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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Brown/Wolfson

Mailed: **March 31, 2008**

Opposition No. 91167613

TBC BRANDS, LLC

v.

Sullivan, Harold R.

Before Seeherman, Grendel and Kuhlke, Administrative Trademark Judges.

By the Board:

Applicant seeks registration of the mark ORIGINAL BULLET GTX for "land motor vehicles, namely, cars" in International Class 12, alleging a bona fide intent to use the mark in commerce.[1] On November 18, 2005, opposer filed a notice of opposition against registration of the mark, wherein opposer pleaded ownership of various marks including Registration No. 2972309[2] for MIRADA SPORTS GTX for "tires" in International Class 11 and alleged that "registration and/or use of the ORIGINAL BULLET GTX mark, as set forth in the opposed application, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship and/or association…" with opposer's marks under Section 2(d) of the Trademark Act (see notice of opposition at paragraph #9).

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[1] Application No. 78464093, filed August 9, 2004.

Opposer did not assert any other grounds in the notice of opposition. Applicant denied the salient allegations of the notice of opposition and did not assert any affirmative defenses.

On October 27, 2006, opposer filed a motion to compel applicant to respond to opposer's interrogatories and document production requests and on January 4, 2007, the Board granted the motion as conceded, ordering applicant to provide responses to the discovery requests. Applicant provided responses to those discovery requests. In light of those responses, opposer filed a motion for summary judgment on February 27, 2007, on the grounds that applicant lacked a bona fide intention to use the mark in commerce and that applicant had committed fraud in the filing of the application.

As part of his response to the motion for summary judgment, applicant asserted that applicant's alleged lack of a bona fide intent to use the mark and fraud were not pleaded in the notice of opposition. With its reply brief, opposer submitted an amended notice of opposition that asserted applicant's lack of a bona fide intention to use the mark in commerce and fraud as additional grounds for opposition. Since a party generally may not obtain summary judgment upon an issue that has not been pleaded, we must

first consider whether to allow opposer leave to amend the notice of opposition. *See* Fed. R. Civ. P. 56(a) and 56(b); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997).

Under Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *See Polaris Industries v DC Comics*, 59 USPQ2d 1789 (TTAB 2001). Timing plays a large role in the Board's determination of whether an adverse party would be prejudiced by allowance of an amendment and as a result, long, unexplained delays may render the amendment untimely. *See M. Aron Corporation v. Remington Products*, Inc., 222 USPQ 93, 96 (TTAB 1984).

Here, the Board finds that opposer was not fully aware of all the facts it needed in order to include such claims at the time the notice of opposition was filed and it did not become fully aware of them until after the Board, on January 4, 2007, ordered applicant to provide complete discovery responses to opposer's interrogatories and document production requests. Applicant's responses were not provided to opposer until on or after January 31, 2007, and since opposer's amended notice of opposition was filed

[2] Registration No. 2972309, issued July 19, 2005.

less than four months later on April 16, 2007, it was timely. Moreover, while applicant objected to the motion for summary judgment in his responsive brief on the ground that it was based on two unpleaded issues, he also argued against the motion for summary judgment on the merits. Finally, we note that applicant never objected to opposer's motion to amend its pleading that was submitted along with opposer's reply brief.

In view thereof and in the interest of justice and judicial economy, the Board grants the motion to amend, and will consider the amended pleading as the operative pleading. In view thereof, opposer's motion for summary judgment is now on pleaded grounds, and we will rule on the merits of opposer's motion for summary judgment at this time. In deciding the motion for summary judgment, the Board assumes that applicant maintains all denials in his answer to the notice of opposition and that applicant denies opposer's newly asserted claims as alleged in paragraphs 9-15 in the amended notice of opposition.

For the following reasons, we grant opposer's motion for summary judgment.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving

for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett,* 477 U.S. 317 (1986). All justifiable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

As a preliminary matter, we find that there is no genuine issue of material fact as to opposer's standing. In his answer to the notice of opposition, applicant has admitted that opposer "has a live trademark" for the mark "Mirada Sport GTX" (see answer at paragraph #4). In view thereof, there is no genuine issue that opposer has a real interest in this proceeding, and that opposer has established its standing as a matter of law. *See*, e.g., Trademark Act Section 14(a), 15 U.S.C. Section 1064(a); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b)(1), requires that an applicant filing an application based on its bona fide intent to use the mark in commerce verify that it has a "bona fide intention" to use the mark in commerce on the goods or services identified in

the application. If an applicant lacks a bona fide intent to use its mark in commerce on the goods or services identified in the application at the time of its filing, the application is void. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §309.03(c)(6) (2d ed. rev. 2004) and cases cited therein.

Here, opposer alleges that applicant lacked a bona fide intention to use the mark in commerce on the goods identified in the application, i.e., "land vehicles, namely, cars," and that applicant failed to produce any objective evidence to support his claim of a bona fide intention to use the mark on such goods. In support of its motion for summary judgment, opposer relies upon applicant's responses to opposer's requests for admissions and document production requests as well as applicant's answers to interrogatories to show that there is no genuine issue that applicant did not have an intention to use his mark on cars.

In particular, opposer points out that in his answers to interrogatory nos. 1(a) and 26, applicant stated that he "only wishes to use the [m]ark to describe his one automobile, which is the famous 'Silver Bullet' which is the original 1967 Plymouth GTX automobile owned by famous street racing legend James Addison (now deceased) in the Detroit Area." Responding to interrogatory nos. 5 and 6, applicant goes on to state that the mark ORIGINAL BULLET GTX "pertains

to only one automobile that applicant does not intend to sell," and in response to document production request no. 5, applicant declares that there are "no products/services sold or planned to be offered or sold under Applicant's Mark." Moreover, in answers to requests for admission nos. 84, 85 and 86, applicant admitted that he does not manufacture cars and that he has no intention of manufacturing cars.

In an attempt to clarify the "exact goods and services that he intends to supply" under the proposed mark and in opposition to the motion, applicant submitted an affidavit with his responsive brief. Rather than supporting his bona fide intention to use the mark in commerce for the goods specified in the application, however, applicant's affidavit confirms the fact that he is not providing any goods as contemplated in the application and that he has no bona fide intention to either sell, produce or manufacture any automobiles that bear the ORIGINAL BULLET GTX mark.

Indeed, in paragraph nos. 3 and 6 of his affidavit, applicant states the following:

> This vehicle can best be described as an "exhibit car" whereby I am compensated in direct monetary terms and/or by various forms of compensation to display this vehicle at numerous automotive events that take place throughout the entire United States where I am requested to do so by event sponsors and promoters of said events, and I am also requested to feature this vehicle in numerous magazines (18 in total), numerous books, numerous newspapers and numerous television programs. (See affidavit at paragraph no. 3)

> It is the act of providing and displaying the famous Silver Bullet at various automotive events, etc. and the car's world wide reputation and good will (which is a draws [sic] thousands of people to said events) which represents both the goods and services that I am selling and in commerce which I seek a registered mark to prevent clone cars and/or imposters from calling their vehicles by the same or similar name which would cause tremendous confusion within the public. (See affidavit at paragraph No. 6).

Based on the foregoing, we find that there is no genuine issue that applicant uses the mark ORIGNAL BULLET GTX to identify only a single automobile, which he displays at various events, and that he has no intention of selling cars under the mark.

Under Section 45 of the Trademark Act, however, "use in commerce" for goods is defined as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." Section 45 goes on to state that a mark shall be deemed to be in use in commerce on goods when it is placed on the goods, or their containers or displays associated therewith and the actual goods are "sold or transported in commerce." Thus, the act of "providing and displaying the famous Silver Bullet itself at various events" by applicant is, at best, a service and fails to constitute a tangible good; it is not use of the mark to identify the source of goods, and does not constitute trademark use of the type "common to the industry in question" for the goods identified in the application as

provided by law. *See Paramount Pictures Corporation V. James E. White d/b/a R.I. Productions*, 31 USPQ2d 1768, 1774 (TTAB 1994).

Given applicant's own words, we find that there is no genuine issue that applicant has no intention to use his mark on "cars" in a trademark manner, and we further find that there is no genuine issue that applicant lacked a bona fide intent to use his mark on those goods as of the filing date of his application. In view thereof, we find that opposer is entitled to judgment as a matter of law on this ground.[3]

Accordingly, opposer's motion for summary judgment is granted, the opposition is sustained, and registration to applicant is refused.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

[3] In view of our finding that opposer is entitled to summary judgment on this ground, we need not reach the fraud claim as articulated in opposer's motion for summary judgment as well as in its amended notice of opposition, or opposer's likelihood of confusion claim pleaded in the notice of opposition.

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address: http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm