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

Proceeding	91204897
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JOHN GERARD MARINO

Serial No. 85/411,955

Opposer,

Opposition No. 91/204,897

vs

LAGUNA LAKES COMMUNITY

ASSOCIATION, INC.

Applicant.

OPPOSER JOHN GERARD MARINO's REPLY BRIEF

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Argument

Marino Has Priority of Use of the Laguna Lakes Mark Over LLCA And the Proposed Marks are Confusingly Similar to the Marks Used by Marino

It is undisputed that in September 2003, Transeastern, the developer of the Laguna Lakes community, commenced using the Laguna Lakes name and logo marks to sell its real estate development. This is readily apparent from the sales material introduced into evidence (Marino pp. 129, 131-137) which Transeastern used to sell its homes. There is no evidence, however, that Transeastern ever used the name or logo marks for community association services. None. Furthermore, there is no record evidence that LLCA used either mark for community association services until 2006. Thus, Marino should be afforded priority to the opposed marks. The chronology based upon the record evidence in this matter is as follows:

Chronology of Priority

Ostensibly, LLCA's only evidence that it was using the opposed marks before 2006, whether in ornamentally or not, is from self-serving trial testimony from the board members of the LLCA. Thus, because LLCA has no documentary evidence showing use of the mark before its website went live in 2006, Marino provides a summary to the Board of the chronology of priority that can be proved with actual evidence below.

-February 2003-Transeastern first starts selling properties in the Laguna Lakes community (Marino pp. 129, 131-137)¹;

-April 2003-Transeastern starts using the website at the domain www.lagunalakes.com in order to sell real estate, NOT for community association services (Marino p. 131);

-September 2003-LLCA is created and quit claim signed from Transeastern Laguna Lakes, LLC to LLCA of real estate and appurtenances thereto;

-August 3, 2004-Marino starts printing business cards with “Mr. Laguna Lakes” trademark (Marino p. 201);

February 17, 2005-Marino registers MrLagunaLakes.com and uses Laguna Lakes word mark in commerce for real estate services (Marino p. 202);

-March 2005-Transeastern created monument signs with word mark and logo mark on them which were deeded to Laguna Lakes Community Development District, NOT LLCA (Marino at pp. 196-198)

-May 20, 2005, Marino first started printing postcard with “Mr. Laguna Lakes” and started advertising in newspapers and curbside signs and curbside signs uses logo mark and you tube video with logo mark(Marino p. 43) in it(Marino pp. 45, 203-225, 227);

2005-TOUSA acquires all assets of Transeastern (Marino pp.48-49);

2006-Transeastern completes construction and turns over association to homeowners of LLCA;

¹ “Marino” shall refer to TTAB Docket Entry 62.

- August 24, 2006-LLCA creates web site lagunalakesassociation.com where LLCA for first time uses name and logo marks for association services (Marino p. 169)
- July/August 2011-LLCA officers instruct Marino to stop using name and logo marks as they are trademarked (when they were not);
- September 2011-LLCA files for subject trademarks;
- November 2011-Marino purchases www.lagunalakes.com as part of TOUSA liquidation;
- 2012-Marino starts operating www.lagunalakes.com for real estate services with both name and mark logos on new website and redirects MrLagunaLakes.com to this site;
- December 19, 2013-LLCA adds real estate services to its web-site (Marino 199)

As can be seen from this chronology supported by documentary evidence, at no time did LLCA use the opposed marks for real estate services until it updated its website in December 2013. At that time, Marino was already long using his MR. LAGUNA LAKES trademark in commerce for ten years for real estate services. (Marino pp. 201-225) . Moreover, even LLCA's first evidence of use of the opposed marks for community association services was not until 2006 when it started its own website. (Marino p. 128). ***Simply, other than self-serving testimony, LLCA has no proof that it used the opposed marks for any purposes until 2006.*** The Board should not accept testimony by affidavit if there is zero corroboration evidence to support it. See *Solar Turbines Inc. v.*

Gemini Engine Co., 1983 TTAB LEXIS 223, 19-20 (Trademark Trial & App. Bd. Jan. 28, 1983):

(based on oral testimony of applicant's president, the first use of applicant's "GEMINI II" mark was in October 1978 on a natural gas engine and gas compressor shown at the Permian Basin Oil Show in Odessa, Texas. After the show, according to Clarke, the unit bearing the "GEMINI II" mark was shipped to Texas Oil & Gas Company in Woodward, Oklahoma. ***As opposer points out in its brief, there is no documentary evidence to corroborate these facts and Clarke's testimony as to how the mark was applied to the goods and other details of the transaction was vague and indefinite.*** The date of first use alleged in the application for registration, January 27, 1979, also could not be substantiated by documentary or testimonial evidence. In fact, from Clark's testimony, it appears that this date may be erroneous. n7 The earliest proved documentary evidence of use is an invoice dated March 27, 1979) (emphasis added).

At best, LLCA claims that it inherited Transeastern's use of the marks for community association services, however, Transeastern's use of the marks (in evidence) was only for real estate services and in connection with the sale of real property not for community association services or for the "promoting the use of and managing the maintenance of real estate," which is recited in the recitation of services for the opposed marks. Simply, ***Transeastern never used the opposed marks for the services LLCA now claims inure to them.***

LLCA further argues it inherited the priority rights to use the opposed marks from the builder Transeastern whose use dated back to 2003 for non-homeowner's association services. (See, LLCA Trial Memorandum) The evidence demonstrates that is far from the truth. At best, in 2003 Laguna Lakes was deeded the real property and common areas of the community. The deed does not reference intellectual property. Given the fact that Transeastern and

TOUSA continued to market and sell homes in Laguna Lakes through 2006, it certainly would not be reasonable to assume that it deeded LLCA all of its intellectual property rights to these marks since Transeastern continued to use them to sell their real estate holdings. Thus, LLCA's claims that the "related company doctrine" should be applied are not supported.

LLCA then attempts to argue that it did not need to use the marks in commerce in order to claim the protections of the Lanham Act, citing to the District of Idaho case of *Committee for Idaho's High Desert* case. First, This a case from the District of Idaho from 1989 is not binding on the Board. Second, the Idaho case holds that "The fact that an organization is non-profit and sells no goods does not take it out of the protection of the law of **unfair competition.**" (emphasis added). It is clear that the services of the opposed marks must be rendered for them to be in use. See, *David Couture v. Playdom Inc.*, Case No: 2014-1480 (Fed. Circ. 2015). Indeed, the issues before this Board are not ones of unfair competition, but are whether LLCA has used its proposed marks in commerce prior to Marino. This argument by LLCA is thus a red herring.

Finally, LLCA argues that Marino's argument that the proposed marks are merely ornamental is a new argument not raised by the pleadings. In actuality, this is not a new argument as it relates to the same priority argument that Marino has argued since the beginning of this case. Ornamentality is directly related to use of a trademark. It is part and parcel that if a phrase is not used as a trademark it was never in use under the Lanham Act, which if not directly germane to the issue of priority is certainly tangentially related to priority. Indeed,

Marino's position is that since the opposed marks were merely ornamental in their use by LLCA, LLCA could not have possibly have used the marks sufficient to establish priority over Marino's use of the marks. That is, the opposed marks were never used as a trademark before 2006 by the LLCA, even if the self-serving testimony of LLCA is accepted as evidence, because the words "Laguna Lakes" and the logo are merely ornamental and describe the community. However in an abundance of caution, Marino has filed a Motion for Leave to Conform to the pleadings to the evidence in accordance with TBMP Section 507.03(a).

In summary, the opposed marks and the mark MR. LAGUNA LAKES were used by Marino prior LLCA, and registration of them for community association services and for "promoting the use of and managing the maintenance of real estate," would be confusingly similar to the use by Marino, especially given LLCA's 2013 attempts to utilize its web site for real estate services such as leasing and selling real property.

**The Proposed Marks Should be Denied Registration
as Geographically Descriptive**

Registration of the opposed marks should also be denied in that they are geographically descriptive of a well-known area in California. The name chosen was not arbitrary, in that the entire development was themed around the California life-style and every name pertaining to the community including the development, the sub-divisions and the streets are all well-known areas in California. (Marino 133, 135). Transeastern wanted buyers to love the "New California Glow." Id. That is, the opposed marks are not coined, but indeed are

intended to describe a particular community. The opposed marks are no more registerable than a development named “Manhattan Gardens” or “Chicago Towers” where the developer wanted to give the unit owner the feel of the City for which the development is named after. Additionally the 4 subdivisions within Laguna Lakes: Beverly Hills, Monterey, Santa Barbara and Pebble Beach are also geographic locations and not eligible for trademark status.

The cases cited by LLCA in support of its arguments that the proposed marks are not geographically descriptive are also not binding authority on this Board. Moreover, they are factually distinguishable from the case at bar. First, LLCA cites to the case of *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F.Supp. 1513 (S.D. Texas 1996). In the *Pebble Beach* case, Tour 18 challenged registration of the “PINEHURST” mark. *Id.* at 1538. This case clearly holds that “terms that are descriptive of a geographic location” can only be protected by the Lanham Act if they have achieved secondary meaning. *Id.* In *Pebble Beach*, the Court held in favor of the trademark holder because the term “Pinehurst” only obtained geographic connotation based upon the success of the resort and that the term had obtained secondary meaning. *Id.* None of these factors are present in this case or have even been argued by LLCA. The Laguna Lakes name is certainly not well-known based upon LLCA’s use and LLCA does not even argue that the term has obtained secondary meaning.

LLCA also cites to *Prestwick v. Don Kelly Building*, 302 F.Supp. 1121 (D. Md. 1969). In this case, a builder was sued by the owner of the TANTALON mark, to prevent Don Kelly from using the name “Tantalon Square.” Plaintiff

sought to enjoin builder's use of the mark, and builder defended, at least in part based upon geographic descriptiveness. *Id.* The Court held that the builder could be enjoined and that the mark was not geographically descriptive. But in that case, it appears the Court relied upon the fact that the Plaintiff had already spent considerable money in developing the registered mark, that the mark was not related to any geographic area in the United States and that the mark appears to have developed secondary meaning. *Id.* Thus, this case would also be inapplicable to the case at bar.

As set forth herein, registration of the proposed marks should be denied as they are geographically descriptive and LLCA has not proven any secondary meaning whatsoever.

Conclusion

Based upon all of the foregoing arguments, the registration of the opposed marks should be refused.

Certificate of Service

I HEREBY CERTIFY that a true and correct copy of the foregoing was furnished by electronic mail on this 5 day of October 2015 to: Donna M. Flammang, Esq., Brennan Manna & Diamond, P.L., 3301 Bonita Beach Road, Suite 100, Bonita Springs, FL 34134.

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