

ESTTA Tracking number: **ESTTA694308**

Filing date: **09/08/2015**

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.
Correspondence Address	ERIC J SHIMANOFF COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036 UNITED STATES ejs@cll.com, lmr@cll.com, wmb@cll.com, trademark@cll.com, fxm@cll.com, mlk@cll.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Lindsay M. Rodman
Filer's e-mail	trademark@cll.com,ejs@cll.com, lmr@cll.com, wmb@cll.com
Signature	/Lindsay Rodman/
Date	09/08/2015
Attachments	Opposers Trial Brief - Public Version (redacted).pdf(2021542 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

-----X	:	
ESRT EMPIRE STATE BUILDING, L.L.C.,	:	
	:	Opposition No. 91189692
Opposer,	:	
	:	
v.	:	
	:	
MICHAEL LIANG,	:	
	:	
Applicant.	:	
-----X	:	

OPPOSER'S BRIEF ON FINAL HEARING

PUBLIC VERSION

TRADE SECRET/COMMERCIALY SENSITIVE INFORMATION REDACTED

COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

TABLE OF CONTENTS

PRELIMINARY STATEMENT 1

SUMMARY OF THE PROCEEDINGS..... 3

DESCRIPTION OF THE RECORD..... 4

STATEMENT OF ISSUES 6

STATEMENT OF FACTS 7

I. THE EMPIRE STATE BUILDING AND OPPOSER’S EMPIRE STATE BUILDING MARKS ARE FAMOUS AND HAVE LONG BEEN USED AND/OR REGISTERED IN CONNECTION WITH A BROAD RANGE OF GOODS AND SERVICES 7

 A. Opposer’s EMPIRE STATE BUILDING Marks..... 8

 1. EMPIRE STATE BUILDING Observatory Services 8

 2. EMPIRE STATE BUILDING Lighting Display Services 12

 3. EMPIRE STATE BUILDING Real Estate Services 15

 4. EMPIRE STATE BUILDING Events Services 15

 5. EMPIRE STATE BUILDING Broadcasting Services 17

 6. EMPIRE STATE BUILDING Licensed Uses..... 17

 B. The Marketing, Promotion and Advertising of Opposer’s EMPIRE STATE BUILDING Marks 20

 C. The Fame and Public Recognition of the Empire State Building and Opposer’s EMPIRE STATE BUILDING Marks..... 22

 D. Opposer’s EMPIRE STATE BUILDING Registrations..... 24

II. APPLICANT’S MARK AND APPLICATION..... 26

ARGUMENT 28

I. OPPOSER HAS STANDING TO MAINTAIN THIS OPPOSITION 28

II. REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT’S MARK CREATES A LIKELIHOOD OF CONFUSION WITH OPPOSER’S EMPIRE STATE BUILDING MARKS 29

 A. Opposer Has Prior Rights in Its EMPIRE STATE BUILDING Marks..... 29

 B. Applicant’s Mark Creates a Likelihood of Confusion with Opposer’s EMPIRE STATE BUILDING Marks 29

 1. Opposer’s EMPIRE STATE BUILDING Marks Are Famous and Entitled to a Broad Range of Protection..... 30

 2. The Parties’ Marks are Highly Similar..... 33

 3. Applicant’s Goods Are of the Type Consumers Would Expect to Originate from or be Licensed by Opposer 37

4.	Applicant Intended that His Mark Resemble Opposer’s EMPIRE STATE BUILDING Marks	38
5.	The Absence of Actual Confusion Evidence Is Immaterial in View of Applicant’s Lack of Actual Use of Applicant’s Mark.....	39
6.	Any Evidence of Third Party Usage Is <i>De Minimis</i>	39
7.	Weighing the Relevant Factors Shows that Confusion Is Likely	40
III.	REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT’S MARK DILUTES THE DISTINCTIVE QUALITY OF OPPOSER’S EMPIRE STATE BUILDING MARKS.....	40
A.	Opposer’s EMPIRE STATE BUILDING Marks Were Famous and Distinctive Prior to Applicant’s Constructive First Use Date.....	40
B.	Applicant’s Mark Is Likely to Blur the Distinctive Quality of Opposer’s EMPIRE STATE BUILDING Marks	41
1.	The Parties’ Marks Are Highly Similar.....	42
2.	Opposer’s EMPIRE STATE BUILDING Marks Are Highly Distinctive	43
3.	Opposer Is Making Substantially Exclusive Use of Its EMPIRE STATE BUILDING Marks	43
4.	Opposer’s EMPIRE STATE BUILDING Marks Enjoy a High Degree of Recognition	43
5.	Applicant Intended to Create an Association with Opposer’s EMPIRE STATE BUILDING Marks	44
6.	The Actual Association Factor Is Neutral	44
7.	Analysis of the Relevant Factors Shows that Dilution Is Likely.....	44
IV.	REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT’S MARK FALSELY SUGGESTS A CONNECTION WITH THE EMPIRE STATE BUILDING.....	44
A.	Applicant’s Mark Is the Same as, or a Close Approximation of, the Empire State Building’s Identity	45
B.	Applicant’s Mark Points Uniquely and Unmistakably to the Empire State Building.....	46
C.	Opposer Is Not Connected with Applicant	48
D.	The Fame of the Empire State Building Is Such that, When Applicant’s Mark Is Used with Applicant’s Goods, a Connection with the Empire State Building Would Be Presumed	48
	CONCLUSION.....	49

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Andre Oliver Inc. v. Products Exchange Co. Inc.</i> , 1 U.S.P.Q.2d 1817 (T.T.A.B 1986).....	39
<i>Anheuser-Busch, LLC v. Innvopak Sys. Party Ltd.</i> , Opp. No. 91194148, 2015 BL 267868 (T.T.A.B. Aug. 17, 2015) (precedential)	<i>passim</i>
<i>Black & Decker Corp. v. Emerson Elec. Co.</i> , 84 U.S.P.Q.2d 1482 (T.T.A.B. 2007).....	39-40
<i>Bose Corp. v. QSC Audio Prods., Inc.</i> , 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002)	30, 32, 33
<i>Carl Karcher Enters., Inc. v. Stars Rest. Corp.</i> , 35 U.S.P.Q.2d 1125 (T.T.A.B. 1995)	39
<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992).....	39
<i>Chanel, Inc. v. Makarczyk</i> , 110 U.S.P.Q.2d 2013 (T.T.A.B. 2014)	<i>passim</i>
<i>Coach Servs., Inc. v. Triumph Learning LLC</i> , 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012)	28
<i>Edom Laboratories, Inc. v. Lichter</i> , 102 U.S.P.Q.2d 1546 (T.T.A.B. 2012).....	29, 33
<i>Genesco Inc. v. Martz</i> , 66 U.S.P.Q.2d 1260 (T.T.A.B. 2003)	29
<i>H-D Michigan, Inc. v. Boutique Unisex El Baraka, Inc.</i> , Opp. No. 91108265, 2004 TTAB LEXIS 595 (T.T.A.B. Sept. 30, 2004)	38
<i>Henry Siegel Co. v. M & R Int’l Mfg. Co.</i> , 4 U.S.P.Q.2d 1154 (T.T.A.B. 1987)	36
<i>Hewlett-Packard Co. v. Packard Press, Inc.</i> , 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002)	34
<i>Hornby v. TJX Companies Inc.</i> , 87 U.S.P.Q.2d 1411 (T.T.A.B. 2008).....	48
<i>In re Anton/Bauer Inc.</i> , 7 U.S.P.Q.2d 1380 (T.T.A.B. 1988).....	34
<i>In re Capital Brewery Co.</i> , App. Ser. No. 78/655,889, 2007 TTAB LEXIS 646 (T.T.A.B. Dec. 12, 2007).....	34
<i>In re Chatam Int’l Inc.</i> , 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004)	33-34, 35, 37
<i>In re Collegian Sportswear, Inc.</i> , 224 U.S.P.Q. 174 (T.T.A.B. 1984).....	34
<i>In re Cotter & Co.</i> , 228 U.S.P.Q. 202 (T.T.A.B. 1985).....	47
<i>In re E.I. du Pont DeNemours & Co.</i> , 177 U.S.P.Q. 563 (C.C.P.A. 1973).....	29
<i>In re Genghis Grill Franchise Concepts, LP</i> , App. Ser. No. 85/372,951, 2013 TTAB LEXIS 354 (T.T.A.B. July 2, 2013)	37
<i>In re Industria Licorera Quezalteca, S.A.</i> , App. Ser. No. 77/013,941, 2008 TTAB LEXIS 688 (T.T.A.B. Mar. 12, 2008)	33
<i>In re Jackson Int’l Trading Co.</i> , 103 U.S.P.Q.2d 1417 (T.T.A.B. 2012)	46, 47
<i>In re Majestic Distilling</i> , 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003)	37
<i>In re Nat’l Data Corp.</i> , 224 U.S.P.Q. 749 (Fed. Cir. 1985).....	33
<i>In re Nieves & Nieves LLC</i> , 113 U.S.P.Q.2d 1629 (T.T.A.B. 2015)	<i>passim</i>
<i>In re Rolf Nilsson AB</i> , 230 U.S.P.Q. 141 (T.T.A.B. 1986)	32
<i>In re Shell Oil Co.</i> , 26 U.S.P.Q.2d 1687 (Fed. Cir. 1993)	40
<i>In re Sloppy Joe’s Int’l Inc.</i> , 43 U.S.P.Q.2d 1350 (T.T.A.B. 1997).....	45, 46

<i>In re Tex. Instruments Inc.</i> , App. Ser. No. 76/233,338, 2004 TTAB LEXIS 419 (T.T.A.B. July 21, 2004).....	34
<i>In re Urbano</i> , 51 U.S.P.Q.2d 1776 (T.T.A.B. 1999)	45, 49
<i>In re White Swan Ltd.</i> , 8 U.S.P.Q.2d 1534 (T.T.A.B. 1988)	33
<i>Interstate Brands Corp. v. McKee Foods Corp.</i> , 53 U.S.P.Q.2d 1910 (T.T.A.B. 2000).....	33
<i>Kenner Parker Toys, Inc. v. Rose Art Indus.</i> , 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992).....	30
<i>Kohler Co. v. Baldwin Hardware Corp.</i> , 82 U.S.P.Q.2d 1100 (T.T.A.B. 2007).....	29, 37, 38
<i>Mattel Inc. v. Funline Merchandise Co.</i> , 81 U.S.P.Q.2d 1372 (T.T.A.B. 2006).....	29, 40
<i>N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.</i> , 114 U.S.P.Q.2d 1497 (T.T.A.B. 2015).....	42, 43, 44
<i>Nat’l Bus. Forms & Printing, Inc. v. Ford Motor Co.</i> , 101 U.S.P.Q.2d 1746 (5th Cir. 2012).....	36
<i>New York Yankees P’ship v. Evil Enters., Inc.</i> , Opp. No. 91192764, 2013 TTAB LEXIS 72 (T.T.A.B. Feb. 8, 2013).....	49
<i>Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.</i> , 12 U.S.P.Q.2d 1901 (Fed. Cir. 1989)	32
<i>Opryland USA Inc. v. The Great American Music Show Inc.</i> , 23 U.S.P.Q.2d 1471 (Fed. Cir. 1992).....	30
<i>Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.</i> , 224 U.S.P.Q. 1064 (T.T.A.B. 1984)	32, 36 n.4
<i>Quaker State Oil Refining Corp. v. Quaker Oil Corp.</i> , 172 U.S.P.Q. 361 (C.C.P.A. 1972).....	34
<i>R.J. Reynolds Tobacco Co. v. R. Seelig & Hille</i> , 201 U.S.P.Q. 856 (T.T.A.B. 1978).....	30
<i>Recot, Inc. v. Becton</i> , 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000).....	29, 30
<i>Ritchie v. Simpson</i> , 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999).....	28
<i>Roger & Gallet S.A. v. Venice Trading Co.</i> , 1 U.S.P.Q.2d 1829 (T.T.A.B. 1987).....	38-39
<i>Sealed Air Corp. v. Scott Paper Co.</i> , 190 U.S.P.Q. 106 (T.T.A.B. 1975)	33
<i>The Bd. of Trustees of the Univ. of Alabama v. BAMA-Werke Curt Baumann</i> , 231 U.S.P.Q. 408 (T.T.A.B. 1986)	45, 46, 47
<i>UMG Recordings, Inc. v. Mattel, Inc.</i> , 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011).....	42, 44
<i>Weiss Associates Inc. v. HRL Associates Inc.</i> , 14 U.S.P.Q.2d 1840 (Fed. Cir. 1990).....	39

Statutes

15 U.S.C. § 1051(b), Lanham Act Section 1(b).....	3, 6
15 U.S.C. § 1052(a), Lanham Act Section 2(a)	<i>passim</i>
15 U.S.C. § 1052(d), Lanham Act Section 2(d).....	<i>passim</i>
15 U.S.C. § 1125(c), Lanham Act Section 43(c)	<i>passim</i>

Other Authorities

T.M.E.P. § 1207.01(c)(i) (July 2015)	32
--	----

PRELIMINARY STATEMENT

Opposer ESRT Empire State Building, L.L.C. owns and operates the world-famous Empire State Building, one of the most iconic skyscrapers in the world. With its distinctive architectural design, including its Art Deco tower, pinnacle and unique use of multiple setbacks, the Empire State Building was the tallest building in the world for nearly forty years. As the fifth tallest building in the country today, the Empire State Building soars above the New York City skyline, attracting millions of visitors to its legendary observation decks, which have been featured in notable and classic films such as *King Kong*, *An Affair to Remember* and *Sleepless in Seattle*, and compelling countless others to view from miles away its dazzling nightly lighting displays.

Beginning in 1931, Opposer ESRT Empire State Building, L.L.C. and its predecessors in interest (collectively, “Opposer”), Opposer’s affiliated entities (collectively, with Opposer, “ESB”) and/or ESB’s licensees, have used the word mark EMPIRE STATE BUILDING and image marks depicting the visual equivalent of the Empire State Building alone or with other word, letter and/or design elements, including the following distinctive stylizations:



(collectively, the “EMPIRE STATE BUILDING Marks”), in connection with a wide variety of goods and services, including observatory, exhibit and lighting display services, event and location services, real estate services, broadcasting services, gin, bottled water, barware, apparel, candy, mugs, postcards, collectables, calendars and toys.

By filing intent to use Application Serial No. 85/213,453 (the “Application”), Applicant Michael Liang (“Applicant”) is attempting to register in connection with beer and related goods the following confusingly similar and dilutive mark, which also falsely suggests a connection with the Empire State Building:



(“Applicant’s Mark”).

The building image in Applicant’s Mark—which is the only distinctive element in the logo—undeniably was designed by *literally copying* (and then shading) one of Opposer’s EMPIRE STATE BUILDING Marks long used by ESB and its licensees in connection with observatory, lighting display and real estate services and a wide variety of goods sold in the gift shop in the EMPIRE STATE BUILDING observatory:

Opposer’s Mark



Building in Applicant’s Mark



Applicant admitted that the building design in Applicant’s Mark was intended to resemble and does resemble the Empire State Building, that the Empire State Building and Opposer’s EMPIRE STATE BUILDING Marks are famous and that Opposer’s EMPIRE STATE BUILDING Marks and Applicant’s Mark are similar. Applicant’s obvious attempt to imitate and create an association with

the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks for use in connection with goods consumers would expect to originate from or be licensed by ESB results in a likelihood of confusion, dilution and false suggestion of connection, thus precluding registration.

SUMMARY OF THE PROCEEDINGS

On January 8, 2011, Applicant filed his intent to use Application under Section 1(b) of the Lanham Act to register Applicant's Mark for "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" in International Class 32 ("Applicant's Goods").

The instant opposition was filed against the Application on March 1, 2012.¹ The original Notice of Opposition alleged claims based on likelihood of confusion under Section 2(d) of the Lanham Act, likelihood of dilution under Section 43(c) of the Lanham Act and false suggestion of a connection under Section 2(a) of the Lanham Act. On June 12, 2012, Applicant filed his Answer.

After the Board issued several orders compelling proper discovery responses from Applicant, Opposer filed a motion to amend its Notice of Opposition to add lack of bona fide intent to use as an additional ground for opposition. The Board granted Opposer's motion to amend on June 28, 2014. On August 7, 2014, Applicant filed his Amended Answer ("Am. Answer").

¹ The opposition originally was filed in the name of Empire State Building Company L.L.C., the prior owner of the EMPIRE STATE BUILDING Marks, which entity no longer exists. ESRT Empire State Building, L.L.C., the current owner of the marks, was substituted in as Opposer pursuant to the Board's January 20, 2015 Order.

On August 14, 2014, Opposer filed a motion for summary judgment based on lack of bona fide intent to use. Although the Board found issues of fact precluded summary judgment, the Board's January 20, 2015 Order held that Opposer has standing to maintain the opposition.

DESCRIPTION OF THE RECORD

The evidence of record consists of the following:

Opposer's Testimony

Opposer submitted the following trial testimony:

- Testimony deposition transcript of Applicant Michael Liang, taken March 13, 2015 ("Liang Tr. (3/13/15)"), and accompanying Exhibits 1 through 5.
- Testimony deposition transcript of Stacey-Ann Hosang, ESB's Public Relations Manager, taken March 25, 2015 ("Hosang Tr."), and accompanying Exhibits 6 through 62.
- Testimony deposition transcript of Crystal Persaud, ESB's Legal Counsel, taken March 26, 2015 ("Persaud Tr."), and accompanying Exhibits 63 through 83.
- Testimony deposition transcript of Celeste Beatty, Owner of Harlem Brewing Company, taken March 27, 2015 ("Beatty Tr."), and accompanying Exhibits 84 through 85.
- Opposer's First Notice of Reliance upon Opposer's Registrations, dated March 30, 2015, consisting of current printouts of information from the electronic database records of United States Patent and Trademark Office ("USPTO"), namely, the Trademark Status and Document Retrieval ("TSDR") records, showing the current status and title (owner) of Opposer's Reg. Nos. 2411972, 2413667, 2429297 and 2430828 for the EMPIRE STATE BUILDING Marks attached as Exhibit A ("Opp. 1st Not. Rel.").
- Opposer's Second Notice of Reliance upon Official Records, dated March 30, 2015, consisting of Applicant's Application and Petition to Revive Abandoned Application ("Pet. to Revive") from the Trademark Status & Document Retrieval records for, the Application for the Applicant's Mark attached as Exhibit A ("Opp. 2d Not. Rel.").
- Opposer's Third Notice of Reliance upon Internet Materials, dated March 30, 2015, and the following accompanying Exhibits:
 - (a) Exhibit A – printouts of various website pages available online with articles dated prior to January 8, 2011, concerning Opposer's EMPIRE STATE BUILDING Marks and/or the Empire State Building.
 - (b) Exhibit B – printouts of various website pages available online with articles dated after January 8, 2011, concerning Opposer's EMPIRE STATE BUILDING Marks and/or the Empire State Building.

- (c) Exhibit C – printouts of various website pages available online with artwork available to purchase by the public depicting the visual equivalent of the Empire State Building.
- (d) Exhibit D – printouts of various website pages available online with tourist and general information concerning Opposer’s Marks and/or the Empire State Building.
- (e) Exhibit E – printouts of various website pages available online showing merchandise bearing Opposer’s EMPIRE STATE BUILDING Marks and images depicting the visual equivalent of the Empire State Building in connection with a variety of goods.

(“Opp. 3d Not. Rel.”).

- Opposer’s Fourth Notice of Reliance upon Printed Materials, dated March 30, 2015, and the following accompanying Exhibits:
 - (a) Exhibit A – printed articles dated prior to January 8, 2011, concerning Opposer’s EMPIRE STATE BUILDING Marks and/or the Empire State Building.
 - (b) Exhibit B – excerpts from books about and/or showing images depicting the visual equivalent of the Empire State Building.

(“Opp. 4th Not. Rel.”).

- Opposer’s Fifth Notice of Reliance upon Applicant’s Discovery Responses, dated March 30, 2015, and the following accompanying Exhibits:
 - (a) Exhibit A – Applicant’s Response to Opposer’s First Set of Requests for Admission (“App. Resp. to Opp. Req. to Admit”) Nos. 4, 5, 7 and 8.
 - (b) Exhibit B – Opposer’s First Set of Interrogatories and Request for Production of Documents and Things, Interrogatory Nos. 1, 2, 4-6, 8-11, 13, 15 and 16 and Document Request Nos. 1-14, 17, 18, 20-23.
 - (c) Exhibit C – Applicant’s Response to Opposer’s First Set of Interrogatories and Request for Production of Documents and Things, Interrogatory No. 13 and Document Request Nos. 4, 14, 21, and 22.
 - (d) Exhibit D – Applicant’s Amended Response to Opposer’s First Set of Interrogatories (“App. Am. Resp. to Opp. Interrog.”) and Request for Production of Documents and Things, Interrogatory Nos. 1, 2, 4-6, 8-11, 13, 15 and 16 (a typographical error lists Response 16 as Response 10), and Document Request Nos. 1-14, 17, 18 and 20-23.
 - (e) Exhibit E – Applicant’s e-mail response to Interrogatory No. 16 and attached document to Opposer’s e-mail request to supplement App. Am. Resp. to Opp. Interrog.

(“Opp. 5th Not. Rel.”).

- Opposer’s Rebuttal Notice of Reliance upon Official Records, dated July 8, 2015, consisting of a printout of information from the electronic database

records of the USPTO, namely, the TSDR record, showing that the current status of the registration for the mark NY (and Design), Reg. No. 1247058, is expired (“Opp. 1st Reb. Not. Rel.”).

- Opposer’s Second Rebuttal Notice or Reliance upon Applicant’s Discovery Responses, dated July 13, 2015, consisting of App. Resp. to Opp. Req. to Admit No. 3 (“Opp. 2d Reb. Not. Rel.”).

Applicant’s Testimony

Applicant submitted the following trial testimony:

- Testimony deposition transcript of Applicant’s friend, Xuefeng Yang, taken May 22, 2015 (“Yang Tr.”), and accompanying Exhibits 1-6.
- Testimony deposition transcript of Applicant Michael Liang, taken May 22, 2015 (“Liang Tr. (5/22/15)”), and accompanying Exhibits 7-8.
- Applicant’s First Notice of Reliance upon Official Records, dated May 27, 2015, and accompanying Exhibits A-C (“App. 1st Not. Rel.”).

STATEMENT OF ISSUES

1. Does Applicant’s Mark so closely resemble Opposer’s EMPIRE STATE BUILDING Marks as to be likely, when applied to Applicant’s Goods, to cause confusion, to cause mistake or to deceive because the public is likely to believe that goods bearing marks comprising or containing Applicant’s Mark have their origin with Opposer and/or that such goods are approved, endorsed, or sponsored by Opposer or associated in some way with Opposer under Section 2(d) of the Lanham Act?

2. Does Applicant’s Mark so closely resemble Opposer’s EMPIRE STATE BUILDING Marks as to be likely, when applied to Applicant’s Goods, to cause a likelihood of dilution through blurring of the distinctive quality of Opposer’s EMPIRE STATE BUILDING Marks under Section 43(c) of the Lanham Act?

3. Does Applicant’s Mark falsely suggest a connection with the Empire State Building under Section 2(a) of the Lanham Act?

4. Opposer is not pursuing at trial its claim based on Applicant’s lack of bona fide intent to use under Section 1(b) of the Lanham Act.

STATEMENT OF FACTS

I. THE EMPIRE STATE BUILDING AND OPPOSER'S EMPIRE STATE BUILDING MARKS ARE FAMOUS AND HAVE LONG BEEN USED AND/OR REGISTERED IN CONNECTION WITH A BROAD RANGE OF GOODS AND SERVICES

Opposer owns and operates the Empire State Building, one of the most famous and widely-recognized buildings in the world. Completed in 1931 and for nearly forty years after that, the Empire State Building was the tallest building in the world, standing today at 1,454 feet as the fifth tallest building in the country. Located at the busy intersection of 5th Avenue and 34th Street, the building soars above the New York City skyline and can be seen for miles away from numerous vantage points. For nearly 85 years, and beginning long before Applicant filed his intent to use Application, the Empire State Building, with its distinctive style, including its unique use of multiple setbacks, Art Deco tower and pinnacle on top, has been recognized as an American architectural icon. Hosang Tr. 13:9-28:14; Persaud Tr. 10:17-11:12, 13:23-16:25, 21:15-25; Opp. Ex. 56.

The Empire State Building and Opposer's EMPIRE STATE BUILDING Marks have become associated closely in the minds of the public with a variety of uses, goods and services. This has made the Empire State Building more than just a tall building with a magnificent view. It is a world famous, privately-owned iconic landmark that attracts notable tenants and provides an immersive experience to millions of visitors each year who enjoy its observation decks, stunning Art Deco lobby displaying images of the building exterior, historical and sustainability exhibits, special events such as the annual run-up tower race and Valentine's Day weddings and a variety of shops and restaurants. Countless more consumers are drawn to view from afar the daily famous lighting displays that grace the top of the building. *See, infra*, pp. 8-17.

Since its historic opening day in 1931, the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks consistently and continuously have received press coverage and widespread public recognition of a magnitude likely not enjoyed by any other building in the world.

From the building's ranking as a top tourist attraction in New York City to its integral use in the plots of numerous film and television shows such as *King Kong*, *An Affair to Remember* and *Sleepless in Seattle*, it is difficult to imagine anyone who is not familiar with the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks. *See, infra*, pp. 22-24. Applicant himself has admitted that Opposer's EMPIRE STATE BUILDING Marks are "famous" and that the Empire State Building is an "international landmark" that "everybody knows." Liang Tr. (5/22/15) 39:24 – 40:07; Liang Tr. (3/13/15) 78:4-9; Opp. Ex. 3.

Because of the overwhelming attraction and renown of the Empire State Building, unlike Applicant, numerous third parties have sought permission to use Opposer's EMPIRE STATE BUILDING Marks to advertise, promote and sell their goods or services, including alcoholic beverages and goods related thereto. *See, infra*, pp. 17-20. As set forth in further detail below, the fame of the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, is undeniable.

A. Opposer's EMPIRE STATE BUILDING Marks

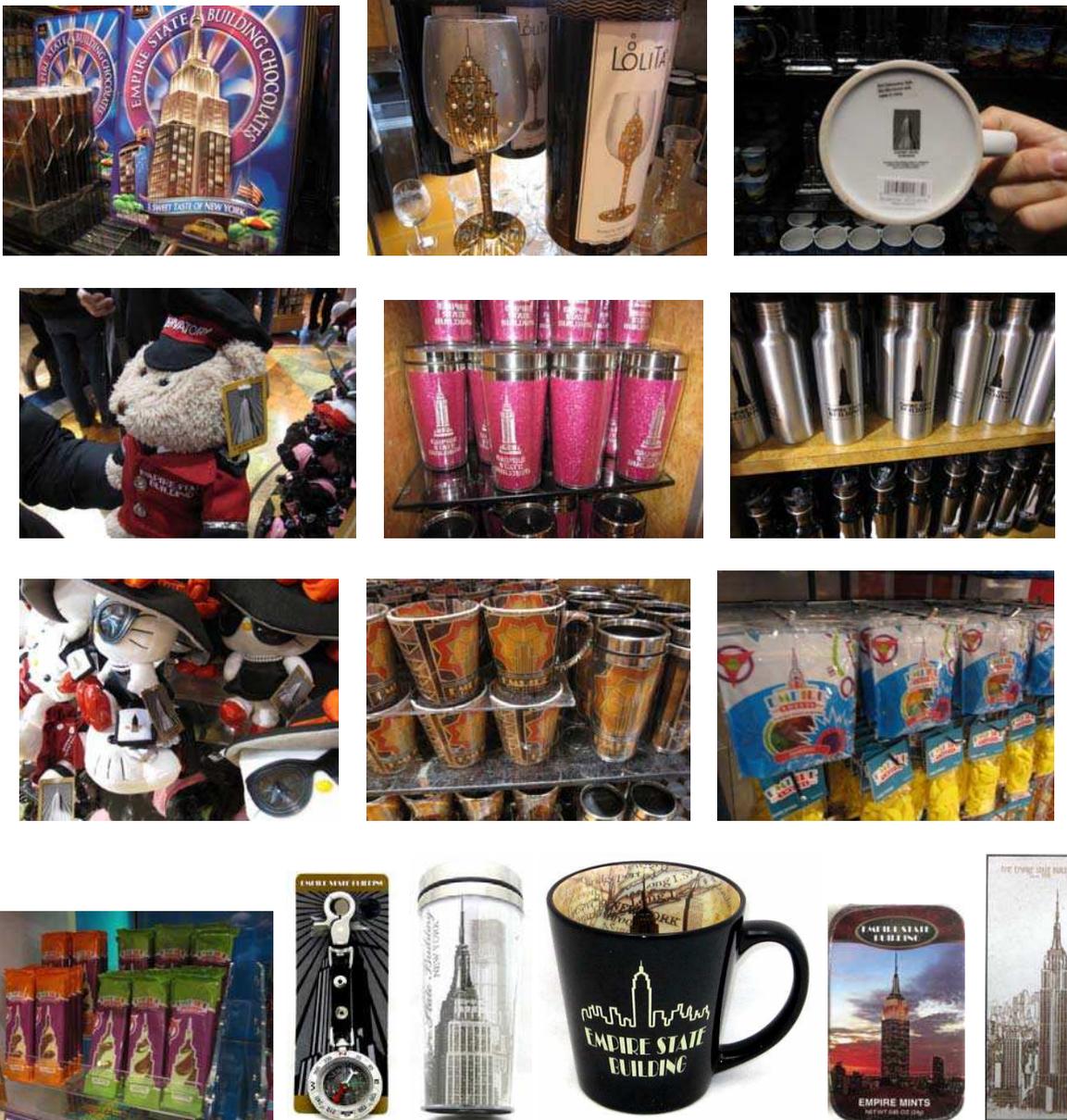
1. EMPIRE STATE BUILDING Observatory Services

Since 1931, Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, consistently and continuously have been used in connection with observatory and related services. The EMPIRE STATE BUILDING observation decks with their 360 degree views of New York City are enjoyed by millions of visitors annually. Such visitors hail from a wide range and myriad of states across the country, as well as from abroad. The highest observatory on the 103rd floor was originally built in 1931 as a disembarkation floor for airships, and now mainly is used for celebrity visits. Recent visitors to the building include Tom Cruise, Mariah Carey, Hugh Jackman, Mary J. Blige, Taylor Swift and Pharrell. The main observatory, featured in numerous classic movies and popular television programs, is found the 86th floor. Visitors also have the opportunity to visit an enclosed observation lounge on the 102nd floor,

which originally was intended to be a waiting area for airships on the 103rd floor. On the 80th floor is the Dare to Dream Exhibit chronicling the planning and construction of the Empire State Building. On the 2nd floor, the Sustainability Exhibit showcases the state-of-the-art technology and processes that went into the Empire State Building's award-winning sustainability retrofit that began in 2009. Since 1931, well over 100 million consumers have visited the EMPIRE STATE BUILDING observatories and exhibits, many describing it as a "must see" attraction, with on average approximately [REDACTED] visitors annually over each of the past ten years. Hosang Tr. 13:9-15:23, 18:20-23:2, 29:18-58:12, 109:2-111:2; Persaud Tr. 18:19-23, 22:13-23:2, 35:15-36:6, 45:24-46:18, 90:21-93:9; Opp. Exs. 14, 82.

Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, surround every aspect of the observatory experience. All of the employees who interact with the public—from the doormen and security employees stationed outside the building entrances to the ambassadors in the observatory decks—have long donned both patches and name tags on their jackets that prominently depict the visual equivalent of the Empire State Building. Since 1931, the main visitor lobby of the Empire State Building has featured a large mural of the Empire State Building, which, along with ESB employee "Linda" at the main information desk, is frequently photographed by visitors to building, including those who do not visit the observatory and other exhibits. Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, also appear on carpets, elevator interiors and exteriors, elevator call buttons, wall decor, signage, tickets, kiosks and brochures within the Empire State Building, all of which are seen by the millions of annual visitors to the observatory and other exhibits. And the building itself, soaring above and a distinctive feature of the New York City skyline since 1931, acts as mark denoting ESB's tourism services and the unique perspectives provided by its observatories. Hosang Tr. 13:9-15:23, 31:12-58:12; Opp. Exs. 10-14.

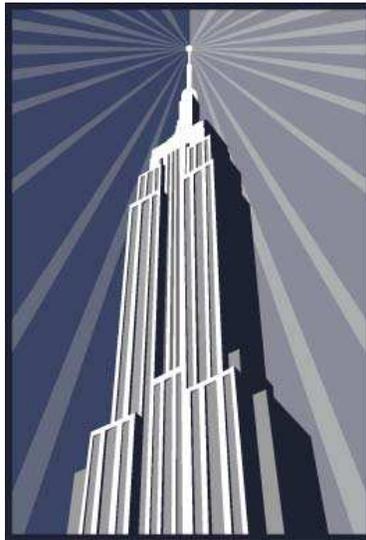
Since at least as early as 1990, all visitors to the EMPIRE STATE BUILDING observatories must “exit through the gift shop.” Operated by EBS’s tenant and licensee, the gift shop features apparel, crystal glassware, candy, beverage holders, shot glasses, mugs, water bottles, toys, books, holiday ornaments, plush toys and other merchandise branded with or sold under the EMPIRE STATE BUILDING Marks, including merchandise identical or similar to that shown below:



Hosang Tr. 21:10-22:4, 58:13-64:4, 126:4-7; Persaud Tr. 46:24-57:23, 90:21-93:9; Opp. Exs. 15, 57.

The gift shop operator has been licensed the right to use Opposer's EMPIRE STATE BUILDING Marks in connection with its procurement and sale of this branded merchandise. Pursuant to written agreements and detailed branding guidelines, source attribution is given for all the goods sold in the gift shop, via either trademark legends on the goods themselves or placards placed throughout the shop, each indicating that the EMPIRE STATE BUILDING Marks are Opposer's property and are licensed for gift shop merchandise. These agreements also permit the gift shop to sell non-alcoholic beverages and serve wine and champagne. Hosang Tr. 61:5-64:4; Persaud Tr. 46:24-57:23; Opp. Exs. 16, 68.

Since well before Applicant filed his Application, consistent with ESB's branding guidelines, numerous goods sold in the gift shop have been branded with or sold under the below mark, which prominently features a depiction of the visual equivalent of the Empire State Building:



Hosang Tr. 58:13-64:4; Persaud Tr. 46:24-57:23; Opp. Exs. 9, 15, 16, 57. Beginning years before 2011, this same mark has appeared on the uniforms and name tags worn by numerous ESB employees who interact with visitors to and tenant employees in the Empire State Building and on carpets and signage throughout the building, as shown below:



Hosang Tr. 13:9-15:23, 31:12-58:12, 74:21-85:16; Opp. Exs. 10, 24, 26. And, as discussed below, this same mark long has been used in connection with the promotion and marketing of ESB's lighting display services. *See, infra*, p.14.

2. EMPIRE STATE BUILDING Lighting Display Services

Opposer's EMPIRE STATE BUILDING Marks long have been used in connection with ESB's famous lighting displays. As shown below, these daily displays, which can be viewed from miles away, grace the top of the Empire State Building and shine above the New York City skyline:



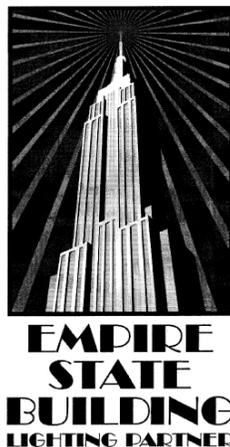
Hosang Tr. 17:23-18:19, 64:9-74:20; Persaud Tr. 35:15-36:6, 57:24-58:16; Opp. Ex. 18.

For nearly 40 years, ESB consistently and continuously has provided lighting display entertainment services either by itself or in conjunction with its lighting partners. The basic Empire State Building lighting has been its signature white, but a variety of dazzling color combinations have been displayed to reflect various holidays, sporting events and teams, and significant public events, or pursuant to lighting agreements with selected parties to reflect cultures or causes in the world community. Beginning long before Applicant's filing date, Opposer has entered into nearly 500 lighting and licensing agreements with partners such as Reebok, Warner Brothers, ASPCA, NFL, Cartier, Mercedes-Benz, Estee Lauder, March of Dimes, Starbucks, Boy Scouts of America and many other well-known organizations, promoting various causes and holidays. Hosang Tr. 17:23-18:19, 64:9-74:20; Persaud Tr. 57:24-62:20; Opp. Exs. 17, 18, 20, 21, 69, 70.

Under these agreements, the Empire State Building has showed specific colors in its lighting displays, and the many of the lighting partners have agreed to participate in lighting ceremonies in the lobby of the Empire State Building, frequently with celebrities and significant media attention. During these ceremonies, which take place in the main visitors lobby in front of the large Empire State Building mural noted above, lighting partners and/or their celebrity spokespeople flip a switch

on a large model of the building that lights up in the lighting partner's designated colors. Hosang Tr. 17:23-18:19, 64:9-74:20; Persaud Tr. 57:24-62:20, 63:9-16; Opp. Exs. 17, 18, 20, 21, 69, 70.

Pursuant to the licensing agreement, lighting partners have acknowledged Opposer's rights in the EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, have agreed that all goodwill from their use of the marks inures to the benefit of Opposer and have agreed to provide attribution when utilizing Opposer's marks. In addition, since at least as early as 2002, lighting partners have agreed to promote EMPIRE STATE BUILDING lighting displays in various media, such as via their websites (linking to ESB's website), publications, social media, email blasts, media outreach and press materials, using the specified logo shown below via license from Opposer:



Hosang Tr. 17:23-18:19, 64:9-74:20; Persaud Tr. 57:24-62:20, 63:9-16; Opp. Exs. 19, 69, 70.² As with ESB's observatory and related services, the Empire State Building itself is part and parcel of, and serves as a source indicator for, ESB's lighting display services. Hosang Tr. 17:23-18:19, 64:9-74:20; Opp. Exs. 17, 18.

² The depiction of the visual equivalent of the Empire State Building in this logo is the same one used in connection with the merchandise sold in the gift shop at the EMPIRE STATE BUILDING observatory, on the uniforms and name tags of ESB employees and on carpets and signage throughout the Empire State Building. *See, supra*, pp. 11-12.

3. EMPIRE STATE BUILDING Real Estate Services

Since 1931, ESB continuously and consistently has used the EMPIRE STATE BUILDING Marks in connection with real estate services, including leasing and management services for office, retail and restaurant space. Considered the “World’s Most Famous Office Building,” ESB’s diverse array of tenants from around the world, who are attracted to the prestige of the building, have included famous companies such as Shutterstock, Bulova, LinkedIn, Global Brands Group, Coty and FDIC. ESB’s restaurant tenants include Heartland Brewery and STATE Restaurant, which restaurants serve beer and other alcoholic beverages. Over 12,000 individuals work in the Empire State Building for nearly 200 different tenants, in addition to approximately 400 of ESB’s own employees. Tenants who work in the Empire State Building and their guests are exposed daily to most of the same images depicting the visual equivalent of the building as are visitors to the observatories and exhibits, such as in murals, on signage and carpets in the lobbies, on building passes given to tenant visitors, in elevator cabs, on uniforms worn by building staff and by the physical building itself. Unlike many buildings in New York City, the Empire State Building is unobstructed on all four sides, even at street level. Hosang Tr. 13:9-15:23, 74:21-85:16; Persaud Tr. 20:4-21:2, 23:22-24:9, 34:9-22, 45:24-46:18; Opp. Exs. 22-26, 56.

Pursuant to written agreements, Opposer has licensed the EMPIRE STATE BUILDING Marks to ESB’s exclusive leasing agents for the agents’ own use in the marketing and promotion of ESB’s leasing services. These agreements require attribution of the ownership and source of the marks. ESB’s tenants also acknowledge Opposer’s rights in the EMPIRE STATE BUILDING Marks and agree not to use such marks without prior permission. Persaud Tr. 80:4-83:3, 94:24-95:24; Opp. Ex. 79.

4. EMPIRE STATE BUILDING Events Services

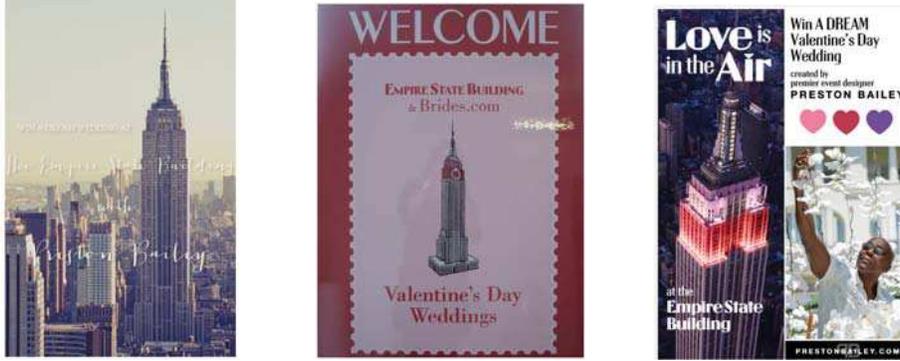
ESB has long used Opposer’s EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, in connection with numerous events

held at the building, which events receive widespread media coverage. For example, since 1978, the annual EMPIRE STATE BUILDING Run-Up has been held in partnership with well-known organizations and companies such as New York Road Runners and Marmot. This is the world's oldest and most famous tower race in which contestants from around the world race up 86 flights. From the applications to enter the race to the bibs worn by the participants and banners throughout the building, the EMPIRE STATE BUILDING Marks are prominently displayed in connection with this race, including as shown below:



Hosang Tr. 7:23-8:11, 85:17-93:25; Opp. Exs. 27-30.

Since 1994, ESB has presented its annual Valentine's Day Weddings Event in which couples enter a contest for the chance to enjoy the ceremony of their dreams in the Empire State Building, one of the most romantic settings in the world. More than 250 couples have exchanged their vows during this event, which is co-marketed by well-known entities such as Brides magazine and event planners such as Preston Bailey and Collin Cowie. The annually televised event is covered by news outlets around the globe. The EMPIRE STATE BUILDING Marks surround every aspect of this annual event, including as shown below:



Hosang Tr. 7:23-8:11, 94:2-103:11; Persaud Tr. 37:15-38:9; Opp. Exs. 31-32.

Other recent events and sponsorships include partnering with Macy's for its famous Fourth of July Fireworks spectacular, partnering with Ford to have a Ford Mustang featured on the 86th floor observatory and hosting ceremonies for the United States Tennis Association. Hosang Tr. 103:12-104:6; Persaud Tr. 62:25-65:19; Opp. Exs. 71-72.

5. EMPIRE STATE BUILDING Broadcasting Services

The EMPIRE STATE BUILDING Marks long have been used in connection with offering services related to broadcasting. It is difficult to imagine anyone residing in the New York metropolitan area over the past 30 years who is not familiar with the popular Z100 radio station's tout that they broadcast "from the top of the Empire State Building." Since the September 11, 2001 attacks on the World Trade Center buildings, nearly all of New York City's commercial broadcast stations (both television and radio) have transmitted from antennae atop the Empire State Building's pinnacle. Hosang Tr. 28:19-29:17, 104:7-17; Persaud Tr. 34:23-35:14.

6. EMPIRE STATE BUILDING Licensed Uses

Given the fame and renown of the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks, unlike Applicant, numerous third parties across a wide range of industries long have sought licenses to use Opposer's EMPIRE STATE BUILDING Marks for a variety of purposes, including use for a wide range of merchandise and in advertising, film and television. Pursuant to these license agreements, licensees acknowledge Opposer's rights in the EMPIRE STATE

BUILDING Marks, expressly license use of the marks and are required to provide source attribution for such use. Hosang Tr. 104:18-111:02; Persaud Tr. 11:13-13:22, 33:20-34:8, 65:20-80:3; Opp. Exs. 68-78.

Opposer's EMPIRE STATE BUILDING Marks, the Empire State Building and its observation decks have been licensed for use and have appeared in print, television and other advertisements for well-known companies such as Hasbro, Reebok, Adidas, Best Buy, Visa, American Express, Sprint, Donna Karan, BMW and Walt Disney. Food and beverage companies are just some of the hundreds of third parties that have licensed the use of a prominent image depicting the visual equivalent of the Empire State Building in connection with their advertising. Hosang Tr. 104:18-111:02; Persaud Tr. 65:20-80:3; Opp. Exs. 73, 74, 75, 77. As just one example of the many licensed advertising uses, from 2008 through 2012, Opposer licensed the alcoholic beverage giant Gallo the right to use "a primary-focus description of the Empire State Building" in connection with the below advertisement for New Amsterdam Gin in a wide variety of print media, including newspapers, magazines and point-of-sale displays:



Hosang Tr. 106:06-22; Persaud Tr. 77:22-79:13, 113:21-115:11; Opp. Exs. 77, 78.

In addition to the merchandise sold in the observatory gift shop, Opposer has granted numerous licenses for its EMPIRE STATE BUILDING Marks across a number of merchandise categories, including apparel, license plates, calendars, posters, trading cards, mugs, umbrella, wallets and a variety of collectibles. Hosang Tr. 104:18-111:02; Persaud Tr. 65:20-80:3; Opp. Exs. 73, 74, 75. For example, a depiction of the Empire State Building was licensed in 2006 to the NYC Department of Environmental Protection for the labels on bottled water, as shown below:



Opp. Ex. 75. In 2008, LEGO obtained a license of the EMPIRE STATE BUILDING Marks to use with a model in its Architectural Series, as shown below, allowing children and architectural enthusiasts to build a replica of the Empire State Building:



Persaud Tr. 73:6-75:5; Opp. Exs. 75, 76.

Opposer's EMPIRE STATE BUILDING Marks also have been licensed for prominent use in films, television and mobile games. As just one of numerous examples, Universal Pictures licensed

use of the visual equivalent of the Empire State Building within the 2005 version of the film *King Kong* as well as for merchandising in connection with the film's release. Pursuant to licenses, many television shows and films, such as *Elf*, *Gossip Girl* and *America's Next Top Model*, have filmed on location at the Empire State Building. Hosang Tr. 104:18-111:02; Persaud Tr. 65:20-80:3; Opp. Exs. 73, 74, 75, 77.

In recognition of the fame long attached to the EMPIRE STATE BUILDING Marks, in 2013, when ESB established Empire State Realty Trust, Inc.—a publicly-traded real estate investment trust that controls numerous office and retail properties in the greater New York metropolitan area—ESB decided to incorporate the famous design of the Empire State Building into its logo shown below:



Persaud Tr. 39:3-45:23; Hosang Tr. 5:15-21, 164:08-166:08; Opp. Exs. 56, 67.

B. The Marketing, Promotion and Advertising of Opposer's EMPIRE STATE BUILDING Marks

ESB and its licensees have spent significant time and resources marketing, promoting and advertising the goods and services offered under Opposer's EMPIRE STATE BUILDING Marks across a wide variety of media and through various other methods. Since at least as early as 2008, ESB has spent between [REDACTED] annually marketing, promoting and advertising the goods and services offered under Opposer's EMPIRE STATE BUILDING Marks. Advertisements for such goods and services, which prominently feature Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, appear in and on a wide range of media and locations, including Internet ads, magazines, newspapers, brochures, flyers, billboards and other posters (including on taxis, busses, newsstands, subways, airport terminals and tourist kiosks). ESB often works directly with numerous other well-known companies,

including tour operators, other tourist attractions, department stores and hotels, to market, advertise and promote the observatory and related services offered under Opposer's EMPIRE STATE BUILDING Marks. Hosang Tr. 141:2-153:21, 181:18-190:25; Opp. Exs. 46-50.

Since 1998, ESB has operated a website, accessible via www.empirestatebuilding.com and www.esbnyc.com, which site prominently displays Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building. Visited by millions of users each year, the site provides information regarding the full breadth of ESB's services, including information and ticket sales to visitors of the observatory and exhibits. The site also has an application page for entities to license the EMPIRE STATE BUILDING Marks, including through becoming a lighting partner. ESB receives multiple license requests daily. Hosang Tr. 64:14-65:18, 67:14-18, 153:22-164:07; Opp. Exs. 51-55.

Since at least as early as 2009, ESB's gift shop tenant has operated a website at www.empirestatebuildinggifts.com to promote and sell a wide range of branded merchandise offered at the gift shop at the EMPIRE STATE BUILDING observatory. The website, which hyperlinks to ESB's own primary website (and vice versa), has prominently featured the EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building. Hosang Tr. 166:9-169:7; Opp. Ex. 57.

ESB also has a strong social media presence, with accounts on Facebook (over 750,000 likes) and Twitter (over 70,000 followers) since March 2010. Both accounts frequently post information about ESB and its services. Facebook users can purchase tickets to the EMPIRE STATE BUILDING observatory directly through the social media platform. ESB also maintains a strong presence on Pinterest, Yelp and Instagram, where a search of #empirestatebuilding reveals over 650,000 photographs. All of these social media accounts consistently and continuously have promoted Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building. Hosang Tr. 169:8-181:13; Opp. Exs. 58-62.

C. The Fame and Public Recognition of the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks

The fame and public recognition of the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the Empire State Building, are well-evidenced by the significant, geographically diverse and broad range of media coverage of and public references concerning the building and Opposer's EMPIRE STATE BUILDING Marks. In fact, there are so many third party media references to the Empire State Building and the EMPIRE STATE BUILDING Marks that ESB is only able to retain a small portion of the references of which it becomes aware, including those provided by its clipping service, which clippings could fill a large room. Hosang Tr. 128:12-137:20.

Since its completion in 1931, the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks, and the goods and services offered thereunder, consistently and continuously have received enormous press and media coverage in a broad range of printed and digital publications from around the country, such as *The Wall Street Journal*, *The Miami Herald*, *The Boston Globe* and the "newspaper of record," *The New York Times*, as well as in numerous and diverse television and radio news programs, such as *CNN Headline News*, *FOX News*, *Live! with Regis and Kelly* and *Good Morning America*. Hosang Tr. 128:12-137:20; Opp. Exs. 41-44; Opp. 3d Not. Rel. Exs. A, B, D; Opp. 4th Not. Rel. Ex. A. Many of these articles and other media references refer to the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks as "distinctive," "famous" or "iconic." Opp. Exs. 41-44; Opp. 3d Not. Rel. Exs. A, B, D; Opp. 4th Not. Rel. Ex. A. Indeed, the media giant HGTV touts that the Empire State Building is "[o]ne of the most iconic architectural structures in the United States." Opp. 3d Not. Rel. Ex. D.

The Empire State Building and Opposer's EMPIRE STATE BUILDING Marks have been the subject of numerous travel guides highlighting ESB's services associated with the observatory and other exhibits. Such travel guides tout the Empire State Building as "a world-famous landmark,"

an “iconic building, where the views of Manhattan are unmatched,” one of New York City’s “Top Attractions” and “the most famous member of the New York Skyline.” Opp. 3d Not. Rel. Ex. D; Opp. 4th Not. Rel. Ex. B; Hosang Tr. 137:21-139:2. Indeed, the Empire State Building is so famous that the U.S. Post Office will deliver mail simply addressed to “Empire State Building” without reference to a physical address. Hosang Tr. 122:13-123:11, 127:18-128:11.

The Empire State Building, its distinctive building design and iconic observation deck and Opposer’s EMPIRE STATE BUILDING Marks have been featured prominently in hundreds of films and television shows. Hosang Tr. 111:3-125:22; Persaud Tr. 83:4-90:20; Opp. Exs. 33-39, 80-81. It is difficult to imagine any consumer who is not familiar with the use of the Empire State Building and Opposer’s EMPIRE STATE BUILDING Marks in the 1933 movie *King Kong*, where the iconic final scene features the giant gorilla climbing to the top of the Empire State Building, carrying a terrified Fay Wray, where he slaps away planes before falling to his death. *King Kong* was remade in 2005 by director Peter Jackson and starred Jack Black, Adrian Brody and Naomi Watts. The remake also prominently featured the Empire State Building and Opposer’s EMPIRE STATE BUILDING Marks as an integral part of its plot and merchandising, pursuant to license from Opposer. Hosang Tr. 112:11-114:17; Persaud Tr. 83:4-18; Opp. Exs. 34, 73, 74, 75, 77.

In *An Affair to Remember* (1957), a remake of *Love Affair* (1939), Cary Grant and Deborah Kerr play star-crossed lovers who made an appointment—sadly missed—to meet on the EMPIRE STATE BUILDING observation deck if they still felt their love months after first meeting. The integral use of the Empire State Building in the plot of the film inspired the romantic comedy *Sleepless in Seattle* (1993), featuring Tom Hanks and Meg Ryan, an episode of the popular television series *Gossip Girl* (2010) and the Chinese-language film *Finding Mr. Right* (2012), all of which were licensed uses. Hosang Tr. 106:23-107:21, 114:18-116:25; Persaud Tr. 83:19-86:7; Opp. Exs. 35, 71, 72, 80. Based on these uses, the well-known travel guide Expedia has touted that the Empire State Building is “one of the city’s most significant and romantic skyscrapers.” Opp. 3d Not. Rel. Ex. D.

Other memorable films prominently featuring the Empire State Building include *Superman II* (1980), *Independence Day* (1996), *Elf* (2003), *Percy Jackson & the Olympians: The Lightning Thief* (2010) and *Oblivion* (2013). Children familiar with the *Percy Jackson* movies and books, where the Empire State Building serves as the gateway to the Olympians, often write to ESB asking if they can visit the home of the “gods.” Hosang Tr. 117:2-125:22; Persaud Tr. 83:4-18; Opp. Exs. 36-39, 81.

The Empire State Building has received numerous nationally recognized awards and distinctive honors, including: one of the seven greatest engineering achievements in America’s history by American Society of Civil Engineers (1955); City Landmark by New York City Landmarks Preservation Commission (1981); National Historic Landmark by National Parks Services (1986); Building of the Year (Historic Building Category) by Building Owners’ and Managers’ Association International (1991-92); Civil Engineering Monuments of the Millennium by American Society of Civil Engineers (2001); and America’s Favorite Architecture (#1) by American Institute of Architects (2007). Hosang Tr. 139:3-140:25; Opp. Ex. 45.

The Empire State Building and the EMPIRE STATE BUILDING Marks have been featured topics in a range of books, including *Empire State Building: When New York Reached for the Skies* (2006), *Building America Then and Now: The Empire State Building* (2009) and *The Empire State Building: The History of New York City’s Most Iconic Landmark* (2015). Hosang Tr. 125:23-126:18; Opp. 4th Not. Rel. Ex. B; Opp. Ex. 57. As a shining beacon topping the New York City skyline, the Empire State Building is the subject of widely-available artwork and photographs by numerous artists and photographers. Opp. 3d Not. Rel. Ex. C.

D. Opposer’s EMPIRE STATE BUILDING Registrations

Opposer owns the following federal registrations for its famous EMPIRE STATE BUILDING Marks, which registrations are incontestable and issued a decade prior to the time Applicant filed his intent to use Application:

Mark	Registration Number & Date	Goods & Services
	2429297 – Feb. 20, 2001	Class 36 – real estate services, namely the management and leasing of real estate
	2430828 – Feb. 27, 2001	Class 41 – entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing
EMPIRE STATE BUILDING	2411972 – Dec. 12, 2000	Class 41 – entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing
EMPIRE STATE BUILDING	2413667 – Dec. 19, 2000	Class 36 – real estate services, namely the management and leasing of real estate

Persaud Tr. 17:2-24:9; Opp. Ex. 64; Opp. 1st Not. Rel. Ex. A.

Opposer also owns App. Ser. No. 86/320,449, filed Jun. 25, 2014, for the mark EMPIRE STATE BUILDING and App. Ser. No. 86/361,227, filed Aug. 08, 2014, for another mark depicting the visual equivalent of the Empire State Building. These applications cover a wide variety of services in International Classes 35, 36, 38, 41, 42, 43 and 45. Nearly all of the dates of first use in App. Ser. No. 86/320,449 precede Applicant’s earliest possible constructive first use date, as confirmed by Opposer’s testimony. Persaud Tr. 24:10-39:2; Opp. Exs. 65-66.

II. APPLICANT’S MARK AND APPLICATION

On January 8, 2011, Applicant filed his intent to use Application for Applicant’s Mark,



for intended use in connection with Applicant’s Goods, many of which goods Applicant himself could not identify or define during his testimony deposition. Liang Tr. (3/13/15) 58:12-68:20. Applicant has not yet used Applicant’s Mark in U.S. commerce and intends to use his mark only once the Application is approved. Opp. 5th Not. Rel. Exs. B, D (App. Am. Resp. to Opp. Interrog. Nos. 1, 5, 6, 13); Liang Tr. (3/13/15) 68:21-69:14.

The dominant portion of Applicant’s Mark depicts the visual equivalent of the Empire State Building and is nearly identical and confusingly similar to Opposer’s EMPIRE STATE BUILDING Marks. It is quite apparent that the building design in Applicant’s mark is a literal reproduction, with minor shading adjustments, of one of Opposer’s EMPIRE STATE BUILDING Marks long used in connection with EBS’s observatory, lighting display and real estate services, as well as a broad range of merchandise sold through the gift shop in the EMPIRE STATE BUILDING observatory:

Opposer’s Mark



Building in Applicant’s Mark



The only word elements of Applicant's Mark are the descriptive or generic terms "NYC," "BEER" and "LAGER," which terms Applicant has disclaimed in his Application and admitted during his deposition have no source indicative qualities. Liang Tr. (3/13/15) 108:12-110:13. Applicant also admitted in his initial application that the "wheat pattern" in his mark signifies "that beer is brewed with a proportion of wheat." Application (01/08/11) (Description of Mark).

Applicant has made a number of other admissions that are relevant to the Board's analysis, including:

- Opposer is the owner of U.S. Registration Nos. 2411972, 2413667, 2429297 and 2430828. Am. Answer ¶ 2.
- Opposer's EMPIRE STATE BUILDING Marks covered by U.S. Registration Nos. 2411972, 2413667, 2429297 and 2430828 are "closely associated" with the services listed in such registrations, namely "entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing," in International Class 41 and "real estate services, namely the management and leasing of real estate," in International Class 36. Opp. 5th Not. Rel. Ex. A (App. Resp. to Opp. Req. to Admit No. 3); Opp. 1st Not. Rel. Ex. A.
- Applicant was aware of Opposer's EMPIRE STATE BUILDING Marks, including in connection with "sightseeing services," prior to filing the Application. Opp. 5th Not. Rel. Ex. A (App. Resp. to Opp. Req. to Admit Nos. 4, 5).
- The Empire State Building and Opposer's sightseeing services offered in connection with Opposer's EMPIRE STATE BUILDING Marks are "famous," Liang Tr. (5/22/15) 39:24-40:7.
- That "of course . . . everybody knows" that the Empire State Building is a "famous landmark." Liang Tr. (3/13/15) 78:4-9.
- Applicant "intended the building design in Applicant's mark to resemble the Empire State Building." Opp. 5th Not. Rel. Ex. A (App. Resp. to Opp. Req. to Admit No. 8);
- The building design in Applicant's Mark "resembles the Empire State Building." Application (01/08/11) (Description of Mark); Liang Tr. (5/22/15) 24:24-25:1.
- Applicant's "mark consists of a building resembling the Empire State Building . . ." Pet. to Revive (10/2/11) (Description of Mark).
- Applicant's "business plan" states that this intended mark "must make reference to international landmarks in the design: such as . . . the Empire State Building."

Opp. Ex. 3; Opp. 5th Not. Rel. Ex. E (e-mail Supp. to App. Am. Resp. to Opp. Interrog. No. 16).

- Applicant used the words “Empire State Building” when communicating to his designer what his logo should look like. Liang Tr. (3/13/15) 107:24-108:5.
- Opposer’s EMPIRE STATE BUILDING Marks and the building in Applicant’s Mark are “similar” and “resemble each other.” Liang Tr. (5/22/15) 13:15-15:1, 16:3-16:22.
- Applicant has no connection with Opposer and as no authorization from Opposer to use the building design in Applicant’s Mark. Opp. 5th Not. Rel. Ex. A (App. Resp. to Opp. Req. to Admit No. 7).
- Applicant has not sought a license from Opposer to use Opposer’s EMPIRE STATE BUILDING Marks. Opp. 5th Not. Rel. Exs. B, D (App. Am. Resp. to Opp. Interrog. No. 15).

ARGUMENT

I. OPPOSER HAS STANDING TO MAINTAIN THIS OPPOSITION

To establish its standing, Opposer merely must show that it has a real interest in the outcome of this proceeding and a reasonable basis for its belief that it would be damaged by issuance of a registration of the mark to Applicant. *See Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023, 1025 (Fed. Cir. 1999). In its January 20, 2015 Order on summary judgment, the Board already determined that Opposer has standing based on Applicant’s admission that Opposer is the owner of Opposer’s pleaded registrations and Opposer’s reasonable claim of likelihood of confusion. *See Board Order (1/20/15) at p. 3. See also Anheuser-Busch, LLC v. Innvopak Sys. Party Ltd.*, Opp. No. 91194148, 2015 BL 267868, at *3 (T.T.A.B. Aug. 17, 2015) (precedential) (“In light of its pleaded ground of likelihood of confusion, Opposer’s submission of its trademark registrations adequately establish its interest in this proceeding and a reasonable basis for its belief that damage would result from registration of Applicant’s mark”). Having established its standing with respect to its likelihood of confusion claim, Opposer need not separately show its standing to assert its claim of dilution or false suggestion of a connection. *See Coach Servs., Inc. v. Triumph Learning LLC*, 101 U.S.P.Q.2d 1713, 1727-28 (Fed. Cir. 2012).

II. REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT'S MARK CREATES A LIKELIHOOD OF CONFUSION WITH OPPOSER'S EMPIRE STATE BUILDING MARKS

In order to sustain its claim under Section 2(d) of the Lanham Act, Opposer must show that it has priority over Applicant and that Applicant's Mark, when used in connection with Applicant's Goods, creates a likelihood of confusion with Opposer's EMPIRE STATE BUILDING Marks. *See Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1267-68 (T.T.A.B. 2003); 15 U.S.C. § 1052(d).

A. Opposer Has Prior Rights in Its EMPIRE STATE BUILDING Marks

Because Opposer has submitted in evidence its pleaded registrations for Opposer's EMPIRE STATE BUILDING Marks, which predate Applicant's constructive first use date, priority is not an issue. *See Edom Laboratories, Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1549 (T.T.A.B. 2012). In any event, inasmuch as Applicant admits that he was aware of Opposer's EMPIRE STATE BUILDING Marks prior to filing his Application and that such marks are famous, and the record shows ESB's use of the EMPIRE STATE BUILDING Marks for nearly 80 years before Applicant filed the Application, Opposer has established priority. *See Mattel Inc. v. Funline Merchandise Co.*, 81 U.S.P.Q.2d 1372, 1373 (T.T.A.B. 2006); *Kohler Co. v. Baldwin Hardware Corp.*, 82 U.S.P.Q.2d 1100, 1106-09 (T.T.A.B. 2007).

B. Applicant's Mark Creates a Likelihood of Confusion with Opposer's EMPIRE STATE BUILDING Marks

"Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations." *Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1896 (Fed. Cir. 2000). Likelihood of confusion is analyzed under the relevant *du Pont* factors, including: the strength or fame of the prior mark; the similarity of the marks at issue; the similarity of the relevant goods and services, trade channels and purchasers; the price point of Applicant's Goods; evidence of actual confusion; the applicant's intent; and the extent of third-party use of similar marks. *See In re E.I. du Pont DeNemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The relevance and weight given the

various factors may differ from case to case. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1472-73 (Fed. Cir. 1992). Analysis of the relevant factors here leads to the conclusion that confusion is not only likely, it is highly likely.

1. Opposer's EMPIRE STATE BUILDING Marks Are Famous and Entitled to a Broad Range of Protection

The fame of a prior mark “plays a ‘dominant’ role in the process of balancing the *du Pont* factors.” *Recot, Inc.*, 54 U.S.P.Q.2d at 1897. Marks that have achieved a high degree of fame are afforded a correspondingly broad scope of protection. See *Bose Corp. v. QSC Audio Prods., Inc.*, 63 U.S.P.Q.2d 1303, 1309 (Fed. Cir. 2002). The Board has long recognized “the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any resemblance thereto.” *R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 U.S.P.Q. 856, 860 (T.T.A.B. 1978). This is because famous marks “are more likely to be remembered and associated in the public mind than a weaker mark,” *Recot*, 54 U.S.P.Q.2d at 1897, and consumers are less likely to perceive differences from famous marks. *Id.* Further, “[t]he fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.” *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). A famous mark thus “casts a long shadow which competitors must avoid.” *Id.* A junior user who adopts a mark similar to a famous mark does so at his own peril. See *id.*

Opposer's EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of Empire State Building, are famous and have enjoyed such fame since long before Applicant filed his intent to use Application in 2011. As set forth in detail above:

- The EMPIRE STATE BUILDING Marks consistently and continuously had been in use for nearly eighty years prior to the time Applicant filed his intent to use Application, and remain in use today in connection with a broad range of goods and services;

- Since 1931, well over 100 million tourists have visited the EMPIRE STATE BUILDING observatory, a top New York City tourist attraction, with millions visiting annually today;
- Countless more consumers have seen from as far as miles away the spectacular lighting displays that grace the top of the Empire State Building and light up the New York City skyline every evening;
- Numerous commercial tenants and their employees have called the “World’s Most Famous Office Building” their home;
- A diverse range of media—including newspapers, magazines, Internet articles, films, television shows, books, travel guides and art—extensively have featured and referenced the Empire State Building and Opposer’s EMPIRE STATE BUILDING Marks, and the goods and services offered in conjunction therewith, without solicitation;
- Many of these media citations refer to the Opposer’s EMPIRE STATE BUILDING Marks, including those marks depicting the visual equivalent of the building, as “iconic,” “famous” and “distinctive”;
- Opposer’s EMPIRE STATE BUILDING Marks have been featured in some of the most classic and well-known scenes in cinematic history, including in films such as *King Kong*, *An Affair to Remember*, *Sleepless in Seattle*, *Elf* and *Independence Day*;
- ESB has heavily promoted, marketed and advertised its EMPIRE STATE BUILDING Marks;
- A diverse myriad of well-known third parties have recognized the value of and goodwill in Opposer’s rights in the EMPIRE STATE BUILDING Marks and have licensed the marks for use in connection with a wide variety of goods and services, including prominent use in advertising, film and television; and
- The Empire State Building has received numerous awards and distinctions, including for its architectural design.

Moreover, Opposer’s EMPIRE STATE BUILDING word marks are inextricably linked with Opposer’s marks that depict the visual equivalent of the Empire State Building, such that the marks essentially are one and the same. Not only have the marks long been used, promoted and referenced in the media together, but the building design is itself inseparably interconnected with and integral to ESB’s provision of its famous observatory, lighting display and event services offered under the EMPIRE STATE BUILDING Marks. One cannot view an image of the visual equivalent of the

Empire State Building without thinking of the EMPIRE STATE BUILDING word mark, and vice-versa. As such, they are legal equivalents. *See Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 U.S.P.Q. 1064, 1066 (T.T.A.B. 1984) (“There can be no doubt that the public has been well educated to opposer’s connections with the word PUMA as well as with configurations of the feline animal in a number of different poses as used in connection with opposer’s goods”). *See also* T.M.E.P. §1207.01(c)(i) (July 2015) (“a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers”); *In re Rolf Nilsson AB*, 230 U.S.P.Q. 141, 142-43 (T.T.A.B. 1986) (design of lion’s head and mark LION regarded as legal equivalents for shoes).

In total, the record makes indisputable that Opposer’s EMPIRE STATE BUILDING Marks are famous and entitled to an extremely broad scope of protection. *See, e.g., Bose Corp.*, 63 U.S.P.Q.2d at 1372 (ACOUSTIC WAVE famous for loudspeaker systems based on 17 years of use, annual sales over \$50 million, annual advertising over \$5 million, and extensive media coverage); *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1901 (Fed. Cir. 1989) (NINA RICCI famous for perfume, clothing and accessories based on over 27 years of use, over \$37 million advertising expenditures, and \$200 million in sales). Even Applicant has conceded the fame of Opposer’s EMPIRE STATE BUILDING Marks, admitting the marks are famous and closely associated with the observatory and real estate services set forth in Opposer’s registrations. And Applicant’s only other witness, Mr. Yang, similarly admitted that the Empire State Building is “of course” “famous.” Yang Tr. 12:22-23; 36:24-25. Such fame weighs heavily in favor of finding likely confusion.³

³ Although evidence of fame subsequent to Applicant’s constructive first use date is relevant to show the impact of ESB’s use and promotion of and publicity surrounding Opposer’s EMPIRE STATE BUILDING Marks prior to that date, as well as the continuing fame and recognition of the marks, the vast majority of evidence on the record concerns the marks’ fame prior to January 8, 2011.

2. The Parties' Marks are Highly Similar

The similarity of the parties' respective marks is determined by comparing the marks in terms of overall appearance, sound, and connotation. *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988). Similarity in any one of the elements can be sufficient to support a finding of likely confusion. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d 1910, 1914 (T.T.A.B. 2000). Where, as here, Opposer's EMPIRE STATE BUILDING Marks are admittedly famous, a lower degree of similarity between the marks is necessary to support a conclusion that confusion is likely. *See Bose Corp.*, 63 U.S.P.Q.2d at 1307-08. Moreover, similarity must be viewed based on "the recollection of the average purchaser, who normally retains a general rather than a specific impression of the trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975).

In determining similarity, more emphasis is placed on the dominant, distinctive and non-descriptive portions of the marks. *See In re Nat'l Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985); *Edom Laboratories*, 102 U.S.P.Q.2d at 1551. Here, the dominant and only distinct portion of Applicant's Mark is the illustration of the building that literally is the visual central focus of the mark. *See In re Industria Licorera Quezalteca, S.A.*, App. Ser. No. 77/013,941, 2008 TTAB LEXIS 688, at *10 (T.T.A.B. Mar. 12, 2008) ("the letters XL are dominant in that they are the largest and 'dead center' in the mark, therefore serving as the visual focal point"). Indeed, in describing his mark in his current Application, Applicant leads with: "The mark consists of a building resembling the Empire State Building" and only afterward describes the secondary and non-distinct elements. Pet. to Revive (10/2/11) (Description of Mark).

Applicant has admitted that the text portions of his mark, namely NYC, BEER and LAGER, are non-distinct and do not indicate the source of his intended products. *See also In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d 1944, 1946 (Fed. Cir. 2004) ("Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the

marks under *DuPont*. As a generic term, ALE simply delineates a class of goods”); *In re Collegian Sportswear, Inc.*, 224 U.S.P.Q. 174, 176 (T.T.A.B. 1984) (COLLEGIAN OF CALIFORNIA and design confusingly similar to COLLEGIENNE). Indeed, Applicant disclaimed these terms in his Application, further conceding that they merely are descriptive or generic terms. See *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 172 U.S.P.Q. 361, 363 (C.C.P.A. 1972). If anything, these terms actually will reinforce a connection with Opposer and enhance likely confusion since NYC describes the location of the Empire State Building and BEER and LAGER are closely related to goods that have been sold in connection with Opposer’s EMPIRE STATE BUILDING Marks. See *In re Collegian Sportswear*, 224 U.S.P.Q. at 176 (consumers likely to “believe that ‘COLLEGIAN OF CALIFORNIA’ clothing was a new line of clothing from registrant featuring a ‘California’ or west coast style); *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002) (applicant’s PACKARD TECHNOLOGIES mark confusingly similar to opposer’s HEWLETT PACKARD marks for computer and computer-related goods and services).

The “wheat pattern” in Applicant’s Mark also is non-distinctive since, as Applicant admits, it merely describes a characteristic of Applicant’s Goods, namely “that beer is brewed with a proportion of wheat.” See *In re Capital Brewery Co.*, App. Ser. No. 78/655,889, 2007 TTAB LEXIS 646, at *8-9 (T.T.A.B. Dec. 12, 2007) (“WHEAT . . . merely describes a style of beer”). Also lacking distinctiveness are the commonplace banner at the bottom of and circles that frame the building design in Applicant’s Mark. See *In re Tex. Instruments Inc.*, App. Ser. No. 76/233,338, 2004 TTAB LEXIS 419, at *6 (T.T.A.B. July 21, 2004) (“applicant’s basic banner design is a simple geometric shape that would not be inherently distinctive”); *In re Anton/Bauer Inc.*, 7 U.S.P.Q.2d 1380, 1381 (T.T.A.B. 1988) (“common geometric shapes such as circles . . . used as backgrounds” not distinct).

Viewed in totality, the dominant portion of Applicant's Mark is nearly identical to Opposer's EMPIRE STATE BUILDING Marks, including those marks shown below:

Opposer's Marks



Applicant's Mark



See In re Chatam Int'l Inc., 71 U.S.P.Q.2d at 1946 (“After discounting any commercial impression of JOSE and GOLD, Chatam is left with GASPAR as the dominant feature of its mark Viewed in their entireties with non-dominant features appropriately discounted, the marks become nearly identical”).

Applicant consistently has admitted that the building in Applicant's Mark was designed to resemble and does resemble the Empire State Building and is similar to Opposer's EMPIRE STATE BUILDING Marks. And it is quite evident that the building design in Applicant's Mark was created by literally copying (and merely shading) one of Opposer's EMPIRE STATE BUILDING Marks

long used in connection with EBS’s observatory, real estate and lighting display services and a broad range of merchandise sold in the gift shop in the EMPIRE STATE BUILDING observatory:

Opposer’s Mark



Building in Applicant’s Mark



See Nat’l Bus. Forms & Printing, Inc. v. Ford Motor Co., 101 U.S.P.Q.2d 1746, 1750 (5th Cir. 2012) (confusion likely where party made “exact copies of Ford’s marks”).

Applicant’s Mark takes Opposer’s mark in full and merely adds non-distinctive words and designs, which makes the parties’ marks highly similar. *See Henry Siegel Co. v. M & R Int’l Mfg. Co.*, 4 U.S.P.Q.2d 1154, 1160 (T.T.A.B. 1987) (L.A. CHIC likely to be confused with CHIC mark because it “contain[ed] the whole of petitioner’s mark with the geographically descriptive designation ‘L.A.’ added thereto”); *Anheuser-Busch*, 2015 BL 267868, at *8 (“although we recognize that WINE is and remains a part of Applicant’s mark, consumers are not likely to view it as a source-distinguishing element, but rather as the name of the goods. To the contrary, the dominant part of Applicant’s mark is clearly ‘BUD,’ which is identical in all respects to Opposer’s registered BUD mark”). Such a high degree of admitted similarity strongly favors a finding of likely confusion.⁴

⁴ Applicant’s Mark also is highly similar to Opposer’s EMPIRE STATE BUILDING word marks that do not depict the visual equivalent of the Empire State Building since Opposer’s building design marks and word marks are legal equivalents. *See Puma-Sportschuhfabriken Rudolf Dassler KG*, 224 U.S.P.Q. at 1066 (holding applicant’s marks featuring design of a mountain lion and opposer’s PUMA word mark were highly similar).

3. Applicant's Goods Are of the Type Consumers Would Expect to Originate from or be Licensed by Opposer

In comparing the relatedness of the parties' goods and services, it is well established that the goods and services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a finding of likelihood of confusion. It is sufficient that the respective goods and services of the parties are related in some manner, or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *Kohler*, 82 U.S.P.Q.2d at 1109-10. *See also Anheuser-Busch*, 2015 BL 267868, at *12 (rejecting applicant's argument that opposer had never sold beer; "The question is not whether Opposer in fact sells the same goods as Applicant, but whether consumers are likely to mistakenly *think* that it does") (emphasis in original).

Well before Applicant filed his intent to use Application, pursuant to license, Opposer's EMPIRE STATE BUILDING Marks depicting the visual equivalent of Empire State Building were used in connection with gin, which is closely related to Applicant's beer and related goods. *See In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d at 1947-48 (beer and ale related to tequila); *In re Majestic Distilling*, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (malt liquor related to tequila); *Anheuser-Busch*, 2015 BL 267868, at *10-11 (beer and wine related goods); *In re Genghis Grill Franchise Concepts, LP*, App. Ser. No. 85/372,951, 2013 TTAB LEXIS 354, at * 6-11 (T.T.A.B. July 2, 2013) (beer related to alcoholic cocktails).

Opposer's EMPIRE STATE BUILDING Marks also have been long used in connection with goods related to alcoholic beverages, such as barware, and restaurant tenants at the Empire State Building serve alcoholic beverages. Moreover, Opposer and its licensees have used the EMPIRE STATE BUILDING Marks in connection with a broad range of collateral goods, including bottled

water, apparel, glassware, beverage holders, mugs, water bottles, toys, books, holiday ornaments, calendars, posters, trading cards, umbrellas, wallets and a variety of collectibles. Under these circumstances, consumers encountering Applicant's Mark are likely to believe, especially based on the striking similarity between the parties' marks, that additional collateral goods, such as Applicant's Goods, are licensed by or originate from Opposer. *See, e.g., H-D Michigan, Inc. v. Boutique Unisex El Baraka, Inc.*, Opp. No. 91108265, 2004 T.T.A.B. LEXIS 595, at *26-27 (T.T.A.B. Sept. 30, 2004) (finding applicant's coffee mugs sufficiently related to Harley-Davidson's broad range of licensed collateral goods, such as baseball caps, T-shirts, belt buckles and pins to cause likelihood of confusion).

Indeed, because Applicant's Goods are broadly identified as to their nature and type, such that there are no restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that the identified goods are offered in all channels of trade which would be normal therefor and that they would be purchased by all potential buyers thereof, including those consumers familiar with Opposer's EMPIRE STATE BUILDING Marks and the wide variety of good and services offered thereunder. *See Kohler*, 82 U.S.P.Q.2d at 1109-10. The relatedness of the parties' respective goods and/or services weighs heavily in favor of a finding of likely confusion.⁵

4. Applicant Intended that His Mark Resemble Opposer's EMPIRE STATE BUILDING Marks

Where, as here, there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, this factor weighs in favor of a likelihood of confusion. *See Roger & Gallet S.A. v. Venice Trading Co.*, 1 U.S.P.Q.2d 1829, 1832 (T.T.A.B.

⁵ The inexpensive nature of Applicant's Goods—3 to 5 dollars (Liang Tr. (3/13/15) 120:18-121:2)—also weighs in favor of likely confusion. *See Anheuser-Busch*, 2015 BL 267868, at *11 ("Because wine and beer can be sold at low price points, many customers will not exercise great care in their purchases of beer and wine . . . , making it more likely that a hurried customer would assume a connection between the source of such products sold under similar trademarks").

1987). Applicant has admitted on numerous occasions, including unequivocally two times during the examination of his Application, that the building design in Applicant's Mark was intended to resemble and does resemble the Empire State Building. Applicant also has admitted that he was aware of the Empire State Building and Opposer's EMPIRE STATE BUILDING Marks, and the fame associated therewith, prior to the time he filed his intent to use Application. Most telling of Applicant's bad faith intent is that the building design in his mark is a literal reproduction of one of Opposer's EMPIRE STATE BUILDING Marks, with minor shading.

5. The Absence of Actual Confusion Evidence Is Immaterial in View of Applicant's Lack of Actual Use of Applicant's Mark

While evidence of actual confusion is not necessary to show a likelihood of confusion, *Weiss Associates Inc. v. HRL Associates Inc.*, 14 U.S.P.Q.2d 1840, 1842 (Fed. Cir. 1990), the lack of actual confusion here is "immaterial" since Applicant has not yet made use of his mark in U.S. commerce. *Andre Oliver Inc. v. Products Exchange Company Inc.*, 1 U.S.P.Q.2d 1817, 1820 (T.T.A.B 1986).

6. Any Evidence of Third Party Usage Is De Minimis

The dearth of evidence concerning third party use of marks similar to the EMPIRE STATE BUILDING Marks weighs strongly in favor of a finding of likely confusion. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992). Although Applicant testified that he encountered Reg. No. 1247058 (now expired) for the mark NY and Design for envelopes prior to filing his Application, there is no evidence on the record concerning the actual use of the mark. Liang Tr. (5/22/15) 51:18-53:2. As such, this registration has no probative value regarding third party use. *See Carl Karcher Enters., Inc. v. Stars Restaurant Corp.*, 35 U.S.P.Q.2d 1125, 1130-31 (T.T.A.B. 1995). There similarly is no evidence concerning the scope and beginning date of use of the building illustration on the take-away bag from Eataly restaurant produced by Applicant's friend, Xuefeng Yang, during his testimony deposition. Yang Tr. 27:15-30:17; App. Ex. 6. As such, this third party use is insignificant. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84

U.S.P.Q.2d 1482, 1495 (T.T.A.B. 2007). Nonetheless, evidence of two limited third party uses over the course of over 80 years would not diminish the strength of Opposer's famous marks or obviate likely confusion. *See Mattel*, 81 U.S.P.Q.2d at 1375.

7. Weighing the Relevant Factors Shows that Confusion Is Likely

Analysis of all the relevant factors leads to the inescapable conclusion that there is a strong likelihood of confusion in this case: Opposer's EMPIRE STATE BUILDING Marks are famous and have been used for the better part of a century in connection with a wide variety of goods and services; the parties' marks are extremely similar and Applicant's Mark was designed by literally copying one of Opposer's marks; Applicant's Goods are of the type that consumers would expect to originate from or be licensed by Opposer; Applicant intended that his mark resemble Opposer's marks; and there is no probative evidence of third party use on the record. Moreover, any doubts regarding the likelihood of confusion must be resolved against Applicant and in favor of Opposer, who has 80 years of priority over Applicant. *In re Shell Oil Co.*, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993). Accordingly, the opposition should be sustained under Section 2(d).

III. REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT'S MARK DILUTES THE DISTINCTIVE QUALITY OF OPPOSER'S EMPIRE STATE BUILDING MARKS

In order to sustain the opposition based on dilution by blurring, Opposer must prove that Opposer's EMPIRE STATE BUILDING Marks were distinctive and famous prior to the date Applicant filed his Application to register Applicant's Mark and that Applicant's Mark is likely to blur the distinctiveness of Opposer's EMPIRE STATE BUILDING Marks. *See Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q.2d 2013, 2018 & n.6 (T.T.A.B. 2014).

A. Opposer's EMPIRE STATE BUILDING Marks Were Famous and Distinctive Prior to Applicant's Constructive First Use Date

In order to establish fame for dilution, a party must show that its mark "is widely recognized by the general consuming public of the United States." 15 U.S.C. § 1125(c)(2)(A). The Lanham Act

sets forth four factors that should be considered when determining whether a mark qualifies as “famous”: (1) the “duration, extent, and geographic reach of advertising and publicity of the mark,” (2) the “amount, volume, and geographic extent of sales of goods or services under the mark,” (3) the “extent of actual recognition of the mark,” and (4) whether “the mark was registered.” *Id.*

As discussed in detail above in the context of the likelihood of confusion analysis, there can be no doubt as to the fame and distinctiveness of Opposer’s EMPIRE STATE BUILDING Marks. By January 8, 2011, the marks had been used consistently and continuously for 80 years in connection with a wide variety of goods and services enjoyed by well over 100 million consumers, had been registered for a decade and had been the subject of extensive promotion, widespread and significant unsolicited media attention, numerous awards and recognitions, frequent requests for third party licenses and prominent references in numerous films, television shows, books and art works. Like the numerous third parties who have referred to Opposer’s EMPIRE STATE BUILDING Marks as “famous,” “iconic” and “distinctive,” Applicant and his only other witness both conceded that Opposer’s EMPIRE STATE BUILDING Marks are famous.

Accordingly, Opposer’s EMPIRE STATE BUILDING Marks are distinct and famous for dilution purposes and achieved such fame and distinction well prior to Applicant’s constructive first use date. *See Chanel*, 110 U.S.P.Q.2d at 2019-22 (CHANEL mark famous and had acquired distinctiveness based on, *inter alia*, decades of use, extensive nationwide sales and advertising, widespread and significant unsolicited media attention, numerous celebrity endorsements, many awards and recognitions, frequent requests for third party licenses and prominent references in fiction and non-fiction books, film and television).

B. Applicant’s Mark Is Likely to Blur the Distinctive Quality of Opposer’s EMPIRE STATE BUILDING Marks

Dilution by blurring is an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C.

§ 1125(c)(2)(B). “Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party’s use of a mark on its goods are immediately reminded of the famous mark and associate the junior party’s use with owner of the famous mark, *even if they do not believe that the goods come from the famous mark’s owner.*” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 1888 (T.T.A.B. 2011) (emphasis added).

In determining whether a mark is likely to cause dilution by blurring, the Board may consider all relevant factors, including: (1) the degree of similarity between the marks; (2) the degree of inherent or acquired distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the mark intended to create an association with the famous mark; and (6) any actual association between the marks. 15 U.S.C. § 1125(c)(2)(B)(i)-(vi); *Chanel*, 110 U.S.P.Q.2d at 2025.

1. The Parties’ Marks Are Highly Similar

Dilution no longer requires a finding of “substantial similarity.” The Lanham Act now refers only to the “degree of similarity” between the marks. *See UMG Recordings*, 100 U.S.P.Q.2d at 1888 (“[T]he previously enunciated standard requiring ‘substantial similarity’ between the famous mark and the mark at issue is no longer the standard for dilution by blurring”). Thus, the question before the Board is simply “whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *Id.* Given the close similarity between the parties’ marks, as addressed above, it is clear that Applicant’s Mark conjures up Opposer’s EMPIRE STATE BUILDING Marks and the parties’ marks are highly similar for dilution purposes. *See N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 U.S.P.Q.2d 1497, 1507 (T.T.A.B. 2015) (finding “consumers encountering Applicant’s mark,” which incorporated near replication of dominant element of opposer’s mark, “will immediately be reminded of Opposer’s famous top hat design mark and associate the two”). Indeed, Applicant’s Mark was created by

literally copying one of Opposer's EMPIRE STATE BUILDING Marks, Applicant clearly admitted twice during the examination process of his Application that the building in Applicant's Mark resembles the Empire State Building and Applicant has admitted that the parties' marks are similar. Such high similarity strongly favors a finding a likely dilution.

2. Opposer's EMPIRE STATE BUILDING Marks Are Highly Distinctive

The discussion above regarding Opposer's extensive evidence of fame of the EMPIRE STATE BUILDING Marks used in connection with a wide variety of goods and services, including without limitation observatory, lighting display and real estate services, sufficiently establishes that Opposer's marks have acquired a high degree of distinctiveness among consumers. *See Chanel*, 110 U.S.P.Q.2d at 2025; *N.Y. Yankees P'ship*, 114 U.S.P.Q.2d at 1507.

3. Opposer Is Making Substantially Exclusive Use of Its EMPIRE STATE BUILDING Marks

The record essentially is devoid of evidence of third party use. Moreover, Opposer maintains an extensive licensing program and enforces against third parties. Thus, the record shows that Opposer is engaged in substantially exclusive use of its marks, which favors a finding of likely dilution. *See Chanel*, 110 U.S.P.Q.2d at 2025-26.

4. Opposer's EMPIRE STATE BUILDING Marks Enjoy a High Degree of Recognition

As discussed above in the context of fame, Opposer's EMPIRE STATE BUILDING Marks enjoy a high degree of recognition among consumers, which strongly favors a finding of likely dilution. In particular, the marks are the subject of numerous unsolicited media references, third party licenses by famous companies, prestigious awards and prominent uses in film, television, books and art. *See Chanel*, 110 U.S.P.Q.2d at 2021, 2026.

5. Applicant Intended to Create an Association with Opposer’s EMPIRE STATE BUILDING Marks

Applicant has admitted that he was aware of Opposer’s EMPIRE STATE BUILDING Marks, and the fame thereof, prior to filing his Application. Applicant also has admitted, including unequivocally two times during the examination of his Application, that the building design in his own mark was intended to resemble and does resemble the Empire State Building. Indeed, Applicant’s own “business plan” states that his mark “must” make reference to the Empire State Building. Such intent to create an association with Opposer’s marks strongly favors a finding of likely dilution. *See Chanel*, 110 U.S.P.Q.2d at 2026.

6. The Actual Association Factor Is Neutral

The actual association factor is neutral here, especially since Applicant has not yet made use of his mark in U.S. commerce. *See UMG Recordings*, 100 U.S.P.Q.2d at 1889.

7. Analysis of the Relevant Factors Shows that Dilution Is Likely

Based on analysis of the factors above—combined with the fact that, well prior to Applicant’s constructive first use date, Opposer had licensed its EMPIRE STATE BUILDING Marks for use in connection with a wide variety of goods and services, including goods closely related to Applicant’s Goods—Applicant’s intended use of Applicant’s Mark is likely to impair and to blur the distinctiveness of Opposer’s EMPIRE STATE BUILDING Marks. *See Chanel*, 110 U.S.P.Q.2d at 2026; *N.Y. Yankees P’ship*, 114 U.S.P.Q.2d at 1509. The opposition thus should be sustained under Section 43(c) of the Lanham Act based on dilution by blurring.

IV. REGISTRATION SHOULD BE REFUSED BECAUSE APPLICANT’S MARK FALSELY SUGGESTS A CONNECTION WITH THE EMPIRE STATE BUILDING

Section 2(a) prohibits registration of “matter which may . . . falsely suggest a connection with . . . persons [or] institutions.” 15 U.S.C. § 1052(a). A party seeking to oppose registration of a mark based on false suggestion of a connection must show: (1) that the mark is the same as, or a close

approximation of, the previously-used name or identity of the person or institution; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) that the person or institution identified by the mark is not connected with the activities performed by applicant under the mark; and (4) that the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods, a connection with the institution would be presumed. *See In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, 1631-32 (T.T.A.B. 2015).

A. Applicant's Mark Is the Same as, or a Close Approximation of, the Empire State Building's Identity

Stylized and design marks are subject to Section 2(a)'s prohibition on registration of marks that create a false suggestion no less than word marks. *See, e.g., In re Sloppy Joe's Int'l Inc.*, 43 U.S.P.Q.2d 1350, 1353-54 (T.T.A.B. 1997). Moreover, a term or image may be considered the identity of a person or institution, even if that person or institution has not used the term or image as a trademark. *See In re Urbano*, 51 U.S.P.Q.2d 1776, 1778-79 (T.T.A.B. 1999); *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1633. That is because the prohibition against registration of a mark that falsely suggests a connection concerns the "right to control use of one's identity," personal or corporate, irrespective of trademark rights or likely confusion. *See The Bd. of Trustees of the Univ. of Alabama v. BAMA-Werke Curt Baumann*, 231 U.S.P.Q. 408, 410 (T.T.A.B. 1986). The relevant inquiry here is whether Applicant's Mark "would be understood by the relevant public as identifying" the Empire State Building. *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1633.

As discussed in detail above, ESB and its licensees have used the distinct design of the Empire State Building—with its unique use of setbacks, Art Deco tower and pinnacle on top—to identify the Empire State Building and wide variety of goods and services. The iconic skyscraper, the tallest building in the world for forty years, soars above the New York City skyline where its spectacular lighting displays can be seen by millions of people from miles away. For the better part of a century, the building frequently has been the subject of and appeared in a wide range of

newspapers, magazines, Internet articles, films, television shows, books, travel guides and art. As such, the design of the Empire State Building is its identity. *See id.* at 1632-36 (PRINCESS KATE identity of Kate Middleton based on significant references in press); *The Bd. of Trustees of the Univ. of Alabama*, 231 U.S.P.Q. at 411 (BAMA uniquely pointed to identity of University of Alabama due to public's association of term with school based on review of press and other media). Indeed, the building design is just as much the identity of the Empire State Building as its name. *See In re Sloppy Joe's Int'l*, 43 U.S.P.Q.2d at 1354 (refusing registration of applicant containing illustrated portrait of Ernest Hemmingway based on false suggestion of connection).

Applicant's Mark is a close approximation of the design of the Empire State Building. The primary focus and only distinct element of Applicant's Mark is a building design that was literally copied from one of Opposer's widely-used design marks depicting the visual equivalent of the Empire State Building. Applicant has admitted that the building design in his mark resembles and is similar to the design of the Empire State Building. Applicant similarly has conceded the fame of the Empire State Building, that the building is an "international landmark" and that his mark was designed to "make reference to" the Empire State Building. Applicant's only other witness, his friend Mr. Yang, also admitted that the Empire State Building is famous. That Applicant's Mark contains additional material, whether or not distinct, does not diminish the close approximation. *See In re Sloppy Joe's Int'l*, 43 U.S.P.Q.2d at 1354 (SLOPPY JOE and design mark containing illustrated portrait of Ernest Hemmingway was close approximation of Hemmingway's identity); *In re Jackson Int'l Trading Co.*, 103 U.S.P.Q.2d 1417, 1419 (T.T.A.B. 2012) (BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) close approximation of Benny Goodman name).

B. Applicant's Mark Points Uniquely and Unmistakably to the Empire State Building

As discussed in detail above, Applicant's Mark was designed to resemble the Empire State Building. Despite Applicant's unsupported self-serving testimony, he has not submitted evidence

showing similar third party designs that point to buildings other than the Empire State Building. *See In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1636 (PRINCESS KATE uniquely pointed to Kate Middleton where record was devoid of any third party who could be identified by that name); *The Bd. of Trustees of the Univ. of Alabama*, 231 U.S.P.Q. at 411 (no evidence third party known as BAMA). Even Applicant's own friend and witness, Mr. Yang, immediately associated the building illustration in Opposer's registered design marks and the building illustration on his take-away bag from Eataly as all pointing uniquely toward the Empire State Building. Yang Tr. 13:17-14:10 ("everything about [the building in Opposer's registrations]" "looks like Empire State Building"), 51:25-52:20; App. Exs. 3, 6. Given the widespread fame of the Empire State Building, there can be no doubt that Applicant's Mark, which is a literally copy of one of Opposer's EMPIRE STATE BUILDING Marks, uniquely and unmistakably points to the Empire State Building. *See In re Cotter & Co.*, 228 U.S.P.Q. 202, 204-05 (T.T.A.B. 1985) (WESTPOINT uniquely and unmistakably pointed to United States Military Academy).

The nature of Applicant's Goods further reinforces the unique connection of Applicant's Mark with the Empire State Building. Not only has ESB licensed the visual equivalent of the Empire State Building for use in connection with gin and goods related to alcoholic beverages, which are closely related to Applicant's Goods, *see In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1636 (PRINCESS KATE uniquely pointed to Kate Middleton for apparel, jewelry and related goods where Middleton was known for her "fashion sense"), but ESB and its licensees have used images depicting the visual equivalent of the building in connection with a broad spectrum of goods and services. *See In re Jackson Int'l Trading Co.*, 103 U.S.P.Q.2d at 1419 (mark pointed uniquely to famous musician where consumers would expect use of name on wide range of collateral goods). The term NYC in Applicant's Mark, which is the location of the Empire State Building, similarly reinforces the connection.

C. Opposer Is Not Connected with Applicant

As to the third element, Applicant does not and cannot claim to have any connection whatsoever with Opposer, ESB or the EMPIRE STATE BUILDING Marks.

D. The Fame of the Empire State Building Is Such that, When Applicant's Mark Is Used with Applicant's Goods, a Connection with the Empire State Building Would Be Presumed

With respect to the fourth element, the relevant inquiry is *not* whether the Empire State Building is well-known for Applicant's Goods, such as beer. The proper question "is whether [the Empire State Building's] renown is such that when [Applicant's Mark] is used in connection with [Applicant's Goods], consumers will understand [Applicant's Mark] as referring to [the Empire State Building] and that a connection with [the Empire State Building] will be presumed. *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1637 (rejecting applicant's argument that "Kate Middleton 'is not involved in the fashion industry, and there is no evidence that the public would perceive such a connection because she does not endorse any products'").

As discussed in great detail above, the well-documented fame and public recognition of the identity of the Empire State Building, including its interchangeable name and design, is so great that, when Applicant's Mark is used in connection with Applicant's Goods, a connection with the Empire State Building will be presumed. *See id.* (sufficient fame for presumption of connection based on vast media attention). That numerous well-known third parties across a wide variety of industries have sought licenses from Opposer to use the visual equivalent of the Empire State Building further supports a finding of requisite fame. *See Hornby v. TJX Companies Inc.*, 87 U.S.P.Q.2d 1411, 1425 (T.T.A.B. 2008). Applicant himself has admitted that the Empire State Building is a "famous" "international landmark." *See In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d at 1637 (applicant conceded general fame of Kate Middleton). Indeed, the fame of the Empire State Building is so great that Applicant's own "business plan" stated that his mark "must" resemble the Empire State Building. Opp. Ex. 3. The presumption here is even further supported by the wide range of

collateral goods for which the visual equivalent of the Empire State Building has been licensed. *See In re Urbano*, 51 U.S.P.Q.2d at 1780; *New York Yankees P'ship v. Evil Enters., Inc.*, Opp. No. 91192764, 2013 TTAB LEXIS 72, at *26-27 (T.T.A.B. Feb. 8, 2013).

Opposer has established all four elements of a false suggestion of a connection claim and Applicant's Mark thus should be refused registration under Section 2(a) of the Lanham Act.

CONCLUSION

For the foregoing reasons, the opposition should be sustained.

Dated: New York, New York
September 8, 2015

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Eric J. Shimanoff/
Eric J. Shimanoff
William M. Borchard
Mary L. Kevlin
Lindsay M. Rodman
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing OPPOSER'S BRIEF ON FINAL HEARING was served on Applicant's Attorney of Record on September 8, 2015 by First Class Mail, postage prepaid, addressed to:

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

Dated: New York, New York
September 8, 2015

/Lindsay M. Rodman/
Lindsay M. Rodman