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

Proceeding	91181022
Party	Plaintiff American Deli Plus, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/755527 for
AMERICAN DELI
Published in the *Official Gazette* on October 2, 2007
(Term for opposition having been extended to
December 3, 2007)

American Deli Plus, Inc.,	)	
Opposer,	)	
v.	)	Opposition No.: 91181022
Yong Lee and Alexander Lee, d/b/a Clean Pass of Atlanta,	)	
Applicant.	)	

OPPOSER AMERICAN DELI PLUS, INC.'S RESPONSE IN OPPOSITION TO APPLICANT'S MOTION TO DENY THE OPPOSITION TO APPLICANT'S TRADEMARK APPLICATION

I. PROCEDURAL STATEMENT

This response is filed in opposition to the Motion to Deny the Opposition to Applicant's Trademark Application ("Motion"), filed by Applicants Yong Lee and Alexander Lee, d/b/a Clean Pass of Atlanta ("Applicant" or "Clean Pass") on January 8. 2009. Subsequent to Applicant filing its Motion, on January 14, 2009, the Board, through interlocutory attorney Linda Skoro, issued an order suspending proceedings in this opposition. In that order, interlocutory attorney Skoro also noted that Applicant had referenced documentary evidence, but failed to properly introduce and authenticate it.

Noting that the interlocutory attorney seemed to, but did not expressly, invite Applicant to correct this deficiency, Opposer filed a Motion to Clarify and to Extend on February 3, 2009.

Since the Motion to Clarify and to Extend has not been ruled on, Opposer is submitting this brief in Opposition on the date it would be due with no extension. However, Opposer notes that on the day this brief is being submitted, Applicant served on Opposer a document entitled "Applicant's Cross Motion for Summary Judgment Against Opposition's [sic] Motion for Summary Judgment," ("Second Motion"). Opposer assumes this Second Motion is an attempt to correct the evidentiary deficiencies noted in the Board's January 14 Order. Obviously, Opposer is not in a position to respond to a motion for summary judgment on the same day it receives it. Accordingly, Opposer intends to respond to Applicant's Second Motion 35 days from the date it was served. Further, notwithstanding the present response, Opposer renews its Motion to Clarify and to Extend, and asks that the Board order that Opposer's responses to the Motion and the Second Motion be due 35 days from the date the Second Motion was served.

II. BACKGROUND

The original American Deli restaurant was opened in the late 1980's by Mrs. Choi (now deceased) in The Gallery Mall, Decatur, Georgia. *See* Kim Decl., ¶ 3. In 1991, Mr. Kim purchased the Decatur American Deli store as a going concern from Mrs. Choi, including the AMERICAN DELI mark and the goodwill associated with the AMERICAN DELI mark, and continued operating the store under the AMERICAN DELI name. *Id.* at ¶ 4. While at the Decatur American Deli restaurant, Mr. Kim created the formula for the special sauce that is still used today for Opposer's signature spicy chicken wings. *Id.* Since purchasing the Decatur American Deli restaurant, Mr. Kim has opened a number of American Deli restaurants throughout Georgia. *Id.* at ¶ 5. In addition to spicy chicken wings, American Deli's restaurants offer sandwiches, burgers, and fries under the AMERICAN DELI name. *Id.* at ¶ 4.

In 1998, Mr. Kim incorporated the business under the name Chong C. Kim, Inc. *Id.* at ¶ 6. The American Deli business, including the Decatur store, was operated by Chong C. Kim,

Inc. until 2006. *Id.* In 2006, Mr. Kim incorporated Opposer American Deli Plus, Inc. and American Deli, Inc. *Id.* at ¶ 7. From 2006 to 2008, operation of American Deli was transferred from Chong C. Kim, Inc. to American Deli Plus, Inc. and American Deli, Inc. *Id.* The AMERICAN DELI mark was assigned from Mr. Kim and Chong C. Kim, Inc. to American Deli Plus, Inc. *Id.* Thus, Opposer, itself and through its predecessors in interest, have continuously used the AMERICAN DELI mark to identify its services since at least 1989. *Id.* at ¶ 8.

III. ARGUMENT

A. Summary Judgment Standard

Summary Judgment is appropriate where "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." TBMP 528.01 (quoting Fed. R. Civ. P. 56(c) and citing *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dana Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991)). The summary judgment movant has burden to show "the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law." TBMP 528.01. Summary judgment is appropriately granted where "there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case." *Id.*

Summary judgment in favor of Applicant is inappropriate in this action because Applicant has not shown that Opposer will not be able to establish its claim at trial. Opposer may prevail in this opposition by showing that it has senior rights in the AMERICAN DELI

mark and that the proposed use is likely to cause confusion. *See* TBMP 309.03(c)(1). The "evidence" relied on by Applicant could at best only stand for the proposition that it has used the AMERICAN DELI mark as early as 1999.[1] However, since the evidence submitted by Opposer herewith[2] demonstrates that it and its predecessors in interest have used the AMERICAN DELI name since 1989, Applicant's "evidence" cannot provide a basis for summary judgment in its favor. Applicant also seems to suggest (without evidence) that there may not be a likelihood of confusion between Opposer's mark and services and those of Applicant. This argument strains the bounds of reason since the marks are identical and the goods listed in Applicant's application just happen to all be on Opposer's menu. Finally, Applicant cannot win on any type of no evidence ground because Applicant has not sought any discovery from Opposer and Opposer's testimony period had not begun before Applicant filed its Motion. Therefore, Opposer has had no previous reason or opportunity to submit evidence in support of its claims.

B. Applicant's Entire Motion is Filled with Unsupported Accusations, Irrelevant Facts, and Misstatements of the Law

Clearly, Applicant is not being represented or even advised by competent trademark counsel in this proceeding. Applicant only attempted provide to provide evidentiary support for two factual assertions out of the many made in its brief. However, even those attempts fail, since Applicant did not properly authenticate the referenced documents or provide any exception to the hearsay rule. Applicant's legal arguments likewise demonstrate a lack on understanding of trademark law. Most notably, Applicant makes much of the fact that Opposer was not incorporated until 2006, ignoring the well-known legal doctrine that use by Opposer's predecessors in interest inures to Opposer's benefit for purposes of determining seniority. Lacking any evidentiary or legal basis for its Motion, Applicant attempts to persuade by making

[1] Opposer contests this fact.
[2] Opposer believes that it has sufficient evidence to prove this fact as a matter of law. That evidence will be provided in conjunction with Opposer's own Motion for Summary Judgment.

liberal use of bold, underlined and all caps text and exclamation marks. Notwithstanding the ferocity with which Applicant makes its arguments, the Motion must be denied.

C. American Deli is the Senior User of the AMERICAN DELI Mark

As discussed in the background section above, Opposer American Deli Plus, Inc., and its predecessors in interest, have been using the AMERICAN DELI mark since at least as early as the late 1980's. *See* Kim Decl., ¶¶ 3-8. The earliest date of use of the AMERICAN DELI name even claimed by Applicant in its Motion is 1999.[3] Therefore, Opposer's date of use precedes the earliest date claimed by Applicant by a decade.

In its Motion, Applicant argues that Opposer cannot claim use of the AMERICAN DELI mark since the 1980's since the "corporation was not filed with the Georgia Secretary of State until 2006." Motion, p. 2. However, Opposer is entitled to claim the use of its predecessors in interest for the purpose of determining seniority. *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 18:15 (4th ed.2002) and cases cited therein. As explained in the background section, Opposer claims the benefit of a chain of title to the AMERICAN DELI mark dating back to the late 1980's. *See* Kim Decl., ¶¶ 3-8. Applicant has not made any arguments, must less proffered evidence, suggesting that Opposer is not entitled to rely on priority gained through this chain of title.

D. Clean Pass' Use of the AMERICAN DELI Mark in Connection with the Goods and Services Listed in its Application is Likely to Cause Confusion with the Services of American Deli

Applicant suggests that there is no likelihood of confusion between the applied-for mark in connection with food goods and Opposer's use of the AMERICAN DELI mark in connection with its restaurant services. In drawing this conclusion, Applicant does not even discuss the

[3] Opposer believes and intends to prove at trial that Applicant had abandoned any use it may have made of the AMERICAN DELI mark before it filed its intent to use application in 2005.

relevant *du Pont* factors or provide any evidence supporting its position. Considering several of these factors, as discussed below,[4] the existence of a likelihood of confusion is apparent.

The first *du Pont* factor addresses the similarity of the marks in their entireties. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Here the applied-for mark is identical to Opposer's mark – AMERICAN DELI. Therefore, this factor strongly favors a finding of likelihood of confusion. The second *du Pont* factor addresses the similarity and nature of the goods and services described in Applicant's application and Opposer's prior use. *Id.* Applicant has applied to register AMERICAN DELI in connection with *spicy chicken wings, prepared breaded chicken pieces and French fries* (IC 029) and *hamburger sandwiches, submarine sandwiches, pizza, fried rice and bakery desserts* (IC 030). Opposer (or its predecessors in interest) has been continuously using the AMERICAN DELI mark in connection with *café and restaurant services* (IC 043) since at least 1989. *See* Kim Decl. ¶¶ 3-8.

It is not necessary that Applicant's goods and Opposer's services be identical to support a likelihood of confusion, all that is required is that they be "related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services." *See In re Opus One, Inc.*, 60 U.SP.Q2d 1812, 1814-1815 (TTAB 2001). In the context of establishing such a relationship between food goods and restaurant services, there must be also be "something more," such as a commercial relationship between the type of food and the restaurant services being provided. *Id.* at 1815 (comparing wine with restaurant

[4] This discussion is not intended to include all of Opposer's arguments regarding likelihood of confusion, which will be presented in Applicant's own motion for summary judgment. The discussion here merely exemplifies several of the factors in response to Applicant's unsupported assertion that there is no likelihood of confusion.

services). There is such a commercial relationship between Applicant's café or restaurant-style foods products and Opposer's café and restaurant services. Applicant has specifically identified its food goods as including spicy chicken wings, hamburgers, sandwiches and pizza – all of which are traditionally served in cafés and restaurants of the type operated by Opposer under the AMERICAN DELI mark. Indeed, with the exception of pizza, Opposer offers these exact types of foods under the AMERICAN DELI mark in its restaurants. *See* Kim Decl. ¶ 4. Based on the close relationship between the type of food goods claimed by Applicant and the restaurant services of Opposer, the second *du Pont* factor also favors a finding of likelihood of confusion. *See In re Opus One*, 60 U.S.P.Q.2d at 1815 ("The fact that applicant's restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that applicant's services and opposer's goods are related.").

The fourth *du Pont* factor addresses the conditions under which and buyers to whom sales are made, i.e. "impulse" versus careful, sophisticated purchasing. *See In re du Pont*, 476 F.2d at 1361. Applicant's goods are presumed to encompass inexpensive food items. *See In re Opus One*, 60 U.SP.Q2d at 1818 (regardless of evidence of actual use, analysis is based on goods described in the application, which are presumed to encompass inexpensive goods). Moreover, given the nature of the goods – spicy chicken wings, hamburgers, sandwiches, pizza, etc. – it is undisputable that Applicant's goods are inexpensive and the consuming public is not particularly sophisticated or careful in their selection, since they ostensibly do not expect to own the goods for very long before they are consumed. Accordingly, this factor also favors a finding of likelihood of confusion.

The only *du Pont* factor even alluded to by Applicant is the sixth factor, the number and nature of similar marks in use on similar goods. Applicant asserts that "[i]n light of the various

business [sic] using the word 'American Deli' already doing business in the State of Georgia, obviously makes this averment [regarding likelihood of confusion] totally frivolous." See Motion, p. 5. Applicant does not even identify by name these alleged other businesses, much less has it offered any admissible evidence to support this assertion. As such, there is no evidence on the sixth factor, which is therefore neutral.

Applicant's assertion that there is no likelihood of confusion does not withstand scrutiny. At least three *du Pont* factors weigh in favor of finding a likelihood of confusion. Accordingly, on the record presented on Applicant's motion, Applicant's is not entitled to summary judgment based on the alleged lack of a likelihood of confusion.

IV. CONCLUSION

Applicant's motion is devoid of admissible evidence and is based on erroneous legal assertions. Opposer, on the other hand, has proffered evidence and sound legal argument in favor of both elements of at least one of the grounds for this opposition. Accordingly, Opposer respectfully requests that Applicant's Motion be denied.

Respectfully submitted,

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Counsel for Opposer, American Deli Plus, Inc.

Certificate of Service

I hereby certify that a true and complete copy of the foregoing document, along with all attachments, has been served on all parties to this proceeding by mailing said copy on February 11, 2009, via First Class Mail, postage prepaid to:

Clean Pass of Atlanta
1228 Christiana Crossing
Lawrenceville, GA 30043

____/George Tompkins/_____

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DECLARATION

I, Chong C. Kim, declare under penalty of perjury, as follows:

1. I am over 18 years of age and I have never been convicted of a felony. I make this Declaration upon my personal knowledge.

2. I am the President and majority shareholder of Opposer American Deli Plus, Inc. and its affiliate American Deli, Inc. I have been involved with American Deli Plus, Inc., American Deli, Inc. and their predecessors in interest to the AMERICAN DELI service mark since 1991.

3. The original American Deli restaurant was opened by Mrs. Choi in The Gallery Mall, Decatur, Georgia in the late 1980's.

4. In 1991, I purchased all of the assets of the Decatur American Deli store as a going concern from Mrs. Choi, including the AMERICAN DELI mark and the goodwill associated with the AMERICAN DELI mark, and continued operating the store under the AMERICAN DELI name. While at the Decatur American Deli, I created the formula for the special sauce that is still used today for Opposer and American Deli Inc.'s signature spicy chicken wings. In addition to spicy chicken wings, our American Deli restaurants offer sandwiches, burgers, and fries, under the AMERICAN DELI mark.

5. Since that time, I have opened and operated a number of other American Deli restaurants throughout Georgia.

6. In 1998, I incorporated the business under the name Chong C. Kim, Inc. The American Deli business, including the Decatur store, was operated by Chong C. Kim, Inc. until 2006.

7. In 2006, I incorporated Opposer American Deli Plus, Inc. and American Deli, Inc. From 2006 to 2008, I transferred the operation of American Deli from Chong C. Kim, Inc. to American Deli Plus, Inc. and American Deli, Inc. Chong C. Kim, Inc. assigned the AMERICAN DELI mark and associated goodwill to American Deli Plus, Inc.

8. American Deli Plus, Inc. and its affiliate American Deli, Inc. and their predecessors in interest have continuously used the AMERICAN DELI mark to identify its services since at least 1989.

* * *

Executed at Atlanta, Georgia on February 11, 2009.

Chong C. Kim