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

WINTER

Mailed: April 17, 2008

Opposition No. 91175614

**Swiss Army Brand Ltd.,
Swiss Army Brands, Inc.,
Victorinox A.G.**

v.

Brian Arthur Dempsey

**Before Seeherman, Grendel and Kuhlke,
Administrative Trademark Judges.**

By the Board:

Brian Arthur Dempsey (hereafter "applicant") seeks to register the mark IRISH ARMY KNIFE for "folding knives."¹ Swiss Army Brand Ltd., Swiss Army Brands, Inc. and Victorinox A.G. (hereafter "opposers") have opposed the registration of applicant's mark on the grounds of likelihood of confusion, dilution and applicant's lack of a *bona fide* intention to use his mark. In particular, opposers allege priority based on common law rights accruing from licensed use of the SWISS ARMY mark in the United States for more than sixty years and on ownership of four

¹ Application Serial No. 78753739, filed on November 14, 2005, claiming *bona fide* intent to use the mark in commerce. Applicant has disclaimed the term "knife".

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registrations for the SWISS ARMY mark,² and that applicant did not have at the time the involved application was filed, nor does he have now, a *bona fide* intent to use the mark in connection with the goods identified in the application.

In his answer, applicant has admitted that opposers' mark is SWISS ARMY and that opposers obtained the four pleaded registrations, but has otherwise denied the salient allegations set forth in the notice of opposition.

This case now comes up for consideration of opposers' fully briefed motion (filed October 30, 2007) for partial summary judgment in their favor solely on the claim that applicant lacked as of the application filing date (and continues to lack) the requisite *bona fide* intent to use the IRISH ARMY KNIFE mark in commerce on the goods described in the application, namely, "folding knives."

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). The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no

² The pleaded registrations for the SWISS ARMY mark are: U.S. Reg. No. 2806013, issued January 20, 2004, for "handtools, namely multifunction pocketknives"; U.S. Reg. No. 1734665, issued November 14, 1992, for "watches"; U.S. Reg. No. 1715093, issued September 15, 1992, for "sunglasses"; and U.S. Reg. No. 2948137, issued May 10, 2005, for "perfumes, colognes, skin lotions, deodorant, after shave lotion; flashlights; pens and pencils".

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genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984).

The 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 judgment as a matter of law. Fed. R. Civ. P. 56(c). See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

First, we find that no genuine issues of material fact exist as to opposers' standing to oppose registration of the involved application. In particular, opposers have pleaded

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four registrations for the SWISS ARMY mark and applicant has admitted in paragraphs 10 and 16 of his answer, respectively, that "Opposers obtained U.S. Trademark Registrations 2,806,013, 1,734,665, 1,715,093, and 2,948,137" (the four pleaded registrations, note 2 *supra*) and that "opposers' mark is SWISS ARMY." In view of applicant's admissions, opposers have shown that they are not mere "intermeddlers." Accordingly, we find that there is no issue as to opposers' interest in the proceeding, and that their standing has been established. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). See also *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

With respect to the ground asserted in opposers' motion for partial summary judgment, opposers argue, "there can be no question that Applicant lacks the requisite intent to use the mark in commerce on 'folding knives'." To support their claim, opposers have introduced *inter alia* a copy of applicant's responses to opposers' second request for admissions. In particular, applicant admits that "[he does] not intend to use the IRISH ARMY KNIFE mark for folding knives" (response to Request No. 2). As a corollary to that request for admission, opposers asked that applicant admit that "[he] intend[s] to use the IRISH ARMY KNIFE mark for folding knives," and applicant denied that request

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(response to Request No. 3). Thus, applicant has admitted unequivocally that he has no intention to use the mark IRISH ARMY KNIFE for "folding knives."

Applicant, in his declaration attached to the brief in opposition, explains the nature of the goods for which he does intend to use his mark:

"On November 14, 2005, [the filing date of applicant's application] and at all times thereafter including the present, I have had a bona fide intention to provide goods comprising a handle and at least one implement useful in opening beverage containers or removing corks from beverage containers, with any implement(s) not in use housed within or along the handle, under my 'IRISH ARMY KNIFE' mark." (emphasis added)

Thus, since the filing date of the involved application, applicant's intention has been to use the IRISH ARMY KNIFE mark with goods comprising a handle with at least one implement for opening beverage containers or removing corks from beverage containers. However, the goods identified in applicant's application are "folding knives."

Thus, in view of applicant's admissions and the statement in his declaration, there is no genuine issue that the goods for which applicant intends to use his mark are not the goods identified in his application.

Applicant has argued that the term "folding knives" in International Class 8, as identified in his application, has a different meaning from "folding knives" as specified in the admission requests. As a result of the purported difference in meaning, applicant essentially argues that the

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goods set forth in the application, because they are classified in International Class 8, encompass the goods with which he intends to use the mark; whereas, the wording in the admissions at issue refer only to "folding knives" *per se*. Thus, applicant maintains that he intends to use the mark with "folding knives classified in International Class 8," and also contends that his admission responses would have been different had opposers worded their admission requests to refer to "folding knives classified in International Class 8."

Applicant's argument in essence is that, because of the classification in International Class 8, the wording "folding knives" in the application encompasses the goods on which applicant intends to use his mark. Applicant states in his declaration that on or about the filing date of his application he had a telephone conversation with a trademark examining attorney who advised him that "'folding knives' accurately described my identification of intended goods." Notwithstanding any conversation applicant may have had with an examining attorney, wording in an identification of goods is read to have its ordinary meaning. *See In re Thor Tech, Inc.*, 85 USPQ2d 1474 (TTAB 2007), *citing* TMEP §§ 1402.01, 1402.05 and 1402.07(a) (5th ed. 2007). The identification "folding knives" in International Class 8 clearly indicates that the tool includes, at a minimum, a knife. Accordingly,

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we find as a matter of law that the goods identified in the involved application, namely, "folding knives," do not encompass the goods with which applicant actually intends to use the IRISH ARMY KNIFE mark, namely, a folding corkscrew or folding bottle opener implement.

Accordingly, there is no genuine issue that applicant did not at the time he filed his application, nor does he now, have a *bona fide* intention to use his mark on "folding knives," the goods identified in his application. We therefore conclude that opposers have demonstrated, as a matter of law, that they are entitled to summary judgment on the ground that applicant did not have at the time the application was filed (nor does he continue to have), the required *bona fide* intent to use the mark in commerce with the goods described in the involved application.

Accordingly, opposers' motion for partial summary judgment is hereby granted, and the opposition is sustained on the ground of lack of *bona fide* intent to use the mark.

