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

Proceeding	91204122
Party	Defendant Michael Liang
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PRELIMINARY STATEMENT

Applicant applied to register his Mark, Serial No. 85/213,453 on January 8, 2011. Empire State Building Company, L.L.C., the predecessor of ESRT Empire State Building, L.L.C., filed Notice of Opposition (opposition no. 91204122) against the Applicant's application for registration of Mark, Serial No. 85/213,453 on March 1, 2012, *solely* based on its U.S. federal registrations in International Classes 36 and 41, namely, Registration Nos. 2411972, 2413667, 2429297 and 2430828.

In its purported pretrial disclosures, 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 Paragraph 1 of Opposer's Notice of Opposition, however, does not contain the Opposer's mark relied upon by the Opposer in its trial depositions and brief. Opposer has thoroughly relied upon a mark in its trial depositions and brief that was not basis of its Notice of Opposition and was not disclosed in its purported pretrial disclosures.

DESCRIPTION OF THE RECORD

The evidence of record consists of the following:

1. Applicant's Notice of Reliance upon Official Records, dated May 27, 2015 and accompanying Exhibits A-C.
2. Testimony deposition transcript of Applicant Michael Liang, taken May 22, 2015 and accompanying Exhibits 7-8.
3. Testimony deposition transcript of Applicant's friend, Xuefeng Yang, taken May 22, 2015 and accompanying Exhibits 1-6.

STATEMENT OF ISSUES

1. Whether Opposer has waived its opposition based on its unregistered mark's prior use when Opposer failed to raise the opposition based on its unregistered mark's prior use and failed to disclose its unregistered mark's prior use in its purported pretrial disclosure?

2. Whether Opposer owns a family of marks depicting the visual equivalent of the Opposer's registered marks?

3. Whether Applicant's Mark, when applied to the Applicant's Goods, is likely to cause confusion, mistake or deceive as to their origin with Opposer's registered trademarks under Section 2(d) of the Lanham Act where the Applicant's Mark does not resemble the Opposer's registered marks and where the Applicant's Goods are totally distinctive from the Opposer's Goods stated in its registered trademarks?

4. Whether Applicant's Mark, when applied to Applicant's Goods, is likely to cause dilution under Section 43(c) of the Lanham Act where the Applicant's Mark does not resemble the Opposer's registered marks?

5. Whether Applicant's Mark falsely suggests a connection with Opposer under Section 2(a) of the Lanham Act where other third parties' use and reference to the Empire State Building do not suggest any connection with Opposer?

STATEMENT OF FACTS

The Empire State Building is famous only in the field of real estate as one of the skyscrapers in the City of New York. Opposer has failed to show that Opposer's EMPIRE STATE BUILDING Marks have become associated closely in the minds of the public with a variety of uses, goods and services, especially with the Applicant's goods and services. *See generally* Hosang Tr. and Persaud Tr.

The Opposer's witness, Crystal Persaud, did not have any personal knowledge about the picture described in the trial depositions of Stacey-Ann Hosang and Crystal Persaud. Persaud Tr. 77:22-79:13, 113:21-115:11. Moreover, Gin is not the same product of beer. *See id.* It is not relevant whether someone ever used the Opposer's mark in its sale of Gin. Furthermore, Opposer has failed to show that New Amsterdam Gin has continued to use something alleged to have connection to the Opposer's mark. Therefore, it is not relevant with respect to the Opposer's case. Although Opposer has had ample opportunity to provide evidence or testimony upon which the Board could base the conclusion that consumers would assume that New Amsterdam Gin and Empire State Building are offered by the same entity, Opposer has failed to do so.

At least during the time of the Opposer's filing of its Notice of Opposition until October 8, 2013, a mark (registration number 1247058) is valid and alive, which highly resembles the Opposer's registered Mark in its Mark. The mark was first used in commerce on March 27, 1968. The description of the mark shows that, "The mark shows a fanciful design of the Empire State Building surrounded by smaller buildings and envelopes and the letter 'N' and 'Y' in a rectangle."

ARGUMENT

I. OPPOSER HAS WAIVED ITS OPPOSITION BASED ON ITS UNREGISTERED MARK'S PRIOR USE

Opposer has failed to oppose the registration of the Applicant's Mark based on its unregistered stylizations depicting the visual equivalent of the Empire State Building. Opposer filed its Notice of Opposition against the Application on March 1, 2012. Opposer then amended its Notice of Opposition on June 28, 2014.

However, neither of the Opposer's initial Notice of Opposition nor its amended Notice of Opposition has ever mentioned the Opposer's basis of opposition as the prior use of its unregistered mark, although Opposer relied upon its opposition in its Brief of Final Hearing entirely on the said unregistered mark as shown in its Brief at pages 11, 12, 14, and 26.

Opposer has also 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.

In its pretrial disclosures, 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 Paragraph 1 of Opposer's Notice of Opposition, however, does not contain the Opposer's mark relied upon by the Opposer in its trial depositions and brief. Opposer has thoroughly relied upon a mark in its trial depositions and brief that was not disclosed in its purported pretrial disclosures.

At this late stage of the litigation, Opposer's use of its unregistered mark in supporting its Brief is highly prejudicial to Applicant.

II. OPPOSER DOES NOT OWN A FAMILY OF MARKS DEPICTING THE VISUAL EQUIVALENT OF THE OPPOSER'S REGISTERED MARKS

Opposer has never pled that it owns any family of marks depicting the visual equivalent of its registered marks. Hence, Opposer has waived such claim.

In the event Opposer claims in its reply brief that it owns such family of marks, the Opposer's contention shall be rejected by the Board. The "family" of marks doctrine has applicability in those situations where the Opposer had established a family of marks characterized by a particular feature, so that the Applicant's subsequent use of its mark containing the feature will cause the relevant purchasing public to assume that Applicant's mark is yet another member of the Opposer's family. *See Blansett Pharmaceutical Co. Inc. v. Camrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977). It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar goods or related goods or services is insufficient to establish, as against an applicant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to the opposer's first use of its challenged mark, the various marks said to constitute the family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); *Cambridge Filter Corp. v. Sensodyne Corp.*, 189 USPQ 99 (TTAB 1975).

In the instant case, there is insufficient evidence relating to Opposer's use and advertising of its marks together such that the Board can conclude that the relevant purchasing public has

come to identify Empire State Building marks as the “surname” of a family of marks. The mere fact that Opposer uses marks that depicts the visual equivalent of the Empire State Building does not in itself prove that a family of marks exists. Thus, at least on the record before the Board, Opposer has failed to establish purchaser recognition of a family of marks owned by it.

III. APPLICANT’S MARK, WHEN APPLIED TO THE APPLICANT’S GOODS, IS NOT LIKELY TO CAUSE CONFUSION, MISTAKE OR DECEIVE AS TO THEIR ORIGIN WITH OPPOSER’S REGISTERED TRADEMARKS

The issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Although that the substantial marking, licensing, and advertising by opposer of its registered Marks and the many years Opposer’s continuous use of such marks for a variety of services in connection with its registration could establish the fame of the mark, its fame is largely limited in its registered goods or services, such as real estate services or management or leasing of real estate as well as entertainment services, such as providing observation decks in a skyscraper for purposes of sightseeing.

When Opposer waived its opposition based on its unregistered mark discussed in Section I above, Opposer failed to submit sufficient record before the Board that the Applicant’s Mark and the Opposer’s registered marks, when considered in their entirety, are not similar in

appearance, connotation or commercial impression and that Opposer's goods are not commercially related to the goods and services set forth in Applicant's application such that the use of the Applicant's Mark in connection with the respective goods and services would be likely to cause confusion.

Obviously, the Applicant's Mark and Opposer's registered markers are not similar to each other when each mark is considered in its entirety. The logo design of each mark is different. Moreover, the Applicant's Mark connotes life style of having beer or larger in metropolitan areas, such as NYC or New York City. On the contrary, the Opposer's registered marks connote nothing but buildings or skyscraper.

The differences in the marks' connotation clearly and significantly weighs against a finding that the marks are confusingly similar. *See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998).

Regarding the parties' goods and services, even *assuming arguendo* that Applicant's goods are sold in all the normal channels of trade to all of the usual purchasers, nonetheless, Opposer has failed to submit any evidence or testimony upon which the Board can conclude that consumers would assume that the Opposer's registered marks for skyscraper, on the one hand, and the Applicant's Mark for beer and lager, on the other hand, are offered by the same entity. Simply because Applicant's goods may be used in Opposer's goods is not a sufficient basis to find that the goods are related. Opposer's goods are services in connection with the skyscraper, which Applicant's goods are drinks of beer and lager. There is no evidence that these kinds of goods commonly emanate from the same sources.

The only overlapping trade channel for Opposer's goods and applicant's services is the Internet. However, inasmuch as thousands of goods and services are offered through the

Internet, the mere fact that both opposer's goods and applicant's services are offered through the Internet to ordinary consumers is certainly not a basis to find that they are related within the meaning of the Trademark Act. Simply put, Opposer has the burden of proving that its goods and services set forth in Applicant's application are related, but Opposer has not met this burden. Therefore, the *DuPont factor* favors Applicant.

IV. APPLICANT'S MARK, WHEN APPLIED TO THE APPLICANT'S GOODS, IS NOT LIKELY TO CAUSE DILUTION BECAUSE THE APPLICANT'S MARK DOES NOT RESEMBLE THE OPPOSER'S REGISTERED MARK

As stated the above, the Applicant's Mark does not resemble the Opposer's registered mark and the Applicant's Goods are totally distinctive from the Opposer's Goods stated in its registered marks. Opposer's conclusory allegations is insufficient to state a claim of dilution under the Federal Trademark Dilution Act. 15 U.S.C. § 1125(c).

Registration and use of a mark (registration number 1247058), which highly resembles the Opposer's registered Mark in its Mark, on March 27, 1968 has cut into the chest of the Opposer's claim that its marks became famous in connection with its goods and services prior to a third party's use of its mark. The description of the mark (registration number 1247058) shows that, "The mark shows a fanciful design of the Empire State Building surrounded by smaller buildings and envelopes and the letter 'N' and 'Y' in a rectangle." Hence, Opposer has failed to meet its burden of proof that its marks were ever diluted.

With respect to its unregistered mark, the FTDA created a new federal cause of action to protect "famous" trademarks through amendment of Section 43 of the Lanham Act, but also provided that "ownership by a person of valid registration," is "a "complete bar" to any action brought under "common law or a statute of a State and that seeks to prevent dilution of the

distinctiveness of a mark, label, or form of advertisement.” 15 U.S.C § 1125(c), repealed byu the TDRA in 2006.

V. APPLICANT’S MARK DOES NOT FALSELY SUGGEST A CONNECTION WITH THE OPPOSER’S REGISTERED MARK

Opposer has failed to meet its burden to establish four elements of a false suggestion of a connection claim since the marks are not similar to each other.

CONCLUSION

For the foregoing reasons, the Opposition shall be denied.

Dated: Flushing, New York
November 2, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and complete copy of the foregoing *Applicant's Trial Brief* has been served on Opposer's Attorney of Record, Eric J. Shimanoff, Esq. Cowan Liebowitz, & Latman, P.C. by mailing said copy on November 2, 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/

David Yan