

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: November 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*BioWorld USA Inc.*

*v.*

*Advanced BioTech LLC*  
—

Opposition No. 91236811  
—

Peter Sean Bradley of the Law Office of Peter Sean Bradley,  
for BioWorld USA Inc.

Paul A. McLean of Greenberg Traurig LLP,  
for Advanced BioTech LLC.

—  
Before Mermelstein, Lynch, and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Advanced BioTech LLC, filed an application to register the mark  
BIOWORLD, in standard characters, for the following goods in International Class

1:

Chemical and biological goods, supplies and commercial product formulations, namely, specially formulated chemical, biological and odor neutralizing compounds for the treatment, mitigation, cleanup and bioremediation of oils, algae, odors, and organic wastes, and bioenhancement and augmenting compounds associated with the

growth and production of bacterial and microbial cultures and plant life and the addition of naturally occurring microorganisms for use and application in the environmental cleanup of oil spills, cleanup of contaminated soils, solid wastes, sludge, fresh water, brackish water, salt water, wastewater, and air.

Opposer, BioWorld USA Inc., filed a Notice of Opposition opposing registration of the Application on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act with the mark BIOWORLD PRODUCTS used in connection with “chemical compounds that are used to treat wastewater treatment facilities, septic tanks, oil spills, pet food and agricultural soil” at common law, and with the mark BIOWORLD PRODUCTS in Registration No. 3947172 owned by a third-party as the owner’s licensee.<sup>1</sup>

---

<sup>1</sup> 1 TTABVUE. Opposer also pleaded grounds of deceptiveness under Section 2(a) of the Trademark Act, fraud on the USPTO, and “corporate powers suspended,” which we dismiss forthwith. Opposer did not plead the elements of a Section 2(a) claim, or present any evidence or argument related to that claim; Opposer merely checked off the 2(a) deceptiveness ground on the Notice of Opposition cover sheet.

Opposer’s pleaded fraud claim is based on Applicant’s alleged “fail[ure] to inform the Patent and Trademark Office of the true facts concerning” the actual address of the third-party owner of Registration No. 3947172, the registration Opposer relied on as a licensee. That registration is not the subject of this proceeding, and such alleged facts, even if taken as true, do not constitute fraud. Opposer in its brief argues a different set of facts giving rise to a purported fraud claim, possibly in the procurement of the present application. However, the new factual basis for fraud was not pleaded, nor was it tried by consent. In all averments of fraud, the circumstances constituting fraud shall be stated with particularity. *See, e.g., King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (“While [Fed. R. Civ. P.] Rule 9(b) does not require the pleading of detailed evidentiary matters, we agree with the board that appellant has not stated with sufficient specificity the factual bases for its allegations of appellee’s fraudulent misrepresentation to the PTO ... Rule 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud”). The fraud claim is dismissed.

Opposer’s further claim that “Applicant lacked the corporate power to file the application” due to suspension of its corporate status in California, 1 TTABVUE 6 (Notice of Opposition, ¶ 16), was not argued at trial, so it is deemed waived. It would have been moot in any event because Applicant provided evidence showing reinstatement of its corporate status and good standing. 24 TTABVUE 8-9, 57-58 (Dale’s Decl., ¶ 22, Exhibit P). Under California law, a

Applicant denied the salient allegations in its answer to the notice of opposition.<sup>2</sup> In addition, Applicant asserted various “affirmative defenses,” including failure to state a claim upon which relief may be granted; lack of standing to oppose; laches, estoppel, acquiescence, waiver, fraud, mistake, unclean hands; and opposition barred through a prior judgment in and the cancellation of U.S. Trademark Registration No. 3947172 for BIOWORLD PRODUCTS. All of these asserted defenses are either not proper affirmative defenses, are improperly asserted, or are mere amplifications of its denials.<sup>3</sup>

---

corporation’s good standing operates retroactively. *Cahill v. San Diego Gas & Elec. Co.*, 124 Cal. Rptr. 3d 78 (Ct. App. 2011).

<sup>2</sup> 4 TTABVUE.

<sup>3</sup> Failure to state a claim upon which relief must be granted is not an affirmative defense. *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (“The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer’s claim rather than a statement of a defense to a properly pleaded claim.”). Because Applicant neither filed a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) during the pretrial phase of this proceeding, nor argued this purported affirmative defense in its briefs, it is deemed waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1752 n.6 (TTAB 2013).

Lack of standing is also not an affirmative defense. Inasmuch as Opposer must prove its entitlement to bring a statutory cause of action as a threshold matter in order for its claims to be heard, *see Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), Applicant’s assertion that Opposer lacks standing will be construed as an amplification of its denials of the salient allegations of the notice of opposition.

Applicant’s asserted defenses of laches, estoppel, acquiescence, waiver, fraud, mistake, and unclean hands are conclusory statements lacking a factual basis and specific alleged misconduct on the part of Opposer. *See e.g., Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (“respondent’s ... defense does not include allegations that state a defense of unclean hands. There are no specific allegations of conduct by petitioner that, if proved, would prevent petitioner from prevailing on its claim; instead, the allegations ... are either unclear, non-specific, irrelevant to a pleading of unclean hands, or merely conclusory in nature.”). Further, the affirmative defenses of laches and acquiescence are inapplicable in opposition proceedings. *See Nat’l Cable Television Ass’n Inc. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Moreover, Applicant did not present evidence in support of these asserted defenses and presented no

We dismiss the Opposition.

## I. The Record

The record includes the pleadings, the file of the opposed application pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following submissions by the parties:

**A. Opposer's Evidence:** Testimony declaration of Diane Barnes ("Diane's Decl.") with exhibits;<sup>4</sup> Rebuttal testimony declaration of Diane Barnes ("Diane's Rebuttal Decl.") with exhibits;<sup>5</sup> Rebuttal testimony declaration of Dan Damschen ("Damschen Decl.");<sup>6</sup> and Rebuttal testimony declaration of Opposer's attorney, Peter Bradley ("Bradley Decl.").<sup>7</sup>

**B. Applicant's Evidence:** Testimony declaration of Dale Barnes ("Dale's Decl.") with exhibits;<sup>8</sup> and Testimony declaration of Applicant's attorney, Paul McLean ("McLean Decl.") with exhibits.<sup>9</sup>

## II. Preliminary Issues

Applicant raised numerous objections to Opposer's testimony and evidence,<sup>10</sup>

---

argument regarding them at trial, so in any event, they are deemed waived. *See, e.g., Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013) (affirmative defense of unclean hands deemed waived because applicant failed to argue and present evidence regarding the defense at trial).

Finally, with respect to the purported affirmative defense claiming the action is barred further to a final judgment regarding the purported cancellation of U.S. Trademark Registration No. 3947172 for BIOWORLD PRODUCTS, apart from providing no factual basis for the alleged defense, the registration was cancelled for failure to file the required maintenance documents and Applicant (as petitioner in that proceeding) later withdrew its cancellation petition. The cancellation proceeding was dismissed without prejudice as moot.

<sup>4</sup> 10 TTABVUE.

<sup>5</sup> 26 TTABVUE 2-102.

<sup>6</sup> 26 TTABVUE 103-105.

<sup>7</sup> 31 TTABVUE.

<sup>8</sup> 24 TTABVUE.

<sup>9</sup> 23 TTABVUE.

<sup>10</sup> 29 TTABVUE 43-70 (Applicant's Brief).

which we discuss here before turning to the merits in this case.

**A. Objections to the Testimony Declaration of Diane Barnes & Exhibits**

Opposer's first set of objections are directed to the testimony declaration of Opposer's witness, Diane Barnes. Noting that pages 2–4 are missing from that declaration as filed by Opposer during its testimony period, Applicant requests that the Board disregard in their entirety those pages and the supporting exhibits referenced by those missing pages (Exhibits A–M).<sup>11</sup>

Opposer, with its reply brief, filed the declaration of its counsel, Peter Bradley, who attaches a complete copy of the five-page declaration with exhibits and the following explanation and requests that we accept the corrected copy:<sup>12</sup>

2. In April of 2019, I prepared a declaration for Diane Barnes in the present case. A true and correct copy of the declaration that I prepared is attached hereto as Exhibit A.

3. I intended to file the declaration attached as Exhibit A but I inadvertently and unknowingly filed a declaration that somehow omitted pages 2 through 4.

4. Within a few weeks of filing Diane Barnes' declaration, action on the case was suspended while the parties discussed mediation and went through mediation.

5. In October 2019, I was contacted by Applicant BioTech LLC's counsel and told that the declaration we had served on them omitted pages two through 4. At their request I served the complete declaration of Diane Barnes on or around October 22, 2019. A true and correct copy of the declaration I served at that time is attached as Exhibit B.

6. Attached hereto as Exhibit C is a true and correct copy of the email thread constituting the communications concerning the declaration with the omitted pages and my sending of the correct declaration.

---

<sup>11</sup> *Id.* at 46.

<sup>12</sup> 31 TTABVUE.

7. I did not know that a flawed declaration had been served on Advanced BioTech LLC's counsel.

8. I also did not know that the same flawed declaration had been filed with the Patent and Trademark Office until I read Advanced BioTech LLC's counsel's Objections to Evidence.

9. Since both Advanced BioTech LLC's counsel and I have the correct and complete declaration, I request that the correct and complete declaration attached hereto as Exhibit A be accepted in lieu of the incorrect and incomplete declaration accidentally filed.

Generally speaking, “[e]vidence which should constitute part of an opposer’s case in chief, but which is made of record during the rebuttal period, is not considered when the applicant objects.” *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1977 (TTAB 2010). However, this is not the typical situation involving a party’s attempt to introduce evidence on rebuttal that should have been provided with its case-in-chief. Rather, it appears to have been caused by a careless, albeit inadvertent, error on the part of Opposer’s counsel when the declaration was scanned and submitted.

Applicant’s counsel notified Opposer’s counsel on October 19, 2019 that several pages were missing from the service copy of Ms. Barnes’ declaration.<sup>13</sup> Opposer’s counsel then served a complete copy of the declaration on October 22, 2019.<sup>14</sup> Apparently, Opposer’s counsel did not realize that (nor did he check to see if) the copy he had filed with the Board on April 5, 2019 was also flawed. He therefore did not move to reopen Opposer’s testimony period to correct this deficiency.

---

<sup>13</sup> *Id.* at 83 (Exhibit C).

<sup>14</sup> *Id.* at 81.

Following Opposer's defective filing of the declaration, this proceeding was suspended for approximately 11 months until March 2020 when it resumed. Applicant waited until briefing to note this problem. "As a general matter, objections which can be cured must be raised when the testimony or other evidence is offered." *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009) (citing *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1264 (TTAB 2003) ("If a party objects on procedural grounds to testimony ... the objecting party should promptly file a motion to strike the testimony or notice of reliance; and failure to do so will generally result in a waiver of the procedural objection.")). Had Applicant raised this issue promptly, Opposer would have likely moved to reopen its testimony period to correct its filing which, under the circumstances, the Board would likely have allowed.

Although parties are responsible for the accuracy of their electronic filings, *see e.g., Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements"), we find that the circumstances here arose from an inadvertent error that was harmless to Applicant. All of the documents attached to Ms. Barnes' declaration were provided to Applicant and the Board with Opposer's original filing of April 9, 2019. And the complete declaration (with the previously missing three pages) was provided to Applicant on October 22, 2019, more than 5 months prior to Applicant's own testimony. Applicant suffered no prejudice from this inadvertent error.

In light of the foregoing (no objection by Opposer, no prejudice to Opposer or

burden to the Board, and no bad faith), we overrule Applicant's objection and will accept the full declaration provided with Opposer's counsel's reply declaration as the operative testimony declaration of Ms. Barnes. Fed. R. Civ. P. 6(b)(1)(B); *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1585-86 (TTAB 1997).

### **B. Objections to Rebuttal Evidence**

Applicant's second set of objections are directed to "sections of the rebuttal declarations of [Opposer's witnesses] Diane Barnes and Dan Damschen and the exhibits attached thereto regarding Dale Barnes' Workers Compensation case and/or disability as they constitute improper rebuttal."<sup>15</sup> "It is axiomatic that rebuttal testimony may be used only to rebut evidence offered by the defendant." *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1958 (TTAB 2008). The function of rebuttal evidence is "to explain, repel, counteract, or disprove the evidence of the adverse party." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 116 USPQ2d 1869, 1883 (Fed. Cir. 2015).

According to Applicant, "these facts and exhibits plainly relate to facts that should have been introduced as part of [Opposer's] case-in-chief," and Applicant's opportunity to rebut that evidence "was foreclosed because [Opposer] withheld the evidence until its rebuttal declarations, a vehicle fairly limited to denials, refutations or explanations of Applicant's testimony and evidence."<sup>16</sup>

Opposer, in response, argues that its witnesses' testimony about Dale Barnes'

---

<sup>15</sup> 29 TTABVue 43 (Applicant's Brief) (objections to ¶¶ 18, 20, 22-24, 29-30, and exhibits H-I, M, Q of Diane Barnes' rebuttal declaration; ¶ 5 of Dan Damschen's rebuttal declaration).

<sup>16</sup> *Id.* at 45.



disability (1) “contradicts, defuses or impeaches Dale’s claim that he had ‘continued to work in tandem’ and ‘worked hard over the years to grow the brand’ and grew the brand ‘all under his supervision’; (2) “contradicts, impeaches or explains Dale’s testimony that Don Damschen incorporated an allegedly competing company “unbeknownst” to Dale because, namely, Dale wasn’t around”; and (3) “impeaches or explains the true facts relative to Dale’s statement that “[Applicant] sells its products to agricultural, commercial, governmental and residential customers throughout the United States and worldwide. I have been involved in this business continuously for more than 32 years, beginning in 1987.”

We view Opposer’s rebuttal testimony and documentary evidence as a reasonable attempt to deny, explain or otherwise discredit the testimony of Mr. Barnes as it relates to Mr. Barnes’ claims referenced above and therefore will not exclude the evidence as improper rebuttal. On the other hand, the referenced claims are not outcome determinative; we accord the evidence whatever probative value it merits.

### **C. Applicant’s Remaining Objections**

Applicant’s final set of objections based on hearsay, relevancy, improper opinion testimony, lack of foundation, authentication, and similar objections, are overruled. Because an opposition proceeding is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding such testimony and evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that we cannot rely on the evidence in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so,

we have kept in mind Applicant’s objections and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1542, 1540 (TTAB 2006); *Poly-Am., L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) (where the objections refer to probative value rather than admissibility and the evidence that is subject to the objections is not outcome determinative, “we choose not to make specific rulings on each and every objection”).

### **III. Background and Findings of Fact**

Dale Barnes (the President of Applicant)<sup>17</sup> and Diane Barnes (the Administrative Manager of Opposer),<sup>18</sup> a formerly married couple, are two of the main characters in this trademark dispute, which follows the story of a marriage that went awry.<sup>19</sup> Over several decades and during the course of their marriage prior to this dispute, Dale and Diane created a number of different corporate entities, sometimes together and sometimes individually and for varying purposes. Now, years later and following the dissolution of their marriage, Dale and Diane – as witnesses for the respective parties at odds in this proceeding – provide different tales regarding the purposes and activities of those companies, and the respective rights they and their companies had in the mark BIOWORLD. Having carefully reviewed the record, we conclude that as

---

<sup>17</sup> 24 TTABVUE 2 (Dale’s Decl., ¶ 1).

<sup>18</sup> 31 TTABVUE 5 (Diane’s Decl., ¶ 1).

<sup>19</sup> We will refer to them herein by their first names for ease of reference, as the parties do, since they both maintain the same surname.

often happens, the truth lies somewhere in between.

**A. Dale’s Activities Prior to Diane’s Involvement**

The Barnes family lived in Oklahoma in the 1980s.<sup>20</sup> In 1987, “Dale devised the product formulations that would become the MULTIFIX soil and crop enhancement product and the first line of BIOWORLD PRODUCTS,” which were intended to combine “beneficial, naturally-occurring microbes with a balance of nutrients that would clean up environmental wastes more efficiently, more quickly, and at a far lower cost than traditional clean-up methods.”<sup>21</sup>

“Sometime before 1988,” Dale had taken a position with a Kansas company to sell agricultural products,<sup>22</sup> so he already had some experience with the agricultural sales market. In 1988, Dale “developed two new specialized products primarily for the agricultural market, marketed as BIOWORLD Wastewater and Septic Treatment and BIOWORLD Dairy Wastewater Treatment.”<sup>23</sup>

To develop a market for his goods, Dale began to divide his time between Tulsa, Oklahoma and Visalia, California.<sup>24</sup> In late 1988, he incorporated a California company called Western Biotech Products, Inc. “for the purpose of manufacturing and distributing MULTIFIX and BIOWORLD PRODUCTS bioremediation<sup>25</sup> products to

---

<sup>20</sup> 26 TTABVUE 3-3 (Diane’s Rebuttal Decl., ¶ 3).

<sup>21</sup> 24 TTABVUE 3 (Dale’s Decl., ¶ 3).

<sup>22</sup> 26 TTABVUE 3 (Diane’s Rebuttal Decl., ¶ 3).

<sup>23</sup> 24 TTABVUE 3 (Dale’s Decl., ¶ 5).

<sup>24</sup> *Id.* (¶ 4).

<sup>25</sup> “Bioremediation” is the “use of biological agents, such as bacteria or plants, to remove or neutralize contaminants, as in polluted soil or water.” The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *In re*

customers in California and other states.”<sup>26</sup> In early 1989, he incorporated an Oklahoma company called BioWorld Products, Inc. “for the purpose of manufacturing, blending, marketing and distributing both MULTIFIX and BIOWORLD PRODUCTS bioremediation products to customers in Oklahoma, Kansas, Missouri, Texas and other nearby states.”<sup>27</sup>

### **B. Dale and Diane Begin Working Together**

In 1990, the Barnes family relocated to Visalia, California.<sup>28</sup> Dale and Diane then began working “together in the environmental field.”<sup>29</sup> How they worked together is a matter that they and the parties dispute. According to Dale, he and Diane established a new California company, BioWorld Products, “which targeted commercial and governmental sales in complement to Western Biotech Products targeting farmers and agricultural customers.”<sup>30</sup> He describes their working relationship as follows:<sup>31</sup>

Throughout the following years, Diane and I continued to work in tandem. I worked full-time on product research and testing, sales, marketing, regulatory compliance and more while Diane worked part-time on bookkeeping and ministerial tasks which allowed her to be home with our children as they were growing up. Our companies shared the same office space, the same warehouse, the same phone number, the same P.O. Box, and our desks were literally next to each other.

---

*Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). (<https://www.ahdictionary.com/word/search.html?q=bioremediation>)

<sup>26</sup> *Id.* at 3-4 (¶ 6).

<sup>27</sup> *Id.* at 4 (¶ 7).

<sup>28</sup> *Id.* (¶ 8).

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> 24 TTABVUE 4-5 (Dale’s Decl., ¶ 8).

Diane paints a somewhat different picture of her involvement with BioWorld Products in her rebuttal testimony. According to Diane:

I started BioWorld Products in approximately 1991 as its sole owner. I was involved in all aspects of BioWorld Products' operation including inventory, distribution, accounting and management. Although my work during the school year was part time, in the summer I worked full-time. On September 16, 1991, I filed a Fictitious Business Name Statement in Tulare County for BioWorld Product [*sic*] naming myself as owner and sole owner.<sup>32</sup>

Diane also obtained a California state trademark registration on February 4, 1992.<sup>33</sup>

In evaluating the above testimony, we keep in mind that the activities of the parties during time period, as well as the activities we describe occurring over the next decade or more, took place when the Dale and Diane were getting along. In addition, we note that Diane's clarification of her role comes in her rebuttal testimony. She was silent about her role during Opposer's case-in-chief. Regardless, apart from the characterization of Diane's role ("booking and ministerial tasks" versus "involved in all aspects of [the] operation including inventory, distribution, accounting and management") and her working hours ("part-time" versus part time during the school year, full time in the summer), the descriptions are not that different. It is clear that Dale and Diane, during this time period, depended on each other to handle their respective roles in managing the family businesses.

---

<sup>32</sup> 26 TTABVUE 3, 16-17 (Diane's Rebuttal Decl., ¶ 3, Exhibit C).

<sup>33</sup> 31 TTABVUE 6, 15-16 (Diane's Decl., ¶ 7, Exhibit C).

**C. Don Damschen Joins Advanced BioTech Inc.<sup>34</sup>**

In the summer of 1992, Dale changed the name of Western Biotech Products, Inc. to Advanced BioTech Inc.<sup>35</sup> In 1993, he met Don Damschen, the third main character in this dispute (and CEO of Opposer),<sup>36</sup> and subsequently hired him as a Vice President and Senior Project/Operations Manager.<sup>37</sup> Over the years, Dale “educated and trained Mr. Damschen in the environmental and bioremediation business.”<sup>38</sup>

**D. BioWorld Products Becomes BioWorld Products, LLC**

According to Dale, “on January 23, 1998, after consultation with our attorney and accountant for tax and business succession reasons to best protect my wife and children, Diane and I decided to formalize our BioWorld Products company as a limited liability company” in California.<sup>39</sup> “As the years went on, my wife Diane and I continued to work in tandem in our environmental and bioremediation business.”<sup>40</sup> Diane, for her part, is silent about the reason BioWorld Products was formalized as an LLC or why it was put in her name.

**E. Dale Establishes Applicant, and Don Damschen Returns to the “Advanced BioTech/BioWorld Products Family”**

“On December 7, 1999, Advanced BioTech Inc. filed for bankruptcy under Chapter

---

<sup>34</sup> Not to be confused with Applicant, Advanced BioTech, LLC.

<sup>35</sup> 24 TTABVUE 3-4 (Dale’s Decl., ¶ 6).

<sup>36</sup> 10 TTABVUE 59 (Damschen Decl., ¶ 1).

<sup>37</sup> 24 TTABVUE 5, 25 (Dale’s Decl., ¶ 9, Exhibit D).

<sup>38</sup> *Id.* at 5 (¶ 9).

<sup>39</sup> *Id.* at 5, 31-32 (¶ 10, Exhibit E).

<sup>40</sup> *Id.* at 6 (¶ 13).

7.”<sup>41</sup> Don Damschen left the company at that time.<sup>42</sup> On January 5, 2000, Dale formed Applicant (Advanced BioTech, LLC) in California, serving as its President up through the present time.<sup>43</sup> According to Diane, [w]ith income short after bankruptcy, [Dale] became an employee of BioWorld Products and was on payroll from 2002 – 2007.”<sup>44</sup> In 2005, Don Damschen approached Dale and asked him for a job once again.<sup>45</sup> He was then “hired by BioWorld Products LLC and returned to the ‘Advanced Biotech/BioWorld Products’ family.”<sup>46</sup>

#### **F. Transmutation of BioWorld Products, LLC**

In 2007, Dale and Diane signed the transmutation agreement shown below transmuting 100% of the personal property interests in BioWorld Products, LLC from the community property of both Dale and Diane to the separate property of Diane:<sup>47</sup>

---

<sup>41</sup> 24 TTABVUE 5 (Dale’s Decl., ¶ 11).

<sup>42</sup> *Id.* at 5 (¶ 9); 26 TTABVUE 103 (Damschen Decl., ¶ 3).

<sup>43</sup> 24 TTABVUE 5-6 (Dale’s Decl., ¶ 12). Diane notes that the incorporator, as shown on the articles of incorporation, was Mohammed Piraiegar, a friend of Dale. 26 TTABVUE 5 (Diane’s Rebuttal Decl., ¶ 17). Opposer argues, without evidence, that “Dale “used Mr. Piraiegar as a strawman because he was trying to hide his own involvement in [Applicant]” and had “a conscious desire to avoid the attention of the bankruptcy trustee.” 30 TTABVUE 9 (Opposer’s Reply Brief).

<sup>44</sup> 26 TTABVUE 5 (Diane’s Rebuttal Decl., ¶ 18).

<sup>45</sup> 24 TTABVUE 7 (Dale’s Decl., ¶ 16).

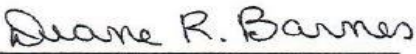
<sup>46</sup> 26 TTABVUE 103 (Damschen Rebuttal Decl., ¶ 5).

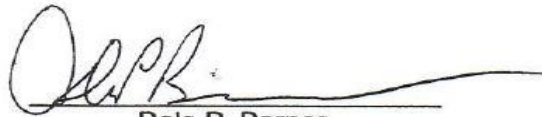
<sup>47</sup> *Id.* at 7, 18-19 (¶ 9, Exhibit E); 24 TTABVUE 6, 37-38 (¶ 13, Exhibit H). California is a community property state, which means that “all property, real or personal, wherever situated, acquired by a married person during the marriage while domiciled in [California] is community property.” Cal. Fam. Code § 760. However, couples in California may contract their respective property rights as they wish either pre-marriage, Cal Fam. Code § 1612, or post-marriage, *Hough v. Hough*, 26 Cal. 2d 605, 614, 160 P.2d 15, 17 (1945)). One such post-nuptial agreement is referred to as a transmutation agreement, which is enforceable under California law, under certain conditions, when it “is made, joined in, consented to, or accepted by the spouse whose interest in the property is adversely affected.” Cal. Fam. Code § 852.

**AGREEMENT TRANSMUTING CHARACTER  
OF PERSONAL PROPERTY**

Diane R. Barnes and Dale P. Barnes, husband and wife, agree that one hundred percent (100%) of the ownership interest in the business conducted by Diane R. Barnes under the trade name, BioWorld Products, LLC, is hereby transmuted from the community property of both spouses to the separate property of Diane R. Barnes. This agreement is not made in contemplation of a separation or dissolution.

Executed this 15 day of December, 2007, at Visalia, California

  
Diane R. Barnes

  
Dale P. Barnes

**G. Dale Establishes BioWorld Prime Source/BioWorld Engineering**

In 2008, Dale was involved in establishing, with his son-in-law, BioWorld Prime Source Inc. in California, which he refers to as Applicant's sister corporation, "to secure disabled service veteran contracts with government and commercial customers."<sup>48</sup> The company changed its name to BioWorld Engineering Inc. in 2011. According to Dale, that company "continuously used the BIOWORLD trademark on their products throughout the years 2008 to the present, all under my supervision."<sup>49</sup> Dale provided a number of invoices for the years 2014 – 2020 to corroborate use of the mark BIOWORLD by Applicant and BioWorld Engineering Inc. with the relevant goods.<sup>50</sup> Dale testified that at the time of his declaration, he owned 100% of BioWorld Engineering.

---

<sup>48</sup> 24 TTABVUE 6-7 (Dale's Decl., ¶ 6).

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 64-103 (Exhibit R).



### **H. Dale and Diane Separate**

Sometime in 2013, Dale and Diane separated.<sup>51</sup> “Although there was some tension during this period,” their respective companies, Applicant and BioWorld Products Inc. (which converted from an LLC in 2010) continued to work together.<sup>52</sup> Given their separation and, presumably due to their growing tensions, Dale and Diane found it necessary to memorialize their companies’ continued partnership. In June and October/November of 2013, they signed two partnership agreements setting out “mutually beneficial responsibilities” for each company: BioWorld Products Inc. would supply inventory, deliver product, handle billings and collections, and manage bookkeeping and banking; Applicant would handle sales, customer service, and manage sales agents.<sup>53</sup>

### **I. BioWorld Products Inc. (f/k/a BioWorld Products LLC) “Assigns” the BLOWORLD PRODUCTS trademark to Phillip Barnes**

Meanwhile, on October 12, 2013, Diane, unbeknownst to Dale, signed the below-shown “Trademark Ownership Transfer” in favor of Phillip Barnes, the son of Dale and Diane, as a wedding gift:<sup>54</sup>

---

<sup>51</sup> *Id.* at 7 (¶ 17).

<sup>52</sup> 24 TTABVUE 7 (Dale’s Decl., ¶¶ 15, 17); 31 TTABVUE 7, 22-23 (Diane’s Decl., ¶ 11, Exhibit G).

<sup>53</sup> 26 TTABVUE 71-72, 75-76 (Diane’s Rebuttal Decl., Exhibits R, T).

<sup>54</sup> 31 TTABVUE 7, 24-27 (Diane’s Decl., ¶ 12, Exhibits H-I);

## Trademark Ownership Transfer

Effective October 12, 2013, BioWorld Products Inc. has gifted the full rights to the trademark "BioWorld Products" to Phillip Barnes. This is my son, and I have decided to give this to him as a wedding gift.

Word Mark	BioWorld Products
Serial Number	85076560
Registration Number	39471712

On October 30, 2013, Phillip filed a request to record his ownership of the mark and Registration No. 3947172 of the mark BIOWORLD PRODUCTS (previously owned by BioWorld Products Inc. in 2011), which the USPTO accepted and recorded on the same date. That registration was subsequently cancelled under Section 8 on November 2, 2018 and is not at issue in this proceeding.<sup>55</sup>

### **J. The Relationship Disintegrates; Don Damschen Establishes Opposer**

According to Diane, on or about April 7, 2014, she received a letter from Dale dissolving the partnership arrangement that was memorialized in June and October/November 2013.<sup>56</sup> In his letter, Dale alleged that BioWorld Products, Inc. had during the year prior failed to fulfill certain of its responsibilities under the agreement, and that the agreement was "no longer mutually beneficial."

On September 14, 2015, between the signing of the two partnership agreements

---

<sup>55</sup> 25 TTABVue 5-11 (McClellan Decl., Exhibit A).

<sup>56</sup> *Id.*

referenced in paragraph H above and unbeknownst to Dale, Don Damschen incorporated Opposer (BioWorld USA, Inc.), which Diane was aware of and approved.<sup>57</sup> Don became the CEO of Opposer, Diane became its Administrative Manager, and Opposer operated out of the same location as BioWorld Products, Inc.<sup>58</sup> According to Dale, Opposer sold the same products as BioWorld Products, Inc. and Applicant.<sup>59</sup>

On April 1, 2016, Don Damschen, in his capacity as Vice President of BioWorld Products, Inc., sent a cease-and-desist letter to Applicant, addressed to Dale, revoking the authorization of Applicant and Bioworld Engineering Inc. to act as BioWorld Products, Inc.'s dealer/distributor.<sup>60</sup>

On September 1, 2016, BioWorld Products, Inc. sold all of its assets, including its trademarks (unnamed), as well as its trade names "BioWorld" and "BioWorld Products," to Opposer for \$30,000.<sup>61</sup> Six weeks later, on October 29, 2016, BioWorld Products, Inc. filed for bankruptcy.

Dale and Diane divorced in 2018 following institution of this proceeding.<sup>62</sup>

---

<sup>57</sup> 24 TTABVUE 46-51 (Dale's Decl., Exhibits L-M); 31 TTABVUE 79 (Damschen Decl., ¶ 13); 31 TTABVUE 9, 28-29 (Diane's Decl., ¶ 36, Exhibit J).

<sup>58</sup> 31 TTABVUE 59, 79 (Damschen Decl., ¶¶ 1, 13); 31 TTABVUE 28-29, 75 (Diane's Decl., ¶ 1, Exhibit J).

<sup>59</sup> 24 TTABVUE 7-8 (Dale's Decl., ¶ 18).

<sup>60</sup> 10 TTABVUE 82-83 (Damschen Decl., Exhibit L).

<sup>61</sup> 31 TTABVUE 8, 30-41 (Diane's Decl., ¶ 8, Exhibit K).

<sup>62</sup> 24 TTABVUE 7 (Dale's Decl., ¶ 17).

#### IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, \*3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061 (Fed. Cir. 2014). A party in the position of plaintiff may oppose a mark where it has “both a ‘real interest’ in the proceedings as well as a ‘reasonable’ basis for its belief of damage.” *Australian Therapeutic*, 2020 USPQ2d 10837 at \*3; *see also Empresa Cubana*, 111 USPQ2d at 1058; *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

In this case, Opposer has presented evidence, including the declaration testimony of Diane and Don Damschen, supporting Opposer’s claim of common law rights in the mark or trade name BIOWORLD PRODUCTS, which it alleges is confusingly similar to Applicant’s mark BIOWORLD, as used on goods similar to Applicant’s goods. Moreover, both parties are managed by individuals who previously worked together and are now competitors for the same mark and goods. Opposer claims ownership of that mark as a trade name, and as a mark for the associated goods, to the exclusion of Applicant.

In view thereof, we find that Opposer has established a personal stake in the outcome of this proceeding and a reasonable belief in damage. *See Empresa Cubana*, 111 USPQ2d at 1062 (Cuban cigar manufacturer had standing to seek cancellation

of competitor's trademark registrations); *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (competitor has standing); *Syngenta Crop Prot. Inc.*, 90 USPQ2d at 1118 (in opposition proceeding under Section 2(d), testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged by registration of applicant's mark."). Opposer therefore has demonstrated its entitlement to a statutory cause of action.

## V. Priority

"In an opposition founded on section 2(d), the opposer must establish its own prior proprietary rights in the same or a confusingly similar designation in order to defeat the application." *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). Section 2(d) challenges may be based either on ownership of a registered mark (which is not implicated here) or prior use of an identical or similar trademark or trade name. *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1302 n.8 (TTAB 2015); see also *Herbko Int'l., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002), cited in *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1658 (TTAB 2014).

Because Opposer has not pleaded ownership of a subsisting registration, it must rely on its common law use to establish priority. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) "[T]o the extent opposer wishes to rely on its common law rights, it must establish priority with respect to such rights. That is, opposer must prove by a preponderance of the evidence that its common law rights were acquired before any date upon which applicant may rely." *Embarcadero Techs.*,

*Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013) (citing *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (The “decision as to priority is made in accordance with the preponderance of the evidence”)).

#### **A. Opposer’s First Use and Arguments Regarding Priority**

Opposer has advanced two different theories on priority. In the Notice of Opposition, Opposer alleged that it “has used the ‘BioWorld Products’ trademark since 2014 with the permission of the trademark owner Phillip Barnes.”<sup>63</sup> Opposer’s CEO, Don Damschen, corroborated and explained that allegation in his testimony as follows:

12. In 2013, Diane Barnes assigned to Phillip Barnes the BioWorld Product trademark. Phillip Barnes is the son of Dale Barnes and Diane Barnes.

...

16. Before she assigned the trademark, Diane Barnes permitted BioWorld Products LLC and BioWorld Products, Inc. to use the BioWorld trademark. After he received the assignment, Phillip Barnes permitted BioWorld Products, Inc. and BioWorld USA, Inc. to use the BioWorld trademark.

During trial, Opposer presented another theory of priority, likely as a result of the cancellation of Phillip Barnes’ trademark Registration No. 3947172, which is that Opposer’s priority rights derive from its purchase of BioWorld Products, Inc.’s assets through the September 1, 2016 Asset Purchase Agreement, which included transfer of the company’s trademarks (unnamed) and the trade names “BioWorld” and

---

<sup>63</sup> 1 TTABVUE 4 (Notice of Opposition, ¶ 9).

“BioWorld Products.”<sup>64</sup> Opposer lists the following chronology leading to its ownership of the mark:<sup>65</sup>

- Step 1: “Diane and her successor business entities continuously used the BioWorld Products trademark in commerce since 1992, including acquiring trademark rights under a fictitious business name statement, corporate filings and state trademark filings”;
- Step 2: “BioWorld Products LLC acquired the goodwill/trademark to ‘BioWorld Products’ from [Diane] as her sole proprietorship”;
- Step 3: “BioWorld [Products, Inc.] in turn acquired the goodwill/trademark of ‘BioWorld Products’ from BioWorld Products LLC”; and
- Step 4: “[Opposer] purchased the goodwill and intellectual property, including common law trademarks of BioWorld Products, Inc. (‘BioWorld (California)’) under a written Asset Purchase Agreement.”

Applicant argues that Opposer, which formed in 2014, could not have acquired rights in the mark BIOWORLD PRODUCTS through the 2016 Asset Purchase Agreement with BioWorld Products, Inc. because BioWorld Products, Inc. had previously assigned the mark to a third party, Phillip Barnes:<sup>66</sup>

Diane signed the Trademark Ownership Transfer and transferred the “full rights” to the mark to Phillip on October 12, 2013, and the Assignment was recorded on October 30, 2013. Notably, the Assignment conveys “the entire interest and goodwill” in the mark to Phillip. Thus, any common law use of BIOWORLD PRODUCTS, or its alleged priority of rights dating back to 1991 as [Opposer] contends, attached to the trademark and were also transferred/assigned to Phillip and no longer belonged to [BioWorld Products, Inc.], if indeed [BioWorld Products, Inc.] owned any such rights at that time.

---

<sup>64</sup> 28 TTABVUE 13 (Opposer’s Brief); 30 TTABVUE 6 (Opposer’s Reply Brief).

<sup>65</sup> *Id.*

<sup>66</sup> 29 TTABVUE 25 (Applicant’s Brief).

Again, contrary to [Opposer's] assertion that it acquired the BIOWORLD PRODUCTS mark through the Asset Purchase Agreement in 2016, [BioWorld Products, Inc.] could not and did not transfer the mark to USA through the Asset Purchase Agreement because the mark was no longer an asset of [BioWorld Products, Inc.] as of October 2013 and could not be sold to [Opposer] through the Asset Purchase Agreement in 2016.

On rebuttal, Opposer makes the somewhat tenuous argument that it both licenses the mark from Phillip (just the non-federal rights portion) and owns the mark (that it purchased from BioWorld Products, Inc.):<sup>67</sup>

[Opposer] did allege to being a licensee of Phillip Barnes as to the federal trademark. However ... Phillip was only assigned the federal trademark [from BioWorld Products, Inc.] and that assignment was invalid as an assignment in gross. In any event the federal trademark issue is now moot since the federal trademark has been cancelled. ...

BioWorld [Products, Inc.] certainly had its common law trademark to sell with its business pursuant to the Asset Purchase Agreement.

## **B. Findings of Fact and Analysis of Priority**

We begin our analysis by remarking on the unsatisfactory state of the record before us, which has a number of holes not filled in by the parties, leading us to question the credibility of both parties and their witnesses to some degree. As with any dispute, the Board is charged with determining the relevant facts reflected in the record, which becomes more challenging when the parties have not been completely forthright. This is particularly true in the case of individuals who were previously involved in a domestic relationship, as in the case here, whose testimony may be colored with rancor and resentment. Nonetheless, the Board must concentrate on

---

<sup>67</sup> 30 TTABVUE 16 (Opposer's Rebuttal Brief).



what is written or otherwise clearly established by the evidence. We must “look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.” *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994), *quoted in Daniel J. Quirk, Inc. v. Vill. Car Co.*, 120 USPQ2d 1146, 1150 (TTAB 2016). In this case, there are pieces missing from the puzzle.

“It is an accepted principle that the fact that an individual is the controlling stockholder and principal officer of a corporation is not, in and of itself, sufficient to establish ownership in a mark which only a corporation has used.” *Monorail Car Wash, Inc. v. McCoy*, 178 USPQ 434, 437-438 (TTAB 1973). Thus, “the question whether or not an individual including an officer of a corporation or the corporation itself is the owner of a mark for a product produced and distributed by the corporation must be resolved on a case-by-case basis dependent upon the particular facts adduced in the case.” *Id.* at 438.

Dale, on behalf of Applicant, testified that formation of the BioWorld Products company as an LLC in 1998 was done “after consultation with our attorney and accountant for tax and business succession reasons to best protect my wife and children[.] Diane and I decided to formalize our BioWorld Products company as a limited liability company, and filed for the same with the California Secretary of State.”<sup>68</sup> However, he never explains why Diane was listed as the owner on the California fictitious business statement prior to the company’s formation; why Diane

---

<sup>68</sup> 24 TTABVUE 5 (Dale’s Decl., ¶ 10).

was listed as the President of the LLC that was formed; or why he signed the transmutation agreement in 2007, converting 100% of the ownership of the company to the sole property of Diane.

Notwithstanding the couple's subjective intentions at the time (which remain obscure) and Dale's testimony in this case, it is clear from their actions at the time and the documentary evidence of record that Dale and Diane wanted the BioWorld Products company and all rights to it to be in Diane's name, at least publicly. Dale's contention that he never intended to relinquish his rights in the mark BIOWORLD is belied by the objective evidence in this case. Therefore, we find that Diane, not Dale, owned the company and mark during the early years of the company – that is, until she assigned it away.

In 2007, she assigned the mark to her and Dale's son, Phillip.<sup>69</sup> Both Diane and Dom Damschen testified that before Diane assigned the mark to Phillip, she "permitted BioWorld Products LLC and BioWorld Products, Inc. to use the BioWorld trademark."<sup>70</sup> They both also testified that after Diane assigned the mark, "Phillip Barnes permitted BioWorld Products, Inc. and [Opposer] to use the BioWorld trademark." We reproduce again below a complete image of the assignment for reference:

---

<sup>69</sup> 31 TTABVUE 7, 24-27 (Diane's Decl., ¶ 12, Exhibits H-I).

<sup>70</sup> 31 TTABVUE 16 (Diane's Decl., ¶ 16); 10 TTABVUE 62 (Damschen Decl., ¶ 16).



**Trademark Ownership Transfer**

Effective October 12, 2013, BioWorld Products Inc. has gifted the full rights to the trademark "BioWorld Products" to Phillip Barnes. This is my son, and I have decided to give this to him as a wedding gift.

Word Mark	BioWorld Products
Serial Number	85076560
Registration Number	39471712

Diane R. Barnes  
Diane Barnes  
President/Owner

Date: 10-12-13

www.bioworldusa.com • support@bioworldusa.com • 888.851.2042  
PO Box 2828 • Vista California 92083-2828 • United States of America

Opposer presents two arguments on rebuttal to try to blunt the effect of Diane’s assignment to Phillip, the new owner of the mark, notwithstanding the testimony of its two witnesses: (1) the assignment only pertained to the federal registration of the mark, and (2) the assignment was invalid because no goodwill was assigned.<sup>71</sup>

First, as a matter of fact, the trademark assignment was limited to ‘this’ trademark and it specified that ‘this’ trademark was ‘Serial Number 85076560; Registration Number 39471712,’ [sic: 3947172] i.e., the federal trademark.

Second, the assignment was invalid because no portion of BioWorld (California)’s goodwill was assigned to Phillip. Phillip certainly had no expectation that customers of BioWorld [Products, Inc.] would go to him for business, which is what “goodwill” means. Since Phillip had no business to which the trademark could be appurtenant, the assignment

<sup>71</sup> 30 TTABVue 26 (Opposer’s Rebuttal Brief).

was invalid. Phillip did not acquire the goodwill of BioWorld [Products, Inc.] and he did not have any commercial activity to which the trademark would have been appurtenant. As such, the assignment to Phillip was invalid.

Opposer's argument that the assignment was limited to just the registration is unpersuasive, since the document states in no uncertain terms that "BioWorld Products Inc. has gifted **the full rights to the trademark 'BioWorld Products'** to Phillip Barnes" (emphasis added). "Give him this," mentioned in the document, clearly refers to mark itself and not simply the registration listed below. It is simply inconsistent with, and contrary to trademark law that one can assign **full rights in a mark**, including its federal registration, while at the same time retaining separate common law rights.

As to Opposer's argument that the assignment was invalid because it does not mention the magic word "goodwill," Opposer has presented no case precedent, nor are we aware of any such precedent, holding that the transfer of "full rights in a mark" does not encompass its goodwill. It is true that "[u]nlike patents or copyrights, trademarks are not separate property rights. They are integral and inseparable elements of the goodwill of the business or services to which they pertain." *Visa, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 216 USPQ 649, 651 (Fed. Cir. 1982). "A naked transfer of the mark alone – known as a transfer in gross – is invalid." *Id.* However, in this case, Opposer has presented no evidence to show that the transfer was invalid. To the contrary, Opposer's witnesses Diane and Don, treat the assignment in their testimony as if it was valid and that their use was based on permission, essentially a license back from Phillip to use the mark. Accordingly,

we also treat the assignment as valid and find that following the assignment, Diane and BioWorld Products, Inc. no longer owned the mark. It follows, then, that BioWorld Products, Inc. had no ownership rights in the mark BIOWORLD PRODUCTS to transfer to Opposer through the Asset Purchase Agreement of September 1, 2016.

Opposer argues that “Phillip certainly had no expectation that customers of Bioworld [Products, Inc.] would go to him for business, which is what ‘goodwill’ means. Since Phillip had no business to which the trademark could be appurtenant, the assignment was invalid.”<sup>72</sup> But there is no evidence supporting Opposer’s argument. For whatever reason, Phillip is not a witness in this proceeding and the facts relevant to his involvement with BioWorld Products, Inc. have not been disclosed. In any event, just as Dale is bound by the documents he signed in favor of Diane regarding ownership of the mark, Diane is also bound by the documents she signed giving away BioWorld Products, Inc.’s rights in the mark.

Based on the foregoing, Opposer may only claim priority stemming from its own common law rights in the mark. However, Opposer provided no competent evidence regarding its own use of the term BIOWORLD or BIOWORLD PRODUCTS as a trademark in commerce, use analogous to trademark use, or as a trade name. Opposer provided seven invoices issued by BioWorld Products (LLC and Inc.) during

---

<sup>72</sup> 30 TTABVUE 12 (Opposer’s Reply Brief).

the years 2004-2010, but those invoices were issued well prior to Opposer's incorporation on September 14, 2015.<sup>73</sup>

Opposer also provided copies of advertisements purportedly "setting forth the nature and extent of the products marked by [Opposer] under the BioWorld trademark," and purportedly "showing use of the BioWorld Product trademark in association with its products."<sup>74</sup> However, there is no testimony or evidence showing when these advertisements were created, if and when they were ever distributed and to whom, or the extent of any such distribution. Simply put, we have no context within which to assess these advertisements, which do not correspond to any particular date. Thus, apart from Opposer's conclusory allegation that it "continuously used the BioWorld trademark in commerce in connection with its commercial products,"<sup>75</sup> we are unable to find in the record any competent use of the name BLOWORLD PRODUCTS on or in connection with the relevant goods, as a mark or as a trade name, by Opposer since its incorporation on September 14, 2015.<sup>76</sup>

"It is settled that oral testimony in situations such as this one where documentary evidence may be insufficient or unavailable for various reasons may be sufficient to

---

<sup>73</sup> 31 TTABVUE 8-9, 46-52 (Diane's Decl., ¶ 17, Exhibit M); 10 TTABVUE 62-63, 86-92 (Damschen Decl., ¶ 17, Exhibit M).

<sup>74</sup> *Id.* at 8-9, 53-70 (¶¶ 17-18, Exhibits N-O); 10 TTABVUE 60, 62-63 (Damschen Decl. ¶¶ 17-18, Exhibits N-O).

<sup>75</sup> 31 TTABVUE 6, 8 (Diane's Decl., ¶¶ 3, 17); 10 TTABVUE 60, 62-63 (Damschen Decl., ¶¶ 3, 17).

<sup>76</sup> On the other hand, Applicant provided evidence in the nature of 39 invoices issued between May 14, 2014 and February 19, 2020, which corroborate Dale's testimony that Applicant and its related company, BioWorld Engineering Inc., have used the mark in commerce for the relevant goods since at least as early as May 14, 2014, approximately 16 months prior to Opposer's formation. 24 TTABVUE 9-10, 64-103 (Dale's Decl., ¶ 24, Exhibit R).

establish both prior and continuous use of a designation providing that the testimony is by a witness or witnesses personally conversant with the facts, and that it is **clear, convincing, consistent, and sufficiently circumstantial to convince the trier of fact of the probative value thereof.**” *Liquacon Corp. v. Browning-Ferris Indus., Inc.*, 203 USPQ 305, 316 (TTAB 1979) (emphasis added), *cited in Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011). “The presence of business records would strengthen the case that these transactions occurred in the ordinary course of trade, and the absence of such records does the opposite.” *Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017). We find the conclusory testimony regarding Opposer’s use in this case unclear and unconvincing. “[W]hen it is within a party’s power to produce a certain kind of persuasive testimony or documentary evidence on an urged factual finding, and it fails to do so, a tribunal is at least permitted—perhaps even compelled—to draw the inference that that fact is unsupported and/or untrue.” *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1794 (TTAB 2017). The absence of corroborating documents further undermines the reliability of the conclusory testimony.

Opposer’s evidence in support of its claimed chain of use title in the mark BIOWORLD PRODUCTS from Diane or BioWorld Products, Inc. fails. In the absence of competent evidence, Opposer’s claim to common law use of the term, as a mark or trade name, also fails. In short, Opposer has failed to carry its threshold burden of proving prior rights in the common law mark or trade name BIOWORLD

PRODUCTS by a preponderance of the evidence, *see Life Zone*, 87 USPQ2d at 1960, and its claim under Section 2(d) fails for this reason alone.

***Decision:*** The opposition is dismissed.