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Filing date: **10/07/2015**

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

Proceeding	91204122
Party	Defendant Michael Liang
Correspondence Address	DAVID YAN LAW OFFICES OF DAVID YAN 136-20 38TH AVENUE, SUITE 11E FLUSHING, NY 11354-4232 UNITED STATES davidyanlawfirm@yahoo.com
Submission	Other Motions/Papers
Filer's Name	David Yan
Filer's e-mail	davidyanlawfirm@yahoo.com
Signature	/s/ David Yan
Date	10/07/2015
Attachments	Motion to Strike Opposer's Purorted Pretrial Disclosures_10-6-2015.pdf(16985 bytes ) Exhibit A_Opposer's Pretrial Disclosure & Certificate of Service.pdf(837157 bytes ) Exhiibt B_Pitney Bowes Stamp.pdf(189314 bytes ) Exhibit C_ttabvue-91204122-OPP-1.pdf(57962 bytes ) Exhibit D_Unregistered Mark.pdf(1692297 bytes ) Exhibit E_Picture of some image.pdf(362495 bytes )

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

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

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ESBT EMPIRE STATE BUILDING, L.L.C., :                   Opposition No.: 91204122  
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**MOTION TO STRIKE OPPOSER’S PURPORTED PRETRIAL DISCLOSURES**

*and*

**MOTION TO SUSPEND THE PROCEEDING PENDING THE DECISION  
ON THE APPLICANT’S MOTION TO  
STRIKE OPPOSER’S PURPORTED PRETRIAL DISCLOSURES**

NOW COMES the Applicant, MICHAEL LIANG, by and through his attorney, DAVID YAN, ESQ., and for his Motion to Strike Plaintiff/Opposer, ESBT EMPIRE STATE BUILDING, L.L.C.’s attempted late pretrial disclosures on grounds of timeliness and substance, states as follows:

1. On January 20, 2015, the Trademark Trial and Appeal Board (“TTAB”) denied the Opposer’s Motion for Summary Judgment and resumed the proceeding with the dates being reset for the Plaintiff/Opposer’s Pretrial Disclosures due on February 11, 2015 and the Plaintiff/Opposer’s trial period ended on March 28, 2015.

2. The TTAB ordered in its January 20, 2015 Order that “strict compliance with the Board’s deadlines is expected in the future”.

3. Plaintiff/Opposer failed to server its purported pretrial disclosures by the due day on February 11, 2015.

4. Applicant timely served his pretrial disclosures by April 12, 2015.

5. Plaintiff/Opposer’s “Certificate of Service” is not in conformity with the TTAB’s suggested format for a certificate of service by failing to state when Plaintiff/Opposer served the Plaintiff/Opposer’s pretrial disclosures “by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid . . . to” the Applicant’s counsel. The copy of the Plaintiff/Opposer’s purported pretrial disclosures (including the purported certificate of service) is annexed hereto as Exhibit A.

6. Plaintiff/Opposer claimed that it served its purported pretrial disclosures by “caus[ing] the foregoing *Opposer’s Pretrial Disclosures* . . . to be served on Applicant by causing a true and accurate copy thereof to be mailed to Applicant’s Attorney of Record . . . .” However, Plaintiff/Opposer does not have any proof of mailing to support its claim that it mailed its purported pretrial disclosures on February 11, 2015.

7. The envelope that Plaintiff/Opposer used to send its purported pretrial disclosures to the Applicant’s Attorney of Record dose not have any post mark that can support the Plaintiff/Opposer’s claim that it mailed its purported pretrial disclosures on February 11, 2015.

8. The stamp on the envelope that Plaintiff/Opposer used to send its purported pretrial disclosures to the Applicant’s Attorney of Record is not the postmark when the U.S. Post Office accepts the mail on the date of mailing. Instead, the said stamp is the “Pitney Bowes” stamp that cannot be used as the proof of the mailing. The copy of the said envelope bearing the Plaintiff/Opposer’s “Pitney Bowes” stamp is annexed hereto as Exhibit B.

9. The undersigned counsel for Applicant did not receive the Plaintiff/Opposer's purported pretrial disclosures until February 19, 2015, which is way out of the normal first class mail delivery period of time if the first class letter were accepted by the U.S. Post Office on February 11, 2015. Accordingly, Plaintiff/Opposer did not serve its purported pretrial disclosures on February 11, 2015, in violation of the TTAB's January 20, 2015 Order.

10. Applicant, *via his undersigned counsel*, made several inquiries about the proof of mailing that can corroborates the Plaintiff/Opposer's claim that it served its purported pretrial disclosures on February 11, 2015. Plaintiff/Opposer, however, has never produced such proof.

11. Plaintiff/Opposer, has never made any motion to extend the due day to serve its purported pretrial disclosures.

12. In the substance, Plaintiff/Opposer failed to disclose in its purported pretrial disclosure that it would rely upon its unregistered mark in its trial deposition and brief. Therefore, the trial deposition and brief that have relied upon its unregistered mark should be disregarded and not be considered.

13. In its late purported pretrial disclosures, Plaintiff/Opposer stated that its witnesses, Stacey-Ann Hosang, Thomas N. Keltner, Jr., and Crystal Persaud, would testify to the "History and background of Opposer's Empire State Building property located in New York City and its use and registration of Opposer's Empire State Building Mark (as defined in Paragraph 1 of the Notice of Opposition in this proceeding) . . . ." The copy of the Paragraph 1 of the Notice of Opposition is annexed hereto as Exhibit C.

14. The Paragraph 1 of Opposer's Notice of Opposition, however, does not contain the Opposer's mark relied upon by the Plaintiff/Opposer in its trial depositions and brief. Plaintiff/Opposer has thoroughly relied upon a mark in its trial depositions and brief that was not

disclosed in its purported pretrial disclosures. A copy of the mark relied upon by the Plaintiff/Opposer and Description of the Record are annexed hereto as Exhibit D.

15. Plaintiff/Opposer also relies upon a picture in its brief that was not disclosed in its purported pretrial disclosure. A copy of the picture in the page 18 of the Plaintiff/Opposer's brief is annexed hereto as Exhibit E.

16. Moreover, the Plaintiff/Opposer's witness, Crystal Persaud, did not have any personal knowledge about the picture described above in the Plaintiff/Opposer's trial deposition. Therefore, it cannot be used as any evidence to support the Plaintiff/Opposer's case.

17. Accordingly, the Plaintiff/Opposer's purported pretrial disclosures should be stricken as untimely because it was served well after the time period for the Plaintiff/Opposer's pretrial disclosures.

18. Further, the purported pretrial disclosures fail to comply with the requirements of Trademark Rule 2.121(e) and FRCP 26 because it fails to identify the substance of its witnesses' anticipated testimony, nor are any purported exhibits clearly identified.

19. Because the decision on the Applicant's Motion to Strike the Opposer's Purported Pretrial Disclosures will materially affect the TTAB's decision of the Plaintiff's opposition, Applicant, *via* his undersigned counsel, requests the TTAB suspend the proceeding pending the decision on the Applicant's Motion to Strike the Opposer's Purported Pretrial Disclosures.

**WHEREFORE**, for the foregoing reasons, Michael Liang, by and through his attorney, DAVID YAN, ESQ., prays that the TTAB strike Plaintiff/Opposer's purported pretrial disclosures and suspend the proceeding pending the decision on the Applicant's Motion to Strike the Opposer's Purported Pretrial Disclosures.

Dated: Flushing, New York  
October 6, 2015

Respectfully submitted,

/s/ David Yan/

David Yan, Esq.

*Attorney for Applicant / Defendant*

136-20 38<sup>th</sup> Avenue, Suite 11E

Flushing, New York 11354

Telephone: (718) 888-7788

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and complete copy of the foregoing *Motion to Strike Opposer's Purported Pretrial Disclosures* has been served on Opposer's Attorney of Record, Eric J. Shimanoff, Esq. Cowan Liebowitz, & Latman, P.C. by mailing said copy on October 7, 2015, *via* First Class Priority Mail, postage prepaid to: Opposer's Attorney of Record, Eric J. Shimanoff, Esq., Cowan Liebowitz, & Latman, P.C., located at 1133 Avenue of the Americas, New York, NY 10036-6799, Tel.: (212) 790-9200.

/s/ David Yan/

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David Yan

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

ESRT EMPIRE STATE BUILDING, L.L.C.,	X	
Opposer,	:	Opposition No. 91204122
v.	:	
MICHAEL LIANG,	:	
Applicant.	:	
	X	

**OPPOSER’S PRETRIAL DISCLOSURES PURSUANT TO 37 C.F.R. § 2.121(e)**

Pursuant to 37 C.F.R. § 2.121(e), Opposer ESRT Empire State Building, L.L.C.

(“Opposer”) hereby serves its Pretrial Disclosures in the above-captioned proceeding identifying the following witnesses from whom it intends to take testimony or may take testimony if the need arises:

1. Stacey-Ann Hosang  
Director of Brand Development and Public Relations  
Empire State Realty Trust, Inc.,  
350 Fifth Avenue, Concourse Suite 100  
60 East 42 Street  
New York, NY 10165  
(212)736-3100

Subjects – The following constitutes a general summary or list of the subjects on which Ms. Hosang is expected to testify:

- a. History and background of Opposer’s Empire State Building property located in New York City and its use and registration of Opposer’s Empire State Building

Marks (as defined in Paragraph 1 of the Notice of Opposition in this proceeding), including, without limitation, licensing, marketing, advertising, enforcement and promotion of Opposer's Empire State Building Marks, and other uses of such marks in connection with a broad range of goods and services on behalf of Opposer.

b. Fame and consumer recognition of Opposer's Empire State Building Marks.

c. The likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents – The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during Ms. Hosang's testimony:

a. Documents concerning Opposer's use of Opposer's Empire State Building Marks, including the licensing, marketing, advertising, enforcement and promotion Opposer's Empire State Building Marks, and the fame and consumer recognition of Opposer's Empire State Building Marks.

b. Articles using Opposer's Empire State Building Marks.

c. Internet websites using Opposer's Empire State Building Marks.

d. Documents concerning Opposer's registration and enforcement of Opposer's Empire State Building Marks.

e. Documents concerning the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and

Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark

2. Thomas N. Keltner, Jr.  
Executive Vice President & General Counsel  
Empire State Realty Trust, Inc.  
One Grand Central Place  
60 East 42 Street  
New York, NY 10165  
(212)736-3100

Subjects – The following constitutes a general summary or list of the subjects on which Mr. Keltner is expected to testify:

- a. History and background of Opposer's Empire State Building property located in New York City and its use and registration of Opposer's Empire State Building Marks, including, without limitation, licensing, marketing, advertising, enforcement and promotion of Opposer's Empire State Building Marks, and other uses of such marks in connection with a broad range of goods and services on behalf of Opposer.
- b. Fame and consumer recognition of Opposer's Empire State Building Marks.
- c. The likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents – The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during Mr. Keltner's testimony:

a. Documents concerning Opposer's use of Opposer's Empire State Building Marks, including the licensing, marketing, advertising, enforcement and promotion Opposer's Empire State Building Marks, and the fame and consumer recognition of Opposer's Empire State Building Marks.

b. Articles using Opposer's Empire State Building Marks.

c. Internet websites using Opposer's Empire State Building Marks.

d. Documents concerning Opposer's registration and enforcement of Opposer's Empire State Building Marks.

e. Documents concerning the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark

3. Crystal Persaud  
Empire State Realty Trust, Inc.  
Legal Counsel  
One Grand Central Place  
60 East 42 Street  
New York, NY 10165  
(212)736-3100

Subjects – The following constitutes a general summary or list of the subjects on which Ms. Persaud is expected to testify:

a. History and background of Opposer's Empire State Building property located in New York City and its use and registration of Opposer's Empire State Building Marks (as defined in Paragraph 1 of the Notice of Opposition in this proceeding), including, without limitation, licensing, marketing, advertising, enforcement and promotion of Opposer's

Empire State Building Marks, and other uses of such marks in connection with a broad range of goods and services on behalf of Opposer.

- b. Fame and consumer recognition of Opposer's Empire State Building Marks.
- c. The likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents – The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during Ms. Persaud's testimony:

- a. Documents concerning Opposer's use of Opposer's Empire State Building Marks, including the licensing, marketing, advertising, enforcement and promotion Opposer's Empire State Building Marks, and the fame and consumer recognition of Opposer's Empire State Building Marks.
- b. Articles using Opposer's Empire State Building Marks.
- c. Internet websites using Opposer's Empire State Building Marks.
- d. Documents concerning Opposer's registration and enforcement of Opposer's Empire State Building Marks.
- e. Documents concerning the use and/or intended use and/or proposed registration of Applicant's Mark and Applicant's intent to trade on the goodwill of Opposer and Opposer's Empire State Building Marks, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark

4. Unknown Representative of Sky Blue Web Design Studio  
15 7<sup>th</sup> Avenue South  
New York, NY 10014  
(917) 916-8802

Subjects – The following constitutes a general summary or list of the subjects on which a representative of Sky Blue Web Design Studio is expected to testify:

- a. The conception, selection, and adoption of Applicant's mark, including without limitation, the intended commercial impression created by the building design in Applicant's Mark.
- b. Knowledge of Opposer, Opposer's Empire State Building Marks and Opposer's Empire State Building property located in New York City.
- c. Knowledge of Applicant's business plan and market research performed by Applicant or by Sky Blue Web Design Studio on the commercial impression of Applicant's Mark.
- d. Draft design proposals for Applicant's Mark, particularly designs of buildings.
- e. Communications with Applicant concerning Applicant's Mark, Opposer, Opposer's Empire State Building Marks and Applicant's intended goods and services.
- f. Applicant's actual or bona fide intent to use Applicant's Mark in the U.S.
- g. Likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents – The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during the representative’s testimony:

a. Documents produced by Sky Blue Web Design Studio in connection with its testimony.

LLC

5. Celeste Beatty and/or Unknown Representative of Harlem Brewing Company,  
2 West 123rd Street  
New York, New York 10027  
(888) 559-6735

Subjects – The following constitutes a general summary or list of the subjects on which Celeste Beatty and/or Unknown Representative of Harlem Brewing Company, LLC is expected to testify:

a. Communications and meetings with Applicant about the licensing and use of Applicant’s Mark in the U.S. in connection with alcoholic beverages and/or distribution or brewing of alcoholic beverages through a partnership, joint venture or other entity that includes Harlem Brewing Company.

b. Knowledge of Applicant’s business plan and market research performed by Applicant on the commercial impression of Applicant’s Mark.

c. Communications and meetings with Applicant concerning Applicant’s Mark, Opposer, Opposer’s Empire State Building Marks and Applicant’s intended goods and services.

d. Applicant’s actual or bona fide intent to use Applicant’s Mark in the U.S.

e. Likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant’s

Mark, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents – The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of Celeste Beatty and/or Unknown Representative of Harlem Brewing Company, LLC:

- a. Documents produced by Harlem Brewing Company, LLC in connection with its testimony, including without limitation all communications between Applicant and Harlem Brewing Company, LLC.
- b. Documents concerning Applicant's actual or bona fide intent to use Applicant's Mark in the U.S.
- c. Documents concerning likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

6. Applicant Michael Liang  
55-25 98th Place, Apt. 3C  
Corona, New York 11368  
Phone number unknown

Subjects – The following constitutes a general summary or list of the subjects on which Mr. Liang is expected to testify:

- a. The alleged goods for which Applicant has used Applicant's Mark, or similar to or comprising of Applicant's Mark, anywhere in the world.
- b. The specific goods in which Applicant uses and/or intends to use Applicant's Mark in the United States.

- c. The reason for the conception, selection, and adoption of Applicant's Mark, including without limitation, the intended commercial impression created by the building design in Applicant's Mark.
- d. Knowledge of Opposer, Opposer's Empire State Building Marks, and Opposer's Empire State Building property located in New York City.
- e. Communications with Sky Blue Web Design Studio concerning Applicant's Mark, Opposer, Opposer's Empire State Building Marks and Applicant's intended goods and services.
- f. Applicant's market research concerning Applicant's Mark, Applicant's products or services, Opposer's Empire State Building Marks or any goods or services advertised, promoted, offered for sale, sold, licensed or rendered by Opposer.
- g. Applicant's actual or bona fide intent to use Applicant's Mark in the U.S.
- h. Applicant's actual or intended plans for licensing, promotion, advertising, marketing and distribution of products bearing the Applicant's Mark in the U.S.
- i. Applicant's actual or intended channels of trade.
- j. Likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

Documents -- The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during Mr. Liang's testimony:

- a. Documents produced by Applicant in discovery.
- b. Documents produced by Applicant in connection with his testimony.

c. Trademark Application Serial No. 85/213,453.

d. All documents submitted by Applicant or his counsel to the Board in these proceedings or to the USPTO during the examination of Trademark Application Serial No. 85/213,453.

e. All documents upon which Applicant intends to rely in defense of the Opposition.

f. Documents concerning Applicant's actual or bona fide intent to use Applicant's Mark in the U.S.

g. Documents concerning likelihood of confusion, dilution by blurring and false suggestion of a connection caused by the use and/or intended use and/or proposed registration of Applicant's Mark, and the resulting injury to Opposer from the use and/or intended use and/or proposed registration of Applicant's Mark.

7. Unknown past or present representative of Northstar Research Partners  
160 Varick Street, 3rd Floor  
New York, New York 10013  
(212) 986-4077

Subjects -- The following constitutes a general summary or list of the subjects on which an unknown past or present representative of Northstar Research Partners is expected to testify:

a. Consumer research surveys and reports concerning visitors to the EMPIRE STATE BUILDING Observatory.

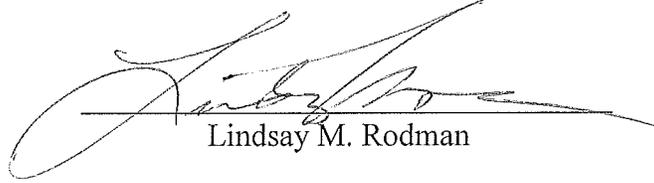
Documents -- The following constitutes a general summary or list of the types of documents and things which may be introduced as exhibits during Mr. Liang's testimony:

a. Documents concerning consumer research surveys and reports concerning visitors to the EMPIRE STATE BUILDING Observatory.

**CERTIFICATE OF SERVICE**

I hereby certify that, on February 11, 2015, I caused the foregoing *Opposer's Pretrial Disclosures Pursuant to 37 C.F.R. § 2.121(e)* to be served on Applicant by causing a true and accurate copy thereof to be mailed to Applicant's Attorney of Record, David Yan, Law Offices of David Yan, 136-20 38th Avenue, Suite 11E Flushing, New York 11354-4232.

Dated: New York, New York  
February 11, 2015



Lindsay M. Rodman

**COWAN  
LIEBOWITZ  
LATMAN**

Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036-6799

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



ESTTA Tracking number: **ESTTA459494**

Filing date: **03/01/2012**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Empire State Building Company L.L.C.
Granted to Date of previous extension	04/04/2012
Address	c/o Malkin Holdings, LLC 60 East 42nd St New York, NY 10165 UNITED STATES

Attorney information	Maya L. Tarr Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com, wmb@cll.com, mxt@cll.com Phone:212-790-9200
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**Applicant Information**

Application No	85213453	Publication date	12/06/2011
Opposition Filing Date	03/01/2012	Opposition Period Ends	04/04/2012
Applicant	Liang, Michael 55-25 98th Place, Apt. 3C Corona, NY 11368 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 032. All goods and services in the class are opposed, namely: Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration	2411972	Application Date	05/13/1999
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No.			
Registration Date	12/12/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		
Design Mark	<b>EMPIRE STATE BUILDING</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing		

U.S. Registration No.	2413667	Application Date	05/13/1999
Registration Date	12/19/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		
Design Mark	<b>EMPIRE STATE BUILDING</b>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE		

U.S. Registration No.	2429297	Application Date	05/13/1999
Registration Date	02/20/2001	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of	The mark consists of the shape of the exterior of a skyscraper with a pointed,		

Mark	spindled top.
Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE

U.S. Registration No.	2430828	Application Date	05/13/1999
Registration Date	02/27/2001	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
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Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top.
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Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 ENTERTAINMENT SERVICES, NAMELY, PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FOR PURPOSES OF SIGHTSEEING
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Attachments	75705741#TMSN.gif ( 1 page )( bytes ) 75705740#TMSN.gif ( 1 page )( bytes ) 75705772#TMSN.gif ( 1 page )( bytes ) 75705756#TMSN.gif ( 1 page )( bytes ) NYC BEER LAGER NOO.pdf ( 6 pages )(69284 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Maya L. Tarr/
Name	Maya L. Tarr
Date	03/01/2012



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”), as shown in intent to use Application Serial No. 85/213,453 (the “Application”), and having been granted extensions of time to oppose up to and including April 4, 2012, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since long prior to January 8, 2011, Applicant’s filing date and constructive first use date, Opposer, its predecessors, and its affiliated and related entities, and/or licensees have used the word mark EMPIRE STATE BUILDING and various marks depicting the visual equivalent of the world-renowned Empire State Building, which is located in New York City, including, without limitation, the following distinctive stylizations:



, alone or with other word, letter and/or design elements (“Opposer’s Empire State Building Marks”), in connection with entertainment services, real estate services and a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages.

2. Opposer owns U.S. federal registrations for Opposer’s Empire State Building Marks in International Classes 36 and 41, namely, Registration Nos. 2411972, 2413667, 2429297 and 2430828, which are all incontestable.

3. Since long prior to January 8, 2011, Applicant's constructive first use date, Opposer, its predecessors, and their affiliated and related entities, and/or licensees have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's Empire State Building Marks, including, but not limited to, entertainment services, real estate services and a wide variety of goods and services, including, but not limited to, restaurant services and alcoholic beverages, and have offered such goods and rendered such services in commerce.

4. Opposer has built up highly valuable goodwill in Opposer's Empire State Building Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

5. On January 8, 2011, Applicant filed the Application for Applicant's Mark for Applicant's Goods, based on an intent to use.

6. Upon information and belief, Applicant did not use Applicant's Mark in United States commerce for any of Applicant's Goods covered in the Application prior to its constructive first use date of January 8, 2011.

7. The description of Applicant's Mark in the Application indicates that "The mark consists of a building resembling the Empire State Building surrounded by three concentric circles." Moreover, the word elements of Applicant's Mark include only the descriptive or generic terms "NYC," "BEER," and "LAGER," which Applicant has disclaimed in the Application. Upon information and belief, Applicant intends to trade on the enormous good will of Opposer by using a design of the "Empire State Building" in combination with the geographic term "NYC," which is the abbreviation for New York City, in Applicant's Mark.

8. The dominant feature of Applicant's Mark is the image of the Empire State Building.

9. The goods covered by the Application are closely related to the goods offered and services rendered in connection with Opposer's Empire State Building Marks.

10. Applicant's Mark so resembles Opposer's Empire State Building Marks as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's Goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

11. Opposer's Empire State Building Marks are distinctive and famous and were so prior to January 8, 2011, Applicant's constructive first use date of Applicant's Mark for Applicant's Goods. Registration of Applicant's Mark will also injure Opposer by causing a likelihood of dilution by blurring of the distinctive quality of Opposer's Empire State Building Marks.

12. Applicant's Mark violates Section 2(a) of the Lanham Act in that it would falsely suggest a connection between Applicant and Opposer. More specifically, Applicant's Mark violates Section 2(a) of the Lanham Act because (a) Applicant's Mark contains as an important element of its mark a design of Opposer's famous Empire State Building previously used by Opposer; (b) Applicant's Mark would be recognized as being associated with the Empire State Building in that Applicant's Mark points uniquely and unmistakably to that building; (c) Opposer is not connected with the activities performed by Applicant under Applicant's Mark;

and (4) Opposer's identity is of sufficient fame or reputation that a connection with Opposer would be presumed when Applicant's Mark is used with Applicant's Goods.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding William M. Borchard, Mary L. Kevlin, and Maya L. Tarr (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York  
March 1, 2012

Respectfully submitted,

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

By: /Maya L. Tarr/

William M. Borchard  
Mary L. Kevlin  
Maya L. Tarr

1133 Avenue of the Americas  
New York, New York 10036  
(212)790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on March 1, 2012, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney of Record, David Yan, Esq., Law Offices of David Yan, 13620 38<sup>th</sup> Avenue Suite 11E, Flushing, New York 11354-4232.

/Maya L. Tarr/  
Maya L. Tarr

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<sup>®</sup> 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

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?

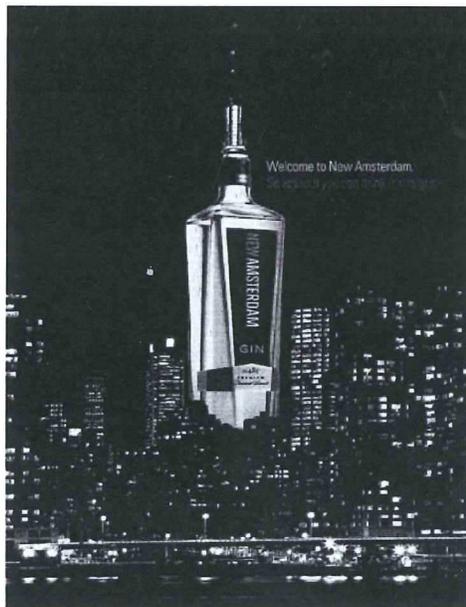
2. Does Applicant’s Mark so closely resemble Opposer’s EMPIRE STATE BUILDING Marks as to be likely, when applied to Applicant’s Goods, to cause a likelihood of dilution through blurring of the distinctive quality of Opposer’s EMPIRE STATE BUILDING Marks under Section 43(c) of the Lanham Act?

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.

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.