Docket No. 41271-073

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

In re Matter of Serial No. 77/549,263 *for the mark:* ONE LOVE RAISING CANE'S USA, LLC, Opposer, vs. FIFTY-SIX HOPE ROAD MUSIC, LTD., Applicant.	Opposition No. 91-198552 **APPLICANT AND PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO OPPOSER AND REGISTRANT RAISING CANE'S USA, LLC'S MOTION FOR SUMMARY JUDGMENT**
In re Matter of Registration No. 3,033,511 *for the mark:* ONE LOVE FIFTY-SIX HOPE ROAD MUSIC LIMITED, Petitioner, vs. RAISING CANE'S USA, LLC, Registrant.	Cancellation No. 92-053461

I. INTRODUCTION

Opposer and Registrant Raising Cane's USA, LLC ("Registrant") moves for summary judgment on its opposition and on Applicant and Petitioner Fifty-Six Hope Road Music Limited's ("Petitioner") petition for cancellation on the grounds that it has prior rights in the ONE LOVE mark for restaurant services. Registrant's motion is facially deficient in that it only addresses Petitioner's § 2(d) claim for likelihood of confusion and dilution claims and presents no facts or argument relevant to Petitioner's § 2(a) claim for false suggestion

of a connection with a dead person, namely the iconic Bob Marley. Specifically, Bob Marley's song "One Love" is so well known and so closely associated with Bob Marley that consumers are likely to believe that Registrant's use of the ONE LOVE mark is connected with Bob Marley or licensed or approved by Bob Marley's heirs, Petitioner. There is no dispute that Bob Marley wrote and commercially released "One Love" well before Registrant's registration of ONE LOVE, and Registrant has presented no evidence related to any elements of Petitioner's § 2(a) claim, including Petitioner's showing of the fame of the "One Love" song and its undisputed association with Bob Marley.

Further, Petitioner has prior rights in the ONE LOVE mark or, at the very least, has presented evidence sufficient to create an issue of fact as to whether Registrant or Petitioner is the prior user of ONE LOVE. First, Petitioner used ONE LOVE for restaurant services in connection with a restaurant in Orlando, Florida in 1999, well before Registrant's March 4, 2004 filing date (although Registrant claims that it first used ONE LOVE for restaurant services in 2001, it has not produced any corroborating evidence). This fact is consistent with Petitioner's registration of BOB MARLEY, Reg. No. 3,692,924, for restaurant services which states a date of first use of February 6, 1999.

Second, Petitioner used ONE LOVE for clothing as early as 1991, giving Petitioner prior rights in ONE LOVE given the relationship between clothing and restaurant services. Although Registrant claims that clothing and restaurant services are not related, Registrant's own conduct belies its claim – specifically, Registrant filed an extension of time to oppose a third-party's application to register ONE LOVE for clothing in Class 25. And Registrant uses ONE LOVE on clothing displayed at its restaurants that consumers can purchase. Further, Petitioner itself offers clothing and restaurant services under its BOB MARLEY and ONE LOVE marks, and Petitioner has presented undisputed evidence of numerous registrations on the Principal Register for clothing and restaurant services.

In sum, there are material facts in dispute at least as to (1) Petitioner's § 2(a) claim, (2) the relatedness of the goods at issue, (3) the strength of Petitioner's ONE LOVE Mark,

and (4) Registrant's date of first use of ONE LOVE. Registrant has not shown that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. On the contrary, Registrant totally failed to address Petitioner's § 2(a) claim and has not established that it is the undisputed prior user of the ONE LOVE mark. Accordingly, the Board should deny Registrant's motion for summary judgment.

II. RELEVANT FACTS

A. Petitioner's Rights in the ONE LOVE Mark

Petitioner is owned and operated by the widow and children of the world-renowned reggae artist, Bob Marley, and is the owner of all intellectual property rights in the name, likeness, identity and persona of Bob Marley, as well as many trademarks associated with and made famous by Bob Marley. (Crujeiras Decl. ¶¶ 3-5.) Robert "Bob" Nesta Marley (aka Bob Marley) was a Jamaican singer, songwriter, guitarist, and activist. He was the frontman, lead singer, songwriter and guitarist for the ska, rocksteady and reggae bands The Wailers (1964-1974) and Bob Marley & the Wailers (1974-1981). Despite his death thirty years ago, Bob Marley remains one of the world's most well known and beloved entertainers and is the most widely known performer of ska/reggae music of all time, and is often credited for helping spread Jamaican music to a worldwide audience. (Crujeiras Decl. ¶¶ 6-9.)

Petitioner and its affiliates are the owners of the following registered marks derived from the identity, persona and legacy, including song titles, of Bob Marley:

- BOB MARLEY (Reg. No. 2,349,361) for incense; novelty license plate of non-precious metal; plastic cases for beepers; magnets; jewelry; watches; medallions; greeting cards; stickers; stationery type portfolios; posters; postcards; postcard books; songbooks; decals; trading cards; calendars; novels; bookmarks; backpacks; fanny packs; wallets; tote bags; mugs; textile wall hangings; t-shirts; thermal shirts; jackets; hats; caps; sweatshirts; ties; bandannas; ornamental cloth patches;

- BOB MARLEY (Reg. No. 3,692,924) for restaurant services, namely, preparation and service of food and beverages for consumption;
- BOB MARLEY (Reg. No. 3,934,085) for audio/visual recordings featuring music; downloadable ring tones for cell phones, musical sound recordings; digital music downloadable from the internet;
- BOB MARLEY AND THE WAILERS (Reg. No. 2,820,741) for series of sound and video recordings featuring music and downloadable sound and video recordings featuring music, t-shirts, thermal shirts, jackets, hats, caps, sweatshirts, ties, bandanas;
- BOB MARLEY AND THE WAILERS (Reg. No. 3,849,342) for all purpose carrying bags;
- MARLEY RESORT & SPA (Reg. No. 3,612,800) for hotel services, namely, serving food and drinks and providing temporary accommodations and lodging;
- MARLEY COFFEE (Reg. No. 3,778,736) for coffee roasting and processing;
- MARLEY COFFEE (Reg. No. 3,871,574) for clothing, namely, t-shirts and zippered pull-over jackets;
- CATCH A FIRE (Reg. No. 2,850,611) for dresses, t-shirts, pullovers, blouses, skirts, shorts, pants, jackets, belts, hats, caps;
- CATCH A FIRE (Reg. No. 3,692,515) for soap and body oils;
- CATCH A FIRE (Reg. No. 3,746,162) for clothing, namely, undergarments, jumpers, jeans, socks, shirts, intimate apparel, pajamas, swimwear;
- CATCH A FIRE (Reg. No. 3,751,455) for handbags;
- ROOTS ROCK REGGAE (Reg. No. 3,456,082) for clothing, namely, t-shirts, hats and caps;
- NICE TIME (Reg. No. 3,757,895) for coats; jackets; pants; pullovers; shirts; shorts; skirts and t-shirts; and
- BURNIN' (Reg. No. 3,757,894) for caps; coats; hats; jackets; pants; pullovers; shirts; shorts; and t-shirts.

(Bost Decl. ¶ 2, Ex. A.)

Petitioner is also the owner of three pending applications to register ONE LOVE in Classes 25, 41 and 43. (Bost Decl. ¶ 3, Ex. B.) Petitioner first began use of the ONE LOVE mark for certain goods and services prior to Registrant's alleged date of first use of ONE LOVE and before the filing date of Registrant's application to register ONE LOVE ("the Registration") - March 4, 2004. Specifically, Petitioner's predecessor-in-interest first used the mark ONE LOVE for clothing in 1991. Petitioner also uses ONE LOVE for musical sound recordings, music-related services, and a charitable organization. (Crujeiras Decl. ¶ 11.) Also, on January 24, 1996, Petitioner entered an agreement with Universal City Development Partners ("Universal") to license use of Bob Marley's name, likeness, and artistic performances for use at a restaurant at Universal Studios City Walk in Orlando, Florida named Bob Marley - A Tribute to Freedom ("the Bob Marley Restaurant"). Pursuant to this authorization, Petitioner's licensee has used "One Love," as well as other Bob Marley song titles, in conjunction with its operation of the Bob Marley Restaurant since at least 1999. [1] (Crujeiras Decl. ¶ 12, Ex. A.) Petitioner offers licensed merchandise, including clothing and other merchandise bearing the ONE LOVE mark, at the Bob Marley Restaurant. (Crujeiras Decl. ¶ 13, Ex. B.) The ONE LOVE mark has thereby acquired secondary meaning for restaurant services, and that secondary meaning lies with Bob Marley and Petitioner, not Registrant.

B. Bob Marley's Exclusive Association with the Title to His Famous Song "One Love"

"One Love" is a song by Bob Marley & The Wailers. It is a classic, widely known reggae song which expressed Bob Marley's views on global unity, and has become one of the most influential and well known reggae songs in the world. Marley first recorded "One Love" in 1965, and it was famously re-recorded and included on Bob Marley & The Wailers'

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[1] Registrant claims that the Bob Marley Restaurant's menu does not feature the ONE LOVE mark. However, the version of the menu online is incomplete and does not include beverages, which does in fact show use of ONE LOVE. (Bost Decl. ¶ 14, Ex. M)

legendary and lauded 1977 album *Exodus*. (Bost Decl. ¶ 4, Ex. C.) "One Love" has also been included on many of Bob Marley's compilation albums, most famously "Legend," an album certified Diamond by the Recording Industry Association of America ("RIAA") for sales of more than ten million copies in the United States. (Bost Decl. ¶ 5, Ex. D.)

"One Love" has been inducted into the Grammy Hall of Fame, was the British Broadcasting Corporation's official anthem of the millennium eve, and has been awarded with numerous other awards and honors. (Bost Decl. ¶ 6, Ex. E.) "One Love" has been licensed by the Jamaican tourism organization, and is repeatedly played on nationally televised advertisements to promote tourism in Jamaica. (Crujeiras Decl. ¶ 10.)

Far from just a song title, "One Love" has become a phrase closely associated with Bob Marley and his musical legacy. In 1978, Bob Marley & The Wailers participated in the now legendary One Love Peace Concert, so named in reference to Marley's famous song. (Bost Decl. ¶ 7, Ex. F.) Also, the phrase "One Love" has been used as the title for various media featuring and associated with Bob Marley. In 2001, the record label Tuff Gong released "One Love: The Very Best of Bob Marley," a greatest hits compilation featuring Bob Marley & The Wailers' best known songs. Similarly, in 1991, Heartbeat Records released a compilation of early Bob Marley & The Wailers' recordings entitled, "One Love (At Studio One)." (Bost Decl. ¶ 8, Ex. G.) In 1999, Turner Network Television televised, and Palm Pictures later released on DVD, a concert entitled "One Love: The Bob Marley All-Star Tribute Concert DVD." (Bost Decl. ¶ 9, Ex. H.) The trademark ONE LOVE has also been used in association with other posthumous concerts in tribute to Bob Marley and his music. (Bost Decl. ¶ 10, Ex. I.) Finally, and perhaps most importantly, because it is associated so readily with his legacy, the phrase "One Love" is often invoked in articles about or related to Bob Marley. (Bost Decl. ¶ 11, Ex. J.)

Petitioner and its predecessors have parlayed the fame of the "One Love" song title into a strong trademark with secondary meaning. As noted above, Petitioner has used the ONE LOVE mark on a variety of products and services, including, but not limited to,

restaurant services, clothing, musical sound recordings, music-related services, and a charitable organization. In most, if not all, of these instances, the ONE LOVE mark is used in conjunction with Bob Marley's identity and persona, further exclusively associating the term "One Love" with Bob Marley. (Crujeiras Decl. ¶ 11.)

II. REGISTRANT IS NOT ENTITLED TO SUMMARY JUDGMENT ON THE ISSUE OF PRIORITY

"A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law." TBMP § 528.01, *citing Copelands' Enterprises Inc. v. CNV Inc.*, 20 U.S.P.Q.2d 1295, 1298-99 (Fed. Cir. 1991). The nonmovant is not required to present its entire case or defense but merely sufficient evidence to show an evidentiary conflict as to the disputed material facts. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992). Further, the evidentiary record and all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmovant. *Id.*

Here, there is no question that Registrant has not met its burden of proof on Petitioner's false association claim – indeed, Registrant fails to even mention the claim in its motion. Further, there is no question that disputed facts exist as to which party has priority of use of ONE LOVE for restaurant services, and for products and services related thereto. In short, it would be improper to grant summary judgment to Registrant in this case.

A. Registrant's Use of the ONE LOVE Mark Falsely Suggests a Connection with Bob Marley

In addition to its likelihood of confusion claim (addressed below), Petitioner, pursuant to 15 U.S.C. § 1052(a), has petitioned to cancel Registrant's ONE LOVE registration on the grounds that it consists of or comprises matter which may falsely suggest a connection with Bob Marley. A claim for false suggestion of a connection is separate and distinct from a claim for likelihood of confusion. To establish a claim for false suggestion of a connection, a plaintiff must demonstrate:

> (i) that the defendant's mark is the same or a close approximation of plaintiff's previously used named or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods and services, a connection with the plaintiff would be presumed.

Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, 429 (TTAB 1985).

Unlike a § 2(d) claim, a false suggestion of a connection claim "does not depend for its existence on the adoption and use of a technical trademark." *Id.* Further, and importantly for the instant matter, "the protection afforded by . . . Section 2(a) is not strictly limited to the unauthorized use of a 'name or likeness.'" *Id.* Instead, the question is whether the term "One Love" is so associated with Bob Marley such that when Petitioner uses ONE LOVE in connection with its services, a connection with Bob Marley would be assumed. *Id.* at 430; *see also In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 U.S.P.Q.2d 1630, 1633 (TTAB 2003) (ex parte appeal of examining attorney's refusal to register the mark TO PROTECT AND SERVE on the grounds that it was likely to falsely suggest a connection with the Los Angeles Police Department; "[t]here is no real dispute that applicant's mark is the same as the official LAPD slogan, nor is there any dispute as to the fact that the slogan is well known and associated with the LAPD.")

For these reasons, the case cited by Registrant – *St. Nicholas Music Inc. v. Lolly-Jolly, Inc.*, Opp. No. 91-155371 (TTAB 2005) – is entirely inapposite and inapplicable to the instant facts (in addition to being not citable as a precedent of the TTAB). In *St. Nicholas*, the opposer opposed registration of the mark LOLLY-JOLLY on the grounds that is was likely to be confused with a mark in which the opposer claimed protectable rights, <u>not</u> false suggestion of a connection with opposer. Thus, unlike this case, the opposer in *St. Nicholas* did not claim that the applicant's use of the LOLLY-JOLLY mark was likely to falsely suggest

a connection with opposer based on any association between the song "A Holly Jolly Christmas" and the opposer.[2]

The more applicable precedent was that set forward by the Board in *Buffett*, the facts of which are clearly analogous to those at issue in the instant matter. In *Buffett*, opposer Jimmy Buffett alleged that "in 1977, [he] wrote, published and recorded a song entitled 'Margaritaville'; that the song and opposer became well-known throughout the United States; and that by reason of the fame of the song and its lyrics . . . 'MARGARITAVILLE' has become closely associated with Jimmy Buffett in the minds of a substantial portion of the purchasing public." *Buffett* at 428. Based on these rights, the opposer claimed that the applicant's registration of MARGARITAVILLE for restaurant services would falsely suggest a connection with opposer, and that "purchasers would be likely to assumed that opposer sponsors or in some way is associated with applicant's services." *Id.*

In opposition to applicant's motion for summary judgment on opposer's § 2(a) claim, Jimmy Buffett submitted evidence supporting his claim that the term "Margaritaville" was associated with his public persona, including affidavits, press clippings relating to opposer and "Margaritaville," licensing agreements held by opposer for the name "J.B.'s Margaritaville" for a restaurant and clothing, and advertisements and depictions of clothing bearing the term "Margaritaville." *Id.* at 430. Additionally, there were various press clippings and other evidence on the record supporting "opposer's claim that the public mind, in fact, associates the term 'MARGARITAVILLE' with the public persona of Jimmy Buffett." *Id.* Based thereon, the Board denied applicant's motion for summary on opposer's § 2(a) claim. *Id.*

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[2] It should be noted, though, that the Board did not deem opposer's copyright in, and the fame of, the song "A Holly Jolly Christmas" irrelevant to the likelihood of confusion issue. Instead, the Board merely stated that the opposer "has not established any trademark rights in the title of the song or a link between the song and any derivative fame from the song and opposer's HOLLY JOLLY trademark for the identified goods and services." *St. Nicholas Music Inc*, Opp. No. 91-155371, p. 9, fn. 9.

Registrant has literally presented no evidence relevant to Petitioner's § 2(a) claim to support its motion. On the contrary, Petitioner has submitted herewith evidence setting forth the fame of Bob Marley's "One Love" song and its exclusive association with Bob Marley, evidence that is at least sufficient to raise a genuine issue of material fact as to whether ONE LOVE is "so uniquely and unmistakably associated with [Petitioner] as to constitute [Opposer's] name or identity such that when [Registrant's] mark is used in connection with its services, a connection with opposer would be assumed." *Id.* at 430. "One Love" has become one of the most influential and known reggae songs in the world and is associated by the public with Bob Marley; in fact, "One Love" is almost synonymous with Bob Marley.

Therefore, Petitioner's use of the mark ONE LOVE is exclusively associated with Bob Marley, his musical legacy, and his message of global unity, and, thus, Registrant's use of the ONE LOVE mark falsely suggests a connection with Bob Marley. Registrant tries to avoid this obvious conclusion by focusing exclusively on Petitioner's likelihood of confusion and dilution claims.

B. Petitioner is the Senior User of ONE LOVE

Petitioner licensed use of Bob Marley's name, likeness, and artistic performances to Universal in 1996, and the Bob Marley Restaurant has been open since February 2, 1999. Since the date of the Bob Marley Restaurant's opening, Universal has used Petitioner's ONE LOVE mark in conjunction with restaurant services. Further, Universal has sold clothing and other merchandise at the Bob Marley Restaurant bearing the ONE LOVE mark, and continues to do so. Accordingly, Petitioner's first use of the ONE LOVE mark, in conjunction with restaurant services precedes Registrant's claimed date of first use of the ONE LOVE mark of 2001 (for which it has offered *no* evidence) and March 4, 2004, the filing date of the Registration.

Petitioner is not precluded from claiming trademark rights in ONE LOVE for restaurant services just because Petitioner did not identify such rights in its interrogatory

responses. In its interrogatory responses, Petitioner expressly reserved its right "to make any changes in these responses if it appears that omissions or errors have been made therein or that future or more accurate information is available. [Petitioner] has not completed its own investigation and discovery." (Registrant's Motion, Ex. C, Petitioner's Response to Registrant's First Set of Interrogatories, p. 2.) Petitioner will supplement its discovery responses once this matter is removed from suspension to reflect the results of its further investigation. Likewise, the parties only recently filed a protective order governing the treatment of confidential documents. (Docket No. 7.) Once the protective order is entered by the Board, Petitioner will produce additional documents supporting its claim of the use of ONE LOVE for restaurant services. But for now, and as Registrant may easily see from the exhibits submitted herewith, Universal uses ONE LOVE for menu items. Indeed, Universal has always had the right to use Bob Marley's artistic performances as part of its license and has done so. (Crujeiras Decl. ¶12, Ex. A.)

Also, Petitioner has prior rights in the ONE LOVE mark pursuant to its use of ONE LOVE for clothing beginning at least as early as 1991. Restaurant services and clothing are related as shown by Registrant's own actions. Specifically, Registrant filed an extension of time to oppose a third-party's application to register ONE LOVE & Design in Class 25 for clothing (Bost Decl. ¶ 12, Ex. K), and displays ONE LOVE clothing at its restaurants for sale. (Bost Decl. ¶ 15, Ex. N.) Registrant cannot in one breath claim that restaurant services and clothing are unrelated but then, in another, file an extension of time to oppose an application for ONE LOVE for clothing based on its alleged rights in ONE LOVE for restaurant services. Also, Petitioner's commercial efforts evidence the relatedness of restaurant services and clothing, as Petitioner has used its BOB MARLEY and ONE LOVE marks in conjunction with both restaurant services and clothing. In fact, Petitioner owns registrations of BOB MARLEY for clothing and restaurant services. (Bost Decl. ¶ 2, Ex. A.)

Furthermore, the Principal Register is replete with registrations offering clothing in Class 25 and restaurant services in Class 43. (Bost Decl. ¶ 13, Ex. L.) These registrations

show that restaurant services and clothing commonly emanate from the same source, such that consumers are likely to be confused by the use of identical marks on said services and goods. *See In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q.2d 1467, 1470 (TTAB 1988) ("Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce . . . may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"); *see also* TMEP § 1207.01(d)(iii).

Also, Petitioner's and Registrant's ONE LOVE marks are identical in sound and appearance. It is well established that the greater the similarity in marks, the lesser the similarity needed of the goods and services offered by the parties to support a finding of likely confusion. *See In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812, 1815 (TTAB 2001). Naturally, if the marks are identical, the degree of similarity needed to find a likelihood of confusion further declines. *See Kohler Co. v. Baldwin Hardware Corporation*, 82 U.S.P.Q.2d 1100, 1110, 1113-14 (TTAB 2007) (Board found that applicant's use of DEVONSHIRE for "metal door hardware, namely locks, latches and knobs" was likely to be confused with the opposer's use of an identical mark for plumbing and bathroom fixtures). Likewise, Petitioner's and Registrant's use of the identical ONE LOVE mark – an arbitrary mark, no less, as used for the parties' respective goods and services – bridges any gap existing between Petitioner's goods and Registrant's services.

The case cited by Registrant – *7-Eleven, Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715 (TTAB 2007) – is inapposite. Unlike the present circumstances, the marks at issue in *7-Eleven* – GULPY and BIG GULP – were not identical. Also, unlike this case in which Petitioner itself offers both clothing and restaurant services under its ONE LOVE mark and other marks derived from the life and legacy of Bob Marley and, further, has presented evidence of the relatedness of the goods and services at issue by means of third-party registrations and Registrant's own efforts to police against third-party use of the ONE LOVE mark for clothing, there was no evidence on record in *7-Eleven* "that any companies use the same

trademarks for products for human consumption and products for animal consumption or for accessories for animals." *Id.* at 1724.

IV. CONCLUSION

Based on the foregoing, Petitioner requests that the Board deny Registrant's motion for summary judgment. This case is replete with factual disputes that preclude entry of summary judgment in Registrant's favor.

Respectfully submitted,

MANATT PHELPS & PHILLIPS, LLP

Dated: September 23, 2011

/s/ Jill M. Pietrini
Jill M. Pietrini
Paul Bost
Attorneys for Applicant and Petitioner
Fifty-Six Hope Road Music Limited

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 23rd day of September, 2011.

/s/Erica Embray
Erica Embray

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Answer to Notice of Opposition is being deposited as first class mail, postage prepaid, in an envelope addressed to: Bassam N. Ibrahim, Esq., BUCHANAN INGERSOLL & ROONEY, PC, 1737 King St., Suite 500, Alexandria, VA 22313-1404, on this 23rd day of September, 2011.

/s/Erica Embray
Erica Embray

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