

This Opinion is not a
Precedent of the TTAB

Mailed: January 26, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Donald Reid

v.

Monster, Inc.
—

Opposition No. 91218973
—

Wendy Peterson of Not Just Patents LLC
for Donald Reid.

Andrew S. Mackay of Donahue Fitzgerald LLC
for Monster, Inc.
—

Before Cataldo, Bergsman and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Monster, Inc., (“Applicant”) filed an application to register the marks GO DJ (in standard characters),¹ GODJ (in standard characters),² and GODEEJAY (in standard

¹ Application Serial No. 86047996 was filed on August 26, 2013, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act; “DJ” disclaimed.

² Application Serial No. 86048004 was filed on August 26, 2013, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

characters)³ all for “computer software and hardware for music mixing; audio and video cables; cases for consumer electronic products, namely, cases for audio speakers, mobile computers, and portable DJ equipment; audio speakers; headphones” in International Class 9.

Donald Reid opposes registration of Applicant’s marks on the ground that Applicant lacks a bona fide intent to use the marks in commerce.

Applicant filed an answer in which it denied the salient allegations in the notice of opposition.

Each party filed a trial brief and Opposer filed a reply brief.

I. Record

The record includes the pleadings, and by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file. In addition, the parties introduced the following testimony and evidence listed below.

A. Opposer’s Evidence.

- 1) Notice of reliance on Opposer’s requests for production, Opposer’s requests for admissions and Applicant’s responses and supplemental responses thereto.
- 2) Notice of reliance on a TSDR printout of Opposer’s pleaded application Serial No. 86397296, and TSDR printouts of Opposer’s unpleaded Registration No. 4699143 and Opposer’s unpleaded application Serial No. 86467434.
- 3) Notice of reliance on TSDR printouts of Applicant’s abandoned USPTO intent-to-use trademark applications that include the term “DJ;” TSDR printouts of certain intent-to-use applications abandoned by Applicant.

³ Application Serial No. 86047984, was filed on August 26, 2013, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

- 4) Notice of reliance on copies of WHOIS registration information for GoDj.net, GoDj.org, GoDj.biz, GoDj.mobi, GoDj.com, and Godiskjockey.com.

Applicant's evidence.

- 1) Testimony of Chang "Robin" Lee, Business Development Manager of Applicant and accompanying exhibits; Exhibits 6, 9-13 were also introduced by way of notice of reliance.
- 2) Notice of reliance on Opposer's responses to Applicant's discovery (interrogatory requests, requests for production and requests for admissions).

II. Preliminary Issues

A. Earlier disposition of claims in this proceeding.

In the course of this proceeding, Applicant filed a withdrawal of application Serial No. 86047984 without Opposer's written consent. The Board entered judgment against Applicant on the claim relating to this application pursuant to Trademark Rule 2.135, 37 CFR § 2.135.

B. Evidentiary and Other Matters

Opposer has objected to Applicant's reference in its trial brief to declaration testimony submitted by Applicant on summary judgment at 19 TTABVUE. Inasmuch as this evidence was not submitted during Applicant's trial period, the objection is sustained. *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Opposer also has objected to portions of Applicant's arguments in its trial brief as unsupported by evidence. We have accorded no evidentiary value or consideration to any unsupported factual statements made by Applicant in its brief, except to the extent that such statements may be considered admissions against interest. *See*

TBMP §§ 704.06(a) and (b) (2017). *See also Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007) (unsupported factual assertions in brief concerning third-party use and registration not considered).

Opposer objects to the testimony of Chang “Robin” Lee and accompanying exhibits based on hearsay and lack of personal knowledge and alternatively argues that, at a minimum, the testimony and evidence should be given little weight.

We overrule Opposer’s objection to Mr. Lee’s testimony. We find that Mr. Lee was competent to testify regarding the GO DJ/GODJ products. In 2013 Mr. Lee was the President of JD Sound and had as his primary responsibility the marketing and selling of a portable DJ product (PDJ). (36 TTABVUE 13). Mr. Lee sought and obtained a partnership with Applicant in connection with the portable DJ device in which JD Sound was the licensee and Applicant the licensor. (36 TTABVUE 12-13, 19). Early in the partnership, the portable DJ device was renamed GO DJ/GODJ/GO-DJ (hereinafter GO DJ) in conjunction with discussions between Applicant and JD Sound. (36 TTABVUE 17-18). Later, in 2014, Mr. Lee joined Applicant as Business Development Director, continuing to work on the GO DJ project (36 TTABVUE 10). In 2015, Mr. Lee was still working on the GO DJ project, but at a higher level, with two other individuals assigned to work on the project on a day-to-day basis. (36 TTABVUE 115).

As to Opposer’s hearsay objections in connection with Mr. Lee’s testimony, we have only considered non-hearsay statements and testimony where it has been demonstrated that Mr. Lee’s testimony is based on his personal knowledge of the

subject matter.⁴ As to the exhibits that accompanied Mr. Lee's testimony, we find they are not hearsay as the testimony demonstrates that Mr. Lee had personal knowledge of the contents of these documents and was competent to testify as to the contents therein. Therefore, Opposer's hearsay objection as to these exhibits also is overruled. To the extent that Mr. Lee's testimony regarding the nature of any exhibit is based solely on hearsay, such testimony and the characterizations made regarding the exhibit have been given no consideration.

Opposer's, objection, to Applicant's alternative request, in its trial brief, to amend the application, is well taken. Applicant's alternative request to amend is denied as untimely. *See Personnel Data Systems, Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied).

Applicant's objection on the basis of relevance to Opposer's submission under notice of reliance of Applicant's intent-to-use applications for other marks is overruled.

C. Opposer's unpleaded Registration No. 4669143 and application Serial No. 86467434.

Opposer filed a notice of reliance indicating his intention to rely on unpleaded Registration No. 4669143 and unpleaded application Serial No. 86467434. Because

⁴ A portion of Mr. Lee's deposition testimony was designated as confidential. However, Applicant over-designated some of this testimony. Therefore, in this opinion, we will treat only testimony that is truly confidential or commercially sensitive as such. Trademark Rule 2.116(g), 37 CFR §2.116(g); *see e.g. Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016).

Applicant did not object to the introduction of Opposer's unpleaded registration and application and because Applicant treated the registration and application as being of record by arguing in its brief on the case that substantively the registration and application should not be considered for purposes of Opposer's standing, we find that Opposer's reliance on the registration and application was tried by implied consent. We accordingly deem the pleadings to be amended to include Opposer's Registration No. 4669143 and application Serial No. 86467434. *See* Fed. R. Civ. P. 15(b); *Boise Cascade Corp. v. Cascade Coach Co.*, 168 USPQ 795, 797 (TTAB 1970) ("Generally speaking, there is an implied consent to contest an issue if there is no objection to the introduction of evidence on the unpleaded issue, as long as the adverse party was fairly informed that the evidence went to the unpleaded issue").

III. Standing

A threshold question in every Board inter partes case is whether the plaintiff has established standing. In a Board proceeding, the plaintiff is required to show that it has a "real interest"; that is, a "direct and personal stake," in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

To prove his standing, Opposer references his Registration No. 4699143 for GODJ and his application Serial No. 86467434 for GODDJ, which has been suspended

because of Applicant's GODJ application.⁵ (32 TTABVUE; 33 TTABVUE; 35 TTABVUE 10; 39 TTABVUE 10). Opposer further points to application Serial No. 86397296 and Registration No. 4699143 as having related services to Applicant's goods (music mixing and music listening). (32 TTABVUE; 33 TTABVUE; 35 TTABVUE 10).

Applicant argues that Opposer failed to prove damage with regard to his allegations in the notice of opposition relating to application Serial No. 86397296 since Applicant's applications were not cited as a bar to registration, and the application was published for opposition.⁶ Applicant further argues that Opposer's later-filed applications (Serial No. 86467434 and Registration No. 4699143) have no impact on standing since they both were filed subsequent to the filing of the opposition.

Even assuming that Applicant is correct that application Serial No. 86397296 does not now provide a basis for standing, although initially providing standing at the commencement of the proceeding,⁷ we find that the filing of Opposer's application

⁵ In the notice of opposition, Opposer alleged use in commerce of GODJ and GO DJ but it did not put any evidence into the record of such use. (1 TTABVUE 4). Opposer has put in evidence of his domain name registrations. (32 TTABVUE; 33 TTABVUE). However, the mere registration of a term as a domain name does not establish any trademark rights or trademark use. *United Global Media Group, Inc. v. Bonnie Tseng*, 112 USPQ2d 1039; 1046 (TTAB 2014); *see also Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ2d 1545, 1555 (9th Cir. 1999).

⁶ In the notice of opposition, Opposer alleged that it reasonably expects application Serial No. 86397296 for GODJ to be refused based on Applicant's involved applications. (1 TTABVUE 5).

⁷ Applicant has not argued that Opposer did not have the required standing at the commencement of the proceeding.

Serial No. 86467434 and the Office's action taken in regard to that application provides Opposer with standing. *Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) (opposer's standing may be based on the Office's provisional refusal of opposer's application based on prior pending applications), citing *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008) (standing found because the opposed application was cited as a potential bar to opposer's registration); *see also Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 189. Contrary to Applicant's assertions, the subsequent filing of application Serial No. 86467434 during the pendency of the Board proceeding (after Serial No. 86397296 was approved for publication) does not result in loss of standing. *See Schreiber Foods, Inc. v. Beatrice Cheese, Inc.*, 402 F.3d 1198, 1203, 1259 (Fed.Cir.2005) (allowing plaintiff who sold and then reacquired patent to proceed to judgment because plaintiff's stake in litigation was restored); *cf. Log Cabin Republicans v. United States*, 716 F.Supp.2d 884, 894 (C.D.Cal. 2010) *vacated on other grounds*, 658 F.3d 1162 (9th Cir. 2011) ("Courts have recognized that a plaintiff who possesses standing when it brings suit, later loses it, and then regains standing before entry of judgment, may still maintain its claims.").

IV. Lack of Bona Fide Intent

We now turn to consideration of whether Applicant did not have a bona fide intention to use its marks in commerce in connection with the identified goods when it filed its trademark applications.

Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), states that:

A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). One way an opposer can establish its prima facie case of no bona fide intent is by proving that the applicant has no documentary evidence to support its allegation in the application of its claimed previous bona fide intent to use the mark in commerce as of the application filing date. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010). Opposer has taken this avenue to question Applicant's bona fide intent.

The absence of any documentary evidence regarding an applicant's bona fide intention to use a mark in commerce is sufficient to prove that an applicant lacks the intention required by Section 1(b) of the Trademark Act, unless other facts are presented which adequately explain or outweigh applicant's failure to provide such documentary evidence. *See Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008). If opposer satisfies its initial burden of showing the absence of documentary evidence regarding applicant's bona fide intention to use the mark, the burden of production

shifts to applicant to come forward with evidence adequately explaining or outweighing the failure to provide such documentary evidence. *See Commodore Electronics.*, 26 USPQ2d at 1507 n.11.

Opposer relies on Applicant's responses to requests for admissions and responses to requests for production, both of which consist solely of objections, and argues that Applicant lacks documents supportive of Applicant's intent to use the marks in commerce on the identified goods. (35 TTABVUE 14; 35 TTABVUE 15). Opposer's requests for admissions, at least as to the identified goods in the involved applications, relate to projected first use dates and whether all of the goods were offered for sale or are currently offered for sale in connection with the marks. Opposer's requests for production (those that are not directed to seeking documents in connection with any admissions) also seek documents related to first use in connection with GO DJ/GODJ, goods being sold or transported in connection with GO DJ/GODJ, exposure of GO DJ/GODJ branded goods to actual purchasers and documentation related to annual sales. However, because Applicant's objections were not of a nature which would have led Opposer to believe that no such documents existed, and because the requests were not directed to Applicant's bona fide intent to use the GO DJ and GODJ marks but rather to Applicant's first use of the GO DJ and GODJ marks, whether goods were offered for sale in connection with the marks, and actual sales in connection with the goods, we do not find this evidence particularly

probative to the question of whether Applicant has a bona fide intent to use the GO DJ and GODJ marks in commerce.⁸

We consider the other evidence in the record, in particular, testimony from Applicant's witness and supporting exhibits as well as the other evidence submitted by Opposer under notice of reliance.

Applicant is a manufacturer of electronic cables, power products, headphone products, speaker products, and mobile accessories including cables. (36 TTABVUE 9, 53, 90, 106; 37 TTABVUE 4, 5, 10). In 2013, Applicant entered into a partnership/licensing agreement with JD Sound in connection with a standalone

⁸ The question before us is not whether Applicant has made bona fide use of the mark in commerce. As our reviewing court has pointed out, under the Trademark Law Revision Act (TLRA) an applicant filing a trademark application based on a bona fide intent to use a mark is not required to have actual use in commerce at the time of filing:

To address the problem of "token use," the TLRA heightened the burden for use applications by requiring that an applicant's use be "bona fide use of [the] mark in the ordinary course of trade." Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (effective November 16, 1989) (codified at 15 U.S.C. § 1127) (emphasis added). Concurrently, the TLRA lowered the bar to starting registration by allowing applicants to proceed on the basis that they have a "bona fide intention to use the mark in commerce" at a later date. 15 U.S.C. § 1051(b)(1); see H.R. Rep. No. 100-1028 ("House Report"), at 8-9 (1988). ("By permitting applicants to seek protection of their marks through an 'intent to use' system, there should be no need for 'token use' of a mark simply to provide a basis for an application. The use of the term 'bona fide' is meant to eliminate such 'token use' and to require, based on an objective view of the circumstances, a good faith intention to eventually use the mark in a real and legitimate commercial sense."); J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition § 19.14, at 19.47-48 (4th ed. 2014) (McCarthy on Trademarks). *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1896-97 (Fed. Cir. 2015).

hardware music production device (portable DJ device) that combined a touch screen,⁹ analog hardware and proprietary software for music recording, production, mixing and other functions, packaged with a data transfer/power USB to mini USB cable,¹⁰ international power adapter and international tips and encased in velvet-type packaging. (36 TTABVUE 18-19, 26-27, 104).¹¹ Applicant and JD Sound entered into a formal partnership agreement in the summer of 2013 with regard to the portable DJ device. (36 TTABVUE 19). In 2013, during the period prior to entering into the formal partnership agreement and subsequent thereto, the parties discussed product development and modification of the portable DJ product, as well as branding the product as GO DJ/GODJ/G0-DJ.¹² (36 TTABVUE 20-23). Mr. Lee explained that Applicant and JD Sound identified different versions of the GO DJ mark that they would use to identify and advertise the portable DJ product: “[w]e also had two versions of it, “GODJ” as one word and “GO DJ” separated by a space, because when

⁹ Mr. Lee testified about the GO DJ video screen in connection with a YouTube video commercial: “... we also at the end used the new load -- screen loading shot...By that I mean you see a graphic representation of Monster and then the word -- the logo “GO DJ,” which appears underneath. That graphic animation is now used or ... is currently used as the load-up screen. When you turn your Monster GO DJ on, you see it say “Monster” and then the “GO DJ” logo appears.” (36 TTABVUE 66, 183; 37 TTABVUE 9, 12).

¹⁰ Mr. Lee testified regarding the “introductory” user manual. The user manual states: “You can connect the GO-DJ™ to an electric outlet by using an [sic] authentic GO-DJ™ power cables and adapters.” (36 TTABVUE 145). “You can connect the GO-DJ™ to a computer using the official GO-DJ™ USB file transfer cable.” According to Mr. Lee’s testimony, the USB cable can be used to power the GO DJ device and to transfer digital files for storage and play, including sound files, MP3s, WAV files, documents, and videos. (38 TTABVUE Confidential 10-11).

¹¹ The licensing agreement provided licensee JD Sound the right to use the Monster mark as well as the Monster GO DJ mark in exchange for a royalty to Applicant for each portable DJ unit sold. (36 TTABVUE 18-19).

¹² Hereinafter the GO DJ/GODJ marks will be referred to in the aggregate as “GO DJ.”

we discuss it online, we may -- either Monsters or third parties may spell it “GODJ” or “GO,” space, “DJ.”¹³ (36 TTABVUE 94).

Q. So Monster has used “GODJ” as one word as well as “GO DJ” with a space between the “GO” and the “DJ” --

A. Yes.

Q. -- to identify its -- and advertise its portable DJ product, correct?

A. Yes. (36 TTABVUE 94).

Q. ... Let's go back to when you changed the logo to add the play button. How do you think that someone perceives that play button? ...

A. ...And we -- we actually have different spellings of the word “GO DJ”: GO, space, DJ; GODJ as one word; as well as GO, hyphen, DJ. And different people spell it in different ways.

We didn't see the play button as something that would confuse a consumer specifically, but we did know that people may spell the word “GO DJ” differently, hence

¹³ The early versions of Applicant's and/or JD Sound's websites for the GO DJ product display the mark as GODJ, GO DJ, and GO-DJ. (36 TTABVUE 44-45; 36 TTABVUE 145-158; 36 TTABVUE 50; 36 TTABVUE 162-173). Examples include the following:

“GO DJ allows ample amount of songs in addition large high resolution files.” (36 TTABVUE 158).

“GODJ features: GO DJ is a completely standalone and all-in-one DJ system. ... GO DJ will allow anyone to take the party anywhere and anytime.” (36 TTABVUE 157).

“Delivery ... (If you buy Monster GO-DJ, you may qualify for FREE Shipping)” (36 TTABVUE 156).

“Monster Cable, a globally known audio and sound equipment company, is the licensing partner of JD Sound's Monster GODJ.” (36 TTABVUE 159).

internally we recognized the “GODJ” as one word, “GO DJ” with a space in between “GO” and “DJ” as well as “GO-DJ.”

Q. So when you’re talking about GO DJ in general, you’re including all three of those things?

A. Yes, usually, because different people spell it differently and we wanted to make sure that all those avenues were covered. (36 TTABVUE 102).¹⁴

Other activities Applicant and JD Sound jointly engaged in both before and after the filing of the GODJ and GO DJ trademark applications included branding the portable DJ system with the GO DJ name, creation of prototype product packaging, creation of an instruction manual, creation of a style guide regarding the Monster GO DJ logo, creation of various versions of the logo (phase one, and relaunch), participation in events such as sales launches, roadshows, domain name registration, creation of social media accounts and social media content on Facebook, Twitter, Instagram, and YouTube as well as preparation for and participation in the 2014 Consumer Electronics Show and the North American Music Merchants show in connection with the GO DJ branded product. (36 TTABVUE 20-23, 30, 32-33, 35, 42-43).¹⁵ Mr. Lee testified that most of 2013 was spent on preparations for marketing the GO DJ product, and a launch calendar was created and shared by Applicant and JD Sound’s marketing, sales and product development teams to identify key events to market the GO DJ product at as well as other opportunities. (36 TTABVUE 34,

¹⁴ Opposer has argued that Mr. Lee’s testimony is in the “aggregate” and does not distinguish the activity undertaken by Applicant in connection with both marks; however, as Mr. Lee clarified, he was referring to both GODJ and GO DJ when providing his testimony as a whole.

¹⁵ Many of these activities occurred between March 2013 through February 2014. (36 TTABVUE 22-73). Additional YouTube video content was created from 2013 through May 2015. (36 TTABVUE 73).

37).¹⁶ Applicant started talking to potential distributors in October 2013 regarding the GO DJ product. (36 TTABVUE 100). In late October 2013, press releases for events related to the GO DJ product were released, and in November 2013, a website and social media accounts for Facebook, Twitter, Instagram and YouTube were launched. (36 TTABVUE 35). Applicant created commercials for the GO DJ product that were uploaded to Applicant's YouTube channel in November 2013 and February 2014. (36 TTABVUE 66).

Between October 2013 through January 2014, the GO DJ product was provided in limited amounts by gift or purchase (at price or a discounted price) to celebrities and influencers, including technology reviewers.¹⁷ (36 TTABVUE 49, 50, 100, 101). Mr. Lee testified that headphones were bundled with the GO DJ product and displayed with the GO DJ mark for sales or marketing promotions. (36 TTABVUE 90). For example, during the Consumer Electronics Show, Applicant displayed the GO DJ device and headphones on a museum case with the GO DJ logo. (36 TTABVUE 88). Applicant also created a GO DJ portability campaign in 2014-2015 to show the portability of the GO DJ product, advertising the GO DJ product with a portable speaker branded with the GO DJ logo. (36 TTABVUE 91-92).

Opposer argues that the documentary evidence provided in connection with Mr. Lee's testimony is not contemporaneous with the filing of the applications for most or

¹⁶ The launch calendar in the record is for the period from October 27, 2013 to February 1, 2014. (36 TTABVUE 147).

¹⁷ At the 2015 and 2016 North American Music Merchants show the GO DJ product was displayed in a "curtained off" area for celebrities and industry professionals. (36 TTABVUE 116).

all of the goods as “by the time Lee was working for Monster, the contemporaneous period of time had already passed.” (35 TTABVUE 17). However, the fact that some actions were taken (e.g., launching of website and social media accounts) and documents were created after the trademark applications were filed is not dispositive. In *Lane Ltd.*, 33 USPQ2d at 1356, the Board found that documentary evidence created nine to eleven months after the application was filed to be sufficiently contemporaneous evidence of intent. “Neither the statute nor the Board’s decision in *Commodore Electronics* expressly imposes any specific requirement as to the contemporaneousness of an applicant’s documentary evidence corroborating its claim of bona [f]ide intention.” *Id.* In this case, the testimony and documentary evidence reflect activities related to the GO DJ and GODJ marks that occurred both before and after the August 2013 filing of the trademark applications. Mr. Lee’s testimony and the corroborating documentary evidence indicates that during 2013, both before and after filing the applications and while negotiating the partnership and licensing agreement for the portable DJ product, discussions began relating to branding the portable DJ system with the GO DJ name, creation of prototype product packaging, an instruction manual, a style guide regarding the Monster GO DJ logo, various versions of the logo (phase one, and relaunch), participation in events such as sales launches and roadshows, creation of social media accounts and content on Facebook, Twitter, Instagram, and YouTube, as well as preparation for the Consumer Electronics Show and the North American Music Merchants show. We find this

testimony and documentary evidence sufficiently identifies activities contemporaneous with the filing of the GODJ and GO DJ applications.

As evidenced by the testimony and documentary evidence, we find that Applicant had the capacity and experience needed to manufacture or otherwise offer all identified goods. Applicant developed concrete plans and took concrete actions for using the GO DJ/GODJ marks in connection with computer hardware, computer software and data cables. In particular, the record facts show that Applicant undertook product redesign, logo creation, creation of a style guide, design of a product manual, design of prototype packaging, creation of social media accounts and content, creation of a website and content, creation of marketing or promotional materials, preparation of marketing plans/calendar, marketing the goods at road shows and trade shows, providing a limited release of the portable DJ goods to influencers and celebrities,¹⁸ and communicating with prospective distributors in connection with the portable DJ device, with some of these activities taking place either before or after filing the trademark applications. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 n.5 (Fed. Cir. 2015) (product development, market research, manufacturing activities, promotional activities, steps to acquire distributors or other similar activities are objective evidence of

¹⁸ Opposer questions in his reply brief whether “seeding” i.e., limited distribution to celebrities and influencers of the portable DJ unit, is in the ordinary course of trade, and whether some of the identified goods (hardware, software and USB cable) are actual goods in trade. (40 TTABVUE 11). However, the nature of Applicant’s actual use in regards to limited placements, or whether the hardware, software and data cable are goods in trade are not issues that we need address in connection with the lack of bona fide intention to use the marks in commerce claim. *See* n.8 *supra*.

intent). Although Opposer argues that there is no evidence in the record of Applicant's intent to use the marks in connection with "transferable computer hardware or software" (36 TTABVUE 12), we find that the documentary evidence and testimony regarding the portable DJ device, which consists of computer hardware and proprietary software, packaged with a USB data cable, is sufficient objective evidence to establish Applicant's bona fide intention to use the GO DJ/GODJ marks in connection with computer hardware, computer software and audio and video cables.¹⁹

Opposer also argues that there is no evidence of Applicant's intent to use the marks in connection with cases (36 TTABVUE 12), speakers, or headphones (40 TTABVUE 11). But we find that testimony was not sufficiently developed by either Applicant or Opposer as to these goods and that Opposer did not meet his initial burden of establishing by a preponderance of the evidence that Applicant lacked an intent to use the marks on these goods.

With regard to speakers and headphones, Mr. Lee testified that Applicant and JD Sound were keen on bundling Applicant's Monster portable speakers and headphones with the GO DJ device. (36 TTABVUE 53). The documentary evidence and testimony also show that for sales or marketing promotions, Applicant created promotional displays of the GO DJ device with headphones or speakers and sometimes those

¹⁹ In his reply brief, Opposer appears to acknowledge that Applicant did have a bona fide intention to use the mark in commerce in connection with a portable DJ device. ("Monster has provided no explanation for why applications were filed for the list of goods when the only alleged intent was for a portable DJ unit."). (40 TTABVUE 11).

speakers and headphones were labeled with a GO DJ logo. (36 TTABVUE 53, 86-88, 90-92, 111).

On cross-examination, Opposer did not ask questions which fully explored Applicant's actual intent as to these particular goods. The testimony Opposer adduced regarding the speakers and headphones was as follows:

Q. Are there any headphones that say "GO DJ" on them and are sold as GO DJ headphones?

A. The -- we bundled the Monster GO DJ with Monster headphones; they were not considered GO DJ headphones, they were considered Monster headphones for use with DJ'ing activities.

Q. Okay. So you've never sold anything that's called a "GO DJ headphone"? (36 TTABVUE 106).

A. We may have skinned a headphone for promotional use, meaning we put the GO DJ logo on an already-existing headphone, but we have not created a separate Monster headphone and called it a GO DJ-branded headphone. (36 TTABVUE 107).

Q. Is this something [a speaker labeled with the Monster GO DJ logo] that the public could buy or is this something that was made up for the photo shoot?

A. From my recollection, this was made up for the photo shoot, because if you look at the -- if you look below the name "Monster GO DJ," you see actually the brand name of the speaker. So this speaker was probably used for the photo shoot and/or a live event to help with the brand -- visual branding of the Monster GO DJ. (36 TTABVUE 111).

Opposer's cross-examination was limited to whether GO DJ headphones and speakers were available for sale and was not directed to Applicant's intent to use GO DJ in connection with headphones or speakers. Additionally, after obtaining an initial

response from Mr. Lee as to the availability of the GO DJ speakers and headphones for purchase, Opposer did not elicit further testimony as to these goods nor did Opposer ask questions which fully explored Applicant's actual intent. Merely because Applicant may not have taken steps to actually produce and sell GO DJ headphones or speakers does not establish that Applicant otherwise had no intention to develop or market the product. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007). It is clear from Mr. Lee's testimony that Applicant had the capacity to manufacture and market headphones and speakers, having produced and sold them in the past under different Monster marks, which would weigh against a finding that Applicant lacked a bona fide intent to use the marks in connection with such goods. *Swatch AG (Swatch SA) (Swatch Ltd.) v. M. Z. Berger & Co.*, 108 USPQ2d 1463, 1477 (TTAB 2013) (citing *Wet Seal Inc.*, 82 USPQ2d at 1477), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015). Under the circumstances, the evidence falls far short of demonstrating by a preponderance of the evidence that Applicant lacked a bona fide intention to use the GO DJ and GODJ marks in connection with headphones and speakers.

As for cases for consumer electronics products, as we stated previously, Applicant's discovery responses are not particularly probative to establish by a preponderance of evidence that no documentation exists for these goods. Opposer did not cross-examine Mr. Lee regarding Applicant's intent to use the GO DJ/GODJ marks on consumer

electronic cases²⁰ nor did Opposer ask Mr. Lee whether Applicant had any documentary evidence relating to these particular goods. Opposer has not met his initial burden of demonstrating by a preponderance of the evidence that Applicant lacked documentary evidence regarding Applicant's bona fide intention to use the mark in connection with cases for consumer electronics.

Opposer also argues that Applicant has a "strong and repeated pattern" of filing intent to use applications for marks and then abandoning them at the statement of use stage, pointing to TSDR printouts (submitted by way of notice of reliance) showing Applicant's abandoned intent-to-use applications (32 TTABVUE 78-101; 33 TTABVUE 3-83) as evidence of a lack of bona fide intent. Applicant's filing and subsequent abandonment of prior applications is not persuasive of a different result. *Cf. L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1443-44 (TTAB 2012). The other applications, filed in 2009, 2010, 2011, 2012, were for different marks and/or different goods than those involved here or were abandoned after a final office action or suspension. We find this evidence to have minimal probative value on Applicant's bona fide intent at the time of filing the GO DJ and GODJ trademark applications in 2013 for computer software and hardware for music mixing; audio and video cables; cases for consumer electronic products; audio speakers and headphones. Indeed, an applicant can file more than one intent-to-use application covering the same goods or services and still have the requisite bona fide intention to use each mark. *Commodore*

²⁰ Based on Mr. Lee's testimony regarding the packaging of the goods, (36 TTABVUE 27), Applicant has argued that the GO DJ marks are shown on the "cases that contain the portable DJ system." (39 TTABVUE 21, 22).

Electronics, 26 USPQ2d at 1506 n.7 (quoting S. Rep. No. 100-515, 100th Cong. 2d Sess. at 24-25 (1988)).

Considering the evidence as a whole, we find that Opposer has not demonstrated by a preponderance of the evidence that Applicant lacked a bona fide intention to use the marks in connection with any of the identified products.

Decision: The opposition grounded on Applicant's alleged lack of bona fide intent to use the applied-for marks GO DJ and GODJ is dismissed.