.S.C. 1051(b), and Section 45 of the Lanham Act, 15 U.S.C. 1127, Applicant is therefore not entitled to registration of the mark sought to be registered." Lastly, opposer alleged

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<sup>1</sup> Application Serial No. 75655561, filed March 8, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

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that in connection with its application, the examining attorney indicated that registration of opposer's mark might be refused under Section 2(d) in the event that applicant's application serial no. 75655561 matured into a registration. Opposer also stated that its application serial no. 75758060 later was suspended pending the disposition of applicant's application involved herein.

Applicant, in his answer, admitted allegations in the paragraphs of the notice of opposition regarding the filing date of his application and the identification of goods set forth therein, and stated that "the Applicant had or continues to have a bona fide intent to use the mark in commerce on the goods and services listed in his original application filed on March 8, 1999 and in the goods listed in his amended application filed on September 20, 1999." Applicant also affirmatively claimed that he has since commenced use of the mark for the goods listed in his application. Applicant otherwise denied the allegations in the notice of opposition.

The record consists of the pleadings; the involved application file; trial testimony, and related exhibits, of two individuals taken by opposer by way of depositions upon written questions.<sup>2</sup> Applicant did not take any testimony or

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<sup>2</sup> Opposer also filed a notice of reliance on two excerpts retrieved from Internet websites. However, this type of evidence is not admissible by notice of reliance under Trademark Rule

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introduce any other evidence. Only opposer filed a brief.<sup>3</sup>  
An oral hearing was not requested.

Section 13(a) of the Trademark Act allows for opposition to the registration of a mark by anyone "who believes that they would be damaged by the registration of a mark..." The party seeking to oppose the registration of the mark must prove two elements: (1) that it has standing, and (2) that there is a valid ground to prevent the registration of the opposed mark. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

The standing question is an initial and basic inquiry made by the Board in every inter partes case. That is, standing is a threshold inquiry. Standing is an essential element of an opposer's case which, if it is not proved at trial, defeats an opposer's claims. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *No Nonsense Fashions, Inc. v. Consolidated*

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2.122(e). *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n. 3 (TTAB 1999); and TBMP §704.08 (2d ed. rev. 2004). Even if considered, however, this evidence is irrelevant to opposer's standing in this case; rather, it pertains to the claim of no bona fide intent to use the mark.

<sup>3</sup> While it is indeed the better practice for a defendant, if it believes that the plaintiff has failed to sustain its burden of proof in the case, to file a brief indicating the inadequacy of the plaintiff's evidence and arguments, there is no requirement that a defendant do so. Trademark Rule 2.128(a)(3); and TBMP §801.02 (2d ed. rev. 2004) ["The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant."]. Consequently, it cannot be said that applicant has conceded the issues herein, including opposer's standing, by failing to file a brief on the case.

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Foods Corp., 226 USPQ 502 (TTAB 1985). See also: Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); and Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

In the present case, the notice of opposition includes a proper allegation of opposer's standing. More specifically, paragraph 1 of the notice of opposition, as noted above, contains allegations of opposer's use of the mark TAXIRIDE in connection with certain goods and services. The problem is that opposer has failed to prove its standing in this case to be heard on any issue.

Firstly, applicant did not make any admissions in his answer that would excuse opposer from having to prove, as an element of its case in chief, its standing to be heard in this proceeding. Allegations alone do not establish standing.

Secondly, opposer failed, at trial, to take any testimony or introduce any other evidence to prove its standing to bring this opposition proceeding. Opposer took two testimony depositions on written questions, one of a private investigator specializing in intellectual property matters, and the other of an attorney at a Canadian law firm. The entireties of both depositions center on opposer's claim of applicant's failure to have a bona fide intention to use the mark in commerce. The testimony is

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devoid of any facts and/or exhibits that bear on opposer's standing.<sup>4</sup>

Because opposer has not proven its standing, the opposition must be dismissed.<sup>5</sup> In view thereof, we elect not to consider the merits of the pleaded ground. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990); and *American Forests v. Sanders*, 54 USPQ2d 1860, 1864 (TTAB 2000).

Decision: The opposition is dismissed for opposer's failure to prove its standing.

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<sup>4</sup> Further, opposer did not make its application serial no. 75758060 of record, and the Board does not take judicial notice of files of applications and/or registrations, where no copies thereof are filed, and where they are not the subject of the proceeding. *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986).

<sup>5</sup> Although statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial, it is interesting to note that opposer's brief does not include even a single sentence setting forth a fact which is relevant to opposer's standing.