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

Proceeding	91204122
Party	Plaintiff Empire State Building Company L.L.C.
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Attachments	Reply Memo of Law and declaration.pdf(172790 bytes)

INTRODUCTION

“The absence of any documentary evidence on the part of [Applicant] regarding [his bona fide] intent constitutes objective proof that is sufficient to prove that [Applicant] lacks a bona fide intention to use [his] mark in commerce.” *SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 U.S.P.Q.2d 1300, 1304 (T.T.A.B. 2010). As set forth in further detail below, Applicant’s responsive papers—which were untimely filed and served—fail to rebut Opposer’s showing that Applicant lacked a bona fide intent. Even under Applicant’s alternative translation of his purported “business plan,” the document still is nothing more than a “plan to apply for a trademark” that contains only vague and generalized references to hiring salespeople and finding a supplier in the United States. It does not evidence concrete business plans that show Applicant’s bona fide intent. Similarly, Applicant’s testimony about purported attempts to find a local licensee/supplier for his intended goods—which attempts were not disclosed during discovery—are vague, generalized and unsupported by any documentation. This testimony similarly does not show Applicant’s bona fide intent. Thus, Applicant has failed to create a triable issue of fact and the Board should grant Opposer’s motion for summary judgment.

ARGUMENT

A. The Board Should Strike Applicant’s Untimely Opposition Papers

Opposer filed and served via first-class mail its motion for summary judgment on August 14, 2014. Pursuant to 37 CFR §§ 2.127(e)(1), 2.119(c), Applicant’s deadline to file and serve opposition papers was September 18, 2014. On September 19, 2014, after the deadline expired, Applicant filed a motion on consent to extend his time to file and serve opposition papers by three weeks, until and including October 9, 2014, which motion was granted by the Board.

On October 10, 2014, *after* the extended deadline expired, Applicant filed his brief in opposition to Opposer's summary judgment motion. In addition to being untimely, this filing was *incomplete* and did not include Applicant's personal declaration, which was not filed with the Board until October 12, 2014. Although Applicant's counsel states in his certificate of service that he served a full copy of Applicant's opposition papers, including Applicant's declaration, by first-class mail on October 9, 2014, the actual postmark on the envelope containing the service copies indicates the papers were not served until *four days later*, on October 14, 2014. *See* Shimanoff Reply Decl. ¶¶ 2-7 and Ex. J. Thus, Applicant's opposition papers were not timely filed and served, even under the generously-extended deadline.

Applicant's numerous failures to comply with his deadlines in these proceedings are well-documented and need not be reiterated here. Based on the foregoing, as well as Applicant's history of failing to comply with his obligations in these proceedings, the Board should strike and refuse to consider Applicant's untimely opposition papers submitted in response to Opposer's motion for summary judgment, including Applicant's untimely declaration. *See, e.g., Playmore Inc., Publishers and Waldman Publishing Corp. v. John H. Bertholl*, Opposition No. 115,881 (T.T.A.B. Apr. 19, 2001) (refusing to consider untimely papers submitted in opposition to summary judgment motion).

B. Applicant Has Failed to Create a Triable Issue of Fact Sufficient to Defeat Opposer's Showing that Applicant Lacked a Bona Fide Intent to Use His Mark in Commerce When He Filed His Application

Even if the Board considers Applicant's papers, Applicant has failed to create an issue of fact and Opposer is entitled to summary judgment that Applicant lacked a bona fide intent to use his mark in United States commerce when he filed his application.

1. Opposer Has Standing to Assert Its Claims

Applicant argues that Opposer lacks standing because Applicant does not believe there is a likelihood of confusion. But Applicant's argument misconstrues the doctrine of standing. Not only is Applicant's subjective belief about confusion irrelevant, the issue is not whether Opposer eventually will succeed on the merits of its Section 2(d) claim. In order to maintain standing, Opposer need only assert a non-frivolous claim, *see Barbara's Bakery Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1285 (T.T.A.B. 2007), which Opposer has done. Applicant does not dispute Opposer's prior rights in its marks and registrations. And Applicant himself admitted in his application and throughout his opposition papers on the instant motion that his mark contains a building intended to resemble and reference the Empire State Building. *See Shimanoff Decl. Ex. I* (Applicant's admission in his application that his "mark consists of a building resembling the Empire State Building"); *Liang Decl. ¶ 4* ("we want our Mark to have the reference to the landmarks of the international metropolitans, such as . . . the Empire State Building"); *id. ¶ 5* ("What we wanted is the living and life style implied by these logos of . . . the Empire State Building"). Moreover, Opposer's Section 2(a) false association claim does not require a finding of likely confusion. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 217 U.S.P.Q. 505, 508-09 (Fed. Cir. 1983). Opposer thus clearly has satisfied the threshold inquiry of standing.¹

¹ Contrary to Applicant's assertions, as set forth in Opposer's moving papers (Opp. Br. at p. 1, n.1), the substitution of ESRT Empire State Building, L.L.C., is entirely appropriate at this juncture and supported by the recordation in the Assignment Services Division of the USPTO. *See T.B.M.P. § 512.01.*

2. Applicant's Alternative Translation of His Purported "Business Plan" Does not Show His Bona Fide Intent

In its moving papers, Opposer clearly established that Applicant had no documents evidencing Applicant's bona fide intent to use. Indeed, in an industry as heavily regulated as the production and sale of alcoholic beverages, one would expect Applicant to have at least some documentary evidence of trying to enter the field. *See L'Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1443 (T.T.A.B. 2012) (no bona fide intent where Applicant lacked any documentary evidence, including evidence concerning "steps to comply with regulatory requirements"). But Applicant has no such documents.

The *sole* document identified and produced by Applicant in response to Opposer's discovery requests on the issue of bona fide intent consisted of three pages of handwritten notes in Chinese, entitled "*Plan to apply for a trademark.*" This document clearly states that *no plans* to market any products will occur *unless and until the mark is approved*. Applicant's intent not to take any steps regarding proposed goods under his mark unless and until his mark is approved by the USPTO is further confirmed by his written discovery responses. *See* Shimanoff Decl. Ex. C (Applicant's Amended Resp. to Opposer's Interrog. No. 13) (Applicant "intends to market . . . *once the registration of Applicant's Mark is approved by the United States Patent and Trademark Office*") (emphasis in original); *id.* (Applicant's Amended Resp. to Opposer's Interrog. No. 7) ("Applicant intends to use [his] mark . . . once the Applicant's application for registration . . . is approved").

A intention *to apply* for a trademark is not a bona fide intention *to use* the mark in commerce. Applicant's "business plan" and discovery responses confirm that Applicant merely intended to reserve rights in his mark, which does not show a bona fide intent to use. *See*

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993) (intent to reserve rights in mark is not bona fide intent to use mark).

In a vain attempt to rebut the lack of bona fide use established by Opposer, Applicant argues that Opposer’s translation of Applicant’s “business plan” was erroneous. However, the only real difference to which Applicant points in his translation concerns language discussing *where* Applicant claims he intends to market his products—the United States and China (in Applicant’s translation) versus China alone (in Opposer’s translation). But even under Applicant’s proffered translation, the document still merely evidences a plan to apply for a trademark and states that no activities will take place unless and until the trademark registration is granted. The plan’s vague and generalized references to hiring salespeople and finding a supplier in the United States at some point in the future are not the type of concrete business plans that show bona fide intent. See *Lincoln Nat’l Corp. v. Anderson*, 110 U.S.P.Q.2d 1271, 1280-81 (T.T.A.B. 2014); *L’Oreal*, 102 U.S.P.Q.2d at 1443; *SmithKline Beecham Corp.*, 97 U.S.P.Q.2d at 1304.

Thus, Applicant’s proposed alternative translation of his “business plan” does not create an issue of fact sufficient to defeat Opposer’s showing that it is entitled to summary judgment.

3. Applicant’s Undocumented and Generalized Claims Regarding Potential Licensees Do Not Show His Bona Fide Intent

In response to Opposer’s discovery requests that Applicant identify and produce all documents reflecting Applicant’s bona fide intention to use his mark, Applicant identified and produced only the afore-mentioned “plan to apply for a trademark.” See Shimanoff Decl. Ex. C (Applicant’s Amended Resp. to Opposer’s Interrog. No. 16); Ex. D. When Applicant was asked to produce all documents concerning *any actual or proposed licenses* to third parties regarding his intended mark, Applicant responded that he “*has no such documents.*” See Shimanoff Decl.

Ex. B (Opposer's Interrog. No. 12); Ex. C (Applicant's Amended Resp. to Opposer's Interrog. No. 12). Similarly, when Applicant was asked to produce "all documents concerning the *intended channels of trade*" for goods bearing his mark, he responded that he "*does not have such documents.*" See Shimanoff Decl. Ex. B (Opposer's Interrog. No. 20); Ex. C (Applicant's Amended Resp. to Opposer's Interrog. No. 20).

Now, for the first time, solely in response to Opposer's summary judgment motion, Applicant claims that, at unspecified times before and after the date on which his filed his Application, he and his business partners "contacted many local brewers about the possible *licensing* of the Mark by using the local brewers' production facilities and *sales channels*[, including] the Harlem Brewing Company located in Harlem, New York." Liang Decl. ¶ 6. Because Applicant failed to disclose these purported licensing efforts and intended sales channels during discovery, the Board should strike from the record and not consider this purported evidence. See *Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 U.S.P.Q.2d 1789, 1792 (T.T.A.B. 2009) (striking from record evidence proffered for first time at trial that had not been disclosed in discovery).

Nonetheless, even if the Board considers this evidence, Applicant's declaration about these purported licensing attempts do not objectively show a bona fide intent to use. First, Applicant proffers no documentary evidence to support these new claims about his purported licensing efforts, such as correspondence, calendars, budgets, transportation receipts, meeting notes, planning notes, business cards, phone logs, mock-ups, presentations or sales decks. Nor does Applicant identify the precise dates of his purported meetings with any of these potential licensee, the exact nature of what was discussed during these meetings and whether any actual agreements were reached during these meetings. Based on Applicant's representation that none

of the breweries, including the Harlem Brewing Company, “want to license [Applicant’s] Mark prior to the final approval of the registration of the Mark by the U.S. Patent and Trademark Office,” Liang Decl. ¶ 6, it is apparent that no agreements were reached and no concrete steps were taken with respect to licensing. That Applicant likes the “thick and bitter taste” of the beer currently produced by the Harlem Brewing Company under another brand is not a concrete step taken by Applicant that objectively would show his bona fide intent with respect to this mark.

The Board consistently has found that, in light of the lack of documentary evidence, an applicant’s general testimony about licensing efforts is insufficient to show a bona fide intent to use. For example, in *SmithKline Beecham Corp.*, the applicant failed to produce any documents showing his bona fide intent. As here, the only documents produced by the applicant in support of his purported bona fide intent were meeting minutes that contained “only vague references to research and development of products.” Although the applicant testified generally that he had contacted numerous potential licensees to manufacture his intended products, he failed to produce any documents relating to these licensing attempts, such as “correspondence with prospective licenses.” As such, the applicant’s testimony was insufficient to rebut the opposer’s showing that the applicant lacked the requisite bona fide intent. 97 U.S.P.Q.2d at 1303-04. *See also L’Oreal*, 102 U.S.P.Q.2d at 1443 (“the record is devoid of facts showing the efforts applicant has taken to commence use of the marks, such as . . . correspondence with prospective licensees or suppliers”).

Similarly, in *Lincoln Nat’l Corp.*, the Board found the applicant’s testimony regarding his licensing “efforts and activities . . . too non-specific . . . as to the actual nature and results of the efforts . . . to provide any significant support for a finding that applicant possessed the requisite bona fide intent.” Even though the applicant produced several correspondence with

potential licensees, none of the correspondence provided insight as to the precise terms of the licensing proposal. Moreover, the correspondence confirmed that neither the applicant nor any potential licensee had reached any agreement or taken any concrete steps toward licensing. 110 U.S.P.Q.2.d at 1279-80.

Similarly here, Applicant's unsupported and non-detailed testimony concerning his purported licensing efforts is insufficient to rebut Opposer's showing that Applicant lacked a bona fide intent. As such, Applicant's belatedly-disclosed "evidence" concerning his purported licensing efforts does not create an issue of fact sufficient to defeat Opposer's showing that it is entitled to summary judgment.²

CONCLUSION

Based on the foregoing, as well as the arguments and evidence set forth in Opposer's moving papers, Opposer respectfully requests that the Board:

- (1) substitute ESRT Empire State Building, L.L.C. for Empire State Building Company L.L.C. as Opposer;
- (2) grant Opposer's motion for summary judgment that Applicant lacked a bona fide intention to use Applicant's Mark in connection with Applicant's Goods at the time that he filed his Application; and
- (3) enter final judgment in favor of Opposer, terminating these proceedings.

² Applicant's subjective statement that he had a bona fide intent, *see* Liang Decl. ¶ 11, is irrelevant. *See L'Oreal*, 102 U.S.P.Q.2d at 1444.

Dated: New York, New York
October 24, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Reply Memorandum of Law in Further Support of Its Motion for Summary Judgment, including the Reply Declaration of Eric J. Shimanoff, was mailed on October 24, 2014 via First Class Mail, postage prepaid, to counsel for Applicant as follows:

David Yan, Esq.
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136-20 38th Avenue, Suite 11E
Flushing, New York 11354-4232

/Eric J. Shimanoff/
Eric J. Shimanoff

6. In addition to being untimely, this filing was incomplete and did not include Applicant's personal declaration, which was not filed with the Board until October 12, 2014.

7. Although Applicant's counsel states in his certificate of service that he served a full copy of Applicant's opposition papers, including Applicant's declaration, by first-class mail on October 9, 2014, the actual postmark on the envelope containing the service copies indicates the papers were not served until four days later, on October 14, 2014. A true and correct copy of that envelope is attached hereto as **Exhibit J**.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON OCTOBER 24, 2014 AT NEW YORK, NEW YORK.



ERIC J. SHIMANOFF

EXHIBIT J

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