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

Proceeding	91192118
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IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

LFP IP, LLC, Plaintiff/Opposer v. LEGAL HUSTLERS, LLC, Defendant/Applicant	Opposition No.: 91192118 PLAINTIFF LFP IP, LLC'S MOTION FOR SUMMARY JUDGMENT
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I. FACTUAL BACKGROUND

Defendant/Applicant Legal Hustlers, LLC (“Defendant” or “Applicant”) filed its trademark application for LEGAL HUSTLERS on November 24, 2008, in International Class 025 for “Long-sleeved shirts; short-sleeved shirts” (USPTO Application Serial Number 77620945). Applicant’s LEGAL HUSTLER’s trademark was published for opposition on September 1, 2009, and this opposition proceeding was timely commenced on September 30, 2009.¹

¹ Duane D. Stewart, the principal of Legal Hustlers, LLC, also filed a trademark application for LADY HUSTLERS on or about September 13, 2009 (Serial Number:

Plaintiff/Opposer LFP IP, LLC (“Plaintiff” or “LFP”) is the registrant of various HUSTLER trademarks, including but not limited to the HUSTLER and NATURAL BORN HUSTLER marks used in connection with various apparel/clothing items.² Larry Flynt’s various LFP-affiliated companies have been utilizing the HUSTLER name and trademark for nearly 40 years. Through LFP’s affiliated companies and licensees, the various HUSTLER trademarks have been utilized throughout the world in connection with magazines, videos, broadcasting services, websites, novelties, retail stores, night clubs and apparel items. (See **Exhibit D** to the Brown Decl.).³

LFP brings its instant motion on the grounds that registration Applicant’s LEGAL HUSTLERS trademark should be refused because it is likely to cause confusion, to cause mistake, or to deceive. See 15 U.S.C. § 1052(d).

II. ARGUMENT

The Federal Rules of Civil Procedure generally apply to proceedings before the Trademark Trial and Appeal Board. *See* 37 C.F.R. § 2.116(a). Therefore, on a motion for summary judgment, the Board may render judgment for the moving party if there is no genuine issue as to any material fact. *See* Fed. R. Civ. P. 56(c). Further, a party may

77825530). The LADY HUSTLERS application has been abandoned after the issuance of an Office Action refusing to register the mark based on a likelihood of confusion objection that cited LFP’s HUSTLER trademarks.

² Attached as **Exhibit D** to the Declaration of Jonathan W. Brown (“Brown Decl.”) is a non-exhaustive list of U.S. trademark registrations held by LFP IP, LLC for the HUSTLER trademark and variations thereof.

³ By this reference, LFP incorporates its Notice of Opposition filed on or about September 30, 2009 in this proceeding.

move for summary judgment in its favor regarding all asserted claims, or any part thereof. *See* Fed. R. Civ. P. 56(a).⁴

The burden of a party moving for summary judgment is met by showing “that there is an absence of evidence to support the nonmoving party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). When the moving party shows that there is no genuine issue of material fact, the nonmoving party “may not rest upon the mere allegations or denials of [its] pleadings.” Fed. R. Civ. P. 56(e). It must respond, setting “forth specific facts showing that there is a genuine factual issue for trial.” *Id.*

In this instance, there is no question that the goods at issue are identical or nearly identical, that the channels of trade overlap, and that the alleged “Legal Hustlers” trademark and incorporates the distinctive and well-known HUSTLER trademark.

A. Applicant’s Mark is Likely to Cause Confusion, To Cause Mistake and/or Deceive

Section 2(d) of the Lanham Act provides that registration of a trademark should be refused if the mark “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, to cause mistake, or to deceive...” 15 U.S.C. § 1052(d).

⁴ In *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984), the Federal Circuit affirmed the Board’s grant of summary judgment in an opposition proceeding. The court explained that the “basic purpose of summary judgment is one of judicial economy.” *Id.* at 743 (*citing Exxon Corp. v. National Food Line Corp.*, 198 U.S.P.Q. 407, 408 (C.C.P.A. 1978)). It is against public interest to conduct unnecessary trials, and where the time and expense of a full trial can be avoided by the summary judgment procedure, such action is favored. *See Pure Gold*, 222 U.S.P.Q. at 743.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

Simply adding the word “Legal” before a duly registered trademark, when used on or in connection with similar goods, does not adequately distinguish an applied-for mark. Indeed, Applicant would not be permitted to register “LEGAL COCA-COLA” for soft drinks, or “LEGAL LEVI’S” for jeans, or “LEGAL APPLE” for computers, or “LEGAL PLAYBOY” for magazines. Despite any contentions to the contrary, it is obvious that Applicant is merely attempting to usurp the good will and consumer recognition enjoyed by the HUSTLER trademarks.

The court in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), listed a number of factors which may be considered when testing for a likelihood of confusion under Section 2(d). These factors include:

- Similarity of the marks;
- Similarity of the goods;
- Similarity of the trade channels;
- Conditions under which consumers purchase the goods;
- Strength of the prior mark;
- Number and nature of similar marks used on similar goods;
- Nature and extent of actual confusion;
- Length of time and conditions under which concurrent use has not produced actual confusion;
- Variety of goods on which a mark is used (e.g., “family” mark);
- Market interface between applicant and owner of a prior mark;

- Extent to which applicant has right to exclude others from use of its mark on its goods;
- Extent of potential confusion; and
- Any other fact probative of effect of use.

Id. at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. Similarity in any one of these elements may be sufficient to find a likelihood of confusion. See TMEP §1207.01(b).

In this matter, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. As set forth in the accompanying Declaration of Jason Haughey, Vice President of LFP Apparel, LLC (“LFP Apparel”), HUSTLER brand clothing is sold through various retail stores found throughout the United States.⁵ Trademarks in the apparel industry are extremely important, and help to drive sales. Indeed, as indicated in the Declaration of Jason Haughey, if you take similar apparel items, one with an unknown trademark and the other item with an established name or trademark, the one with the established trademark can be sold at a premium or higher price point, even if the products themselves are virtually identical.⁶

1. Comparison of the Marks

The marks are compared in their entirety under Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be

⁵ See the Declaration of Jason Haughey (“Decl. Haughey”), ¶ 4.

⁶ See Decl. Haughey ¶ 6.

recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

The HUSTLER clothing trademark has become well-known to consumers, through various promotional and advertising efforts, as well as through sales of the products throughout the United States.⁷ The Applicant and the Opposer share a common term, namely, “HUSTLER.” The Applicant’s mark contains an additional term, “legal.” However, the term “HUSTLER” is the dominant and distinctive term in the Applicant’s mark. Indeed, the word “legal” is an adjective that, in this instance, is used to modify the dominant word “Hustlers.”

In this instance, Applicant is utilizing the HUSTLER trademark and is simply adding the word “Legal” and the letter “s” to the end of the word “Hustler.” Such an obvious ploy to mislead or deceive consumers by using a well-known and established mark should not be permitted. This is especially true when the “extra” word used by

⁷ In 2008, at the wholesale level alone, LFP Apparel sold approximately 450,000 items generating approximately \$6,000,000 in gross revenues in HUSTLER brand apparel items. In 2009, LFP Apparel sold approximately 470,000 items resulting in gross revenues of approximately \$6,200,000. See Haughey Decl. ¶ 7.

Applicant, “Legal”, also is part of another mark associated with and owned by LFP - the BARELY LEGAL trademark. The BARELY LEGAL trademark is also utilized by LFP Apparel on tee shirts. See Decl. Haughey ¶ 10, **Exhibit C**.

2. Similarity of Goods

The decisions in the clothing field have held many different types of apparel to be related under Trademark Act Section 2(d). *For example, see Jockey Int’l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (women’s pants, blouses, shorts and jackets related to women’s shoes). As demonstrated in the accompanying exhibits, HUSTLER brand tee shirts and other apparel items utilize the HUSTLER mark in various ways.⁸ Not only is the HUSTLER mark displayed on hang tags and neck tags, but the mark is incorporated in numerous graphics that appear on LFP Apparel’s clothing items. See the Haughey Decl. ¶¶ 3, 5 and **Exhibits A and B**.

3. Channels of Trade

LFP Apparel sells its clothing to various retail outlets, including the affiliated HUSTLER HOLLYWOOD retail store, and non-affiliated NO FEAR and SPENCER’S GIFTS retail stores found throughout shopping malls in the United States. Further, HUSTLER brand clothing items are also sold online through various retail websites,

⁸ See **Exhibits A and B** attached to the Haughey Decl.

including hustlerhollywood.com.⁹ Likewise, Applicant sells or intends to distribute his “Legal Hustler” clothing items on the Internet.¹⁰

B. The “LEGAL HUSTLERS” Application Should Be Rejected for Non-Use

The federal definition of “use” of a trademark is “the bona fide use of [the] mark in the ordinary course of trade and not merely to reserve a right in the mark.” Lanham Act § 45, 15 U.S.C.A. § 1127 (“Use in Commerce”). An applicant cannot obtain a registration under Section 1 of the Trademark Act for goods upon which it has not used the applied-for trademark. Token use is not the same as a bona fide use of a mark in the ordinary course of trade.

In this instance, Applicant filed a “1A” trademark application claiming use of the “Legal Hustlers” mark of July 7, 2006 and a first use in commerce date of July 7, 2007. However, it appears that any use of the “Legal Hustlers” mark, at best, was *de minimus* or token.

In particular, when responding to an Interrogatory requesting annual sales figures of products bearing the “Legal Hustlers” mark, Applicant responded: “*Applicant is not aware of it[sic] annual sales.*” (See Interrogatory No. 9, found in **Exhibit E** to the Brown Decl.). Moreover, in Schedule C of a 2008 tax return, Applicant indicated that “Legal Hustlers, LLC” had gross receipts in the amount of \$235.00, in Schedule C of a

⁹ See Haughey Declaration, ¶ 4.

¹⁰ See Applicant’s Response to First Set of Interrogatories (Attached as **Exhibit B** to the Brown Declaration), Interrogatory No. 4.

2009 tax return, the gross receipts claimed were in the amount of only \$90.00.¹¹ Even at \$15 a shirt, the Applicant appears to have sold as little as 22 shirts over a two year period.

Given the non-use or at best minimal use of the “Legal Hustlers” trademark, the application filed by Applicant’s should be refused on this basis alone.

**C. The USPTO Previously Found the Applicant’s Other Trademark –
LADY HUSTLERS – Confusingly Similar to LFP’s Trademark**

Duane D. Stewart, the principal of Legal Hustlers, LLC, also filed a trademark application for “Lady Hustlers” on or about September 13, 2009 (Serial Number: 77825530).¹² The “Lady Hustlers” application has been abandoned after the issuance of an Office Action refusing to register the mark based on a likelihood of confusion objection that cited LFP’s HUSTLER trademarks. Simply put, the likelihood of confusion rejection raised in the “Lady Hustlers” Office Action equally applies to the instant application for “Legal Hustlers.” Indeed, the distinctive, recognizable component of both the purported “Lady Hustlers” and “Legal Hustlers” trademarks is the term “Hustler.”

¹¹ A redacted copy of Schedule C from Mr. Stewart’s 2008 and 2009 tax returns are attached as **Exhibit F** to the Brown Decl.

¹² Note, among other things that the correspondence address for the LADY HUSTLERS application matches the correspondence address for the LEGAL HUSTLERS application, and also references “Legal Hustlers, LLC” in the mailing address.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Plaintiff/Opposer's Motion for Summary Judgment was mailed, first class, postage prepaid this 30th day of December, 2010, upon the Defendant/Applicant at the following address:

Duane Stewart
Legal Hustlers, LLC
9102 Kerrville Rosemark Road
Millington, TN 38053

/Lori Vangelov/

Lori Vangelov