

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: July 6, 2012

Opposition No. 91198552 (parent)

Raising Cane's USA, L.L.C.

v.

Fifty-Six Hope Road Music
Limited¹

Cancellation No. 92053461

Fifty-Six Hope Road Music
Limited

v.

Raising Cane's USA, L.L.C.

**Before Quinn, Cataldo and Bergsman,
Administrative Trademark Judges**

By the Board:

This consolidated proceeding comes up on
opposer/respondent Raising Cane's USA, LLC's combined motion
for summary judgment and motion to compel filed on August 19,
2011. The motion for summary judgment is fully briefed.

Background

¹ The change of correspondence filed by applicant/petitioner's
counsel on January 12, 2012, is noted and the Board's records
have been updated accordingly.

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Applicant/petitioner Fifty-Six Hope Road Music Limited filed on December 27, 2010, a petition to cancel opposer/respondent's Registration No. 3033511 for ONE LOVE in standard characters for "restaurant services" in International Class 43.² Applicant/petitioner pleads three pending applications for ONE LOVE in standard characters³ as well as two registrations for BOB MARLEY-formative marks⁴ and "all other rights associated with Bob Marley, including the rights associated with his identity and persona, and song and album

² The underlying application was filed on March 4, 2004, and the registration issued on December 27, 2005, with a date of first use anywhere and in commerce of November 2001. Section 8 and Section 15 affidavits were filed on December 29, 2010. Because December 26, 2010 was a Sunday and the petition to cancel was filed on December 27, 2010, it was filed prior to the fifth anniversary of the registration and, therefore, the claims within the petition are timely.

³ Application Serial No. 77233644 for "cloth bibs; infant and toddler one piece clothing; hats; shirts; sweat shirts; tank-tops" in International Class 25, filed on July 19, 2007, under Section 1(a) of the Trademark Act, alleging a date of first use anywhere and in commerce of March 1999.

Application Serial No. 77549263 for "entertainment services in the nature of live musical performances; organizing cultural festivals featuring music, dance, art exhibitions and heritage markets; providing information on a website relating to music, entertainment, and cultural festivals of others; and music publishing services" in International Class 41, filed on August 18, 2008, under Section 1(b) of the Trademark Act.

Application Serial No. 77782232 for "bar and restaurant services; catering; coffee bars; health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; hotel services; providing advice to tourists and business travelers on hotel and restaurant destinations; rental of beach chairs, towels and umbrellas for recreational use; resort lodging services; and wine bars" in International Class 43, filed July 16, 2009, under Section 1(b) of the Trademark Act.

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titles" and, based thereon, alleges priority and likelihood of confusion, dilution and - this is a point of contention between the parties - false suggestion of a connection under Section 2(a) of the Trademark Act.

Opposer/respondent filed on February 9, 2011, a notice of opposition against applicant/petitioner's application Serial No. 77549263 for ONE LOVE in standard characters for "entertainment services in the nature of live musical performances, organizing cultural festivals featuring music, dance, art exhibitions and heritage markets; providing information on a website relating to music, entertainment, and cultural festivals of others; and music publishing services" in International Class 41.⁵ Opposer/respondent pleads its registration involved in the cancellation proceeding and alleges priority, likelihood of confusion and dilution.

The opposition and cancellation proceedings were consolidated by the Board on March 24, 2011, with the opposition maintained as the parent proceeding.

On August 19, 2011, opposer/respondent filed a combined motion for summary judgment and motion to compel discovery.

Opposer/Respondent's Motion for Summary Judgment

⁴ Registration No. 2349361 for BOB MARLEY in typed form and Registration No. 2820741 for BOB MARLEY AND THE WAILERS in typed form.

⁵ Filed August 18, 2008, under Section 1(b) of the Trademark Act.

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In its motion for summary judgment, opposer/respondent claims priority of use of the ONE LOVE mark in connection with restaurant services since 2001, that applicant/petitioner itself has never used the mark in connection with restaurant services, and that applicant/petitioner can neither rely on its use of ONE LOVE in connection with musical services and clothing to establish priority, as those goods and services are unrelated to restaurant services, nor on any claimed use by Universal Studios, as such use was unlicensed.

In response, applicant/petitioner argues that opposer/respondent's motion is "facially deficient" as it does not address applicant/petitioner's claim for false suggestion of a connection under Section 2(a), that opposer/respondent's claim of use of the ONE LOVE mark since 2001 is uncorroborated by any evidence, that its use of the ONE LOVE mark in connection with clothing predates any claimed date of use by opposer/respondent and that Universal Studio's use of ONE LOVE in connection with restaurant services was a licensed use that predates opposer/respondent's use.

In reply, opposer/respondent reiterates that applicant/petitioner's Section 2(a) claim was not part of the original petition and that the alleged license to Universal

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Studios does not mention the ONE LOVE mark and cannot be interpreted as encompassing the mark.⁶

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board may not resolve disputes of material fact; it may only ascertain whether disputes of material fact exist. See *Lloyd's Food Products,*

⁶ Applicant/petitioner filed a surreply in response thereto but it has been given no consideration as surreplies are not permitted. See Trademark Rule 2.127(a).

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987 F.2d at 766, 25 USPQ2d at 2029; *Olde Tyme Foods*, 961 F.2d
at 200, 22 USPQ2d at 1542.

Here, on the record presented, we find that there are genuine disputes of material fact as to the issue of priority. Regardless of whether opposer/respondent can establish a date of first use since 2001, applicant/petitioner points to events that occurred prior to 2001 to establish its priority in the ONE LOVE mark. For instance, the purported licensing agreement between applicant/petitioner and Universal Studios is alleged to have been entered into in 1996 and to have encompassed the use of ONE LOVE in conjunction with a Bob Marley-themed restaurant at Universal Studios since at least February 6, 1999. *Declaration of Doreen Crujeiras* ("*Crujeiras Declaration*"), ¶ 12 and Exhibit A. This raises a genuine dispute as to the existence of a license and whether ONE LOVE was encompassed by said license.

Furthermore, applicant/petitioner's claim of prior use of the ONE LOVE mark since 1991 in connection with clothing, see *Crujeiras Declaration*, ¶ 11, raises genuine disputes as to the relatedness of clothing and restaurant services, their channels of trade and classes of consumers. Accordingly, opposer/respondent's motion for summary judgment is hereby **DENIED.**⁷

⁷ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only

Opposer/Respondent's Motion to Compel

We turn now to opposer/respondent's motion to compel discovery. In short, opposer/respondent propounded its first set of discovery requests on April 22, 2011. Responses were served by applicant/petitioner on June 10, 2011. However, opposer/respondent alleges that the responses are incomplete and that applicant/petitioner is improperly withholding discovery notwithstanding its objections relating to the inadequacy of the Board's standard protective order. On June 13, 2011, applicant/petitioner proposed an amended protective order which opposer/respondent executed on June 14, 2011. On August 1, 2011, applicant/petitioner proposed another version of the protective order with additional changes to which opposer/respondent agreed via email on August 2, 2011. Applicant/petitioner sent an executed version of the protective order to opposer/respondent on August 16, 2011. Opposer/respondent filed its motion to compel on August 19, 2011. Applicant/petitioner filed a signed copy of the stipulated protective order later that day.

for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981). Furthermore, the fact that we have identified certain genuine disputes of material fact sufficient to deny opposer/respondent's motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

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A motion to compel must be supported by a written statement from the moving party that such party, or its attorney, has made a good faith effort, by conference or correspondence, to resolve with the other party, or its attorney, the issues presented in its motion, and has been unable to reach agreement. See Trademark Rule 2.120(e)(1); and TBMP § 523.02 (3d ed. rev. 2012). Opposer/respondent has failed to certify as such. Indeed, it is not apparent from the record that opposer/respondent could make such a certification. Applicant/petitioner allegedly withheld discovery pending entry of a suitable protective order in this consolidated proceeding. Applicant/petitioner forwarded an executed protective order on August 16, 2011, which opposer/respondent counter-signed and forwarded to applicant/petitioner for filing. Yet, prior to the filing of the stipulated protective order and the Board's entry thereof, opposer/respondent filed a motion to compel only three days after receipt of the executed protective order. In view thereof, opposer/respondent's motion to compel is **DENIED without prejudice.**

The stipulated protective agreement filed on August 19, 2011, is noted and its use in this proceeding is **APPROVED.** The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential

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Materials With Board), 412.05 (Handling of Confidential
Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

As the amended protective order has now been entered in this proceeding, applicant/petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to produce any discovery which it has withheld pending entry of the amended protective order. The parties are reminded that they are obligated to cooperate in discovery in good faith and to exchange appropriate discovery materials. If the parties remain unable to resolve their discovery dispute, a second (and presumably more focused) motion to compel may be filed.⁸ The parties are reminded that if proper discoverable matter is

⁸ Any future motion to compel will not be considered without demonstrative evidence of the steps taken to resolve the dispute. To be specific, the parties must have a telephone discussion regarding discovery issues before filing a motion to compel. An exchange of correspondence or email will not be sufficient to satisfy the requirement to make a good faith effort to resolve the discovery issues prior to filing a motion to compel.

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withheld from the requesting party, the responding party will be precluded from relying on such matter and from adducing testimony with regard thereto during its testimony period. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988).

Applicant/Petitioner's Section 2(a) Claim

As noted *supra*, the parties dispute whether applicant/petitioner has pleaded a claim for false suggestion of a connection under Section 2(a). The elements of this claim are as follows:

- (1) defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- (2) defendant's mark would be recognized as such by purchasers, in that the mark is the same or a close approximation of plaintiff's previously used name or identity;
- (3) plaintiff is not connected with the goods that are sold or will be sold by defendant under its mark; and
- (4) plaintiff's name or identity is of sufficient fame or reputation that when defendant's mark is used on its goods, a connection with plaintiff would be presumed.

Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581 (TTAB 2008). See also *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

In reviewing the petition for cancellation, we find that the claim has been hinted at but not sufficiently pled to give opposer/respondent proper notice thereof. Fed. R. Civ. P. 15(a)(2) directs a court to "freely give leave [to amend a

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pleading] when justice so requires." Accordingly, the Board is generally liberal in granting leave to amend pleadings "unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties."

International Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 (TTAB 2002). Furthermore, "[i]n the absence of any apparent or declared reason - such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. -the leave sought should, as the rules require, be 'freely given.'" *Foman v. Davis*, 331 U.S. 178, 182 (1962) (quoted with approval in *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993)).

There is nothing in the record to suggest that allowing applicant/petitioner to replead its Section 2(a) claim would violate settled law or be prejudicial to opposer/respondent. Accordingly, applicant/petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to amend its petition for cancellation to properly allege its Section 2(a) claim of false suggestion of a connection. Opposer/respondent's answer to the amended petition shall be due within **THIRTY DAYS** of service.

Dates are **RESET** as follows:

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| Expert disclosures due | 10/28/2012 |
| Discovery closes | 11/27/2012 |
| Raising Cane's pretrial disclosures due | 1/11/2013 |
| Raising Cane's 30-day testimony period as opposition plaintiff to close | 2/25/2013 |
| Fifty-Six's pretrial disclosures due | 3/12/2013 |
| Fifty-Six's 30-day testimony period as opposition defendant and cancellation plaintiff to close | 4/26/2013 |
| Raising Cane's pretrial disclosures for rebuttal as opposition plaintiff and as cancellation defendant due | 5/11/2013 |
| Raising Cane's 30-day testimony period as cancellation defendant and rebuttal testimony as opposition plaintiff to close | 6/25/2013 |
| Fifty-Six's rebuttal disclosures as cancellation plaintiff due | 7/10/2013 |
| Fifty-Six's 15-day rebuttal period as cancellation plaintiff to close | 8/9/2013 |
| Brief for Raising Cane as opposition plaintiff due | 10/8/2013 |
| Brief for Fifty-Six as opposition defendant and as cancellation plaintiff due | 11/7/2013 |
| Brief for Raising Cane as cancellation defendant and reply brief, if any, as opposition plaintiff due | 12/7/2013 |
| Reply brief, if any, for Fifty-Six as cancellation plaintiff due | 12/22/2013 |

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **THIRTY DAYS** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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