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

Proceeding	91204122
Party	Plaintiff Empire State Building Company L.L.C.
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Date	11/23/2015
Attachments	NYC BEER Reply Brief.pdf(2340250 bytes)

Attorney Ref. No. 22690.013 TRADEMARK

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., Opposer,	Opposition No. 91189692
v.	
MICHAEL LIANG, Applicant.	

OPPOSER'S REPLY
BRIEF ON FINAL HEARING

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22690/013/1823061

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PRELIMINARY STATEMENT

In its trial brief, Opposer established that Applicant's Mark, which incorporates in whole and is nearly identical to Opposer's EMPIRE STATE BUILDING Marks, should be refused registration because Applicant's Mark is likely to cause consumer confusion under Section 2(d) of the Lanham Act, is likely to dilute to the distinctive quality of Opposer's marks under Section 43(c) of the Lanham Act and falsely suggests a connection with the Empire State Building under Section 2(a) of the Lanham Act. Applicant's responsive brief does nothing to rebut those claims. On the contrary, consistent with his admissions during trial, Applicant concedes that Opposer's marks are "famous," including for observatory and real estate services at the world-renowned and iconic Empire State Building in New York City. Nor does Applicant deny, consistent with his admission in his own application, that his mark was designed to resemble, and does resemble, the Empire State Building.

Applicant's argument that Opposer is precluded from relying on the stylization of Opposer's building design mark literally copied by Applicant is unfounded. Applicant's objection is a desperate (but futile) attempt to mitigate Applicant's counsel failure without explanation to attend the deposition where most of the evidence concerning the use of this stylization was introduced and to extend further Applicant's already extended time period in which to submit arguments in opposition to Opposer's claims. Opposer's notice of opposition covers the stylization literally copied by Applicant, and the representative samples therein, including Opposer's registered mark, are nearly identical to the stylization Applicant copied.

Moreover, Applicant did not object during trial to the extensive testimony and documents concerning Opposer's use of this stylization. In fact, Applicant extensively questioned his own witnesses about this stylization and any confusion or similarity with Applicant's Mark. And

counsel for the parties had an in-depth discussion about this stylization and Applicant's copying thereof weeks prior to the trial depositions of Opposer's witnesses. Applicant hardly can claim any surprise by Opposer's reliance on the stylization Applicant literally copied when creating his own logo. To the extent necessary, the Board may deem the pleadings amended to include this stylization as an issue tried by implied consent.

Even assuming, *arguendo*, that Opposer were precluded from relying on this specific stylization to show common law trademark rights therein, because this stylization is nearly identical to Opposer's registered mark and another example in the notice of opposition, the conclusion that Applicant's Mark is likely to cause confusion and dilution and falsely suggests a connection with the Empire State Building remains incontrovertible. Applicant's own application admitted that the building design in Applicant's Mark, which design is the only distinctive element of the logo, "resembles the Empire State Building." Moreover, the challenged common law stylization may be used to show Applicant's intent to copy and to cause an association with Opposer's marks and the Empire State Building, as well as to establish the identity of the Empire State Building for Opposer's false suggestion claim, which does not require that Opposer establish trademark rights.

Finally, Applicant's reliance on one now-expired third party registration, without any evidence concerning the use of the mark therein, is misplaced. This sole registration does not diminish the strength or fame of Opposer's marks or the likelihood of confusion and dilution or false suggestion of a connection.

As set forth in greater detail herein, and in Opposer's opening brief, the Board should sustain the opposition on all three grounds.

ARGUMENT

I. OPPOSER MAY RELY UPON THE SPECIFIC STYLIZATION OF ITS MARK LITERALLY COPIED BY APPLICANT

Applicant argues that Opposer should be precluded from relying on its common law rights in the following stylization of Opposer's mark depicting the visual equivalent of the Empire State Building:

Applicant claims that this precise stylization was not disclosed in Opposer's notice of opposition. As set forth in detail in Opposer's opening trial brief, this is the exact stylization of Opposer's mark Applicant ***literally copied*** when creating his own logo:

Opposer's Mark	Building in Applicant's Mark

Applicant's evidentiary objection is without merit since the stylization was covered by Opposer's notice of opposition and also was tried by implied consent.

A. Opposer's Notice of Opposition Covers the Stylization of Opposer's Mark Literally Copied by Applicant

Paragraph 1 of the notice of opposition clearly asserts Opposer's reliance on its common law marks, including those "depicting the visual equivalent of the world-renowned Empire State Building, which is located in New York City." The specific stylization about which Applicant objects depicts the visual equivalent of the Empire State Building, precisely as defined in the notice of opposition. This is not an instance where a notice of opposition wholly omits a mark or sets forth only a partial definition of a mark. The definition of Opposer's marks here — EMPIRE STATE BUILDING and the visual equivalent of the Empire State Building, which themselves are legal equivalents — is clear and the challenged stylization squarely falls therein.

Moreover, the stylization Applicant claims was unpleaded (below left) is nearly identical to Opposer's registered design mark and another common law stylization explicitly reproduced in the notice of opposition (below right):

Combined with the above definition, these examples provided Applicant with clear notice of Opposer's claims. Applicant's evidentiary objection thus is without merit.

B. The Stylization of Opposer's Mark Literally Copied by Applicant Was Tried by Implied Consent

To the extent the Board finds that Opposer has not adequately pleaded the stylization of Opposer's mark literally copied by Applicant, the Board should deem the notice of opposition amended to incorporate the stylization as an issue tried by implied consent. *See* Fed. R. Civ. P. 15(b)(2) ("When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings"); 37 C.F.R. § 2.107.

Implied consent to the trial of an unpleaded issue will be found where the non-offering party (1) raised no objection to the introduction of evidence on the issue and (2) was fairly apprised that the evidence was being offered in support of the issue. *See* T.B.M.P. § 507.03(b). Thus, in *Nestle Prepared Foods Co. v. V & V Enters.*, although the opposer's notice of opposition referred only to its HOT POCKETS and "related 'POCKETS' marks" (all of which were defined as "Opposer's HOT POCKETS Marks"), the Board deemed the pleadings amended by implied consent to include the marks LEAN POCKETS and CROISSANT POCKETS where:

> (1) "At trial, opposer clearly asserted its use of the marks HOT POCKETS, LEAN POCKETS and CROISSANT POCKETS in connection with stuffed sandwiches;"
>
> (2) "During opposer's testimony, applicant did not object to testimony about such use and in fact conducted cross-examination on these marks;" and
>
> (3) Well after the trial periods closed, for the first time in its trial brief, the applicant objected to the opposer's introduction of and reliance on these marks.

Opp. No. 91167465, 2011 TTAB LEXIS 68, at *4-9 (T.T.A.B. Mar. 10, 2011). Similarly, in *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana, Inc.*, the Board deemed the pleadings amended by implied consent to include unpleaded marks where the petitioner "emphasized its intention to rely on those marks through the testimony depositions of Jorge Malfavon and Rigoberto Fernandez," "[d]uring the depositions, respondent did not object to that

testimony and it had the opportunity to cross-examine the witnesses" and "in a separate deposition during its own testimony period, respondent deposed Mr. Fernandez regarding the use of those marks." 98 U.S.P.Q.2d 1921, 1924-26 (T.T.A.B. 2011).

The facts here fall squarely within this precedent.

Applicant did not propound any discovery requests of his own or take any discovery depositions. Shimanoff Decl. ¶ 2. Applicant did not comply with his own discovery obligations until compelled and later sanctioned by the Board (Dkt. ## 16, 23).

Opposer's pretrial disclosures clearly state that Opposer's corporate witnesses Stacey-Ann Hosang, ESB's Public Relations Manager, and Crystal Persaud, ESB's Legal Counsel, would testify about and introduce documents concerning the use of "Opposer's Empire State Building Marks (as defined in Paragraph 1 of the Notice of Opposition in this proceeding)," which include its "marks depicting the visual equivalent of the world-renowned Empire State Building, which is located in New York City." *See* Shimanoff Decl. Ex. A.[1]

At trial, Opposer introduced substantial testimony and exhibits concerning the stylized version of Opposer's building design mark literally copied by Applicant. One such exhibit was Opposer's Exhibit 5, which was introduced during Opposer's trial deposition of Applicant, taken March 13, 2015. Applicant did not object to the introduction of this exhibit at his deposition. Moreover, the undersigned counsel for Opposer and counsel for Applicant extensively discussed this stylized version of Opposer's mark, and Applicant's blatant copying thereof, immediately

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[1] Contrary to Applicant's position in its motion to strike (Dkt. # 56), Opposer was not required to list in its pretrial disclosures every document upon which it intended to rely at trial. *See* C.F.R. § 2.121(e); T.B.M.P. § 702.011; *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 U.S.P.Q.2d 1370, 1371 (T.T.A.B. 2011).

following Applicant's trial deposition. Applicant himself was present for most of this discussion. Shimanoff Decl. ¶¶ 3-4.

Two weeks later, on March 25, 2015, Opposer introduced substantial evidence concerning ESB's use of this stylization at the trial deposition of Ms. Hosang, including through the witness's testimony and Opposer's Exhibits 9, 10, 15, 16, 19, 24 & 26. Despite having received adequate notice, *see* Opp. Ex. 40, without any explanation, neither Applicant nor his counsel attended Ms. Hosang's deposition. Nor did Applicant seek to depose Ms. Hosang during his own testimony period. Shimanoff Decl. ¶¶ 5-6.

Opposer introduced further evidence concerning use of this stylization the next day at the trial deposition of Ms. Persaud, including through the witness's testimony and previously-introduced Opposer's Exhibits 9, 15, 16 & 19. Since Applicant's counsel failed to attend the previous day's deposition of Ms. Hosang, Opposer's counsel provided Applicant's counsel with copies of Opposer's Exhibits 6 through 62, introduced at the deposition of Ms. Hosang, on this date. Shimanoff Decl. ¶ 7. Although Applicant's counsel arrived an hour late to Ms. Persaud's trial deposition, Shimanoff Decl. ¶ 8, he had adequate opportunity to cross-examine, and did cross-examine, Ms. Persaud for several hours, including about this specific stylization. *See, e.g.*, Persaud Tr. 205:13-215:19.

Opposer timely served on Applicant copies of Ms. Hosang's and Ms. Persaud's deposition transcripts and exhibits pursuant to 37 C.F.R. § 2.125(a). Shimanoff Decl. ¶ 9.[2]

At no time during Opposer's testimony depositions or the parties' trial periods did Applicant object to Opposer's introduction of evidence concerning this stylization on the basis it

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[2] Applicant did not timely serve copies of his own trial depositions. *See* Dkt. # 57 (Opp. Resp. to App. Mot. to Strike, Shimanoff Decl. ¶ 11 & Ex. D).

allegedly was not pleaded. Shimanoff Decl. ¶ 10. In fact, Applicant himself relied on this stylization in Applicant's Exhibit 5 and Applicant extensively questioned his own witnesses about this stylization and its similarity to and likely confusion with Applicant's Mark during his testimony period. *See, e.g.*, Yang Tr. 20:25-22-11, 24:5- 25:2, 25:25-27:11; Liang Tr. (5/22/15) 16:3- 19:7, 20:11- 22:5.

Applicant first objected to the introduction of this stylization in his motion to strike (Dkt. # 56), filed on October 7, 2015, two days before his trial brief originally was due and months after the parties' trial testimony period closed. Applicant did not file his trial brief by his deadline of October 9, 2015. On October 16, 2015, the Board denied Applicant's motion to strike, deferred the evidentiary issues raised therein until final decision and, to avoid any potential schedule confusion, reset Applicant's deadline to file his trial brief to October 20, 2015 (Dkt. # 58). On October 20, 2015, the extended date Applicant's trial brief was due, Applicant did not file a brief and instead moved to extend the deadline even further, until November 17, 2015 (Dkt. # 61). On October 21, after a teleconference with the Interlocutory Attorney, during which the Interlocutory Attorney admonished Applicant's counsel for consistently failing to comply with deadlines, the Board granted Applicant a final extension of time, until November 2, 2015, to file his trial brief (Dkt. # 62).

Based on the foregoing, it is undeniable that Applicant was fairly apprised that Opposer would rely upon its common law rights in the challenged stylization and that Applicant raised no objection thereto during trial. Indeed, Applicant hardly can claim any surprise to Opposer's reliance on the stylization Applicant literally copied when creating his own logo. To the extent necessary, the Board should deem the pleadings amended to include this stylization as an issue tried by implied consent.

II. OPPOSER'S CLAIMS SUCCEED EVEN WITHOUT RELIANCE ON ITS RIGHTS IN THE SPECIFIC STYLIZATION LITERALLY COPIED BY APPLICANT

Even assuming, *arguendo*, Opposer is precluded from relying on its common law rights in the specific stylization literally copied by Applicant, it would not alter the conclusion that Applicant's Mark is likely to cause confusion and dilution with Opposer's mark and falsely suggests a connection with the Empire State Building, as set forth in Opposer's trial brief.

Essentially conceding that Opposer's common law stylization literally copied by Applicant is nearly identical to Applicant's Mark, Applicant futilely argues that Applicant's Mark is not confusingly similar to Opposer's registered mark. But Opposer's registered design mark is nearly identical to its challenged common law stylization and thus is highly similar to Applicant's Mark for the same reasons discussed in Opposer's trial brief and as shown below:

Opposer's Registered Mark

Applicant's Mark

The only distinct element of Applicant's Mark is the copied image of the Empire State Building, made the focus of the logo by its central placement and surrounding circles, as if framed by a telescopic lens. This element is nearly identical to Opposer's registered design mark. Applicant himself admitted, including in his own application, that the building design in his mark resembles and is similar to the design of the Empire State Building. The high degree of similarity between the parties' marks is irrefutable.

Applicant's argument that beer and gin are not related is contrary to well-settled precedent set forth in Opposer's trial brief. Nonetheless, "[i]t is not necessary that the parties' goods be the same or even competitive to support a finding of likelihood of confusion. It is sufficient if the goods are related in some manner or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that the goods come from or are associated with the same source." *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 U.S.P.Q.2d 1816, 1825 (T.T.A.B. 2015). Given the admitted fame of Opposer's marks, the use of Opposer's marks in connection with a wide variety of goods and services — including alcoholic beverages and goods related thereto — that restaurant tenants in the Empire State

Building serve alcoholic beverages and the high degree of similarity between the parties' marks, when sold in conjunction with Applicant's Mark, Applicant's goods are of the type that consumers would expect to originate from or be licensed by or endorsed by Opposer. *See id.* at 1825-28. Thus, the similarity of the goods factor strongly favors a finding of likely confusion. Moreover, any differences between the parties' goods and services are immaterial to Opposer's dilution claim and do not alter the false suggestion analysis.

Additionally, even if Opposer cannot rely upon the precise stylization copied by Applicant to show Opposer's common law rights therein, testimony and documents concerning this stylization still may be used, in conjunction with voluminous other evidence, to show: (1) Applicant's intent to create a logo nearly identical to and an association with Opposer's marks and the Empire State Building, *cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 U.S.P.Q.2d 1234, 1236 (T.T.A.B. 2014) ("unpleaded registration . . . may be considered for 'whatever probative value' it may lend to opposer's showing under the *du Pont* factors") and (2) the identity of the Empire State Building for purposes of Opposer's Section 2(a) false suggestion claim, which does not require a showing of trademark rights. *See In re Urbano*, 51 U.S.P.Q.2d 1776, 1778-79 (T.T.A.B. 1999).[3]

III. APPLICANT'S RELIANCE ON EXPIRED THIRD PARTY REGISTRATION NO. 1247058 IN OPPOSITION TO OPPOSER'S DILUTION CLAIM IS MISPLACED

Applicant argues that the mere existence of now-expired third party U.S. Registration No. 1247058 precludes a finding that Opposer's marks were famous for dilution purposes by Applicant's filing date, January 8, 2011. Applicant's argument is wholly flawed.

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[3] Applicant's arguments concerning the family of marks doctrine are inapposite since Opposer has not relied on that doctrine.

First, there is no evidence on the record concerning the *use* of the mark depicted in U.S. Registration No. 1247058. As such, the registration has no probative value. *See Carl Karcher Enters.*, 35 U.S.P.Q.2d at 1130-31.

Moreover, although third party use is not an enumerated statutory factor when determining whether Opposer's marks are famous for dilution purposes, *see* 15 U.S.C. § 1125(c)(2)(A), one third party registration covering envelopes would be insufficient to rebut Opposer's showing of fame here. As discussed in great detail in Opposer's opening brief, by January 8, 2011, Opposer's 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. Applicant himself admits throughout his trial brief and testimony that Opposer's marks are famous and Applicant's own business plan, purportedly created prior to his application filing date, admits that the Empire State Building is an "international landmark." Nor would a single registration show that Opposer has not engaged in "substantially exclusive use" of its marks for purposes of dilution by blurring under 15 U.S.C. § 1125(c)(2)(B)(iii). *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 1889 (T.T.A.B. 2011) ("while opposer's use of the MOTOWN mark is not entirely exclusive, it is substantially exclusive").[4]

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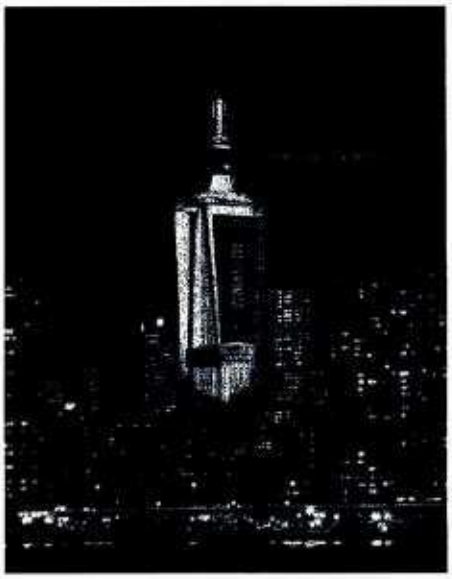
[4] Applicant's reliance on 15 U.S.C. § 1125(c)(6) is misplaced since Applicant is *not* the owner of U.S. Registration No. 1247058. *See* 15 U.S.C. § 1125(c)(6) ("ownership by a person of a valid registration . . . shall be a complete bar to an action *against that person* . . .") (emphasis added).

IV. OPPOSER MAY RELY UPON DOCUMENTS CONCERNING THE LICENSING OF ITS MARKS FOR USE IN CONNECTION WITH THE MARKETING AND SALE OF GIN

In his motion to strike (Dkt. # 56), Applicant argues that the Board should not consider the below photograph of Opposer's licensed use of its marks in connection with gin that appears in Opposer's Exhibit 78 on the ground that such photograph was not specifically listed in Opposer's pretrial disclosures:



This argument has no merit.

37 C.F.R. § 2.121(e) requires only that a party disclose "a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness." "[T]he Board does ***not*** require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial." T.B.M.P. § 702.01 (emphasis added). Opposer's pretrial disclosures clearly stated that each of its corporate witnesses would testify about and introduce documents concerning the "licensing" and "use" of Opposer's marks. Shimanoff Decl. Ex. A. Opposer's Exhibit 78, which contains licenses for use of the marks in connection with gin, including the above photograph, clearly falls within the disclosure.

Moreover, contrary to Applicant's assertion in his trial brief, Opposer's witness, Ms. Persaud, testified in both her corporate capacity and about her personal knowledge regarding these gin licenses and the related advertisement, including the fact that she personally has seen in the marketplace the use of the licensed image depicted in the advertisement. Persaud Tr. 77:19-80:02, 103:14-115:11, 224:18-232:02.

CONCLUSION

For the foregoing reasons, as well as those set forth in Opposer's opening trial brief, the opposition should be sustained.

Dated: New York, New York
November 23, 2015

COWAN, LIEBOWITZ & LATMAN, P.C.
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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., Opposer, v. MICHAEL LIANG, Applicant.	Opposition No. 91189692

DECLARATION OF ERIC J. SHIMANOFF, ESQ.
IN OPPOSITION TO APPLICANT'S REQUEST TO
PRECLUDE OPPOSER'S RELIANCE ON THE COMMON LAW
STYLIZATION OF ITS MARK LITERALLY COPIED BY APPLICANT

ERIC J. SHIMANOFF, pursuant to 28 U.S.C. §1746, declares:

1. I am an attorney with Cowan, Liebowitz & Latman, P.C., attorneys for Opposer. I submit this declaration in opposition to Applicant's request to preclude Opposer's reliance on a specific common law stylization of its mark depicting the visual equivalent of the Empire State Building, which stylization Applicant literally copied when making his own mark. I make this declaration based on my personal knowledge and/or review of my firm's files and records, and if called as a witness am competent to testify to the matters herein.

2. Applicant did not propound any discovery requests or take any discovery depositions during these opposition proceedings.

3. On March 13, 2015, during Opposer's trial deposition of Applicant, Opposer introduced into evidence and questioned Applicant about Opposer's Exhibit 5, which replicated the below stylization of Opposer's mark depicting the visual equivalent of the Empire State Building:

4. Immediately following the deposition, I had an extensive discussion with counsel for Applicant concerning the above stylization of Opposer's building mark and Applicant's copying thereof. Applicant himself was present for most of this discussion.

5. These events occurred approximately two weeks before the trial depositions of Opposer's corporate witnesses, Stacey-Ann Hosang, ESB's Public Relations Manager, and Crystal Persaud, ESB's Legal Counsel, during which depositions Opposer introduced extensive testimony and documents concerning this stylization.

6. Despite having received adequate notice, *see* Opp. Ex. 40, without any explanation, neither Applicant nor his counsel attended Ms. Hosang's trial deposition, taken March 26, 2015. Applicant did not seek to depose Ms. Hosang during his own testimony period.

7. Since Applicant's counsel failed to attend the trial deposition of Ms. Hosang, I provided Applicant's counsel with copies of Opposer's Exhibits 6 through 62, introduced at the

deposition of Ms. Hosang, the next day at the trial deposition of Ms. Persaud, taken March 27, 2015.

8. Without explanation, Applicant's counsel arrived an hour late to Ms. Persaud's trial deposition. Applicant's counsel still had adequate opportunity to cross-examine, and did cross-examine, Ms. Persaud for several hours, including about this specific stylization.

9. On April 16, 2015, Opposer timely served on Applicant copies of the trial deposition transcripts of its corporate witnesses, Ms. Hosang and Ms. Persaud, with accompanying exhibits, pursuant to 37 C.F.R. § 2.125(a).

10. At no time during Opposer's testimony depositions or the parties' trial periods did Applicant object to Opposer's introduction of evidence concerning this stylization on the basis it allegedly was not pleaded.

11. Applicant himself relied on this stylization in Applicant's Exhibit 5 and, during his own testimony period, Applicant extensively questioned his own witnesses about this stylization and its similarity to and likely confusion with Applicant's Mark.

12. Attached hereto as **Exhibit A** is a true and correct copy of Opposer's pre-trial disclosures, timely served on Applicant on February 11, 2015.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON NOVEMBER 23, 2015 AT NEW YORK, NEW YORK.

ERIC J. SHIMANOFF

EXHIBIT A

Ref. No. 22690.013

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., Opposer,	Opposition No. 91204122
v.	
MICHAEL LIANG, Applicant.	

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 7th 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.

5. Celeste Beatty and/or Unknown Representative of Harlem Brewing Company, LLC

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.

b. Documents produced by unknown past or present representative of Northstar Research Partners in connection with their testimony.

Dated: New York, New York
February 11, 2015

Respectfully submitted,

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

By: _____
William M. Borchard
Mary L. Kevlin
Eric J. Shimanoff
Lindsay M. Rodman

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

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

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing OPPOSER'S REPLY BRIEF ON FINAL HEARING with accompanying DECLARATION OF ERIC J. SHIMANOFF, ESQ., was served on Applicant's Attorney of Record on November 23, 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
November 23, 2015

/Lindsay M. Rodman/
Lindsay M. Rodman