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

Proceeding	91204897
Party	Defendant Laguna Lakes Community Association, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

John Gerard Marino,)	
)	
Opposer,)	Opposition No. 91/204,897
)	Opposition No. 91/201,941
)	
v.)	APPLICANT'S TRIAL BRIEF
)	
Laguna Lakes Community Association,)	
Inc.,)	
)	
Applicant.)	

Now comes Applicant, Laguna Lakes Community Association, Inc., by and through the undersigned counsel, and hereby submits its final Trial Brief to the Trademark Trial and Appeal Board with respect to the above-referenced, previously consolidated opposition proceedings.

Respectfully submitted,

Dated: September 18, 2015

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DESCRIPTION OF THE RECORD¹

Marino failed to include a description of the record as required by 37 CFR §2.128(b), and thus waives any objection to LLCA's following description of the record²:

- Applicant's trademark application files [Application Serial Nos. 85/411,955 and 85/414,343];
- The previously-filed trial testimony of Opposer, John Gerard Marino ("Opposer") (including all exhibits thereto) (*see* 62 TTABVUE) (hereafter "10/8/14 Marino Trial Tr.");
- The discovery deposition of Opposer taken on August 22, 2013 (including exhibits) (*see* Ex. A to Applicant's Notice of Reliance, filed under 70 TTABVUE) (hereafter "8/22/13 Marino Depo. Tr.");
- The discovery deposition of Robert Hajicek, as one of Applicant's 30(b)(6) representatives, taken on March 3, 2014 (including all exhibits thereto) (*see* 63 TTABVUE) (hereafter "3/3/14 Hajicek Depo. Tr.");
- The discovery deposition of Robert Hajicek, as one of Applicant's officers, taken on August 23, 2013 (*see* 63 TTABVUE) (hereafter "8/23/13 Hajicek Depo. Tr.");
- The discovery deposition of Patrick Tardiff, one of Applicant's officers and 30(b)(6) representatives, taken on August 23, 2013 (including all exhibits thereto) (*see* 63 TTABVUE and Ex. B to Applicant's Notice of Reliance (affixing Exhibit B to the 8/23/13 Tardiff Depo. Tr.) (hereafter "8/23/13 Tardiff Depo. Tr.");
- Notice of Opposition to Application Serial No. 85/411,955 filed by Opposer in Opposition Proceeding No. 91/204,897 to the extent it is a self-authenticating "official record" that contains admissible party-opponent statements and statements against interest (*see* Ex. C to Applicant's Notice of Reliance);
- Notice of Opposition to Application Serial No. 85/414,343 filed by Opposer in Opposition Proceeding No. 91/204,941 to the extent it is a self-authenticating "official record" that contains admissible party-opponent statements and statements against interest (*see* Ex. D to Applicant's Notice of Reliance);

¹ *See generally* Applicant's Notice of Reliance [69 TTABVUE].

² *See* TBMP § 707.03(c) (providing that objections must be provided with the objecting party's trial brief); *see also Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objection raised at trial waived when petitioner waited until its reply brief to renew objections). In this case, Marino did not make any objections to Applicant's Notice of Reliance or raise any objections in his trial brief.

- Opposer’s Response to Applicant’s Request for Admission No. 1;
- Opposer’s Response to Applicant’s Request for Admission No. 4;
- Opposer’s Response to Applicant’s Request for Admission No. 5;
- Opposer’s Response to Applicant’s Request for Admission No. 6;
- Opposer’s Response to Applicant’s Request for Admission No. 8;
- Opposer’s Response to Applicant’s Request for Admission No. 15;
- Opposer’s Response to Applicant’s Request for Admission No. 17;
- Opposer’s Response to Applicant’s Request for Admission No. 18;
- The Articles of Incorporation of Laguna Lakes Community Association, Inc. filed on September 26, 2003 with the Florida Secretary of State (LL 36 – LL 41, LL 48);
- The Master Declaration for Laguna Lakes recorded with the Lee County, Florida Clerk of Court on October 6, 2003 (LL 50 – LL 96);
- Quit Claim Deed dated December 2, 2003 and recorded with the Lee County, Florida Clerk of Court on December 15, 2013 (LL 97 – LL 98);
- Not-for-Profit Corporation Annual Reports filed with the Florida Secretary of State for the Years 2004 – 2013 (LL 99 – LL 112); and
- *Debtor’s Schedules of Assets and Liabilities* filed under penalty of perjury by TOUSA, Inc. on February 13, 2008 in *In re: TOUSA, Inc.*, Case No. 08-10928 in the United States Bankruptcy Court, Southern District of Florida (LL 113 – LL 164).

LLCA also requests that the Board take judicial notice of the fact that under penalty of perjury, in its schedule of “patents, copyrights, and other intellectual property” (in *In re: TOUSA, Inc.*, Case No. 08-10928 in the United States Bankruptcy Court, Southern District of Florida), TOUSA, Inc. did not list either of the marks LLCA is applying for as a trademark or other intellectual property which it owned. Such fact is capable of accurate and ready determination by resort to court records available to the public through the PACER system, a source whose accuracy cannot reasonably be questioned and from which the documents bates-labeled LL 113 –

LL 164 were downloaded. TBMP § 704.12; *see also* Fed. R. Evid. 201(b); *Landt v. Farley*, No. 4:12CV0740, 2012 WL 4473209 at n.2 (N.D. Ohio 2012) (quoting *C.B. v. Sonora Sch. Dist.*, 691 F.Supp.2d 1123, 1138 (E.D. Cal. 2009) (court “may take judicial notice of matters of public record, including duly recorded documents, and court records available to the public through the PACER system via the Internet”)).

SUMMARY AND STATEMENT OF THE ISSUES

Opposer, John Gerard Marino (“Opposer” or “Marino”), is a property salesman that has objected to the registration of two marks by Applicant, Laguna Lakes Community Association (“LLCA”) – a community association in Fort Myers, Florida for the real estate development known as Laguna Lakes (as coined by the community’s developer). In this Consolidated Opposition Proceeding, Marino specifically advances claims of: (1) fraud; (2) priority and likelihood of confusion; and (3) primarily geographic descriptiveness.

The first mark sought to be registered is the standard character mark “Laguna Lakes.” (See U.S. Trademark Application Serial No. 85/411,955 (“the ‘955 Application”). The second mark sought to be registered is a special form “Laguna Lakes” mark reproduced below:



(See U.S. Trademark Application Serial No. 85/414,343 (“the ‘343 Application”). LLCA is applying for registration of both marks in International Class 35 for “[a]ssociation services, namely, promoting the interests of condominium association and homeowner associations; managing the business affairs of common community associations of HOAs and condominium associations, and promoting the use of and managing the maintenance of real estate.”

With regards to the issue of priority and likelihood of confusion, Marino’s opposition is primarily based on his alleged use of the name “Mr. Laguna Lakes.” The date on which Marino

first used “Mr. Laguna Lakes” has been a moving target throughout this proceeding (explained further below), and as such the Board should be skeptical of Marino’s claim that he first used “Mr. Laguna Lakes” on August 3, 2004.³ In any event, there is no dispute that, among other points discussed herein:

- Laguna Lakes, the real estate development, existed before Marino began using “Mr. Laguna Lakes”;
- Marino only began using “Mr. Laguna Lakes” after LLCA was organized as an entity in September 2003; and
- from 2003 – 2006, the LLCA board of directors was controlled by its developer, Transeastern, and Marino has no personal knowledge of what the LLCA board of directors did or did not do during those years.⁴

All told, and as set forth in detail herein, viewing the record evidence as a whole validates LLCA’s priority of use of both marks sought to be registered. Notwithstanding the fact that the real estate developer transferred its rights in the Laguna Lakes development, and the associated intellectual property, to LLCA on or about December 2003, LLCA has continuously used the standard character “Laguna Lakes” mark and the special form logo since around the time of its inception in the fall of 2003. In short, LLCA was formed in 2003, commenced use of the Laguna Lakes name and special form logo in 2003, and received ownership in 2003 – all prior to

³ Additionally, the evidence of record shows that Marino did not begin using the special form “Laguna Lakes” mark at any time before he began working with Amerivest Realty in June 2010.³ See 8/22/13 Marino Depo. Tr. [70 TTABVUE] at pp. 41-44 (testifying that he began working with Amerivest Realty in June 2010 at the earliest). See also Exhibit 7 to 10/8/14 Marino Trial Tr. [62 TTABVUE], evidencing all postcards Marino claims to have used the special form logo on. Notably, the special form logo does not appear in any of Marino’s postcards dated before 2010. Moreover, the one yard sign shown in Exhibit 7 must be dated after June 2010, when Marino began working for Amerivest Realty. Additionally, the photos of bus signs with the special form logo bearing the “LagunaLakes.com” website in Exhibit 7 are dated May 11, 2014, and in any event would be dated after 2012, when Marino claims to have purchased the domain name (see 71 Marino’s Trial Brief [71 TTABVUE] at p. 10, ¶17).

⁴ 10/8/14 Marino Trial. Tr. [62 TTABVUE] at pp. 95:10 – 96:7. Marino also testified that he did not join the LLCA board of directors until 2007. *Id.* at pp: 95:16-18.

Marino's alleged first use in 2004. Marino simply maintains no affirmative, credible evidence to the contrary sufficient to satisfy his burden of proof on the issue of priority and likelihood of confusion.

Marino's claims of fraud and primarily geographic descriptiveness are similarly unavailing and unconvincing. As to the fraud claim, when viewing the record evidence as a whole, Marino fails to satisfy his heavy burden of proving by clear and convincing that LLCA made a false, material representation in the procurement of its registrations with the intent to deceive the United States Patent and Trademark Office ("USPTO"). At best, Marino points to one lone inadvertent typographical error in the website listed for LLCA in the '955 Application in the identifying portion of the application (and even then LLCA's correct website not only appears on the specimen for the '955 Application, but also in the body of and specimen for the '343 Application). Inadvertent typos like this are far from fraud. Additionally, Marino concedes that LLCA was using both marks at least by the time it filed its trademark applications, and thus date of first use and use in commerce cannot form the basis of a fraud claim. Marino's fraud claim is, in short, entirely without merit.

Marino also fails to satisfy the burden of proof on his primarily geographic descriptiveness claim. According to the Trademark Manual of Examining Procedure, names of residential communities that are coined (such as Laguna Lakes) must not be refused. As a matter of law, and in accordance with law recognized by the Board and other federal and state courts, the marks sought to be registered are not primarily geographically descriptive.

RECITATION OF FACTS

I. Marino Adopted the Moniker “Mr. Laguna Lakes” After Formation of LLCA and Establishment of the Laguna Lakes Real Estate Development.

This is a case where a property salesman (Opposer, John Gerard Marino) has objected to the registration of marks by a community association (Applicant, Laguna Lakes Community Association). In approximately 2003, a real estate developer (Transeastern) began development efforts on an empty field in Florida. The project included developing the property, creating a series of lakes and coining a name for the community: “Laguna Lakes.” (See 8/22/13 Marino Depo. Tr. [70 TTABVUE] at pp. 25:19 – 26:11.)

Without the Laguna Lakes real estate development that was established in 2003 (8/22/13 Marino Depo. Tr. [70 TTABVUE] at p. 26:6-8), Marino would not call himself “Mr. Laguna Lakes.” Before the Laguna Lakes real estate development was established, it did not have a specific name; rather, Marino testified that it was simply “a field with cows in it.” (*Id.* at p. 26:11, 17-18.) As he must, Marino himself admits that Laguna Lakes was established ***before*** he began using the name “Mr. Laguna Lakes.” (Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶9-10.)⁵

⁵ Opposer’s Response to Applicant’s Request for Admission No. 1

• *Request for Admission No. 1:* Admit that Laguna Lakes, the real estate development in Fort Myers, Florida, existed prior to the date that Marino [Opposer] allegedly began using the trade name “Mr. Laguna Lakes.”

• **Response to Interrogatory No. 1: Admit.**

Opposer’s Response to Applicant’s Request for Admission No. 4

• *Request for Admission No. 4:* Admit that Marino [Opposer] did not use the trade name “Mr. Laguna Lakes” prior to October 6, 2003.”

• **Response to Interrogatory No. 4: Admit.**

Similarly, LLCA – a Florida not-for-profit corporation formed to serve as the community association for the Laguna Lakes real estate development – was incorporated on September 26, 2003, nearly one year before Marino allegedly began using “Mr. Laguna Lakes” in connection with relator services. (8/23/13 Tardiff Depo Tr. [63 TTABVUE] at p. 85:16-19; *id.* at pp. 49:22 – 50:3; 8/22/13 Marino Depo. Tr. [70 TTABVUE] at pp. 19:14 – 20:8; 10/8/14 Marino Trial Tr. [62 TTABVUE] at p. 115:10-13; Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶15-16.) Thus, only after Laguna Lakes (the real estate development) was established and LLCA was incorporated did Marino begin using “Mr. Laguna Lakes” to promote his business of selling real estate in Laguna Lakes. (Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶15-16; 10/8/14 Marino Trial Tr. [62 TTABVUE] at p. 115:10-13.)

II. LLCA Used the Laguna Lakes Name and Special Form Logo Prior to Marino.

On September 26, 2003, an entity by the name of Transeastern Laguna Lakes, LLC (“Transeastern”)⁶ filed the Articles of Incorporation for LLCA. (*See* 10/8/14 Marino Trial Tr. [62 TTABVUE] at pp. 31:16 – 32:11; 8/23/13 Tardiff Tr. [63 TTABVUE] at pp. 49:22 – 50:4; Applicant’s Notice of Reliance [69 TTABVUE] at ¶6.) A true and accurate copy of the Articles of Incorporation is bates-labeled LL 36 – LL 41 as part of Exhibit B to the deposition of LLCA’s corporate representative taken on August 23, 2013. (8/23/13 Tardiff Tr. [63 TTABVUE] at pp. 49:22 – 50:4; Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶6, 17.) From 2003 – 2006,

⁶ Marino claims, without any support from the record, that “[t]he name Laguna Lakes and the logo for Laguna Lakes were created by Transeastern Homes.” *See* 71 TTABVUE at p. 6. Marino presents no credible evidence to support the notion that an entity known as “Transeastern Homes” created these marks. *See Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981) (explaining that statements of counsel in a brief even though factually correct, must be supported by evidence within . . . the record”). Certainly, there is no evidence in the record of what type of entity Transeastern Homes is, if in fact it is one at all. Unlike Marino, LLCA presents competent evidence that “Transeastern Laguna Lakes, LLC” is an LLC organized under the laws of the State of Florida.

the LLCA board of directors was controlled by Transeastern, who was the developer of the Laguna Lakes real estate development. (10/8/14 Marino Trial Tr. [62 TTABVUE] at pp. 32:2-9; 32:12-25; 95:10 – 96:7; *see also* 71 TTABVUE at p. 7.) Although the individuals that sat on the LLCA board of directors, these individuals also conducted the business of LLCA. (*Id.* at p. 99:9-17; 3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 18:9-23.) In other words, LLCA, through its board of directors, was using the Laguna Lakes name and special form logo. (*Id.*)

On October 6, 2003, Transeastern filed and recorded the Master Declaration for Laguna Lakes” (hereafter “Declaration”) with the Lee County, Florida Clerk of Court. (*See* Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶6, 17 and documents bates-labeled LL 50 – LL 96 affixed thereto as part of Ex. B.) The Declaration declared that LLCA “shall have all of the powers indicated or incidental to those contained in its” Articles of Incorporation and Bylaws – i.e. the right to use the Laguna Lakes name and special form logo. (*See* Section 2.3 of the Declaration.) According to the Articles of Incorporation, LLCA’s powers, rights, and duties are set forth very broadly as follows: to “administer, enforce, carry out and perform all of the acts, functions, rights and duties provided in, or contemplated by, the” Declaration. (Section 3.2 of the Articles of Incorporation.) A non-exhaustive list of examples of such acts, functions, rights and duties is set forth in Section 3.2 of the Declaration. Additionally, the Declaration further provides that LLCA “may enter into any agreement with any community development district [such as the Laguna Lakes Community Development District]. . . to maintain any property or interest in any property owned by [LLCA].” (*Id.* at §14.4.)

As of the fall of 2003, LLCA was using the subject marks “from the standpoint of enticing people to purchase property in the [Laguna Lakes] community.” (3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 14:13-18; *see also id.* at p. 11:5-9.) Then, in December 2003, by way

of a Quit Claim Deed, Transeastern expressly conveyed the common areas in Laguna Lakes to LLCA. (8/22/13 Marino Depo. Tr. [70 TTABVUE] at pp. 44:8 – 45:25 and Ex. 6 thereto; *see also* Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶6, 17⁷.) Transeastern’s managing member, Transeastern Properties, Inc., executed the Quit Claim Deed on behalf of Transeastern effectuating the transfer. (*Id.*) As testified to by LLCA’s corporate representative, the transfer of property included ownership of signs bearing the Laguna Lakes name and special form logo. (8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at pp. 81:12 – 82:13; 82:22 – 83:12; *see also* 8/23/13 Hajicek Depo. Tr. [63 TTABVUE] at p. 10:3-7.) The Quit Claim Deed also transferred certain intangible assets that were previously used by Transeastern before LLCA, including the Laguna Lakes name and special form logo, to LLCA. (3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at pp. 17:18 – 18:8; 37:4-19; 39:3-24.) Thus, the LLCA was formed in 2003, commenced use of the Laguna Lakes name and special form logo in 2003, and received ownership in 2003 – all prior to Marino’s alleged first use in 2004. (Marino’s Trial Brief [71 TTABVUE] at p. 5, ¶1.)

LLCA’s use of the Laguna Lakes name and special form logo continued into and through 2006. (Applicant’s Notice of Reliance [69 TTABVUE] at ¶14⁸; 8/23/13 Hajicek Depo. Tr. [63 TTABVUE] at p. 7:9-24.) During this time, as it does now, LLCA “managed” the properties in Laguna Lakes and took “care of all of the amenities” in the real estate development, including the clubhouse, the pool, tennis courts, volleyball courts, the front entryway guardhouse and gates that operate to allow people to enter and exit, a back gate, a fishing pier, and roads in the

⁷ Noticing the Quit Claim Deed as LL 97 – LL 98.

⁸ Marino contends that because Transeastern controlled the LLCA board until the 2006 – 2007 time period, LLCA as a separate entity could not possibly have used the Laguna Lakes name or special form logo. (Applicant’s Notice of Reliance [69 TTABVUE] at ¶14.) However, this is a factual and legal fallacy. Trademark law does not *per se* bar two parties from using the same mark at the same time. And as explained above, the LLCA board, controlled by Transeastern, was in fact using the Laguna Lakes name and special form logo.

community. (8/23/13 Hajicek Depo. Tr. [63 TTABVUE] at p. 7:18:22; 8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at pp. 29:12 – 30:12; 3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 87:6-19.) And around this time, on or about August 24, 2006, there is no dispute that LLCA created its website located at LagunaLakesAssociation.com. (71 TTABVUE at p. 10.) LLCA’s website, on which LLCA uses the Laguna Lakes name and special form logo, remains active today.

As previously indicated, LLCA filed the ‘343 Application to register the special form “Laguna Lakes” mark on September 2, 2011 and the ‘955 Application on August 31, 2011 to register the standard character “Laguna Lakes” mark. LLCA seeks registration of its “Laguna Lakes” marks in International Class 35 for “[a]ssociation services, namely, promoting the interests of condominium association and homeowner associations; managing the business affairs of common community associations of HOAs and condominium associations, and promoting the use of and managing the maintenance of real estate.” The date of first use of the Laguna Lakes marks by LLCA for purposes of its trademark applications is October 6, 2003, the filing date of the Declaration – an official, non-hearsay public record that authorizes LLCA’s use of the marks it seeks to register. Though it was incorporated on September 26, 2003 and its first date of use relates back to that of its predecessor, LLCA erred on the side of caution and used the slightly later October date in its applications.

Marino alleges use of “Mr. Laguna Lakes” in connection with real estate services. But the actual date of Marino’s first use is more difficult to ascertain. Marino initially claimed that his first date of use of “Mr. Laguna Lakes” was “as early as July 2005.” (‘343 Notice of Opposition at ¶4; ‘955 Notice of Opposition at ¶4.) After the Board granted in part LLCA’s Motions to Dismiss, Marino next alleged first use as early as April 2003. (Amended ‘343 Notice of Opposition at ¶8; Amended ‘955 Notice of Opposition at ¶8.) Most recently, Marino claims

first use of “Mr. Laguna Lakes” more than a year later – on August 3, 2004, not April 2003. (8/22/13 Marino Depo. [70 TTABVUE] at p. 19:11-13; 10/8/14 Marino Trial Tr. [62 TTABVUE] at p. 115:10-13; Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶15-16.) Based on party-opponent admissions made by Marino in the initial Notice of Oppositions that he filed in April 2012, the Board should be very suspicious of the claim that he first used the name “Mr. Laguna Lakes” on August 3, 2004.

V. Objections to Marino’s Recitation of the Facts.

Throughout his trial brief, Marino conveniently ignores much of the negative facts fatal to his case. Marino also distorts the facts by misleadingly making claims that are either unsupported by the testimony or evidence cited or unsupported by testimony or evidence altogether. For example:

- Marino did not continually use Lagunalakes.com since 2004 (*see* 71 TTABVUE at p. 6) given that he only purchased the domain in 2012 (*id.* at p. 12.).
- The testimony cited in paragraph 4 located on 71 TTABVUE at p. 6 from the August 23, 2013 deposition of LLCA’s corporate representative (i.e. 8/23/13 Tardiff Depo. Tr. at p. 119) does not support the contentions that: (a) Transeastern’s intellectual property was not transferred to LLCA; and (b) the intellectual property was transferred to TOUSA (which is irrelevant anyways given that the issue in this case concerns priority as between LLCA and Marino). LLCA’s corporate representative merely agreed that Transeastern and TOUSA merged at some indefinite time and TOUSA went into bankruptcy. (8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at p. 119:5-20.)⁹

⁹ Additionally, directly contrary to what Marino claims, the two trademarks LLCA seeks to register were not transferred from Transeastern to TOUSA. According to the official public records for the bankruptcy cited by Marino,⁹ under penalty of perjury, in its schedule of “patents, copyrights, and other intellectual property”, TOUSA did not list either of the marks LLCA is applying for as a trademark or other intellectual property which it owned. (Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶6, 17-18: noticing documents bates-labeled LL 120, LL 123, LL 133 – LL 136, and LL 164 attached to the Notice of Reliance as Exhibit B.) In other words, TOUSA did not acquire from Transeastern any rights in the marks LLCA is applying for. All of this makes sense given that Transeastern had previously given LLCA the right to use the marks and eventually transferred the marks to LLCA.

- Hajicek did not concede that the Quit Claim Deed merely transferred common elements of the Laguna Lakes community as claimed at 71 TTABVUE at p. 8. Marino cites to pages 8-10 of testimony provided by Hajicek on March 3, 2014 as LLCA’s corporate representative, but ignores testimony to the contrary indicating that the Quit Claim Deed encompassed intangible assets including the marks at-issue on pages 17, 18, 37 and 39.
- Though the parcel associations may use the Laguna Lakes name and special form logo without objection (71 TTABVUE at p. 8), they are entitled to because they are members of the LLCA. (*See, e.g.*, Section 4.1.1 of the Articles of Incorporation – LL 37; Applicant’s Notice of Reliance [69 TTABVUE] at ¶6.)
- The testimony cited in paragraph 10 located on 71 TTABVUE at p. 8 does not support the claim that as of September 2003, the only entity that was using the Laguna Lakes name in commerce as a trademark was Traneseastern. On March 3, 2014 deposition, LLCA’s corporate representative testified that LLCA was using the logo and name mark “from the standpoint of enticing people to purchase the property in the community.” (3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 14:13-18.) Marino did not serve on the board of directors for LLCA from 2003 – 2006, and therefore cannot speak to how LLCA was using the name and logo mark, or refute LLCA’s claims that it was using said marks in September 2003.
- Marino’s contention that “Traneseastern was well aware of Marino’s use of the name Mr. Laguna Lakes and thought it was ‘clever’” as alleged on 71 TTABVUE at p. 9 is inadmissible hearsay. Marino failed to offer any testimony from any Traneseastern or TOUSA employee to support its burden of proof.
- LLCA does *not* claim that its first use of the Laguna Lakes name and special form logo was on the monument signs discussed by Marino in paragraph 12 located on 71 TTABVUE at p. 9, and contrary to what Marino claims, LLCA did identify its date of first use for both the Laguna Lakes name and special form logo.
- The testimony cited in paragraph 13 located on 71 TTABVUE at pp. 9-10 from the deposition of LLCA’s corporate representative on March 3, 2014 does not support the contention that “LLCA has no evidence or documents evidencing the transfer or assignment or any intellectual property such as ‘Laguna Lakes’ or the applicable logo from Traneseastern [] to LLCA.” LLCA’s corporate representative testified that Traneseastern’s intangible assets were transferred to LLCA.¹⁰ Additionally, the Declaration, an official, non-hearsay public record, authorizes LLCA’s use of the marks it seeks to register. Marino fails to point to any document conclusively demonstrating that the intellectual property was not transferred to LLCA.

¹⁰ And regardless of whether there was a transfer of intellectual property to LLCA or not, LLCA still is the prior user as compared to Marino.

- The testimony cited in paragraph 15 located on 71 TTABVUE at p. 10 does not support the contention from Marino that “a public company by the name of TOUSA, purchased all of the assets of Transeastern.” In fact, LLCA’s corporate representative merely agreed that Transeastern and TOUSA merged at some indefinite time and TOUSA went into bankruptcy. (8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at p. 119:5-20.) Marino fails to point to any document indicating that TOUSA purchased all of Transeastern’s assets.
- Whether LLCA is aware of any damages or harm to it caused by Marino’s use of the Laguna Lakes name and logo and “Mr. Laguna Lakes” is irrelevant given that this Consolidated Opposition Proceeding only concerns whether Marino is damaged at all LLCA’s registration of the at-issue marks. (*See* 71 TTABVUE at p. 10.)
- Marino did not use “Mr. Laguna Lakes” as early as February 2003 as alleged on 71 TTABVUE at p. 12. Marino himself testified as follows:

Q. So, Mr. Marino, let me ask you this: So as far as you know, did you use the name "Mr. Laguna Lakes" or the name "Laguna Lakes" in your real estate business prior to August 2004?

A. Nothing that I can substantiate.

(10/8/14 Marino Trial Tr. [62 TTABVUE] at p. 114:13-17.) Nothing on pages 21 and 22 of Marino’s testimony from October 8, 2014, cited to support the date of Marino’s first use, even remotely suggests that he used the name Mr. Laguna Lakes “as early as February 2003.” **For Marino to represent to the Board that he did is nothing if not frivolous conduct designed to mislead the Board in an effort to gain an unfair advantage over LLCA. Such conduct evidences Marino is lacking in credibility, and is willing to say anything (whether true or not) if it will help him prevail in this Consolidated Opposition Proceeding.**

Additionally, in violation of the Board’s rules and procedures (namely Trademark Rule 2.123(1)), Marino also improperly cites to new evidence such as websites not in the record. (71 TTABVUE at pp. 7, 10, 15, 19.) LLCA also objects to Marino’s reliance on exhibits containing annotations with his subjective analysis of documents that are entirely lacking in foundation and are marred with inadmissible hearsay. *See* 64 TTABVUE at pp. 7-9 (containing LLCA’s objections to the exhibits to Marino’s trial deposition testimony in more detail.) Such imprecision as to dates and “coaching” in the form of annotated exhibits call into question Marino’s veracity and credibility.

LAW AND ANALYSIS

I. Legal Standard.

“The party opposing registration [of a trademark] bears the burden of proof,” and “if that burden cannot be met, the opposed mark must be registered.” *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1300 (2015) (citing 15 U.S.C. § 1063(b)). The burden of proof is generally by a preponderance of the evidence. *Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1918 (Fed. Cir. 1993). The party opposing registration also bears the “burden of persuasion.” *B & B Hardware*, 135 S. Ct. at 1309. In this case, Marino is the Opposer. Accordingly, the burden of proof and burden of persuasion both lie squarely with him.

“[W]hile it is indeed the better practice for a defendant [i.e. Applicant], if it believes that the plaintiff [i.e. Opposer] has failed to sustain its burden of proof in the case, to file a brief indicating the inadequacy of the plaintiff’s evidence or otherwise arguing the insufficiency of the ground or grounds on which the proceeding has been brought, there is no requirement that a defendant do so.” *David J. Fox, D.M.D. v. David S. Hornbrook*, Opp. No. 91/121,292, 2004 WL 1957204 at *8 n.3 (TTAB 2004). Indeed, the “filing of a brief on the case is optional, not mandatory, for a party in the position of defendant.” TBMP § 801.02(b). Consequently, it cannot be said that Applicant concedes the issues herein by failing to file a brief on the case” or giving certain topics more consideration than others. *Fox*, 2004 WL 1957204 at *8 n.3.

II. Analysis.

In the Amended Notices of Opposition, Marino asserts claims of: (1) fraud; (2) priority and likelihood of confusion; and (3) primarily geographic descriptiveness. As explained at length below, with respect to each claim, Marino fails to carry his burdens of proof and

persuasion. Accordingly, Opposition No. 91/204,897 and Opposition No. 91/204,941 should be dismissed with prejudice and LLCA's trademark applications should proceed to registration.

A. Marino Woefully Fails to Carry His Heavy Burden of Proving Fraud.

Marino alleges that Applicant "made material misrepresentations with the intent to deceive the USPTO by misrepresenting: (1) its domain name; (2) the type of business in which it intends to use the mark; (3) that it is using the mark in interstate commerce; and (4) the date of first use of the mark.

To assert a viable claim of fraud, Marino must prove that LLCA knowingly made a false, material representation in the procurement of its registration with the intent to deceive the USPTO. *Zoba Int'l Corp. DBA CD Digital Card*, Cancellation No. 92/051,821, 2011 WL 1060727 (TTAB 2011) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1942 (Fed. Cir. 2009); *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ 2d 1537 (TTAB 2009)); see also Fed. R. Civ. P. 9(b) (requiring that allegations of fraud be pled with particularity). "[D]eception must be willful to constitute fraud." *In re Bose Corp.*, 580 F.3d at 1243. "[T]he very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *In re Bose Corp.*, 580 F.3d at 1243 (citing *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). The Board has consistently acknowledged that there is a material legal distinction between a "false" representation and a "fraudulent" one. A "fraudulent" representation involves an intent to deceive whereas a "false" representation may be occasioned by a misunderstanding, an inadvertence, or a mere negligent omission. *In re Bose*, 580 F.3d at 1243 (citations omitted).

Based on the facts of this case and as a matter of law, Marino's claims fail for several reasons. **First**, LLCA did not knowingly misrepresent its domain name in the '955 Application. Rather, indicating that its website was LagunaLakes.com "was a typo," which is evidenced by the fact that in the '343 Application its website is listed as www.LagunaLakesAssociation.com. (8/23/13 Tardiff Depo. Tr. [69 TTABVUE] at p. 124:13-15; *see also* '343 Application.) Even Marino eventually conceded this much during his trial deposition (*see* 10/8/14 Marino Trial Tr. [63 TTABVUE] at pp. 73-76), and went as far as to agree that typographical errors are not intentional (*id.* at p. 79), though he remarkably and wastefully still tries to argue in his trial brief that Laguna Lakes was somehow trying to deceive the USPTO by using the same website specimen for each trademark application. (71 TTABVUE at p. 20.) In any event, the evidence shows that LLCA did not knowingly misrepresent its domain name.

Second, there is no evidence that LLCA made any *fraudulent* representations to the Board concerning the type of business in which it intends to use the Laguna Lakes marks. LLCA seeks to register the Laguna Lakes marks in International Class 35 for "[a]ssociation services, namely, promoting the interests of condominium association and homeowner associations; managing the business affairs of common community associations of HOAs and condominium associations, and promoting the use of and managing the maintenance of real estate." Fraud must be "proven to the hilt with clear and convincing evidence." *In re Bose*, 580 F.3d at 1243 (citations omitted). In this instance, there is no evidence, let alone clear and convincing evidence, of fraud. LLCA does not claim, as Marino falsely contends, "that it only manages the business of a homeowners association." (Amended '343 Notice of Opposition at ¶6; Amended '955 Notice of Opposition at ¶6.) LLCA specifically identifies that the services that the Laguna Lakes marks are used in connection with also includes "promoting the use and managing the

maintenance of real estate.” (‘343 Application; ‘955 Application.) In addition, LLCA takes “care of all of the amenities” in the real estate development, including the clubhouse, the pool, tennis courts, volleyball courts, the front entryway guardhouse and gates that operate to allow people to enter and exit, a back gate, a fishing pier, and roads in the community (i.e. promoting the use of and managing the maintenance of real estate). (8/23/13 Hajicek Depo. Tr. [63 TTABVUE] at p. 7:18:22; 8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at pp. 29:12 – 30:12; 3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 87:6-19.) LLCA also uses the subject marks “from the standpoint of enticing people to purchase property in the [Laguna Lakes] community” – i.e. promoting the interests of LLCA and the use of real estate. (3/3/14 Hajicek Depo. Tr. [63 TTABVUE] at p. 14:13-18; *see also id.* at p. 11:5-9.) These functions go beyond simply managing the business of the homeowners’ association, and comprise the types of services for which LLCA seeks to register the marks. Because there “is no room for speculation, inference or surmise,” any “doubt must be resolved” in favor of LLCA. As a matter of law, LLCA did not make any *fraudulent* representations to the Board concerning the type of business in which it intends to use the Laguna Lakes marks.

Third, LLCA is using the mark in commerce; Marino’s claims and allegations to the contrary are simply frivolous. To begin, Marino’s allegation that LLCA does not use the marks in commerce are contradicted by his own acknowledgment that LLCA owns and operates a website and defies the courts understanding of how the Internet impacts interstate commerce. Amended ‘343 Notice of Opposition at ¶3; Amended ‘955 Notice of Opposition at ¶3. Under black-letter trademark law principles, “[o]ffering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website.” TMEP § 901.03 (*citing*

Planned Parenthood Federation of America, Inc. v. Bucci, 42 USPQ 2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834 (1998)). “[W]here a trademark is used on the internet so as to draw consumers to a particular website, the use in commerce prong of a Lanham Act claim is satisfied.” *Transamerica Corp. v. Moniker Online Services, LLC*, 672 F. Supp. 2d 1353, 1361 (S.D. Fla. 2009). LLCA offers its services via the Internet and therefore uses its mark in interstate commerce. (See also 8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at p. 90 - explaining that LLCA uses its marks in interstate commerce to attract homeowners from out of state.)

Furthermore, courts recognize that “the names of charitable, educational, and **other non-profit organizations** are entitled to protection under the Lanham Act regardless of whether or not they place products into the stream of commerce.” *Committee for Idaho's High Desert v. Yost*, 881 F. Supp. 1457, 1470-1471 (D. Idaho 1995) (emphasis added). Even if LLCA did not use its mark in interstate commerce, non-profit organizations like LLCA “are entitled to protection under the Lanham Act regardless of whether or not they place products into the stream of commerce.” *Yost*, 881 F. Supp. at 1470-1471. Again, there is no clear and convincing evidence of fraud.

Fourth, the date of first use of the Laguna Lakes marks by LLCA for purposes of its trademark applications is October 6, 2003. Though it was incorporated on September 26, 2003 and its first date of use relates back to that of its predecessor, LLCA erred on the side of caution and used the slightly later October filing date of the Declaration – an official, non-hearsay public record that authorizes LLCA’s use of the marks it seeks to register. (8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at p. 110:2-13; see also 15 U.S.C. § 1055 (“Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure

to the benefit of the registrant or applicant for registration”).¹¹ In this case, Transeastern and LLCA are related companies because LLCA was formed by Transeastern and, until 2006, LLCA’s board of directors was controlled by Transeastern. (8/23/13 Tardiff Depo. Tr. [63 TTABVUE] at pp. 81-82, 84, 86; *see also* LLCA’s Articles of Incorporated). It is undisputed that Transeastern used the Laguna Lakes marks before LLCA was legally formed. This use of the Laguna Lakes marks inured to the benefit of LLCA pursuant to 15 U.S.C. §1055.

Nevertheless, assuming *arguendo* that the date of first use is incorrect, the Board has previously held that as long as there was technical trademark use prior to the filing date of the application, then “the date of first use . . . in [an] application, even if false, is not a material representation and cannot be said to constitute fraud on the Patent and Trademark Office.” *Brenda D. Lewis & William L. Flowers v. Microsoft Corp.*, Cancellation No. 92/043,487, 2005 WL 847443 at *6 (TTAB 2005). The same result follows here given that there is no dispute LLCA used the Laguna Lakes marks prior to filing its applications in August/September 2011.

As set forth above, Marino falls well short of proving that LLCA committed fraud under the standard set forth in *In re Bose*. Accordingly, this ground of opposition should be dismissed as Marino fails to prove that LLCA committed fraud.

B. Marino Also Fails to Carry His Burden of Proving Priority and Likelihood of Confusion.

The burden to prove priority and likelihood of confusion lies squarely and solely with Marino. In order to prove priority and likelihood of confusion under 15 U.S.C. § 1052(d) at trial,

¹¹ Pursuant to the “related company doctrine,” a trademark applicant such as LLCA can establish ownership of mark by showing that it controlled the company that used mark. *Starsurgical, Inc. v. Aperta, LLC*, 832 F. Supp.2d 1000 (E.D.Wis. 2011). A “related company” in this context is one “whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.” 15 U.S.C. §1055. Furthermore, “it is not necessary that [the public] know the *identity* of the source.” *Cent. Garden & Pet Co., infra*.

Marino must show (1) that he maintains priority of use in the mark “Laguna Lakes” and that (2) LLCA’s marks, when used in connection with the services set forth in the applications, would create a likelihood of confusion with his marks. *Hart v. New York Yankees P’ship*, 184 F. App’x 972, 973 (Fed. Cir. 2006) (citing *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1359 (Fed. Cir. 2001)); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20.14 (4th ed. 2004). Date of actual use can be established by oral testimony. *Cent. Garden & Pet Co. v. Doskocil Manufacturing Company, Inc.*, 2013 WL 4635990 at n.14 (TTAB 2013); accord *Msi Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 655 n. 7 (TTAB 1983). Priority may be established based on intrastate commerce, *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1965 (TTAB 2007), and the “use in commerce” requirement does not require as a prerequisite to registration that an applicant’s services be rendered in more than one state. *Maids to Order of Ohio, Inc. v. Maid-To-Order, Inc.*, 78 USPQ 2d 1899 (TTAB 2006).

In this case, the issue of priority is determinative concerning the standard character Laguna Lakes mark and the special form Laguna Lakes mark. To begin, Marino initially claimed that his first date of use of “Mr. Laguna Lakes” was “as early as July 2005.” (‘343 Notice of Opposition at ¶4; ‘955 Notice of Opposition at ¶4.) Only after the Board granted in part LLCA’s Motions to Dismiss his oppositions did Marino falsely, if not fraudulently, allege that he first used the “Mr. Laguna Lakes” mark as early as April 2003. (Amended ‘343 Notice of Opposition at ¶8; Amended ‘955 Notice of Opposition at ¶8.) Finally, Marino admitted during his deposition that he first used the mark “Mr. Laguna Lakes” on August 3, 2004, not in April 2003. (8/22/13 Marino Depo. [70 TTABVUE] at p. 19:11-13; 10/8/14 Marino Trial Tr. [62 TTABVUE] at p. 115:10-13; Applicant’s Notice of Reliance [69 TTABVUE] at ¶¶15-16.)

Before Marino began using “Mr. Laguna Lakes” in August 3, 2004, Applicant LLCA was incorporated as a non-profit organization on September 26, 2003, with the Master Declaration of Laguna Lakes officially filed on October 6, 2003 with the Lee County, Florida Clerk of Court. Courts recognize that “the names of charitable, educational, and **other non-profit organizations** are entitled to protection under the Lanham Act regardless of whether or not they place products into the stream of commerce.” *Yost*, 881 F. Supp. at 1470-1471 (emphasis added). That is to say, “although [LLCA] is a non-profit organization, the . . . general trademark principles, though often referring to vendible goods in commerce, also” apply to Applicant’s first use of the mark as a non-profit “even if no goods or services were exchanged in commerce.” *Id.* at 1471; *Accuride Int’l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534-35 (9th Cir. 1989) (Trade names [like Laguna Lakes Community Association] often function as trademarks or service marks as well. . . . Perhaps because of this functional overlap, the same broad standards of protection apply to trademarks and trade names”). Consequently, and in light of the volume of evidence discussed above and in the record demonstrating that LLCA began using the Laguna Lakes standard character mark in 2003 *well before Marino began calling himself “Mr. Laguna Lakes,”* Marino cannot satisfy his burden of proving priority with respect to use of the standard character Laguna Lakes name mark.

The same result is true as to the special form Laguna Lakes mark. Marino does not allege when he began first using the special form logo. Nevertheless, there is no evidence that Marino used the special form logo at any time before he began working with Amerivest Realty in June 2010. (8/22/13 Marino Depo. Tr. [70 TTABVUE] at pp. 41-44.) On the other hand, the evidence demonstrates that LLCA was using the special form logo well prior to June 2010, and as early as Traneastern’s 2002 use of the special form logo to promote the properties at Laguna Lakes. *See*

15 U.S.C. § 1055; *see also* Recitation of Facts, *supra*. All told, Marino cannot prove that he used the special form Laguna Lakes logo first before LLCA.

Accordingly, Marino fails to satisfy his burden proving priority and likelihood of confusion under 15 U.S.C. § 1052(d).

C. Marino Also Fails to Satisfy His Burden of Proving That LLCA’s Marks Are Primarily Geographically Descriptive.

“Marks that are ‘merely descriptive’ of goods and services are not entitled to protection” under the Lanham Act. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377-1378 (Fed. Cir. 2012) (*citing In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (CCPA 1978)). Similarly, a “geographically descriptive term or phrase is one that ‘designates geographical location and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services.’” *Forschner Group, Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 355 (2d Cir. 1994) (*quoting* 1 J.T. McCarthy, *Trademarks and Unfair Competition*, § 14.02). **“That a phrase or term evokes geographic associations does not, standing alone, support a finding of geographic descriptiveness.”** *Id.* (emphasis added).

Marino alleges that the special form logo and the standard character mark “should not be registered in that [they are] merely geographically descriptive of a development and area in Ft. Myers, Florida.” (Amended ‘343 Notice of Opposition at ¶7; Amended ‘955 Notice of Opposition at ¶7.) However, both the Trademark Manual of Examining Procedure and the courts reject such an assertion. In Section 1210.02(a), the Trademark Manual of Examining Procedure states that the “mere fact that a term may be the name of a place that has a physical location does not necessarily make that term geographic under §2(e)(2). For example, names of amusement parks, **residential communities**, and business complexes which are coined by the applicant, must not be refused.” TMEP § 1210.02(a) (emphasis added). *See also In re Pebble Beach Co.*,

19 USPQ2d 1687 (TTAB 1991) (17 MILE DRIVE not a geographic term, where it was coined by applicant to refer both to applicant's services and the place where the services were performed).

“Where a developer chooses an arbitrary mark to designate a development, the mark is protectable despite the geographical aspects of the development.” *Pebble Beach Co. v. Tour 18 1, Ltd.*, 942 F.Supp. 1513, 1538 (S.D. Texas 1996); *see also Prestwick, Inc. v. Don Kelly Bldg. Co.*, 302 F.Supp. 1121, 1124 (D. Md. 1969) (mark TANTALLON when used for a planned community was not geographically descriptive since it has “no generally known geographic significance” and prior to the development the area had no general geographic name); *In re Pebble Beach*, 19 USPQ2d at 1689 (holding that the mark 17 MILE DRIVE was not geographically descriptive since the term was created by Pebble Beach Company's predecessor to denote a scenic seventeen mile stretch of road within the Del Monte Forest); *Tour 18 1, Ltd.*, 942 F.Supp. at 1538 (explaining that the mark PINEHURST was “an arbitrary name selected by the developer of the Pinehurst resort” making the mark “inherently distinctive and not geographically descriptive. [I]f there is a geographic connotation to [the mark], such meaning has developed over time since the creation of the Pinehurst resort and is directly attributable to the growth and success of the resort”).

The same result recognized in the Trademark Manual of Examining Procedure and by courts follows here. Despite his best to convolute the issue in his trial brief and during his trial testimony, Marino himself admitted that before Laguna Lakes the real estate development was established, it did not have a specific name; rather, it was simply “a field with cows in it.” (8/22/13 Marino Depo. Tr. [70 TTABVUE] at p. 26:11, 17-18.) Florida courts considering similar facts and circumstances agree that name and logo marks like those at issue are not

primarily geographically descriptive. See *Homeowner's Association, Inc. v. Tortoise Island Realty, Inc.*, 790 So. 2d 525 (Fla. 5th DCA 2001). In *Tortoise Island*, the Fifth District reversed the trial court decision which denied the Tortoise Island Homeowners Association, Inc. relief to enjoin infringement and dilution of its trade name/service mark by the realty company Tortoise Island Realty, Inc. *Id.* at 528. The name “Tortoise Island” was selected by a developer of a spoil island and lands, which area eventually became the community for which the homeowners’ association was formed to serve. *Id.* at 528. Prior to the development, the area had no name, and beginning in the late 1970's, the name was used to advertise the community and to sell lots. *Id.* When the project was completed, it was turned over to the homeowners’ association, which was a non-profit corporation whose primary duties were to maintain the common property and amenities, and enforce the pertinent covenants and restriction. *Id.*

Reversing the trial court denial of injunctive relief, the Fifth District stated that although “the name Tortoise Island [eventually] became connected to a real place and community,” the name “Tortoise Island” was “arbitrary and distinctive.” *Id.* at 535. An “‘arbitrary’ or fanciful name when attached to a place or location is generally protectable as a trade name or mark, without the necessity to prove secondary meaning.” *Id.* at 533. Because in *Tortoise Island*, “no evidence was adduced” that indicated that the name had become identifiable as a geographic location, the Fifth District determined that the name “Tortoise Island” was arbitrary, distinctive and protectable as the service mark/trade name for the exclusive residential community. *Id.*

The *Tortoise Island* decision and those discussed above are factually dispositive of the grounds for opposition asserted by Marino that Laguna Lakes is “merely descriptive” or “merely geographically descriptive.” Prior to the development, as in *Tortoise Island*, *Pebble Beach*, and *Tour 18 I, Ltd.*, Laguna Lakes had no name. The special form and standard character “Laguna

Lakes” marks are not merely descriptive and are not merely geographically descriptive; rather, these marks are both distinctive and protectable, and their value is being diluted by Marino. *See Tortoise Island*, 790 So.2d at 534-35 (finding that the mark had “gained a reputation as an exclusive residential community” whose “name and logo are commonly used by real estate agents to advertise properties exclusively in the community,” and further observing that “use by [the realtor] and others of the trade name Tortoise Island would contribute to its loss of distinctiveness and hence, its protectability”).

Accordingly, and in light of the foregoing, Marino cannot satisfy his burden of proving that the standard character and special form marks are primarily geographically descriptive.

D. Marino’s Unpled Grounds for Opposition That The Term “Laguna Lakes” Is Ornamental and LLCA Does Not Use The Laguna Lakes Name/Logo as a Service Mark Should be Summarily Denied.

For the first time in the three (3) years that this Consolidated Opposition Proceeding has been pending (approximately 42 months), Marino claims that “LLCA’s use of the terms Laguna Lakes is ornamental” and that LLCA does not use the Laguna Lakes name or special form logo as a service mark. 71 TTABVUE at p. 16. However, whether LLCA’s mark is ornamental, and whether the marks for which registration is sought have been used as a service mark or not, are two new, unpled separate grounds for opposition. TBMP § 309.03(c)(8). “A plaintiff cannot rely upon an unpled claim unless the plaintiff’s pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.” TBMP § 309.03(c) (citing *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007)). *See also* TBMP § 314 (same). In *Syngentam*, the Board held that “[i]nasmuch as dilution was not pleaded as a ground for relief in the notice of opposition, we will not consider it at this juncture.” 90 USPQ2d at

1115 n.3. “[R]aising the[se] [new] claim[s] for the first time in [Marino’s trial brief] is manifestly untimely,” *Kohler Co.*, 82 USPQ2d at 1103 n.3, and severely prejudices LLCA.

LLCA does not consent to trying these issues at this late juncture, and will not risk impliedly doing so to Marino’s benefit. In accordance with the authority cited above, the Board should reject and/or disregard Marino’s arguments that: (1) LLCA’s marks are ornamental; and (2) that LLCA uses the Laguna Lakes name and special form logo as other than a service mark.

CONCLUSION

As to each claim pled by Marino in the operative, Amended Notices of Opposition, Marino fails to carry his burdens of proof and persuasion. Consequently, for each and every one of the reasons discussed in the above, and for all of them taken together, Applicant, Laguna Lakes Community Association, Inc., respectfully requests that the Board dismiss Opposition No. 91/204,897 and Opposition No. 91/204,941 with prejudice, and allow its trademark applications to proceed through to registration.

Respectfully submitted,

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/s/ Chad R. Rothschild

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