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

Proceeding	91210158
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I. INTRODUCTION

The purpose of this Reply Brief is to rebut the new arguments raised in Opposer, Larry Pitt's¹ Opposition to Applicant's Second Motion for Summary Judgment and respond to the arguments of Pitt's counsel. As will hereinafter be seen, Opposer has not established any genuine issue of material fact for trial. In addition, Opposer's arguments of law are without merit. For these reasons, summary judgment should be entered dismissing the opposition to the mark REMEMBER THIS NAME.

II. THE SUFFICIENCY OF A SPECIMEN IS NOT WITHIN THE PROVINCE OF THE BOARD

Pitt's opposition to the motion for summary judgment on the ground that applicant failed to submit with its application a specimen evidencing valid service mark use is completely without merit. Pitt argues that the specimen filed with the application shows use of INJURED? REMEMBER THIS NAME and not REMEMBER THIS NAME. However, whether a specimen is sufficient for showing use is a question for the Examining Attorney and not the Board. As set forth in *Century 21 Real Estate Corporation v. Century Life of America, dba Century Companies of America and Century Life of America*, 10 U.S.P.Q.2d 2034, 2035 (TTAB 1989):

The sufficiency of the specimens submitted with an application is a technical question which is within the province of the Examining Attorney to determine, and it is not within the function of this Board to supervise the Examining Attorney. *See Granny's Submarine Sandwiches v. Granny's Kitchen Inc.* [*2] , 199 USPQ 564, 567 (TTAB 1978); *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 642 (TTAB 1977). Even assuming applicant's specimens do not show service mark use but only trade name use, the applicant should not be penalized by the Examining Attorney's error in judgment, since any problem with the specimens might have been corrected had the Examining

¹ Opposer, Larry Pitt & Associates is referred to herein as either Opposer or Pitt.

Attorney made a request for new specimens. *See Granny's Submarine Sandwiches v. Granny's Kitchen, Inc., supra.*

Also, as is apparent from the specimen filed with the application, the mark REMEMBER THIS NAME is separable from and presents a distinct commercial impression apart from the word INJURED? and the words REMEMBER THIS NAME are capable of acting as a service mark alone. As set forth in the TMEP §807.12(d):

However, in a §1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

III. THERE IS NO GENUINE ISSUE OF MATERIAL FACT

In Lundy Law's Motion for Summary Judgment on the Amended Notice of Opposition, the undisputed material facts were set forth on pages 2-4. The first statement of fact by Lundy was that Lundy Law's use of the mark REMEMBER THIS NAME began on May 16, 2011. Since that time the mark has been used extensively and continuously by Lundy. This was "disputed" by Pitt at 5 as follows: "Applicant has put forth no evidence substantiating a date of first use or that this use was as a trademark in interstate commerce." Pitt's statement is directly contradicted by ¶4 of the Declaration of L. Leonard Lundy which states, "Lundy Law's use of the mark REMEMBER THIS NAME for legal services began on May 16, 2011. Since that time the mark has been used extensively and continuously by Applicant." Mr. Lundy also describes the advertisements shown in Exhibits 1-25A that are and have been used by Lundy Law. The Declaration of Magdalena Lozada, introduced as Exhibit 26, is a true and correct copy of the current file history of Application Serial No. 85/767,757 for the mark REMEMBER THIS

NAME that was downloaded from the USPTO on August 6, 2013 (see ¶5). The Declaration of Leonard Lundy states that REMEMBER THIS NAME was first used in commerce at least as early as May 16, 2011.

As to fact No. 2 that on October 31, 2012 Lundy Law filed Application Serial No. 85/767,757 with the USPTO to register on the Principal Register the mark REMEMBER THIS NAME for legal services in International Class 45, the fact was not disputed. Rather, what was disputed was that the statement is material. In this respect Opposer states “[t]he mere filing of the application purports to give the Applicant rights in a phrase as a trademark does not create trademark rights.” Pitt further goes on to state “at the time of the filing of the application third parties had been using REMEMBER THIS NAME, REMEMBER THIS NUMBER and the concept of memorability of law firm names was well known.” However, the evidence in this case shows that the only party using the mark REMEMBER THIS NAME was Lundy Law and the only party using the mark REMEMBER THIS NUMBER, at the time the application was filed, was Pitt. Pitt’s statement to the contrary is devoid of any support.

As to Statement of Fact 3, that A.S.N. 85/767,757 included as a specimen of Lundy’s use of the mark, a photograph of Lundy’s advertising prominently displayed on the back of a SEPTA bus.” Pitt does not dispute the fact rather it alleges that this “use of REMEMBER THIS NAME is incorporated within the phrase INJURED? REMEMBER THIS NAME which shows that the phrase does not function as a trademark. As set forth above in Section II hereof, this argument of Pitt is without merit.

With respect to Statement of Fact 4 that the REMEMBER THIS NAME application was published, it was not disputed, rather, its relevance was disputed.

With respect to Statement of Fact 5, that the USPTO found the mark REMEMBER THIS NAME to be inherently distinctive as evidenced by the fact that it was an application on the Principal Register that was published for opposition without a showing of acquired distinctiveness. Opposer did not state that fact was disputed. Rather, what Pitt states is that it is irrelevant. However, by virtue of the fact the mark has been passed to publication and this dispute arises in an opposition, it is Opposer's burden to show the mark should not be registered.

With respect to Statement of Fact No. 6, again, it was not disputed by Opposer, Pitt, rather the materiality of the fact was disputed.

With respect to Statement of Fact 7 that the REMEMBER THIS NAME mark is not the name or an acronym or initialization for legal services and it does not describe the quality, characteristic, function, feature, purpose or use of Applicant's legal services, Pitt's response was "Disputed." But again, Pitt disputes not the fact, but that the fact is relevant.

With respect to Statement of Fact 8, that "the USPTO routinely allows trademarks that are phrases or slogans on the Principal Register without a showing of acquired distinctiveness where the phrase or slogan is not descriptive of an Applicant's goods or services. Examples are shown in Exhibits 27-44." Again, the fact is not in dispute. Pitt merely asserts that the fact is not relevant.

Thus, as can be seen, Pitt has not provided any evidence that any of the facts upon which Applicant relied for Summary Judgment are in dispute. Accordingly Summary Judgment is appropriate because of the lack of dispute of any genuine issue of material fact.

IV. ARGUMENTS OF PITT'S COUNSEL AND TESTIMONY OF ITS MARKETING EXPERT AS TO LEGAL CONCLUSIONS ARE NOT ISSUES OF FACT

The arguments of Pitt's counsel do not create disputes of fact. In addition, there is no

support for the legal conclusions asserted by Opposer, Pitt. Raised throughout Pitt's arguments are assertions that the specimen filed with the application for registration of the mark REMEMBER THIS NAME shows only use of the mark "INJURED? REMEMBER THIS NAME". As set forth in Section II hereof, whether a specimen is sufficient is a technical question which is within the province of the Examining Attorney to determine and it is not within the function of this Board to supervise. In addition, Opposer argues that the object of legal advertising is to cause consumers to remember the name and phone number of the advertising firm. Assuming for the purposes of this motion that this statement is true, it does not follow that use of the words REMEMBER THIS NAME for advertisements for legal services is either required or a common use for law firms. The Board has already rejected in its opinion of October 31, 2014, the Opposer's assertion that the words REMEMBER THIS NAME are either generic or descriptive. A review of third party advertising for law firms attached to the Declaration of Ross Fishman shows only that firm names are used in these ads, the telephone numbers of the firm are included. But notably missing from all of the legal service advertisements of third parties are the words REMEMBER THIS NAME. Thus, what is common when firms wish to have consumers remember the name of their firm is advertising with the name of the firm and its phone number. It is unique to use the phrase "REMEMBER THIS NAME" in addition to the name of the firm and the phone number.

Throughout its argument, Pitt states that REMEMBER THIS NAME is an ordinary slogan, "especially when used after the word Injured?" However, Pitt has shown no evidence whatsoever that there was any other law firm using REMEMBER THIS NAME prior to its use by Applicant, Lundy Law. The only argument that Pitt makes is that at the time of the filing of the application to register the mark REMEMBER THIS NAME by Applicant, he had begun to

use the phrase REMEMBER THIS NUMBER. Accordingly, the crux of Pitt's attorney's arguments, that REMEMBER THIS NAME is common, is completely without merit.

At page 10 of Pitt's Opposition Memorandum, Pitt refers to the Expert Report of Ross Fishman at pgs. 5-6 which is quoted for the legal conclusion that "Consumers simply do not perceive the phrase REMEMBER THIS NAME as a source indicator." However, as set forth in the Opinion of the Board in this case, dated October 31, 2014, Mr. Fishman's qualifications, as set forth in his expert witness report, "do not qualify him to testify as an expert in trademark law," pg. 5, Note 4.

Pitt also asserts that "Whether a mark fails to function as a trademark hinges on consumer perception." Citing *In re Eagle Crest, Inc.* 96 USPQ 2d 1227, (TTAB 2010). However, the full statement of the TTAB in *In re Eagle Crest, Inc.*, 96 USPQ 2d at 1229 is as follows:

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. **To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.** See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). (Emphasis added.)

This statement is also cited in *In re Thomas J. Hulting d/b/a No More RINOs! Enterprises*, 107 USPQ2d 1175, 1177 (TTAB 2013).

When looking at how the mark REMEMBER THIS NAME is used, an examination of the specimen filed in the REMEMBER THIS NAME application and the Lundy Law advertisements of record, it can be seen that the mark REMEMBER THIS NAME is used as a service mark for legal services to identify the source of the mark. This is seen in not only the specimen of record in the prosecution history of the REMEMBER THIS NAME application, but also in the ads attached to the Declaration of Leonard Lundy, which accompanies the Motion for

Summary Judgment, to authenticate the advertisements used by Applicant. The objection of Pitt to the Declaration of Leonard Lundy is completely without merit. Rule 901 (b)(1) of the Federal Rules of Evidence (FRE) is as follows:

Rule 901. Authenticating or Identifying Evidence

(a) In General. To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.

(b) Examples. The following are examples only — not a complete list — of evidence that satisfies the requirement:

- (1) Testimony of a Witness with Knowledge. Testimony that an item is what it is claimed to be.

The Declaration of Leonard Lundy authenticates what is shown in each of the photographs attached. Accordingly, how the mark has been used is authenticated by Mr. Lundy in his declaration and his testimony at deposition. As Mr. Lundy testified throughout the deposition, he was familiar with the type of advertisements that were shown in the photos attached to his declaration. The mere fact that he did not recall who took the photos is not in any way relevant to the authenticity of the scenes depicted in the photographs. In *The State of Arizona vs. Asarco, L.L.C.* 844 F. Supp. 2d 957, 979 (D. Ariz 2011) the Court described what is necessary under FRE 901 to authenticate what is depicted in a photo as follows (at 979):

The photographs are properly authenticated, within the meaning of Rule 901, if the evidence is sufficient to support a finding that they are photographs of graffiti in the portable toilets taken at about the time that Aguilar and Ms. Saenz say that they saw such graffiti. See *Lucero v. Stewart*, 892 F.2d 52, 55 (9th Cir. 1989) (holding that, to authenticate a photograph, the proponent must only identify the scene itself and its coordinates in time and place); *People of the Territory of Guam v. Ojeda*, 758 F.2d 403, 408 (9th Cir. 1985) ("Under the Federal Rules [of Evidence 901(b)], the witness identifying the item in a photograph need only establish that the photograph is an accurate portrayal of the item in question.");

United States v. Brannon, 616 F.2d 413, 416 (9th Cir. 1980) (holding that evidence that photographs accurately depicted events in a bank during a robbery was sufficient foundation to admit the photographs).

With respect to the discovery abuses alleged by Applicant, pursuant to the stipulation of the parties and the Order of the Board, Applicant will file its Opposition to Pitt's Motion for Sanctions of Discovery Abuses and its Request for Removal of the Highly Confidential Designation for the Sortman Deposition, by no later than October 29, 2015 as ordered by the Board. For the purpose of the Motion for Summary Judgment on the Amended Notice of Opposition, it suffices to state that there is not only no relevant facts that were sought by Pitt's counsel by taking the deposition of Tami Sortman, Applicant did not at any time instruct Ms. Sortman to not answer a relevant question.

Accordingly, Opposer has failed to show that there is a dispute of any material fact in this case, it has failed to show that the term REMEMBER THIS NAME is a common ordinary term used in legal advertising and has failed to satisfy its burden to prove the mark REMEMBER THIS NAME is not being used as a service mark. Therefore, the Opposition should be dismissed.

V. CONCLUSION

In light of the foregoing, it is respectfully submitted that Summary Judgment is appropriate where there are no material issues in dispute and the Opposer has not produced evidence that the mark REMEMBER THIS NAME is not being used as a mark for legal services. Nor has Pitt shown that REMEMBER THIS NAME was commonly used in the legal services field now or was at the time registration was sought. Pitt's conclusory statements that the mark REMEMBER THIS NAME has not been used as a service mark are clearly without merit and should be rejected and Summary Judgment granted to dismiss the Opposition.

Respectfully submitted,

CAESAR RIVISE, PC

Dated: October 15, 2015

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CERTIFICATE OF MAILING

The undersigned hereby certifies that the within APPLICANT, LUNDY LAW'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON THE AMENDED NOTICE OF OPPOSITION is being electronically filed with the Trademark Trial and Appeal Board, via the Electronic System for Trademark Trial and Appeals (ESTTA) on this day, October 15, 2015.

 /MPokotilow/
Manny Pokotilow

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on this same day, the within APPLICANT, LUNDY LAW'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON THE AMENDED NOTICE OF OPPOSITION is being served upon Opposer, via First Class Mail in an envelope addressed to:

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