This Opinion is Not a Precedent of the TTAB

Mailed: April 11, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Verde Ridge Homeowners Association, Inc.

v.

Bonnie Alicea

Opposition No. 91225523

Kevin Markow of Becker & Poliakoff PA,
for Verde Ridge Homeowners Association, Inc.

Anthony M. Verna, III, of Verna Law PC,
for Bonnie Alicea.

Before Wellington, Adlin and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Bonnie Alicea ("Applicant") seeks registration on the Principal Register of the mark VERDE RIDGE in standard characters for the following services:[1]

[1] Application Serial No. 86499294 was filed on January 9, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) based on an alleged bona fide intention to use the mark in commerce. The application contains the statement "The English translation of the word VERDE in the mark is GREEN."

> Advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes, in International Class 35.

Verde Ridge Homeowners Association, Inc. ("Opposer") opposes registration of the applied-for mark on the following grounds: (1) the application is void because Applicant lacked the requisite bona fide intention to use the mark in commerce at the time the application was filed; (2) priority and likelihood of confusion with Opposer's previously-used VERDE RIDGE mark; (3) fraud; and (4) misuse of the federal registration symbol with an intent to deceive others.[2] Opposer specifically alleges that it is "a homeowners association responsible for maintaining, operating and managing a residential community name 'Verde Ridge,'" and "the sole owner of [the mark VERDE RIDGE] for services pertinent to and/or otherwise associated with the management, maintenance, advertising, promotion, and operation of [Opposer's homeowners association] and its membership."[3]

Applicant filed an answer denying the salient allegations.[4] The parties have briefed this opposition proceeding.[5]

I. The Record

Opposer filed the testimonial declarations, with accompanying exhibits, of current or former members of Opposer's board: Teresa Bhoj, Amanda Dierking, Chris

[2] 1 TTABVUE (notice of opposition); see also 13 TTABVUE (Board order addressing a motion to dismiss filed by Applicant and discussion of grounds properly pleaded by Opposer).

[3] 1 TTABVUE 3-4.

[4] 14 TTABVUE.

[5] 39, 46 TTABVUE (Opposer's main and rebuttal briefs); 42 TTABVUE (Applicant's brief).

Burgess, and Karen Wonsetler, Opposer's general counsel.[6] Opposer also filed under notice of reliance copies of the following: a printout from Applicant's website and Applicant's responses to Opposer's requests for admissions and interrogatories.[7]

Applicant filed her own testimonial declaration, with accompanying exhibits including copies of Opposer's responses to Applicant's discovery requests.[8]

II. Brief Background

Opposer is a homeowners association for a community known as "Verde Ridge" that comprises approximately 400 homes in Clermont, Florida. Applicant has been a resident of the Verde Ridge community since approximately 2012. Shortly after moving into the community, an acrimonious relationship developed between Applicant and various members (or former members) of Opposer's board of directors. In December 2014, the month before Applicant filed the involved application, Applicant filed a petition with a Florida regulatory agency alleging fraud in connection with a November 2014 election for Opposer's board of directors.[9] In February 2015, Applicant filed a second similar complaint involving the same election

[6] 26 TTABVUE 10-541.

[7] Pursuant to a Board order (31 TTABVUE), the following materials submitted under this notice of reliance were stricken and are not of record: exhibit 2c of the testimony declaration of Amanda Dierking (26 TTABVUE 63-66, comprising website printouts) and copies of letters (26 TTABVUE 543- 50). Although Opposer was allowed time to resubmit these materials, it filed a response (33 TTABVUE) acknowledging the Board order and stating it would not be doing so. One of the letters was already properly made of record as an exhibit to the Burgess declaration (Burgess Dec. Ex. B; 26 TTABVUE 468-470).

[8] 34 TTABVUE. Applicant also filed (redundantly) copies of the same exhibits that were attached to her declaration under notice of reliance. (35 TTABVUE).

[9] 26 TTABVUE (Wonstetler Dec. ¶¶ 19-21, Exs. I, J and K).

with the same agency.[10] Ultimately, both complaints were dismissed and Applicant was ordered to pay Opposer's fees and costs for the case, because Opposer "had to defend two frivolous petitions for arbitration."[11]

While the record includes evidence of irrelevant conversations between Applicant and members of Opposer's board of directors, including personal insults and disputes over non-trademark issues, and Applicant's complaints with the Florida regulatory agency are also irrelevant here, the parties' history and relationship nevertheless provides important insight into and context for this dispute. Specifically, we find it very relevant that on the same day Applicant filed the involved application, she sent a "cease and desist" letter addressed to Chris Burgess, a member of Opposer's board of directors, and other individuals, regarding use of "Verde Ridge" in connection with "social media services."[12] In this letter, Applicant incorrectly states "Please be advised that 'Verde Ridge' is a registered trademark (U.S. Registration No. 86499294) of our business," and then demands that Mr. Burgess (and others) "cease and desist the use of the trademark 'Verde Ridge,' or any confusing[ly] similar trademark…"[13] Applicant acknowledges sending the letter but explains that she has "not sent any cease-and-desist letters after retaining counsel in order to understand trademark law better."[14]

[10] *Id.*

[11] *Id.* (Ex. K at p. 6).

[12] 26 TTABVUE 433; Burgess Dec. Ex. B (copy of letter).

[13] *Id.*

[14] 34 TTABVUE 7 (Alicea Dec. ¶ 27).

III. Standing and Priority

A threshold issue in each inter partes case is the plaintiff's standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010).

In this case, Opposer has established its standing through the testimony, with related exhibits, of its witnesses who have averred that Opposer uses the name VERDE RIDGE to identify and advertise the community.[15] At least one of these witnesses, Mr. Burgess, averred that he was appointed to Opposer's board of directors in 2014 and, as discussed supra, he very shortly thereafter received the aforementioned cease and desist letter from Applicant.[16] This establishes that Opposer possesses a real interest in the proceeding beyond that of a mere intermeddler, and has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988).

IV. Lack of Bona Fide Intent to Use

Our primary reviewing court has made it clear that "[b]ecause a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under Section 1(b), the lack of such intent is a basis on which an opposer may challenge an applicant's mark." *M.Z. Berger & Co. v. Swatch AG*, 787

[15] 26 TTABVUE.

[16] 26 TTABVUE 429, 432-33, and Ex. B (copy of letter from Applicant).

F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). Applicant's intent must be "firm," "demonstrable" with "objective evidence of intent" and "more than a mere subjective belief." *Id.* at 1897-1898; *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008 (TTAB 2015).

We must make an objective determination whether Applicant had a bona fide intention to use the mark in commerce at the time of filing her application, and, in doing so, consider the totality of the circumstances. *See M.Z. Berger & Co.*, 114 USPQ2d at 1898; *Swiss Grill Ltd.*, 115 USPQ2d at 2008. Opposer bears "the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified" services. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). Opposer may meet this burden by establishing that there is an "absence of any documentary evidence on the part of [Applicant] regarding such intent." *Commodore Electronics Ltd. v. CMB Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

If Opposer meets its burden, Applicant may "elect to try to rebut the opposer['s] prima facie case by offering additional evidence concerning the factual circumstances bearing upon [her] intent to use [her] mark in commerce." *Commodore Electronics Ltd.*, 26 USPQ2d at 1507 n.11. However, Applicant's "mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce." *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

Opposer points out that "[d]uring discovery, Applicant failed to produce any evidence or documentation of her actually conducting a business under the name Verde Ridge."[17] Opposer further notes that Applicant's only "use" of the mark "has been to send cease-and-desist letters to various residents of the Verde Ridge Community threatening legal action against them for their own use of the VERDE RIDGE mark within and related to the Community (including on social media)."[18]

In response, Applicant does not dispute that she did not produce any relevant documentary evidence which would tend to show that she had a bona fide intent to use the mark in commerce at the time of filing the application. Rather, Applicant merely states that she is "a highly educated, highly experienced advertising professional."[19] In her declaration, Applicant avers as to her educational background and work experience.[20] In particular, she states that she has owned Project Change Consultants, LLC for 5 years and that this company has "20-30 Fortune 500 companies as clients."[21] Applicant further argues in her brief that she started the

[17] 39 TTABVUE 7.

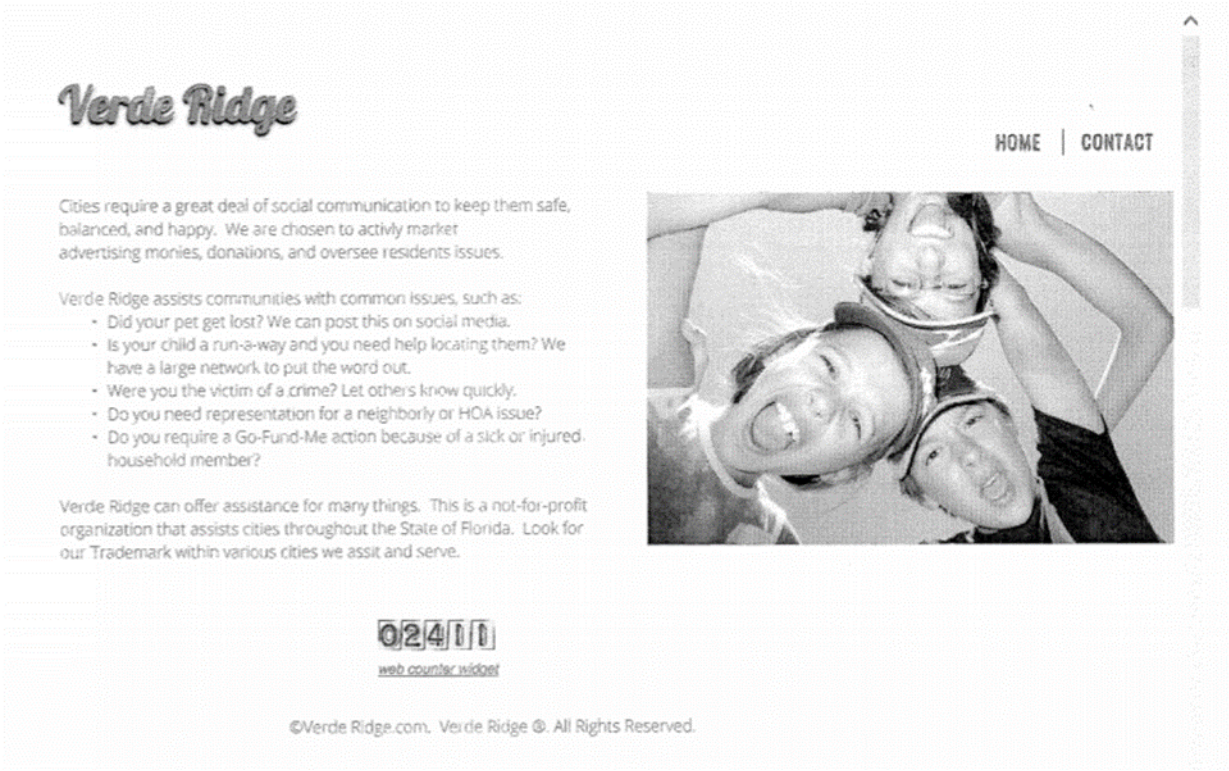
[18] *Id.*

[19] 42 TTABVUE 15.

[20] 34 TTABVUE. Applicant states she holds an undergraduate degree in "applied behavioral science" and a graduate degree from National Louis University, and she holds a PhD from Capella University in the field of "industrial and organizational psychology." Alicea Dec. ¶¶ 7-8.

[21] Id.; ¶¶ 16-17.

website www.verderidge.com and then "pulled back with the opposition filed."[22] A printout from this website, submitted by Opposer, appears as follows:[23]



Upon review of the entire record and based upon the totality of the circumstances, especially Applicant's concession that she has no documents tending to show a bona fide intent to use, and failure to provide any such documents, we find that a prima facie case has been established that Applicant did not have a bona fide intention to use the mark VERDE RIDGE in connection with the advertising, marketing and promotional services identified in the application, at the time the application was filed. Moreover, Applicant has not rebutted this prima face showing.

[22] 42 TTABVUE 15.

[23] 26 TTABVUE 542.

In her declaration, comprising fifty paragraphs, Applicant makes the conclusory, entirely subjective claim that she had a bona fide intent to use the mark in commerce; however she provides neither information nor documents regarding steps she allegedly took at the time of filing the application to support this subjective, purported intent. Applicant does not explain why there is no documentation, such any business plans, or that she made any attempts to contact prospective clients, or anything else that a marketing service provider would likely do in preparation for offering services under a mark. Even if we conclude that Applicant is competent to render the services described in the application, based on her testimony regarding her education and work experience, this does not mean that she possessed an actual intent to render the services under the applied-for mark at the time of filing the application.

We also note Applicant's responses to interrogatories include:[24]

> 13. For each good or service which you have ever offered under the mark VERDE RIDGE or which you intend to offer under the mark VERDE RIDGE, identify all permits, licenses, authorizations, or other approvals applied for by you or issued to you (or to any entity which you own or control) by any governmental body (federal, state, or local) for purposes of allowing or approving the same. As to each permit, license, authorization, or approval, identify the particular governmental agency issuing same, the date or dates on which it was issued, and the particular activity that was being authorized.
>
> Answer: None.
>
> 18. Identify each name, logo, or other symbol (including the VERDE RIDGE mark presently at issue) for which you ever made application for trademark registration (federal or state). As to each such name, logo, or other symbol, separately state (i) whether you ever ordered, made, or

[24] 26 TTABVUE 566-567.

> caused to be made any search, inquiry, or investigation concerning the use or registration of such name, logo, or other symbol by third parties …
>
> Answer: Only the application has been considered. (i) None. …

While these discovery responses, by themselves, would not be sufficient to show that Applicant lacked the requisite bona fide intent to use the mark at the time of filing, they are another "piece of the puzzle" surrounding Applicant's intent, and supports our finding that it was not bona fide.

As to the printout from the website, www.verderidge.com, this page was submitted by Opposer and accessed on October 11, 2017, over 2.5 years after the application was filed. In any event, Applicant scarcely mentions the website in her declaration, only once referencing it to state that she has removed the federal registration symbol.[25] Pointedly, she does not testify or provide any other evidence regarding how this website furthered her interest in rendering the services identified in the application under the VERDE RIDGE mark. More importantly, the services mentioned in the printout are described, in part, as "assist[ing] communities with common issues, such as: Did your pet get lost? We can post this on social media. Is your child a run-a-way [sic] and you need help locating them [sic]? We have a large network to put the word out. …" These types of services are more akin to providing a neighborhood

[25] 34 TTABVUE (Alicea Dec. ¶ 26). Specifically, Applicant avers "While I had one use of the R-in-a-circle federal registration symbol at the bottom of the webpage at verderidge.com, that has been removed." Attached as Ex. A to the declaration is another printout from the website; however, it merely shows a picture of children without "Verde Ridge" or any other wording.

information service and unrelated to marketing, promotion or the other services identified in the application.

In sum, we have considered all relevant circumstances in arriving at our objective determination that Applicant lacked the requisite bona fide intent to use the mark VERDE RIDGE in commerce when the application was filed. Any inference we can draw based on Applicant's testimony regarding her education and capacity to render the services identified in the application is greatly outweighed by Applicant's failure to provide any documents or other objective evidence of such a bona fide intention. In addition, we have considered the context and events surrounding the filing of the application, including Applicant's cease and desist letter dated the very same day as the involved application's filing date. The letter contains false claims that Applicant owns a registration. While a cease and desist letter is generally viewed as an effort to protect rights in an existing mark, this letter appears to be merely a continuation of Applicant's non-trademark dispute with the Verde Ridge residential community.

Accordingly, because Applicant did not have a bona fide intent to use the mark VERDE RIDGE in connection with the identified services when she filed the intent-to-use application, the application is void ab initio.[26]

Decision: The opposition is sustained.

[26] In view of our determination that the application is void ab initio, we need not reach a decision on the remaining grounds of likelihood of confusion, misuse of the Federal registration symbol with an intent to deceive, or fraud. *See Multisorb Tech., Inc. v. Pactiv Corp.,* 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim).