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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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Date	03/19/2009
Attachments	Response to Cross Motion.pdf (23 pages)(816414 bytes)

**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
APPLICANTS' MOTION TO DENY THE OPPOSITION TO APPLICANTS'
TRADEMARK APPLICATION AND APPLICANTS' CROSS MOTION FOR
SUMMARY JUDGMENT**

I. INTRODUCTION AND SUMMARY OF THE ARGUMENTS

Applicants' Cross Motion for Summary Judgment ("Cross Motion") is a collection of repetitive, incoherent arguments based on an obvious lack of understanding of either substantive or procedural law. Applicants' two main arguments appear to be 1) that Opposer has not submitted any evidence in support of its claims and 2) that Opposer cannot have rights going further back in time than its formation date in 2006. However, prior to this response, Opposer has not been under any duty to submit evidence. Therefore, the lack of any prior evidentiary submission cannot be grounds for summary judgment. Also, although American Deli Plus, Inc.

was formed in 2006, it is entitled to claim priority based on use of the AMERICAN DELI mark by its predecessors in interest since at least 1991.

Applicants fail to support any of their factual assertions with admissible evidence. In fact, there is not a single item of admissible evidence included with the motion. Further, even Applicants' unsupported assertions admit that they used the AMERICAN DELI name no earlier than 1999 and that they have not used the name since 2001. In contrast, Opposer submits uncontroverted evidence herewith that it and its predecessors have used the AMERICAN DELI mark continuously from at least 1991 to the present. Accordingly, Applicants' Cross Motion should be denied.

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. Chong C. 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.

In contrast, Applicants, in their Cross Motion, fail to attach any admissible evidence showing that they have ever used the AMERICAN DELI mark. Even their unsupported assertions only claim use of the mark from as early as 1999—a decade after Opposer began using the mark. *See* Cross Motion, p. 10. Applicants also admit that they have not used the mark since 2001. *Id.* Thus, Applicants’ only current claim to rights in the AMERICAN DELI mark stems from their filing of the intent to use application that is the subject of this opposition.

III. PROCEDURAL STATEMENT

On January 8, 2009 Applicants Yong Lee and Alexander Lee, d/b/a Clean Pass of Atlanta (“Applicants” or “Clean Pass”) filed a Motion to Deny the Opposition to Applicants’ Trademark Application (“Motion to Deny”). Subsequent to Applicants filing its Motion to Deny, 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 Applicants had referenced documentary evidence, but failed to properly attach it.

Opposer filed a Motion to Clarify and to Extend on February 3, 2009. When the due date for Opposer’s response to Applicants’ Motion to Deny arrived prior to a ruling on Opposer’s Motion to Clarify and to Extend, Opposer filed a Response in Opposition to Applicants’ Motion to Deny, even though Opposer also renewed its request for an extension. On February 11, 2009, the same day Opposer filed its Response in Opposition to Applicants’ Motion to Deny, Applicants served their Cross Motion on Opposer. Applicants’ Cross Motion is very similar in

“substance” to its earlier Motion to Deny, although the latter includes a handful of additional, inadmissible and unauthenticated exhibits.

On February 17, 2009, Interlocutory Attorney Linda Skoro, noting Opposer’s Motion to Clarify and to Extend and Applicants’ newly-filed Cross Motion and granted Opposer’s requested extension of time to respond to the motions. Pursuant to the February 17 order, Opposer hereby submits its response to Applicants’ Cross Motion.

IV. 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 the 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 Applicants is inappropriate in this action because the uncontroverted evidence Opposer submits herewith demonstrates that Opposer will be able to establish its claim at trial. Opposer will 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 submitted by Opposer herewith demonstrates that it and its predecessors in interest have used the AMERICAN DELI name since 1989.¹ In contrast, the “evidence” relied on by Applicants is completely inadmissible and, even if it were considered, could at best only stand for the proposition that Applicants have used the AMERICAN DELI mark as early as 1999, while Opposer incontrovertibly began its use in 1991, if not earlier.² Thus, Applicants’ “evidence” cannot provide a basis for summary judgment in their favor.

Applicants also seem 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 nearly all of the goods listed in Applicants’ application just happen to be on Opposer’s menu. Finally, Applicants cannot win on any type of no evidence ground because Opposer submits with this opposition sufficient evidence to create at least a fact issue as to Opposer’s claims.³

B. Applicants Offers No Admissible Evidence in Support of Its Motions

Applicants’ legal arguments are premised upon an incorrect understanding of trademark law. Notably, Applicants make much of the fact that Opposer was not incorporated until 2006; ignoring: (1) the long and well-established legal doctrine that use by Opposer’s predecessors in interest inures to Opposer’s benefit for purposes of determining seniority; and (2) the indisputable fact that Opposer and Mr. Kim have been using the AMERICAN DELI mark and

¹ 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.

² Opposer contests this fact.

³ Although Applicants makes many statements in its Cross Motion that Opposer has not produced any evidence in support of its claims, Opposer’s testimony period had not started at the time Applicants filed its Motion to Deny, and Applicants has never served any discovery requests on Opposer. Therefore, Opposer has not previously been required to present any evidence in support of its claims.

name since at least 1991. Not surprisingly, therefore, Applicant's sole and only "evidence" for their first use begins in 1999, many years after Opposer's first use.

Additionally, Applicants repeatedly claim that Opposer has failed to submit evidence in support of its claims, yet they cite no legal requirement for Opposer to have submitted any evidence prior to filing this response brief. Further, as discussed in detail below, Applicants fail to include a single item of admissible evidence in support of their Cross Motion. Lacking any evidentiary or legal basis for their Cross Motion, Applicants attempt to persuade by making liberal use of bold, underlined and all caps text and exclamation marks. Notwithstanding the ferocity with which Applicants makes its arguments, the Cross Motion must be denied.

Opposer's objections to each factual assertion and item of "evidence" in Applicants' Cross Motion are discussed below.

1. Discussions Regarding Potential Purchase of Trademark Application

In their Cross Motion, Applicants asserts "at one time, the Opposer agreed to enter into a financial agreement with Applicants as to the instant trade mark." Cross Motion, p. 2. This alleged statement is not supported by affidavit or declaration and should not be considered. Further, any and all alleged statements and offers made during those discussions were necessarily made for the purpose of settlement negotiations and are not admissible under FRE 408. Finally, even if the statements were admissible evidence, they are irrelevant and have no tendency to show that Applicants has any rights in the American Deli mark which are senior to those of American Deli.

2. "Exhibit A" Information Allegedly from Georgia Secretary of State

Applicants references information allegedly from the Georgia Secretary of State regarding, *inter alia*, the date of formation of Applicant. See Cross Motion, p. 2. The referenced information is inadmissible because it was not properly attached to Applicants' Cross

Motion and because it has not been shown to be authentic. Further, the date of incorporation of Opposer is irrelevant because Opposer is entitled to rely on the use by its predecessors in interest of the AMERICAN DELI mark to establish its priority, including Mr. Kim's extensive and long use of that mark since at least 1991. *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 18:15 (4th ed.2002), cases cited therein, and additional discussion, *infra*.

3. “Exhibit B”—Information Allegedly from the Florida Secretary of State

Applicants also references information which is allegedly from the Florida Secretary of State. *See* Cross Motion, p. 4. This information is likewise inadmissible because it was not properly attached to Applicants' Cross Motion and because it has not been shown to be authentic. Further, this information, if admissible, would be irrelevant. Applicants seem to attempt to rely on the information to show that Opposer has not used its AMERICAN DELI mark in interstate commerce. However, American Deli operates several restaurants in the Greater Atlanta Metropolitan Area. *See* Supplemental Kim Decl., ¶ 4. Most of those restaurants are in mall food courts, and are sure to cater to a significant number of out of state visitors. The Federal Circuit has held that operation of a restaurant in circumstances where the restaurant is likely to serve a significant number of out of state customers qualifies as interstate commerce, even where the restaurant(s) are physically located in only one state. *See, e.g., Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 929 F.2d 662, 666 (Fed. Cir. 1991). Therefore, American Deli has used its AMERICAN DELI mark in interstate commerce regardless of whether it has ever registered to do business in Florida or elsewhere.

4. “Applicants’ Check with the State of Alabama, Tennessee, and South Carolina”

Applicants allege that it checked with the States of Alabama, Tennessee, and South Carolina, and found “no legitimate business activity by Opposer in those state.” Cross Motion,

p. 4. However, this statement is inadmissible as hearsay. Therefore, the statement is not evidence and should not be considered in determining Applicants' Cross Motion. Further, as discussed above, American Deli's use of the mark within the State of Georgia is sufficient to satisfy the interstate commerce requirement.

5. "Google Search"

Applicants refer in its Cross Motion to a hypothetical Google search for "American Deli." Cross Motion, p. 5. It is not at all clear what Applicants contends the Google search would show, or how it supposedly demonstrates the "fictitious nature" of Opposer's claims. In any event, there is no Google search report attached to Applicants' Cross Motion, much less one supported by declaration. Accordingly, any statement from Applicants about what the search would or would not show is inadmissible hearsay and Opposer objects to its admission or consideration.

6. "Various Business" Using the Words American Deli in Georgia.

Applicants make reference to "various business already using the word 'American Deli' and already doing business in the State of Georgia." Cross Motion, p. 5. American Deli first notes that this statement seems to conflict with other inadmissible statements of Applicants regarding Georgia business. In any event, the statement is not backed up by any documents attached to the Cross Motion, much less documents properly authenticated by declaration. Accordingly, Opposer objects to the consideration of this statement.

7. "Business in Florida, Alabama, as well as South Carolina"

Applicants also make reference to "businesses in Florida, Alabama, as well as South Carolina which are using American Deli." Cross Motion, p. 6. Applicants neither reference nor attache any documents, much less documents properly attached to a declaration, to support its

assertion. Accordingly, the statement is inadmissible hearsay and Opposer objects to its consideration.

8. “Exhibit C”

Applicants refer to an “Exhibit C” as attached to Applicants’ Original Opposition Response in an attempt to show that Applicants has made prior use of a business name which includes the words American Deli. Cross Motion, p. 7. Once again, Applicants failed to attach the exhibit and failed to introduce it by way of declaration. Accordingly, the alleged exhibit and statements made about the exhibit are inadmissible hearsay and Opposer objects to their consideration.

9. “Exhibit 1”

Applicants refer to and attach an “Exhibit 1” to their Cross Motion. Cross Motion, p. 9. However, the article attached as Exhibit 1 has not been translated into English and has not been properly authenticated by declaration. Further, statements in Applicants’ Cross Motion about the content of the article are inadmissible hearsay. Accordingly, Opposer objects to the admission or consideration of Exhibit 1 or Applicants’ statements about its contents. However, Opposer does not object to Applicants’ statements regarding Exhibit 1 to the extent they are an admission that Mr. Kim has used the AMERICAN DELI mark since at least 1992 or that his main product is hot wings. *See* Cross Motion, p. 9.

10. “Exhibit 2”

Applicants refer to and attach an “Exhibit 2” to their Cross Motion. Cross Motion, p. 9. However, the article attached as Exhibit 2 has not been translated into English and has not been properly authenticated by declaration. Further, statements in Applicants’ Cross Motion about the content of the article are inadmissible hearsay. Accordingly, Opposer objects to the admission or consideration of Exhibit 2 or Applicants’ statements about its contents.

11. “Exhibit 3”

Applicants refer to and attach an “Exhibit 3” to their Cross Motion. Cross Motion, p. 9. However, the document attached as Exhibit 3 was not properly authenticated by declaration. Further, the document is largely unintelligible. Additionally, Applicants has not established how Exhibit 3 is relevant, since it nowhere refers to any use of the words “American Deli.” Finally, statements in Applicants’ Cross Motion about the content of the article are inadmissible hearsay. Accordingly, Opposer objects to the admission or consideration of Exhibit 3 or Applicants’ statements about its contents.

12. “Exhibit 4”

Applicants refer to and attach an “Exhibit 4” to their Cross Motion. Cross Motion, p. 10. However, the document attached as Exhibit 4 was not properly authenticated by declaration. Additionally, Applicants have not established how Exhibit 4 is relevant, since it nowhere refers to any use of the words “American Deli.” Finally, statements in Applicants’ Cross Motion about the content of the article are inadmissible hearsay. Accordingly, Opposer objects to the admission or consideration of Exhibit 4 or Applicants’ statements about its contents.

13. “Exhibit 5”

Applicants refer to and attach an “Exhibit 5” to their Cross Motion. Cross Motion, p. 10. Exhibit 5 is comprised of a letter and a set of declarations. The purported letter is inadmissible because it is not properly authenticated. Further, the letter is irrelevant because it does not refer to any use of the words “American Deli,” as a trademark or otherwise. The declarations included in Exhibit 5 are the only attempt Applicants make to properly submit evidence by declaration. Nevertheless, the declarations are objectionable due to lack of foundation, since the declarants do not state or even hint at how they supposedly know that Applicants used the mark for three years starting in 1999. Further, even if the statements regarding Applicants’ alleged use of the mark

were admissible, they would not tend to establish that Applicants are entitled to summary judgment since Opposer's evidence shows that it has used the AMERICAN DELI mark since at least 1991.

C. To the Extent Applicants' Motion is a "No Evidence" Motion, it Must Fail Because of Evidence Provided with This Response.

Since none of the "evidence" or factual assertions proffered by Applicants are admissible or may be considered for purposes of their motions, Applicants' Cross Motion must fail as a matter of law.⁴ Further, while Applicants suggests at certain points in its brief that Opposer has not produced any evidence in support of its claims, Opposer's testimony period had not yet begun when Applicants filed their first motion. Further, Applicants did not serve any discovery requests on Opposer or take any depositions during the discovery phase. Rather, this response brief is the first time Opposer has had any opportunity under the TBMP to present evidence in its favor. Remarkably, Applicant seeks to argue, in effect, that it is entitled to summary judgment based on its own failure to seek any discovery during the discovery period and without any trial or opportunity to be heard by Opposer. Opposer presents such evidence herewith, and, as discussed below, the evidence is at least sufficient to defeat Applicants' Cross Motion.

1. 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 early 1990s. *See* Kim Decl., ¶¶ 3-8. **Mr. Kim's testimony is supported by, among other**

⁴ In the event Applicants attempt to remedy their evidentiary problems in a reply brief, such attempts should not be considered. First, the submission of new evidence for the first time in a reply brief is discouraged. *See, e.g., Cia. Petrolera Caribe, Inc. v. Arco Caribbean, Inc.*, 754 F.2d 404, 410 (1st Cir.1985) (holding that district judge erred by not allowing a surreply when the moving party presented new evidence in its reply brief). Such attempt should not be allowed at all in this case where Applicants' were already given one warning and a chance to correct the problem.

things: (a) tax returns filed by Mr. Kim with the IRS since 1991 which expressly note the business name of Mr. Kim's business as "American Deli" on the IRS filing itself; and (b) a letter from the Landlord for Mr. Kim's business at The Gallery at South Dekalb confirming that that Mr. Kim has operated the AMERICAN DELI store there since 1991. See Supplemental Kim Decl., Exhibits 1⁵ and 2, respectively. The earliest date of use of the AMERICAN DELI name ever claimed by Applicants in its Motion is 1999.⁶ The evidence overwhelmingly demonstrates that Opposer's date of use precedes the earliest date claimed by Applicants by almost a decade and is sufficient to defeat Applicants' Motion.

In its Motion, Applicants 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. Applicants 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 or that Mr. Kim has not, in fact, operated an AMERICAN DELI business since 1991.

2. The Evidence of Record Shows that 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

⁵ Exhibit 1 to the Supplemental Kim Decl. contains confidential information and is being filed separately, under seal.

⁶ Opposer believes and intends to prove at trial that Applicants had abandoned any use it may have made of the AMERICAN DELI mark before it filed its intent to use application in 2005.

Applicants suggest 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, Applicants does not even discuss the relevant *du Pont* factors or provide any evidence supporting its position. Considering several of these factors, as discussed below,⁷ 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. *Compare* Application Serial Number 78/755527 with Kim Decl., ¶¶ 2-8. 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 Applicants' application and Opposer's prior use. *du Pont*, 476 F.2d 1357 (CCPA 1973). Applicants 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). *See* Application Serial Number 78/755527. 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 1991. *See* Kim Decl. ¶¶ 3-8.

It is not necessary that Applicants' 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

⁷ This discussion is not intended to include all of Opposer's arguments regarding likelihood of confusion, which will be presented in Applicants' own motion for summary judgment. The discussion here merely exemplifies several of the factors in response to Applicants' unsupported assertion that there is no likelihood of confusion.

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 services). There is such a commercial relationship between Applicants’ café or restaurant-style foods products and Opposer’s café and restaurant services. Applicants 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. *See* Application Serial Number 78/755527. 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 Applicants 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 Applicants’ 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 Applicants’ 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. Applicants’ 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 Applicants' 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 Applicants is the sixth factor, the number and nature of similar marks in use on similar goods. Applicants 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 Cross Motion, p. 6. Applicants 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.

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

V. CONCLUSION

Applicants' Cross 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 Applicants' Motion be denied.

Respectfully submitted,

By: /George Tompkins/

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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 March 19, 2009, via First Class Mail, postage prepaid to:

Clean Pass of Atlanta
1228 Christiana Crossing
Lawrenceville, GA 30043

 /George Tompkins/

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Applicant.)	
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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

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SUPPLEMENTAL DECLARATION OF CHONG C. KIM

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. Attached as Exhibit 1 are true and correct copies of tax returns showing use of the AMERICAN DELI name since the time I first owned the business in 1991 up to 2007.
3. Attached as Exhibit 2 is a true and correct copy of a letter which we requested and received from the operators of The Gallery at South Dekalb Mall in Decatur, Georgia, stating that I operated the AMERICAN DELI store at that mall from 1991.
4. In addition to the Decatur store, American Deli operates other AMERICAN DELI stores in the Atlanta, Georgia area.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed at Roswell, Georgia on March 18th, 2009.


Chong C. Kim



THE GALLERY
AT SOUTH DEKALB

2801 CANDLER ROAD, SUITE 75,
DECATUR, GEORGIA 30034
PHONE 404-241-2431
FAX 404-241-1831
www.galleryatsouthdekalb.com

January 2, 2009

TO: Trade Mark Trial Appeal Board

RE: AMERICAN DELI Chong Chun Kim
The Gallery At South DeKalb
2801 Candler Road - Suite #18
Decatur, Georgia 30034

Mr. Chong Chun Kim has operated American Deli Restaurant in The Gallery At South DeKalb since February 1991 until April 2008.

Ms. Gene Harris, General Manager

by Ernestine McMillan
Office Manager