

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

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Mailed: January 20, 2015

Opposition No. 91204122

ESRT Empire State Building, L.L.C.  
(substituted for Empire State Building  
Company L.L.C.)<sup>1</sup>

v.

Michael Liang

**Before Kuhlke, Wellington, and Gorowitz,  
Administrative Trademark Judges.**

**By the Board:**

Michael Liang (“Applicant”) seeks to register the following mark<sup>2</sup> for “Alcohol-free beers; ... Beer, ale, lager, stout, porter, shandy; ...; Hop extracts for manufacturing beer; Imitation beer; ... Malt extracts for making beer; Malt liquor ...” in International Class 32:

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<sup>1</sup> Inasmuch as Empire State Building Company L.L.C. is no longer in existence and all of Opposer’s rights and title to the pleaded registrations and common law trademarks were assigned to ESRT Empire State Building, L.L.C., as recorded in the Assignment Services Division of the USPTO at Reel/Frame Nos. 5139/0027 and 5136/0116, the motion to substitute (filed in conjunction with Opposer’s motion for summary judgment on August 14, 2014) is hereby granted. See TBMP Section 512.01 (2014).

<sup>2</sup> Application Serial No. 85213453, filed January 8, 2011, based on an assertion of a *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b).



ESRT Empire State Building, L.L.C. (“Opposer”) opposes registration of Applicant’s mark on the grounds of likelihood of confusion with its previously used and registered marks<sup>3</sup>, false suggestion of a connection, dilution, and lack of bona fide intent to use the mark when the application was filed.

Applicant, in his answer to the amended notice of opposition, denied the salient allegations in the notice of opposition.<sup>4</sup>

This case now comes up for consideration of Opposer’s motion (filed July 23, 2014) for summary judgment on the lack of bona fide intent to use claim. While Applicant’s response to the motion for summary judgment is untimely, we have elected to consider the motion on the merits, rather than grant it as conceded. Nevertheless, strict compliance with the Board’s deadlines is expected in the future.

Summary judgment is only appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a

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<sup>3</sup> Opposer pleads ownership of two marks (Registration Nos. 2411972 and 2413667) both containing the words EMPIRE STATE BUILDING and ownership of two marks (Registration Nos. 2429297 and 2430828) both containing a pictorial description of the Empire State Building. Opposer’s services include “entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing” in Class 41 and “real estate services, namely, the management and leasing of real estate” in Class 36.

<sup>4</sup> Applicant’s motion (filed August 7, 2014) to accept the late-filed answer to the amended notice of opposition is granted as conceded.

matter of law. *See* Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods*, 961 F.2d at 200, 22 USPQ2d 1542 (Fed. Cir. 1992). 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. *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 22 USPQ2d at 1544.

As an initial matter, although Opposer did not submit proof of ownership and the issuance of its asserted registrations, in view of Applicant's admission in his answer that Opposer owns the pleaded registrations, and in view of Opposer's pleading of a reasonable claim of likelihood of confusion, we consider there to be no issue regarding Opposer's standing. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). *See also, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

After reviewing the parties' arguments and supporting evidence, we conclude that Opposer is not entitled to summary judgment on the issue of whether Applicant had a bona fide intention to use his mark in commerce at the time he filed his application. In particular, we note that the handwritten notes in Chinese with a certified translation into English from Applicant's

meeting in 2010 were attached to Opposer's declaration in support of its motion. These notes are sufficient to at least raise a genuine issue as whether Applicant possessed a bona fide intention to use the mark at the time of filing his application.<sup>5</sup>

In view thereof, Opposer's motion for summary judgment is hereby denied.<sup>6</sup>

Proceedings herein are resumed.<sup>7</sup> Dates are reset as follows:

Plaintiff's Pretrial Disclosures	<b>2/11/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>3/28/2015</b>
Defendant's Pretrial Disclosures	<b>4/12/2015</b>
Defendant's 30-day Trial Period Ends	<b>5/27/2015</b>
Plaintiff's Rebuttal Disclosures	<b>6/11/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>7/11/2015</b>

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within

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<sup>5</sup> Opposer has objected to Applicant's reliance on his declaration concerning his purported licensing attempts because this evidence was not produced during discovery. This objection is moot because we have not considered this testimony in reaching our decision on this summary judgment motion. However, we note that Applicant is under an obligation to supplement his discovery responses. See TBMP Section 408.03 (2014).

<sup>6</sup> The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the 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).

<sup>7</sup> The fact that we have identified and discussed only one genuine dispute of material fact as a sufficient basis for denying the motion for summary judgment should not be construed as a finding that this is necessarily the only dispute which remains for trial.

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.