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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162330
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PRELIMINARY STATEMENT

When Applicant, Cary Berman, filed an application to register ENYCE for automobile accessories, it was not the first time he tried to exploit a well-known clothing brand for his own use on automobile accessories. In 1998, Mr. Berman attempted to License the mark FUBU for use on custom automotive accessories, such as car covers, shift knobs, rims, license plate holders and spoilers. The FUBU mark was owned by another entity, was federally registered and was already well-known, particularly as an Urban Lifestyle brand. Mr. Berman never reached a deal for his use of the FUBU mark. But he did not give up on the idea of using a well-known Urban Lifestyle clothing brand on his own decorative aftermarket car accessories.

Instead of paying to use FUBU, Mr. Berman decided to simply hijack two other marks that were also well-known and competed head-to-head with FUBU. Specifically, Mr. Berman filed two intent to use applications to register the marks ENYCE and MECCA, both for “Custom automotive accessories, namely, fitted car covers, shift knobs, brake pads and wheels for land vehicles, license plate holders and spoilers for vehicles.” Just like FUBU, ENYCE and MECCA were both federally registered trademarks and were well-known, particularly within the Urban Lifestyle market, before Mr. Berman applied to register them in his own name. Why would Mr. Berman repeatedly target Urban Lifestyle clothing marks? Because there is a close association between clothing fashion and decorative car accessories - - car fashion - - within the Urban Lifestyle market. Consumers are accustomed to seeing clothing brands used in connection with car accessories and car events, and Mr. Berman knew full well that if he could somehow use FUBU, ENYCE or MECCA on car accessories, he could piggy-back on the good will of these clothing brands.

Mr. Berman has made no use to date of the ENYCE mark and does not intend to even begin planning for his use of the mark until the Board renders a decision in this Opposition. Evidently, Mr. Berman's business plan is to first see if his goal of exploiting another's well-known mark will be sanctioned by the United States Patent and Trademark Office. Then, if he receives a registration, he will build a business around the pirated mark.¹

As set forth in greater detail below, Mr. Berman has acted in bad faith by attempting to exploit the well-known trademarks of others and by attempting to manipulate the trademark registration process. At least three times Mr. Berman has targeted well-known coined trademarks that had been registered for use on clothing and attempted to secure rights to use those marks on decorative car accessories. But when asked about this pattern, Mr. Berman remarkably claimed he never heard of Opposer's ENYCE brand and also denied that there was any connection between clothing fashion and decorative aftermarket automobile accessories. Notwithstanding these bold denials, and as set forth in greater detail below, ENYCE is a well-known mark that Applicant was no doubt aware of and there is a close association between clothing fashion and car accessories, particularly in what is known as the Urban Lifestyle market.

For the reasons set forth below, Mr. Berman's application to register ENYCE should be denied.

DESCRIPTION OF THE RECORD

On October 30, 2003, Mr. Berman applied to register the mark ENYCE for "custom automotive accessories, namely, fitted car covers, shift knobs, brake pads and wheels for land

¹ Given Applicant's apparent lack of *bona fide* intent to use the ENYCE mark himself, it appears his business plan may have simply been to sell the mark back to its rightful owner once it matured to registration.

vehicles, license plate holders and spoilers for vehicles” in International Class 12 on an intent-to-use basis. The application was published in the Official Gazette on August 24, 2004.

On September 22, 2004, Opposer, L.C, Licensing, Inc. (“Opposer”) commenced this opposition on the ground that Applicant’s ENYCE mark is identical to Opposer’s ENYCE mark and so closely resembles Opposer’s ENYCE (Stylized) and Lady Enyce marks as to be likely, when applied to Applicant’s goods, to cause confusion, to cause mistake, and to deceive the trade and public, which is likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed, or sponsored by Opposer or associated in some way with Opposer. Applicant filed an answer dated November 5, 2004.

On September 8, 2006, following the discovery deposition of Applicant, Opposer filed a motion to amend its Notice of Opposition to include as an additional ground of opposition that Applicant lacked a *bona fide* intention to use the ENYCE mark in commerce at the time he filed his intent-to-use application to register such mark. Applicant opposed the motion. On September 29, 2006, the Board issued an order granting Opposer’s motion to amend. Opposer filed and served the Amended Notice of Opposition and Applicant served an answer to Opposer’s Amended Notice of Opposition.

The evidence of record consists of Applicant’s Application Serial No. 78/320,850 and the following:

Opposer’s Testimony

Opposer submitted the following trial testimony:

- Opposer’s First Notice of Reliance dated December 21, 2006 attaching certified title and status copies of registrations for the following marks owned by Opposer: “ENYCE” (Reg. No. 2,093,751), “ENYCE and Design” (Reg. No. 2,351,411), and “LADY ENYCE” (Reg. No. 2,338,404) (“Opp. First Not. Rel.”);

- Opposer’s Second Notice of Reliance dated December 21, 2006 attaching the following documents: Applicant’s Answers to Opposer’s First Set of Interrogatories Nos. 14, 16, 17, 18, 33, and 34 dated February 4, 2005; Applicant’s Answers to Opposer’s First Set of Interrogatories Nos. 14, 16, 17, and No. 18 dated September 12, 2005; and Opposer’s Interrogatory Nos. 14, 16, 17, 18, 33, and 34 (“Opp. Second Not. Rel.”);
- Opposer’s Third Notice of Reliance dated December 21, 2006 attaching various advertisements and articles from printed publications showing that Opposer and other clothing/footwear brands advertise in automobile-themed magazines and in magazines that advertise automobile-related goods and services (“Opp. Third Not. Rel.”);
- Opposer’s Fourth Notice of Reliance dated December 21, 2006 attaching various advertisements and articles from printed publications showing that urban lifestyle magazines carry advertisements and feature promotions relating to clothing fashion, automobiles and automobile accessories (“Opp. Fourth Not. Rel.”);
- Opposer’s Fifth Notice of Reliance dated December 21, 2006 attaching various advertisements and articles from printed publications showing that clothing, automobiles, and automobile accessories bearing the same trademark are promoted and advertised in urban lifestyle magazines and that owners and/or licensees use the same marks on both clothing and automobiles and automobile accessories (“Opp. Fifth Not. Rel.”);
- Opposer’s Sixth Notice of Reliance dated December 21, 2006 attaching copies of twelve registrations for MECCA marks (Class 25) owned by International News, Inc. (“Opp Sixth Not. Rel.”);
- Opposer’s Seventh Notice of Reliance dated December 21, 2006 attaching portions of the June 29, 2006 discovery deposition transcript of Applicant Cary Berman and Exhibits A-J thereto; (“Opp. Seventh Not. Rel./Berman Tr.”);
- Declaration of William Cadenilla dated December 8, 2006 (“Cadenilla Decl.”) and accompanying exhibits thereto consisting of Opposer’s Exhibits EE – ZZ submitted in lieu of testimony pursuant to the stipulation of the parties; and
- Testimony Deposition of Rolando Felix taken on December 5, 2006 (Felix Tr.) and accompanying Exhibits A-CC thereto (“Felix Exh.”).

Applicant’s Testimony

Applicant submitted the following trial testimony:

- Applicant's First Notice of Reliance dated February 1, 2007 attaching copies of the deposition of Rolando Felix taken April 6, 2005;
- Applicant's Second Notice of Reliance dated February 1, 2007 attaching copies of the deposition of Rolando Felix taken December 5, 2006;
- Applicant's Third Notice of Reliance dated February 1, 2007 attaching copies of the deposition of Evan T. Davis taken April 7, 2005; and
- Applicant's Fourth Notice of Reliance dated February 1, 2007 attaching copies of a letter dated December 23, 2004.

STATEMENT OF ISSUES

Would Applicant's ENYCE mark so closely resemble Opposer's ENYCE mark as to be likely, when applied to Applicant's goods, to cause confusion, or to cause mistake, or to deceive because the public is likely to believe that Applicant's ENYCE goods have their origin with Opposer and/or that such goods are approved, endorsed, or sponsored by Opposer or associated in some way with it?

Did Applicant have a *bona fide* intent to use the ENYCE mark on the goods listed in the application when he filed Application Serial No. 78/320,850?

STATEMENT OF FACTS

I. The ENYCE Mark

In 1996, Rolando Felix, -- currently Executive Vice President of Enyce, LLC ("Enyce"), a subsidiary of opposer -- and his colleagues coined the mark ENYCE for a clothing line they were developing for Fila, USA. Felix Tr. 14 . They did this because they wanted to use a mark that was unique - - unlike any other mark used before. Felix Tr. 14, 19.

The ENYCE mark was first used by Opposer² in 1996. Felix Tr. 119. The mark has been used on clothing, shoes, scarves, key rings, umbrellas, action figures, luggage tags, cuff links, flight bags, blankets, beach towels, sleep masks and skate boards. Felix Tr. 70-71, 112.

Opposer owns Registrations Number 2,093,751 for ENYCE covering “active apparel and headwear for men, women and children, namely, hats, caps, visors, headbands, shirts, jackets, jogging suits, pants, coats, T-shirts, shorts, tanktops, skirts, warm-up suits, sweatshirts and sweatpants”, Registration Number 2,351,411 for ENYCE and Design covering “active apparel and headwear for men, women and children, namely hats, caps, visors, headbands, shirts, jackets, jogging suits, pants, coats, t-shirts, shorts, tank tops, skirts, warm-up suits, sweatshirts and sweatpants” and Registration Number 2,338,404 for LADY ENYCE covering “women’s clothing, namely, shirts, tops, bottoms, pants, jackets, coats, jogging suits, warm-up suits, T-shirts, polo shirts, tank tops, skirts, shorts, denim shirts, denim pants, denim tops, denim bottoms, denim shorts, denim skirts, sweat shirts, sweat pants, sweat shorts, headwear, caps, hats. Felix Tr. 23, Felix Exhs. G, H and I; Opp. First Not. Rel. Each of these registrations were applied for and issued before Applicant filed his ENYCE application.

The marks that compete most closely with ENYCE are FUBU, MECCA, SEAN JOHN, MARC ECKO, AKADEMIKS, ROCAWEAR and PHAT FARM. Felix Tr. 73, 75. These are all considered Urban Lifestyle brands. Felix Tr. 77-78.

² The ENYCE, ENYCE and Design and LADY ENYCE registrations were assigned from Enyce Inc. to Enyce, L.L.C. and then from Enyce, L.L.C. to L.C. Licensing, Inc.

II. Urban Lifestyle

Rolando Felix is the co-founder and executive vice president of Enyce, LLC and has been with Enyce since its inception in 1996. Felix Tr. 5-6. He has worked in the clothing industry since 1987. Felix Tr.12. He worked his way up from the bottom, having been employed in the clothing industry as a stock-boy, a salesperson, store manager, merchandiser, buyer, designer, product developer, executive vice president and company founder. Felix Tr. 6-13. Since 1992, Mr. Felix has developed and promoted clothing in the Urban Lifestyle market. Felix Tr. 5-9. As Applicant himself recognizes, Mr. Felix “live[s] his life on a daily basis in and amongst th[e] Urban Lifestyle environment.” Felix Tr. 98.

Mr. Felix testified that certain clothing brands are considered “lifestyle brands” because they represent or cater to specific lifestyles. Felix Tr. 77. For example, EDDIE BAUER and LL BEAN are both considered “Outdoor Lifestyle” brands. Felix Tr. 81. He also testified that within the clothing industry there are “Urban Lifestyle” brands. Felix Tr. 76. In this context, “Urban” transcends geography. It is not limited to city lifestyle. Felix Tr. 76. Urban Lifestyle brands appeal to suburban shoppers, urban shoppers and rural shoppers alike. They have not only national, but international appeal. Felix Tr. 76.

The foundation of the ENYCE brand rests in the Urban Lifestyle market and Urban Lifestyle largely finds its identity in its relationship to Hip-Hop and R&B music. Felix Tr. 39. Integral to the Urban Lifestyle are clothing, jewelry, automobiles and automobile accessories. Felix Tr. 82-83.

III. ENYCE is Well-known

“You could pretty much go into any major mall across America and find ENYCE products. You could turn your TV on and watch almost -- if you're watching an hour long show of Hip-Hop or urban music videos, you'll, at least, see us a couple of times. You'll see our logo a couple of times.

You'll see our brands in TV shows. You'll see our brands -- you'll see the ENYCE mark in movies. You'll see we're in close to 2,000 points of distribution in America alone. You'll find our product available throughout Europe, throughout Japan, throughout the U.S.” Felix Tr. 72.

From 1997 through 2006, sales of ENYCE branded goods have topped \$600,000,000. Felix Tr. 71-72.

Since its inception, the ENYCE mark has appeared in at least three places on all Enyce merchandise: on the labels sewn on or into the clothes; on the hangtags that are attached to the clothes and on UPC tickets or price tags. Felix Tr. 18-23, Felix Exhs. B-F. ENYCE-branded products are sold throughout the United States and in thirteen countries across Europe and Asia. Felix Tr. 22, 24.

In the United States, ENYCE products are sold in major department stores such as Bloomingdales, Nordstrom's, Macy's, Dillard's and Saks Fifth Avenue, as well as in high-end specialty stores. Felix Tr. 24. Enyce has relationships with 500 retail accounts who sell the ENYCE products through 2,000 separate points of distribution. Felix Tr. 24-25. Throughout the United States, every major mall has within it an average of three separate stores selling ENYCE goods. Felix Tr. 26. The company has offices in New York City, Los Angeles, Atlanta, Chicago, Canada, Hong Kong, Germany, England, Spain, Paris, Italy and Holland. Felix Tr. 26.

From the start, the ENYCE brand has benefited from a generous advertising budget. In its first full year, 1997, the ENYCE marketing budget was \$900,000, \$500,000 of which was

allocated to advertising. Felix Tr. 54. Since 1997, Enyce has spent approximately \$32,000,000 on marketing, approximately \$13,000,000 of which was allocated to advertising. All marketing and advertising material has featured the ENYCE mark. Felix Tr. 15, 54.

For over ten years, the ENYCE mark has been promoted through national advertising campaigns. Felix Tr. 27. These have included print advertisements, billboards, bus and train advertisements and radio advertisements. Felix Tr. 27. The billboards advertisements have appeared in New York City's Harlem and Times Square, on Sunset Boulevard during the Grammy Awards and Oscar Awards and in Houston, Texas during the National Basketball Association's All-Star Game. Felix Tr. 41-42.

The ENYCE media plan illustrates the scope of the national print advertising campaigns. Exh. J. Opposer has long advertised its ENCYE products in magazines that celebrate the Urban Lifestyle since ENYCE is an Urban Lifestyle brand. Felix Tr. 38. Since 1997, Enyce has advertised in Vibe, a national music magazine that celebrates the Urban Lifestyle and has a monthly circulation of just under 1,000,000. Felix Tr. 33. Likewise, since the late 1990's, Enyce has advertised in XXL and The Source, both of which are nationally distributed magazines with circulations over 500,000. Felix Tr. 33. Additional national magazines in which Enyce advertises include Vibe Vixen, ElleGirl, Complex, Fader, Elemental and Dub.

Complex is a men's Urban Lifestyle magazine that was founded by one of Enyce's competitors, Marc Ecko, and focuses on jewelry, fashion and automobile trends. Felix Tr. 36. Fader focuses more specifically on Hip-Hop music and takes its name from a piece of sound equipment used in the Hip-Hop music industry. Felix Tr. 37. Opposer's evidence includes an edition of Elemental Magazine which features Hip-Hop recording artist Busta Rhymes on the cover and the advertisements for ENYCE products as well as the competing brands LRG,

TRIBAL GEAR, SCIFEN, AKOMPLICE and Urban Lifestyle retailer, DR. JAYS. Felix Tr. 43-44, Felix Exh. K.

Most recently, Enyce was approached by NASCAR to take advertising in the magazine Urban Youth Racing School. NASCAR was attempting to get urban youth interested in NASCAR racing and had identified ENYCE as an authentic brand within the Urban Lifestyle. Felix Tr. 52. Enyce placed six pages of advertising in the magazine. Felix Exh. S.

In addition to its advertising budget, Enyce has an annual sponsorship budget of \$125,000. From this budget, Enyce sponsors, among other things, car shows and youth baseball programs. Felix Tr. 69.

Enyce's website, which has been continuously active since 2000, always features the ENYCE mark, tracks ENYCE print advertising campaigns, hosts contests and receives as many as 80,000 unique visitors per month. Felix Tr. 56-57, Felix Exh. G.

The ENYCE mark appears regularly in music videos and has appeared in the films "Austin Powers", "The Fast and Furious" and "2 Fast 2 Furious". Felix Tr. 72.

IV. ENYCE and Automobiles

Enyce has sponsored car shows, car show ticket giveaway contests and even a contest in which the winner was given a customized 1973 Chevrolet Impala. Felix Tr. 60-63, 68-69. In each case, the ENYCE mark was prominently featured and promoted. The mark was also featured in the car racing films "The Fast and the Furious" and its sequel "2 Fast 2 Furious." Felix Tr. 72.

One of the national magazines in which Enyce and its competitors have advertised regularly is DUB. Felix Tr. 28-30, Felix Exh. J, L-O, AA-BB, Opp. Fifth Not. of Rel. DUB is a lifestyle magazine dedicated to aftermarket car accessories with a focus on Urban Lifestyle and

fashion. Felix Tr. 38-41. DUB tracks and celebrates trends in aftermarket accessories such as rims and tires. Felix Tr. 41. In fact, DUB takes its name from the slang term for aftermarket wheels that are greater than 20 inches in diameter. Felix Tr. 41.

When DUB promotes its car shows, Enyce sponsors ticket giveaways for those car shows. Felix Tr. 68. When there is a car show geared toward the Urban Lifestyle market, Enyce signs on as a sponsor to promote its ENYCE mark. Felix Tr. 69.

In 2006, ENYCE celebrated its 10th Anniversary. To mark the occasion, Opposer considered giving away roses on a large scale, but rejected this idea since it seemed unrelated to the Urban Lifestyle market. Instead, Enyce commissioned multiplatinum-selling Hip-Hop recording artist “T.I.” to customize an automobile that would be given away in a contest. Felix Tr. 61. In addition to being a recording artist, T.I. owned a custom automotive shop in Atlanta where he would install new soundsystems, add new decorative wheels and rims and provide new high-end paint jobs. Felix Tr. 61, 66-67. In connection with the ENYCE contest, T.I. refurbished and customized a 1973 Chevrolet Impala, adding among other things new oversized chrome wheels. Felix Exhs. W and X. He integrated the ENYCE logos into the paint job and into the headrests. Felix Tr. 61, 65.

For weeks, Enyce promoted the contest and displayed the customized ENYCE car outside the Macy’s store located at the Lenox Mall in Atlanta Georgia. Felix Tr. 63-64, Felix Exh. U. The contest was a success and when the winner was selected, T.I. was on hand to give him the keys to the car. Felix Tr. 61, 67, Felix Exhs. Y and Z.

V. Urban Lifestyle and Automobiles

“[C]ar culture and car lifestyle is completely integrated in Hip-Hop lifestyle and Hip-Hop culture and urban culture.” Felix Tr. 38; Berman Tr. 72-73, Exh. I.

The Urban Lifestyle market largely finds its identity in its relationship to Hip-Hop and R&B music. Integral to the Urban Lifestyle are clothing, jewelry, automobiles and automobile accessories. Felix Tr. 82-83. As summarized by Mr. Felix, the Urban Lifestyle market is “where the Hip-Hop music world interrelates with the fashion world, interrelates with the automotive world.” Felix Tr. 67. “Nice cars, nice fashion, urban lifestyle - - all three of them go together and are interrelated.” Id.³

The trendsetters within the Urban Lifestyle Market tend to be recording artists and athletes. They dictate what style of clothing is fashionable, what type of jewelry is in vogue and what automobile embellishments and accessories are desirable. Felix Tr. 84. In fact, certain Hip-Hop recording artists and athletes own and operate custom car shops where they will modify their customers cars to feature the most current auto accessories and designs. Felix Tr. 86. The magazines in which Enyce and its competitors advertise typically feature these celebrity Urban Lifestyle trendsetters on their covers. Felix Tr. 43-50, 90-94; Felix Exhs. K-R AA-BB; Opposer’s Fifth Not. Of Rel.

One would be hard-pressed to find a Hip-Hop album that did not include lyrics celebrating exotic cars and decorative car accessories, including after-market wheels and rims. Felix Tr. 85. Particularly popular are shiny chrome or gold automobile tire rims that are designed to continue spinning even after the car has come to a stop. These rims are aptly called “spinners.” Felix Tr. 94; Cadenilla Decl. Ex. KK.

³ Independent of the Urban Lifestyle market, there is a traditional relationship between clothing and automobiles. (Driving shoes are not just racing accessories, but fashion accessories.) Felix Tradition-L 78-79. Puma has long been a sponsor of various automobile racing teams and offers PUMA branded racing shoes, gloves and suits. Berman Exh. G.

So close is the relationship of cars to the Urban Lifestyle market that some of the most popular jewelry is that which replicates decorative automobile wheels and rims. Felix Tr. 87. Urban Lifestyle magazines and websites are crowded with advertisements for silver, gold and jewel encrusted pendants, watches and bracelets which are simply miniature versions of spinner rims. In at least one case, the fashion appeal of decorative automobile wheels was so compelling that a full size wheel was worn as a necklace. Felix Tr. 87-88. 90-91, 95-96; Felix Exh. AA, Opp. Fifth Not. Of Rel. As one commentator noted, “wheels have become a fashion statement, --a badge of taste and style.” Berman Tr. Exh. I. (Article from MSN.com). Particularly noteworthy is Exhibit LL to the Cadenilla Declaration. This is a printout of a website that advertises the sale of jewelry in the shape of decorative automobile wheels and spinner rims, and also features links labeled ENYCE, FUBU, AKADEMIKS, ECKO, PHAT FARM, ROCAWEAR and SEAN JOHN. Also worth note is Exhibit MM to the Cadenilla Declaration which consists of 30 pages from the website www.hiphopchains.com featuring jewelry that replicates wheels and spinners. Together, Exhibits LL and MM illustrate the convergence of Hip-Hop music, decorative automobile accessories and jewelry in the Urban Lifestyle market.

There is a common and longstanding practice of clothing brands, particularly lifestyle brands, being cross licensed for use on automobiles.⁴ The EDDIE BAUER mark was licensed to Ford for a special edition Ford Explorer. Felix Tr. 79, Cadenilla Decl. Ex. OO. LL BEAN licensed its marks to Subaru for the LL BEAN Edition Subaru Forrester. Felix Tr. 80, Berman Exh. E. The LOUIS VUITTON marks appeared on a special edition Mercedes. Felix Tr. 80. Lexus marketed a COACH edition vehicle and the GUCCI brand was likewise used for car

⁴ Not only are clothing brands licensed for use on motor vehicles, but motor vehicle marks are licensed for clothing. Cadenilla Declaration Exh. 22 (Harley-Davidson clothing).

interiors. Felix Tr. 79; Berman Tr. 62; Berman Exh. F; Cadenilla Decl. Exhs. PP-QQ. And years ago, Levis licensed its marks for a LEVI'S edition Jeep. Felix Tr. 80, Cadenilla Decl. Exh. NN.

This practice of cross-licensing is particularly common with Urban Lifestyle brands. In fact, several of Opposer's direct competitors have already licensed their clothing brands for automobiles and automobile products. Rap music mogul and founder of the SEAN JOHN clothing brand, Sean Diddy Combs, has licensed his name for use on a special edition Lincoln Navigator. Felix Tr. 79. Moreover, his clothing brand SEAN JOHN has expanded into the automobile accessory market with SEAN JOHN automobile wheels. Felix Tr. 49-60; Berman Tr. 72-73 and Exhs. I and J; Cadenilla Decl. Exhs. EE-FF. The MARK ECKO brand has been partnered with Nissan in developing a special edition line of Nissan automobiles which has been advertised in DUB magazine. Felix Tr. 79, 89-90; Felix Exh. AA; Opp. Fifth Not. Of Rel. LEXANI, a footwear company, also advertises automobile wheels and jewel encrusted pendants that replicate automobile wheels. Felix Tr. 91-92, Felix Exh. AA; Opp. Fifth Not. Of Rel. The VANS footwear brand has been used in connection with motorcycle racing. Berman Tr. 69; Berman Exh. H, and the LUGZ footwear brand sells an extensive line of driving shoes and is closely associated with automobiles in its advertising and promotional material. Cadenilla Decl. Exhs. GG-II. Another of Enyce's competitors, LRG, has licensed its mark for use on an All Terrain Vehicle. Felix Tr. 79; Exhs. AA and BB.

Instead of licensing an Urban Lifestyle brands, Toyota has simply designed a vehicle specifically geared toward the Urban Lifestyle consumer. Felix Tr. 83.

Not only are Urban Lifestyle brands used on automobiles, they are also used in connection with automotive events. FILA has sponsored a Ferrarri racing team and a Ducati racing team and TOMMY HILFIGER sponsors formula one racing. Felix Tr. 79.

Since clothing, decorative automobile accessories and jewelry exist at the core of the Urban Lifestyle market, these are the most frequent advertisers in the Urban Lifestyle magazines. Opposer's evidence includes an edition of Elemental Magazine which features Hip-Hop recording artist Busta Rhymes on the cover and advertisements for Enyce and its competitors LRG, TRIBAL GEAR, SCIFEN, AKOMPLICE and Urban Lifestyle clothing retailer, DR. JAYS. Felix Tr. 43-44, Felix Exh. K.

Opposers Forth Notice of Reliance features pages from five different Urban Lifestyles magazines, King, Scratch, XXL, Owners Illustrated and DUB. A review of these magazines illustrates several advertisements for clothing, automobiles and automobile themed jewelry.

Likewise, given the role of automobile within the Urban Lifestyle market, it should come as no surprise that Enyce and its competitors advertise in automobile themed Urban Lifestyle magazine. Opp. Third Not. Of Rel. (DUB, Elemental and Rides magazines featuring advertisements for ENCYE, LRG, ECKO/TOYOTA, LEXANI, TRIBAL GEAR, SCIFEN, AKOMPLICE, MARC ECKO, 310 and SLICK EXOTICA.)

VI. Applicant's Background

Applicant Cary Berman is a college educated businessman with substantial experience in the clothing and automotive industries. Berman Tr. 5-13. Although not an attorney, Mr. Berman has even published a book on employment law titled Know Your Rights at Work. Berman Tr. 93-96.

He is also well versed in intellectual property law. In the mid 1980's, as a founding partner of a clothing company called Active American Apparel, Mr. Berman licensed the rights to use the GIVENCHY trademark on men's clothing products. Berman Tr. 8-9. For 5 years, Mr.

Berman sold GIVENCHY-branded⁵ clothing to major national department stores such as Macy's. Berman Tr. 10, 13. Mr. Berman kept abreast of the industry by reading trade publications and attending "quite a few" trade shows. Berman Tr. 7, 10, 12.

In the years following his licensing relationship with Givenchy, Mr. Berman owned at least three of his own trademarks, CARY CHAIR, OC CONEKSHUN and CARY BRET. Berman Tr. 23, 80, 91-92. He applied to register the CARY CHAIR and OC CONEKSHUN marks. Id.

Mr. Berman's intellectual property experience is not limited to trademarks. He has applied for at least four patents, including two business method patents, sued for the alleged infringement of one of his patents, and issued a cease and desist letter against another alleged infringer. Berman Tr. 15-20, 25 and 29.

In addition to owning clothing companies, Mr. Berman has run or owned three different automobile-related companies. For approximately five years, he ran Rio Trading which imported, branded and sold automobile sound equipment. Berman Tr. 21-24. Mr. Berman was also part owner of Custom Auto.Com which was a web-based automobile business. Specifically, Custom Auto.Com was developing a web based product by which consumers could see what their vehicles would look like with various aftermarket automobile accessories such as rims, wheels and spoilers. Berman Tr. 29, 115. Since 2001, Mr. Berman has represented General Electric in connection with automobile warranties under the company name, C Berman Associates Inc. Berman Tr. 26-29. While doing business in the automobile aftermarket industry, Mr. Berman attended automobile industry trade shows, including the Consumer Electronics

⁵ Other than the GIVENCHY-branded clothing, Active American Apparel sold "very little" else. Berman Tr. 13.

Show and the Specialty Equipment Manufacturers Association show. In some cases he hosted display booths at these trade shows. Berman Tr. 46, 123-126.

VII. Applicant's Attempt to License FUBU

As part owner of Custom Auto.Com⁶, Mr. Berman attempted to license the mark FUBU for custom automobile products. Berman Tr. 105. As explained above, FUBU is an Urban Lifestyle brand and a direct competitor of Enyce. Specifically, Mr. Berman's company entered into negotiations with the owner of the FUBU mark for the right to place the FUBU mark on custom automotive accessories such as fitted car covers, shift knobs, wheels, license plate holders and spoilers - - the same goods listed in his ENYCE and MECCA trademark applications. Berman Tr. 105.

Mr. Berman admitted that he would have been required to pay royalties to use the mark FUBU. Berman Tr. 112. He also acknowledged that he retained the services of two attorneys who negotiated with FUBU on his behalf for at least two months. Berman Tr. 115. Nonetheless, Mr. Berman refused to explain why of the FUBU mark would be valuable to a company selling automobile accessories. Berman Tr. 110. But it is apparent from Mr. Berman's attempt to license FUBU, and his subsequent applications to register ENYCE and MECCA, that he perceived a valuable benefit stemming from the use of Urban Lifestyle clothing brands for decorative automobile accessories.

⁶ Mr. Berman testified later in the transcript that the entity on whose behalf he approached FUBU was OE Conekshunn. Berman Tr. 126. In any event, it appears to be a distinction without a difference since Mr. Berman testified that "Rio became OE Conekshunn became Custom Auto.com which was all an extension of the same company."

VIII. Applicant Targets ENYCE and MECCA

After failing to reach a deal to license the FUBU mark, Cary Berman applied to register the trademark MECCA for “custom automotive accessories, namely, fitted car covers, shift knobs, brake pads and wheels for land vehicles, license plate holders and spoilers for vehicles” Berman Exh. D. MECCA is an Urban Lifestyle brand. Opp. Sixth Not. Of Rel. A review of International News Inc.’s MECCA registrations reveals that 11 of the 12 active registrations were filed well before Mr. Berman filed his MECCA Application. Id. In fact, several were filed in 1996 and 1998. Id.

Two months after filing the MECCA application, Mr. Berman filed the instant application to register ENYCE, also for “custom automotive accessories, namely, fitted car covers, shift knobs, brake pads and wheels for land vehicles, license plate holders and spoilers for vehicles.” Berman Exh. C.

Mr. Berman was given the opportunity to explain whether it was simply a coincidence that the only two marks he tried to register for his automobile accessories were both top Urban Lifestyle clothing brands. Remarkably, all Mr. Berman could say was “Don’t know.” Berman Tr. 147-149.

ARGUMENT

In order to sustain its burden under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), Opposer must establish that it has priority over Applicant, and that Applicant's mark, when used in connection with the goods set forth in the application, creates a likelihood of confusion. See, e.g., Genesco, Inc. v. Martz, 66 U.S.P.Q.2d 1260, 1267 (T.T.A.B. 2003). As set forth below, Opposer can establish both of these elements.

I.

OPPOSER HAS PRIOR RIGHTS IN THE ENYCE MARK

There can be no serious dispute that Opposer has prior rights in the ENYCE Mark. The evidence establishes that Opposer first used the ENYCE mark in 1996. Felix Tr. 19. Moreover, Opposer applied to register its ENYCE mark on June 24, 1996 and that application matured into Registration Number 2,093,751 on September 2, 1997. Opp. First Not. Of Rel.

Therefore, based on the testimony of Rolando Felix and the documentary evidence submitted by Opposer, and based on the constructive date of first use that arises from Opposer's ENYCE registration⁷, there can be no dispute that Opposer has priority in the ENYCE trademark.

⁷ The Registration itself is *prima facie* evidence of Opposer's use of the ENYCE mark at least as early as the first application date of June 24, 2006 and the continued use of the mark thereafter. T.B.M.P. § 3.101 ("In the case of an opposition, the earliest date of first use that the applicant is allowed to rely on, in the absence of taking testimony or offering evidence that proves an earlier date of first use, is the application filing date."); Lanham Act § 7(b) and § 33(a); 15 U.S.C § 1057(b) and § 1115(a) (2007); Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974) (holder of registered mark enjoys benefit of certificate as *prima facie* evidence of, *inter alia*, continued use of mark from date of filing application); J. C. Hall Co. v. Hallmark Cards, Inc., 340 F.2d 960, 962-963, 144 U.S.P.Q. 435, 437 (C.C.P.A. 1965) ("[A] registration is *prima facie* evidence of continuing use of the registered mark beginning on the filing date of the application on which the registration was granted" even if there is no evidence of record relative to such use.).

II.

APPLICANT'S ENYCE MARK IS CONFUSINGLY SIMILAR TO OPPOSER'S ENYCE MARK

Registration will be refused under Section 2(d) of the Lanham Act when the applied for mark so resembles a previously registered or used mark “as to be likely, when used on or in connection with the goods of the opposer, to cause confusion, or to cause mistake, or to deceive.”

15 U.S.C. § 1052(d) (2007). “Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations.” Recot, Inc. v. Becton, 214 F.3d 1322, 1326, 54 U.S.P.Q.2d 1894, 1896 (Fed. Cir. 2000).

The various factors considered by the Board in determining the likelihood of confusion include: the similarity of the marks at issue; the similarity of the relevant goods and services, trade channels and purchasers; the strength or fame of the prior mark; the extent of third-party use of similar marks; and any intent to trade upon another’s goodwill. See In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1967); Roger & Gallet S.A. v. Venice Trading Co., 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 1987). The relevance and weight to be given the various factors may differ from case to case. See Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 850, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992).

Every one of the DuPont factors favors Opposer and together clearly establish a likelihood of confusion.

A. Opposer Coined the ENYCE Mark and Made it Well-known

The strength of a mark rests primarily on two factors: (i) the classification of the mark and (ii) marketplace recognition. J. Thomas McCarthy, McCarthy on Trademarks and Unfair

Competition § 11:83 at 11-149 (4th ed. 1997); See also Edison Bros. Stores, Inc. v. Cosmair, Inc., 651 F. Supp. 1547, 1554 (S.D.N.Y. 1987).

In an effort to adopt a mark that was unlike any other used in the clothing industry, Rolando Felix and his colleagues coined the mark ENYCE. Felix Tr. 14, 19. McCarthy, supra § 11:5 (“If, in the process of selecting a new mark, a seller sits down and invents a totally new and unique combination of letters or symbols that results in a mark that has no prior use in the language, then the result is a “coined” or “fanciful” mark.”).

As a coined term, the ENYCE mark is entitled to broadest scope of protection. “The more distinctive the trademark is, the greater its influence in stimulating sales, its hold on the memory of the purchaser and the likelihood of associating similar designations on other goods with the same source. If the trademark is a coined word such as Kodak, it is more possible that all goods on which a similar designation is used will be regarded as emanating from the same source than when the trademark is one in common use on a variety of goods, such as ‘Gold Seal’ or ‘Excelsior.’” Arrow Distilleries, Inc. v. Globe Brewing Co., 117 F.2d 347, 349, 48 U.S.P.Q. 157, 158 (4th Cir. 1941); see Eastman Kodak Co. v. Rakow, 739 F. Supp. 116, 15 U.S.P.Q.2d 1631, 1632 (W.D.N.Y. 1989); McCarthy, supra §11:6 (“Being a “strong” mark has significance, in that the mark will then be given an expansive scope of judicial protection into different product or geographical markets.”); Tisch Hotels, Inc. v. Americana Inn, Inc., 350 F.2d 609, 146 U.S.P.Q. 566 (7th Cir. 1965). Stork Restaurant v. Sahati, 166 F.2d 348, 76 U.S.P.Q. 374 (9th Cir. 1948) (greater degree of protection given to fanciful marks than to names in common use); Aveda Corp. v. Evita Marketing, Inc., 706 F. Supp. 1419, 1428, 12 U.S.P.Q.2d 1091, 1098 (D. Minn. 1989) (quoting McCarthy: “Fanciful marks, if adopted in a *bona fide* first use, are

considered the strongest of marks because their inherent novelty creates a substantial impact on the buyer's mind.”)

Through the extensive promotion, advertising and sale of products bearing Opposer’s ENYCE mark, that mark has become well-known. ENYCE branded goods are sold throughout the United States in over 2000 stores such as Bloomingdale’s, Nordstrom’s, Macy’s, Dillard’s and Saks Fifth Avenue as well as in high-end specialty stores. Felix Tr. 24-25. Sales of ENYCE – branded goods have topped \$600,000,000. Felix Tr. 22-24, 71-72. Over \$32,000,000 has been spent on marketing and advertising the ENYCE brand. Felix Tr. 54. For over ten years, the Enyce mark has been promoted through national advertising campaigns. Felix Tr. 27. These have included print advertisements, billboards, bus and train advertisements and radio advertisements. Felix Tr. 27. The billboard advertisements have appeared in New York City’s Harlem and Times Square, on Sunset Boulevard during the Grammy Awards and Oscar Awards and in Houston, Texas during the National Basketball Association’s All-Star Game. Felix Tr. 41-42.

Enyce has long advertised in magazines that celebrate the Urban Lifestyle, some of which enjoy a monthly circulation of nearly 1,000,000. Felix Tr. 33, 38. These magazines include Vibe, XXL, The Source, Vibe Vixen, ElleGirl, Complex, Fader, Elemental and Dub.

Since Opposer’s mark is a coined term, and has become well-known, it is a particularly strong mark. Strong marks, such as Opposer’s ENYCE mark, are afforded a broad scope of protection. See, e.g., Bose Corp. v. QSC Audio Prods., 293 F.3d 1367, 1376, 63 U.S.P.Q.2d 1303, 1309 (Fed. Cir. 2002) (ACOUSTIC WAVE and WAVE for electronic audio products so well-known that defendant precluded from using POWERWAVE for amplifiers; Federal Circuit noted “voluminous evidence of nationwide critical notice” of plaintiff’s marks); Mobil Oil Corp.

v. Pegasus Petroleum Corp., 818 F.2d 254, 258, 2 U.S.P.Q.2d 1677, 1682 (2d Cir. 1987) (flying horse symbol representing mythical character Pegasus so strong in connection with plaintiff's petroleum business as to preclude defendant from using word mark PEGASUS in connection with petroleum industry or related businesses).

The broad scope of protection afforded to well-known marks was highlighted by the Federal Circuit Court of Appeals in Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992) (FUNDOUGH confusingly similar to PLAY-DOH for modeling compounds). The Court there noted that “fame of the prior mark[] plays a dominant role in cases featuring a famous or strong mark.” Kenner Parker, 963 F.2d at 352, 22 U.S.P.Q.2d at 1456; accord Bose, 293 F.3d at 1371, 63 U.S.P.Q.2d at 1305; Recot, 214 F.3d at 1328, 54 U.S.P.Q.2d at 1898. The Kenner Parker court further explained that “the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.” 963 F.2d at 353, 22 U.S.P.Q.2d at 1456. See also R. J. Reynolds Tobacco Co. v. R. Seelig & Hille, 201 U.S.P.Q. 856, 860 (T.T.A.B. 1978) (“the law today rewards a famous or well-known mark with a larger cloak of protection than in the case of a lesser known mark because of the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any resemblance thereto”); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:73, at 11-149 (4th ed. 2004) (“the more distinctive, unique and well-known the mark, the deeper is the impression it creates upon the public’s consciousness and the greater the scope of protection to which it is entitled”).

Because of the value implicit in well-known marks such as ENYCE, the onus is on newcomers such as Applicant to avoid choosing a similar mark. See Kenner Parker, 963 F.2d at

353, 22 U.S.P.Q.2d at 1456 (“[a] strong mark ... casts a long shadow which competitors must avoid”); Procter & Gamble Co. v. Conway, 419 F.2d 1332, 1336, 164 U.S.P.Q. 301, 304 (C.C.P.A. 1970) (finding MISTER STAIN confusingly similar to MR. CLEAN; “appellee acted at its peril when, with the world to choose from in selecting a name for its goods, it took the courtesy title long in priority used by appellant and coupled it with a word having a relationship to cleaning”). Indeed, in balancing Opposers’ interest in well-known, established marks such as the ENYCE mark against Applicants’ interest in a newly adopted mark, the courts “are compelled to resolve doubts on this point against the newcomer.” Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 674, 223 U.S.P.Q. 1281, 1284 (Fed. Cir. 1984).

Given the strength of Opposer’s mark, both as coined term and a mark that has become well-known to the consuming public, the first DuPont factor weighs in favor of Opposer.

B. The Parties’ Marks are Identical and the Goods and Services are Closely Related

The greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion.

In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (T.T.A.B. 1983). See also In re Shell Oil Co., 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). (Contemporaneous use of identical or nearly identical marks can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related.")

The potential for confusion based on the use of the identical mark is self evident. When the marks at issue in a trademark dispute are identical, “the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the

marks are not identical or strikingly similar.” Amcor, Inc. v. Amcor Industries, Inc., 210 U.S.P.Q. 70, 78 (T.T.A.B. 1991). See, e.g., Pappan Enters., Inc. v. Hardee’s Food Sys., Inc., 143 F.3d 800, 804, 46 U.S.P.Q.2d 1769, 1772 (3d Cir. 1998) (“[W]here the identical mark is used concurrently by unrelated entities, the likelihood of confusion is inevitable.”); In re Martin’s Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1566, 223 U.S.P.Q. 1289, 1290 (Fed. Cir. 1984).

The lynchpin of relatedness is not how similar the goods are at first blush, but rather, how likely it is that consumers seeing the same mark applied to the different goods will perceive them as coming from the same source. CAE, Inc. v. Clean Air Eng’g, Inc., 267 F.3d 660, 679, 60 U.S.P.Q. 2d 1449 (7th Cir. 2001) (even where the products and services of the parties are “quite different” a likelihood of confusion might exist.)

As the Board has explained, “In order to find that there is likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources.” McDonald’s Corp. v. McKinley, 13 U.S.P.Q. 2d 1895, 1898 (T.T.A.B. 1989). See also In re Opus One, Inc., 60 U.S.P.Q. 2d 1812, 1814-15 (T.T.A.B. 2001).

Particularly relevant to this opposition is a case involving a well-known arbitrary mark, an opposer who had used that mark on skis and an applicant who applied to register the same mark for cigarette filters. Philip Morris, Inc. v. K2 Corp., 555 F.2d 815, 816 (C.C.P.A. 1977). In the Philip Morris proceeding, K2 Corporation sold snow skis under the arbitrary mark K2. Philip Morris applied to register K2 for cigarette filters. The Board had sustained the opposition and Applicant appealed. On appeal, the court found that snow skis and cigarette filters are

“intrinsically unrelated”, but nonetheless affirmed the ski company’s opposition on the basis of likelihood of confusion. In reaching this conclusion, the Board noted that (1) Opposer’s mark was arbitrary, (2) the parties marks were identical; (3) Applicant had sponsored ski events under its Benson & Hedges name and (4) any doubts had to be resolved against Applicant as the “newcomer.”

In the instant case, Opposer’s position is even stronger than that of the ski company in the Philip Morris case because (1) Opposer’s ENYCE mark is not just arbitrary, but is coined, (2) the marks are identical, (3) Opposer has not only sponsored car shows and car-related contests, but opposer’s direct competitors have licensed their clothing marks for use on automobiles and automobile accessories, (4) the evidence establishes that Applicant applied to register the ENYCE mark in bad faith and (5) as the “newcomer” all doubts regarding the likelihood of consumer confusion should be resolved against Applicant, Mr. Berman.

1. Applicant’s Own Actions

Perhaps Applicant’s own actions provide the best evidence of the relationship between clothing and decorative automobile accessories.

Having worked in both the clothing industry and the automobile accessory industry, and having secured and sued to enforce his own patents and trademarks, Mr. Berman knows well that a top-notch Urban Lifestyle brand can help sell wheels, rims and seat covers. That is why he attempted to license the FUBU mark for clothing. Berman Tr.105. And that is why, when the FUBU mark proved too costly, he targeted MECCA and ENYCE. When he chose not to pay to use one Urban Lifestyle brand, Mr. Berman decided to simply hijack two others.

In fact, it is only because of the likelihood that consumers would associate ENYCE, MECCA or FUBU branded car accessories with the clothing lines that made these marks so

popular, that Mr. Berman, a businessman with substantial experience in the clothing and automobile industries, choose these as the only three marks to place on his wheels, rims and seat covers.

2. Urban Lifestyle Market and Cross Licensing of Clothing Brands for Automobiles and Automobile Accessories.

The evidence in the present case reflects consumers' common expectation that clothing related marks will be licensed for use on decorative car accessories.

As set forth in great detail above, within the Urban Lifestyle market, there is a close association amongst music, clothing, decorative car accessories and jewelry. Jewelry manufacturers design pendants, watches and bracelets to look like car wheels and spinner rims. Felix Tr. 87-88, 90-91; Felix Exh. AA. Music magazines carry advertisements for these jewelry manufacturers as well as for clothing brands and automobile-related brands. Recording artists and other Urban Lifestyle celebrities own and operate automobile shops that customize vehicles with the latest trends in decorative automobile accessories. Felix Tr. 86. Hip-Hop recordings regularly feature lyrics celebrating decorative car accessories, such as wheels and rims. Felix Tr. 85.

Moreover, consumers would be likely to believe that Applicant's ENYCE goods are approved by or emanate from Opposer because consumers are accustomed to the licensing of clothing and fashion-related marks for collateral products, such as decorative car accessories. See, e.g., Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 32-35, 9 U.S.P.Q.2d 1690, 1698-99 (1st Cir. 1989) (public likely to believe the sponsor of BOSTON MARATHON race produces, licenses or endorses defendant's t-shirts bearing that mark); Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004, 1012, 185 U.S.P.Q. 364, 369 (5th Cir. 1975), cert.

denied, 423 U.S. 868 (1975) (defendant's embroidered emblems bearing professional hockey teams' marks caused confusion); Paramount Pictures Corp. v. Levy, 1992 TTAB LEXIS 51 (T.T.A.B. Feb.12, 1992) (likelihood of confusion between opposer's MISSION IMPOSSIBLE television series and applicant's use of mark on apparel). As the Board noted more than ten years ago, “[t]he licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens, etc.), which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.” Turner Entertainment Co. v. Nelson, 38 U.S.P.Q.2d 1942, 1945 (T.T.A.B. 1996). See also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group, Inc., 648 F.2d 1335, 1336 n.3, 209 U.S.P.Q. 986, 988 n.3 (C.C.P.A. 1981) (use of marks on collateral products “has become a part of life which we cannot ignore”).

Opposer and its competitors have established ties with the automobile industry through their sponsorship of automobile related events and the licensing of their marks for use on automobiles and decorative automobile accessories.

The Enyce mark has appeared on an automobile customized by a Hip-Hop recording artist and given away through a promotional contest. Felix Tr. 60-63, 68-69; Felix Exhs. W-Z. It has been featured in two car racing films and has been promoted through the sponsorship of car shows and through car show ticket give-aways. Felix Tr. 68-69, 72. The ENYCE brand is regularly advertised in magazines dedicated to aftermarket car accessories and in other magazines that celebrate car fashion and advertise jewelry designed to look like automobile wheels and rims. Felix Tr. 28-30, 38-41; Exhs. J, L-O, AA and BB.

Such evidence supports the conclusion that consumers would likely believe that ENYCE apparel and ENYCE decorative car accessories emanate from the same source. Nasdaq Stock Mkt., Inc. v. Antartica, 69 U.S.P.Q.2d 1718, 1731-1732 (T.T.A.B. 2003) (when a trademark

holder has used its mark “on or in conjunction with collateral products and as an indicia of [the trademark holder’s] sponsorship of a wide variety of events” a reasonable consumer, when confronted that mark on such types of goods “will consider such goods either to be promotional items of opposer or products branded with opposer's mark in conjunction with opposer's sponsorship of an event”). In Nasdaq, Antarctica had applied to register NASDAQ for sports equipment and sports clothing and Nasdaq opposed the application. Even though the Board found that opposer’s services were “per se, very different from applicant’s identified goods” it sustained the opposition. In that case Nasdaq, like Enyce, engaged in extensive advertising and promotion of its mark and, like Enyce, had sponsored events in a field related to applicant’s goods and maintained an often-visited website. *Id.* at 1732. The Board in Nasdaq relied on these facts in sustaining the opposition. Applying the logic of the Nasdaq holding to the facts before the Board here, this opposition should be sustained.

Moving beyond Opposer’s own automobile-related activity, the activity of Opposer’s competitors would shape the expectations of consumers. CAE, Inc., 267 F.3d at 680 (citing fact that Opposer’s competitors offer goods similar to those set forth in application as evidence that consumers would reasonably expect Opposer to expand into its business to offer applied-for products); Forum Corporation of North America v. Forum Ltd., 903 F.2d 434, 442, 14 U.S.P.Q.2d 1950, (7th Cir. 1990) (“[A] trademark protects the owner against not only its use upon the articles to which he has applied but also upon such other articles as might naturally or reasonably be supposed to come from him”), (citing Helene Curtis Indus., Inc. v. Church & Dwight Co., 560 F.2d 1325, 1331 (7th Cir. 1977), cert. denied, 434 U.S. 1070, 55 L. Ed. 2d 772, 98 Sup.Ct. 1252 (1978)). When a trademark holder’s “major competitors” have expanded into a specific area, it is evidence of a natural area of expansion of the trademark holder. CAE, Inc.,

267 F.3d at 679 (“[B]ecause the rights of an owner of a registered trademark extend to any goods that might be, in the minds of consumers, "related," i.e., put out by a single producer, the more accurate inquiry is whether the public is likely to attribute the products and services to a single source.”); Sands, Taylor & Wood v. Quaker Oats Co., 978 F.2d 947, 958, 24 U.S.P.Q.2d 1001, 1010 (7th Cir. 1992) (“Closely related" products are those that "would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner.”; See also In re Phillips-Van Heusen Corp., 228 U.S.P.Q. 949, 951 (T.T.A.B. 1986) (finding likelihood of confusion between registrant’s mark for restaurant services and towels and applied for mark for clothing; “common trade practice” of licensing marks for collateral products reflected in numerous third-party registrations of marks for both restaurant services and clothing and fact “that registrant itself has registered its mark for a collateral product, namely, towels.”).

Enyce’s competitors in the Urban Lifestyle market have fostered an association with aftermarket automobile accessories. Not only do Enyce’s competitors appear in the same magazines alongside automobile-related feature stories and advertisements, but SEAN JOHN has been licensed for use on customized decorative wheels. Felix Tr. 49-60; Burman Tr. 72-73; Exhibits I and J; Cadenilla Exhs. EE-FF. Likewise the LEXANI footwear brand has been used in connection with aftermarket decorative wheels. Felix Tr. 91-92, Exh. AA. Nissan has launched a MARC ECKO special edition line of automobiles and LRG has licensed its mark for all terrain vehicles. Felix Tr. 79, 89-90, Exh. AA and BB. Moreover, the VANS footwear brand has been used in connection with motorcycle racing and the LUGZ footwear mark is used on driving shoes and is closely associated with the automobile car culture. Berman Tr. 69; Exh. H and Cadenilla Decl. Exhs. GG-II.

The similarity of the marks and relatedness of the goods are two separate factors in the likelihood of confusion test. The second and third DuPont factors favor Opposer.

C. Trade Channels and Purchasers

Where products travel through the same or related trade channels, confusion is also more likely. DuPont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. “Absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.” Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1268, 62 U.S.P.Q. 2d 1001, 1005 (Fed. Cir. 2002); See also Bose, 293 F.3d at 1377, 63 U.S.P.Q.2d at 1310-11; Charrette Corp. v. Bowater Communication Papers, Inc., 13 U.S.P.Q.2d 2040, 2042 (T.T.A.B. 1989); McDonald’s Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1898 (T.T.A.B. 1989); Hewlett-Packard, 281 F.3d at 1268, 62 U.S.P.Q. 2d at 1005 (“As this court has previously stated absent, restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”); Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Assoc., 811 F.2d 1490, 1493, 1 U.S.P.Q. 2d 1813, 1814-15 (Fed. Cir. 1987) (“The issue of likelihood of confusion must be resolved [based] ... on consideration of the goods named in the application and in opposer’s registration and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution.”); Squirteo v. Tony Corp., 697 F.2d 1038, 1042-43, 216 U.S.P.Q. 2d 930, 940 (Fed. Cir. 1983) (“Where the likelihood of confusion is asserted with a registered mark, the issue must be resolved on the basis of the goods named in the registration and, in the absence of specific limitations in the registration, on the basis of all normal and usual channels of trade.”)

Since there is no limitation in Mr. Berman's application as to the trade channels through which his products will be distributed, one must assume that he will exploit any and all relevant trade channels. These would include those through which Opposer distributes its ENYCE clothing products.

As set forth in great detail in Sections II, III and V of the Statement of Facts, the evidence establishes that Opposer advertises and distributes its products through the same channels of trade through which decorative automobile accessories are advertised and distributed. These are channels of trade in which clothing and decorative automobile accessories are closely related and in which Opposer and its competitors regularly use their clothing marks on and in connection with automobiles, automobile accessories and automobile-related events. In Opposer's market, clothing and decorative car accessories are advertised, promoted and celebrated in the same lifestyle magazines and are advertised and sold through the same websites. They are promoted at the same trade shows and through the same contests. The same Urban Lifestyle celebrities endorse clothing brands and automobile accessory brands alike. In light of these facts, consumers are likely to assume that ENYCE-branded car accessories originate with Opposer. Accordingly, the fourth DuPont factor favors Opposer.

D. Third Party Use

Since there is no third party use of the ENYCE mark, this fifth DuPont factor favors Opposer.

E. Applicant's Bad Faith

1. Applicant Targets Well-known Marks for Pirating

Where there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, this factor weighs in favor of a likelihood

of confusion. See Roger & Gallet S.A. v. Venice Trading Co., 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 1987). The Court in Shoe Corp. of America v. Juvenile Shoe Corp., 266 F.2d 793, 121 U.S.P.Q. 510 (C.C.P.A. 1959) succinctly explained the rationale for such a rule:

[I]f, in the adoption and use of the mark there be a purpose of confusing the mind of the public as to the origin of the goods to which it is applied, we have a right, in determining the question of likelihood of confusion or mistake, to consider the motive in adopting the mark as indicating an opinion, upon the part of one vitally interested, that confusion or mistake would likely result from use of the mark.

Id. at 795, 512 (citations omitted). Indeed, there is “no excuse for even approaching the well-known trademark of a competitor” because “to do so raises but one inference – that of gaining advantage from the wide reputation established by [another]” Planters Nut & Chocolate Co. v. Crown Nut Co., 305 F.2d 916, 924-25, 134 U.S.P.Q. 504, 511 (C.C.P.A. 1962) (citation omitted).

In the present case, the evidence strongly suggests that Applicant was motivated by an intent to trade upon the goodwill of Opposer and that his actions evidence his opinion that confusion would likely result.

As detailed in Sections VII and VIII of the Statement of Facts and Section II B.1. of the Argument, Mr. Berman applied to register ENYCE in bad faith. Specifically, when choosing potential marks for his automobile accessories, Mr. Berman focused exclusively on Urban Lifestyle marks owned by others. First, he considered legitimately licensing the FUBU mark. When that did not work out, he chose a different strategy and applied to register MECCA and ENYCE in his own name.

2. Applicant's Testimony Lacks Credibility and Illustrates a Contempt for the Proceedings

Almost as remarkable as Mr. Berman's testimony regarding his attempts to license the FUBU mark was his testimony that illustrated a glaring lack of credibility and apparent contempt for these opposition proceeding.

When asked how the mark ENYCE is pronounced, Mr. Berman claimed that when adopting and applying to register the ENYCE mark, he had never even considered how one would pronounce the mark. Berman Tr. 32. He claimed that the first time he heard ENYCE pronounced was when he took Opposer's deposition. Who would adopt and apply to register a mark without giving a moment's thought to how consumers would pronounce that mark? Perhaps no one. Or perhaps someone who was hijacking another's trademark knowing that however it was pronounced, it would be recognized and sought after by brand-loyal consumers.

How could Mr. Berman possibly explain away the fact that after failing to license FUBU, and having applied to register MECCA, he had next filed an application to register yet a third well-known Urban Lifestyle clothing mark? According to Mr. Berman, he had invented the ENYCE mark himself by adding the letter "e" to the beginning and the end of NYC, the abbreviation for New York City. Berman Tr. 39. Despite this tidy explanation, Mr. Berman was at a loss to explain why he thought ENYCE would be a good trademark for automobile accessories. Berman Tr. 41. He did, however, testify that if his branding strategy worked in connection with New York City, he would add and "e" to the beginning and the end of Detroit, LA, Philly and Chicago and roll out an entire family of marks. Berman Tr. 39, 127-128. Again, this testimony appeared to explain away the fact that he had applied to register a well-known,

coined mark. But when asked how he would spell the Philly formative-mark or any of the other marks he allegedly had in mind, Mr. Berman had no answer. Berman Tr.129-131.

Mr. Berman's credibility was further damaged when he was called upon to discuss his application to register MECCA, a mark that, like FUBU and ENYCE, had been registered previously by another entity and had become well-known, particularly in the Urban Lifestyle market. After explaining that he had chosen this mark as a reference to the city to which Muslims make pilgrimages, he volunteered that the reason he had abandoned that mark was because of an anti-Muslim sentiment in the United States "at this time." Berman Tr. 53. Again, it would have appeared that Mr. Berman had provided a cohesive and innocent explanation for his selection of the MECCA mark. But even casual scrutiny of Mr. Berman's account raises questions. Mr. Berman's MECCA application was filed in August 2003, nearly two years after the attacks on the World Trade Center and the Pentagon and five months after the United States' invasion of Iraq. Surely, the anti-Muslim sentiment in the United States was no more prevalent in 2004 when he abandoned the MECCA application than it was in 2003 when Mr. Berman filed it. When given the opportunity to explain this apparent flaw in his story, Mr. Berman answered "I don't know, I don't recall." Berman Tr. 133. So here again, Mr. Berman's efforts to explain away the MECCA application not only fall short, but raise significant questions regarding his credibility.

When questioned about lifestyle clothing brands and the licensing of such brands for automobiles, Mr. Berman testified "I don't know anything about LL Bean." But moments later he volunteered, "[a]nd neither do you apparently, because you keep calling it L&L Bean. At least I know it's LL Bean." Berman Tr. 137-138. Apparently Mr. Berman's fondness for snide

answers had overcome his strategy of denying any and all knowledge regarding lifestyle clothing brands and the use of such brands on automobiles.

In addition to providing dubious explanations for his selection of the MECCA and ENYCE trademarks, Mr. Berman exhibited disregard and even a certain level of contempt, for the opposition proceedings. Mr. Berman simply refused to answer certain questions claiming that he was “not prepared to answer” them or that the questions had been “asked and answered.” Berman Tr. 81-83, 122, 132, 135-136, 142-143. Mr. Berman’s contempt for the proceedings peaked when he asked the court reporter to “note that I am laughing for the record” and then later, when asked whether he was familiar with clothing brands sponsoring car shows, he inexplicably instructed the court reporter to “please take note that I’m laughing again.” Berman Tr. 56 and 85.

Given Applicant’s bad faith in adopting the ENYCE mark and in conducting these proceedings, the sixth DuPont factor favors Opposer.

III.

APPLICANT HAD NO *BONA FIDE* INTENT TO USE THE MARK ON THE GOODS LISTED IN THE APPLICATION

This opposition should also be sustained because Applicant lacked a *bona fide* intention to use the ENYCE mark at the time he filed his application, as required by section 1(b) of the Lanham Act, 15 U.S.C. § 1051 (2007). Paragraph 11 of Opposers’ Amended Notice of Opposition alleged that “Applicant did not have a *bona fide* intention to use the ENYCE Mark in commerce for the specified goods when he filed his intent to use application.”

Mr. Berman has made no use of the ENYCE mark and does not intend to even begin planning for his use of the mark make until the Board renders a decision in this Opposition.

Berman Tr. 40, 106, Opp. Second Not of Rel., Applicant's Responses to Interrogatories Nos. 14-18. Evidently, Mr. Berman's business plan is to first see if his goal of exploiting another's well-known mark will be sanctioned by the United States Patent and Trademark Office. Then, if he receives a registration, he will build a business around the pirated mark. Based on his testimony, that business may simply be the sale of the registration back to Opposer.

The legislative history for the Trademark Law Revision Act of 1988, which introduced the intent-to-use process, makes clear that "Congress intended the test of '*bona fide*' to be evidenced by 'objective' evidence of 'circumstances' showing 'good faith.'" 3 J.T. McCarthy, supra, § 19:14, at 19-40. Recognizing the requirement of objective proof to support a *bona fide* intention to use, the Board has held that "absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a *bona fide* intention to use its mark in commerce as required by Section 1(b)." Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993); Intel Corp. v. Steven Emeny, 2007 WL 1676781 (T.T.A.B. 2007).

In his discovery responses Applicant admitted that there were no documents in his possession, custody or control relating to his intended use of the ENYCE mark.⁸ In particular, Applicant confirmed that there were no documents reflecting his *bona fide* intent to use the ENYCE mark and that there were no documents concerning any steps he had taken to use the ENYCE. Opp. Second Not of Rel., Applicant's Responses to Interrogatories Nos. 14-18. In

⁸ Applicant's lack of *bona fide* intent is further evidenced by the fact that he abandoned his MECCA application which covered the same goods as the ENYCE application. Berman Ex. C.

several of his responses to Opposer's document requests, Mr. Berman wrote "Applicant has not decided on the intended use." *Id.* The complete absence of any documentary evidence concerning Applicant's intent to use the ENYCE mark serves to establish that Applicant lacked a *bona fide* intention to use such mark at the time he filed his application. See Commodore Electronics, 26 U.S.P.Q.2d at 1507.

As Professor McCarthy cogently explains in his leading treatise, the required evidence of a *bona fide* intent must be "in the form of real life facts and by the actions of applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of the applicant later testifying, 'Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future.'" McCarthy, *supra*, § 19:14, at 19-40. See also Lane Ltd. v. Jackson Int'l Trading Co., 33 U.S.P.Q.2d 1351, 1355 (T.T.A.B. 1994) ("[A]pplicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's *bona fide* intention to use the mark in commerce").

Remarkably, the record includes not only Mr. Berman's admissions that he had no documents evidencing an intent to use the mark, it also includes his testimony that altogether undermines any legitimate claim of intent. When asked whether, at the time he filed the application, he intended to use the mark on the goods covered in that application, Mr. Berman testified that "perhaps" he wanted to use the mark on fitted car covers, that he "probably" intended to use the mark on license plate holders and that he had "no" intention of using the mark on brake pads, even though brake pads were listed in the application. Berman Tr. 107-108.

In short, Applicant did not have the necessary *bona fide* intention to use the ENYCE mark within the meaning of the Lanham Act and thus his application should be deemed void ab initio.

CONCLUSION

For the foregoing reasons, the opposition should be sustained.

Dated: New York, New York
June 14, 2007

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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing Opposer's Brief on Final Hearing to be served on June 14, 2007 upon Applicant by first class mail, postage prepaid to Applicant at the following address:

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