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

Proceeding	91204122
Party	Defendant Michael Liang
Correspondence Address	DAVID YAN LAW OFFICES OF DAVID YAN 136-20 38TH AVENUE, SUITE 11E FLUSHING, NY 11354 4232 UNITED STATES davidyanlawfirm@yahoo.com
Submission	Answer
Filer's Name	David Yan
Filer's e-mail	davidyanlawfirm@yahoo.com
Signature	/DavidYan/
Date	08/07/2014
Attachments	Answer to Amended Notice of Opposition_Empire State Building Compang LLC v Michael Liang.pdf(24328 bytes)

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

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

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EMPIRE STATE BUILDING COMPANY L.L.C., :
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 Opposer, :
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 v. : Opposition No.: 91204122
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MICHAEL LIANG, :
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 Applicant. :
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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT’S ANSWER TO AMENDED NOTICE OF OPPOSITION

Applicant, MICHAEL LIANG, for his answer to the Amended Notice of Opposition filed by Empire State Building Company L.L.C. on May 8, 2014 against application for registration of the trademark of NYC BEER LAGER and Design mark:, Serial No. 85213453 filed January 8, 2011, and published in the Official Gazette of December 6, 2011, pleads and avers as follows:

1. Answering paragraph 1 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or to prove that Opposer, its predecessors, and its affiliated and related entities, and/or licensees have ever used word mark EMPIRE STATE BUILDING and various marks depicting the visual equivalent of

the so called Empire State Building in any “wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages.”

2. Answering paragraph 2 of the Amended Notice of Opposition, Applicant admits the allegations thereof, except to the extent of “which are all incontestable” and otherwise pleaded herein.

3. Answering paragraph 3 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or to prove that “Opposer, its predecessors, and its affiliated and related entities, and/or licensees have ever promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer’s Empire State Building Marks, including, but not limited to, entertainment services, real estate services and a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages, and have offered such goods and rendered such services in commerce.”

4. Answering paragraph 4 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or to prove that the so called “goodwill in the Opposer’s Empire State Building Marks” were highly valuable and such “goodwill has become closely and uniquely identified and associated with Opposer”.

5. Answering paragraph 5 of the Amended Notice of Opposition, Applicant admits the allegations thereof except otherwise pleaded herein.

6. Answering paragraph 6 of the Amended Notice of Opposition, Applicant admits the allegations thereof except otherwise pleaded herein.

7. Answering paragraph 7 of the Amended Notice of Opposition, Applicant admits the allegations thereof except begging leave to refer to the original filing to the USPTO for an

interpretation of their true import and meaning. Applicant rejects the compound opposition No. 7. Applicant denies the allegations and asserts that Opposer has failed to provide any information or to prove, especially with respect to the so called “enormous goodwill of Opposer [in] Empire State Building”, that can support the Opposer’s allegations contained therein. Applicant denies the allegations contained therein of “the enormous good will of Opposer . . . of the ‘Empire State Building’” with respect to a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages offered in commerce.

8. Answering paragraph 8 of the Amended Notice of Opposition, Applicant denies the allegations.

9. Answering paragraph 9 of the Amended Notice of Opposition, Applicant denies the allegations. Applicant did have a bona fide intent to use Applicant’s Mark in commerce on the specified goods, namely, “Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter” when it filed Application Serial No. 85/213,453, as confirmed by the Applicant and his partners’ business plans that show the projected date of first use in commerce when “[the Mark] is approved” to sell the above named products in both the United States and in China, through the channels of trade *via* sales agencies in the provincial and local levels in both markets of the United States and China. The business plans reveal that Applicant would like to hire experienced salespersons to promote the sales. The business plans also reveal that partner John Wang would be responsible to design the promotion of their products in the

website. Therefore, the business plans are sufficiently detailed and have clear references to the elements to form the bona fide intent to use the mark under the totality of the circumstances.

10. Answering paragraph 10 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or to prove that Opposer has ever used the Opposer's Empire State Building Marks in commerce on the specified goods, namely, "Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter" or in the alternate, used the Opposer's Empire State Building Marks in commerce on a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages.

11. Answering paragraph 11 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or proof that can support the Opposer's allegations contained therein, especially with respect to "a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages".

12. Answering paragraph 12 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or proof that can support the Opposer's allegations contained therein, especially with respect to "a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages".

13. Answering paragraph 13 of the Amended Notice of Opposition, Applicant denies the allegations and asserts that Opposer has failed to provide any information or proof that can

support the Opposer's allegations contained therein, especially with respect to "a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages".

14. Applicant further affirmatively alleges that there is not any likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar. There is not any similarity of the goods between Applicant and Opposer. The goods bearing the Applicant's marks are presumed to travel in all normal channels and to all prospective purchasers for the relevant goods described in its registration; namely, "Alcohol-free beers; Beer, Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholized beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter;" Alcoholic or non-alcoholic beverage, foods, restaurants, and/or processed food businesses. The goods bearing the pleaded marks of Opposers are presumed to travel in the limited channels to the consumers under its registration of Class 041 for "entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing" and Class 036 for "Real Estate Services, namely, the Management and Leasing of Real Estate".

15. Applicant further affirmatively alleges that there is not any likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar. The Applicant's design mark does not contain any pleaded word marks of Opposer. The Applicant's design mark does not contain any word of "Empire State Building". The Applicant's design mark does contain a drawing of a building in the portion of its design mark. The Applicant's drawing of the building in its design mark, however,

is different from the drawing of the pleaded marks of Opposer. Any similarity, *if at all*, between Applicant's design mark and the pleaded marks of Opposer is in the portion of the Opposer's alleged visual equivalent of the Empire State Building which, upon information and belief, has not been used, or registered by Opposer, its predecessors, and its affiliated and related entities, and/or licensees in the "Alcohol-free beers; Beer, Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholized beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter; Alcoholic or non-alcoholic beverage, foods, restaurants, and/or processed food businesses."

16. Applicant further affirmatively alleges that there is not any likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar because the Opposer's word mark and design drawing mark of the Empire State Building does not have extensive public recognition and renown. Fame for purposes of likelihood of confusion is a matter of degree that varies along a spectrum from very strong to very weak. Opposer has the burden to prove that its mark is famous and has extensive public recognition and renown. It is well-established that fame alone is insufficient to establish likelihood of confusion. When considering the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression, the Applicant's design mark is not similar to the pleaded marks of Opposer. It is improper to dissect a mark. Even when the marks at issue are identical, or nearly identical, differences in connotation can outweigh visual and phonetic similarity.

17. Applicant further affirmatively alleges that the Opposer's word mark "Empire State Building" is or has become generic for inexpensive, convenient or easy but low quality or commercialized versions of items and therefore cannot have meaning as a trademark.

18. Applicant further affirmatively alleges that there is no likelihood of dilution of the Opposer's mark by tarnishment because the Opposer's marks are associated with inexpensive, convenient or easy but low quality or commercialized versions of items.

19. Applicant further affirmatively alleges that there is no likelihood of dilution of the Opposer's mark because dilution fame requires a more stringent showing and widespread recognition by the general public.

20. Applicant further affirmatively alleges that there is not any false association between the Applicant's marks and the pleaded marks of Opposer. The pleaded marks of Opposer do not have widespread recognition by the general population who will unmistakably associate the Applicant's mark with and uniquely point the Applicant's mark to Opposer. The pleaded marks of Opposer have not become a "household name". Opposer has failed to prove since the inception of commencing this Opposition when the general public encounter the Applicant's mark in almost any context, the general public associate the term, *at least initially*, with Opposer. Neither Applicant nor Applicant's predecessors, *if any*, in interest intended any association with Opposer's marks or any of them; and upon information and belief, ordinary prospective purchasers of the Applicant's products bearing the Applicant's mark do not associate the Applicant's mark and the pleaded marks of Opposer.

21. Applicant further affirmatively alleges that the Opposer's translation of the Applicant's business plan from Chinese to English is seriously fraud and misleading at least in the second paragraph of the business plan, which is annexed to Exhibit D of the Opposer's

Motions to Amend and to Suspend Pending Consideration of the Motion to Amend. The true, complete and accurate translation of the business plans from Chinese into English with respect to the second paragraph of the Business Plans shows that, “If [the Mark is] approved, [we] will plan to produce beer and related beverages, [and then] sell [them] in the markets of the United States and China”. On the contrary, Opposer’s translation, which states “If it is approved, will plan to produce beer and related beverages in the United States and sell them in the China market”, deviates substantially from true and accurate meaning of business plans written in Chinese.

WHEREFORE, Applicant requests that the Amended Notice of Opposition be dismissed, and for such other and further relief as the Board deems just and proper.

Dated: Flushing, New York
August 5, 2014

Respectively submitted,

MICHAEL LIANG (Applicant)

by: /s/David Yan

David Yan
Law Offices of David Yan
Attorney for Applicant
136-20 38th Avenue, Suite 11E
Flushing, NY 11354
Tel.: (718) 888-7788

VERIFICATION

The undersigned Applicant, being duly affirm under the penalty of perjury, states (1) that undersigned Applicant has read the APPLICANT'S ANSWER TO AMENDED NOTICE OF OPPOSITION; (2) that the contents of the APPLICANT'S ANSWER TO AMENDED NOTICE OF OPPOSITION are true to the undersigned Applicant's own knowledge except as to those matters which are alleged on information and belief and as to them the undersigned Applicant's believes them to true.

Dated: Flushing, New York
August 5, 2014

/s/ Michael Liang _____
Michael Liang

AFFIRMATION OF SERVICE

I hereby certify that, on August 6, 2014, I caused a true and complete copy of the foregoing Applicant's Answer to Amended Notice of Opposition to be sent by the U.S. Post First Class Mail, postage prepared, to the Opposer's Counsel of Record, William M. Borchard, Esquire, Cowan Liebowitz, & Latman, P.C., located at 1133 Avenue of the Americas, New York, NY 10036.

/s/David Yan

David Yan