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

Proceeding	91213413
Party	Defendant M Webb, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MAPPIN & WEBB, LIMITED)	
)	Opposition No. 91213413
Opposer,)	
)	
v.)	Application Serial No. 85/460569
)	
M WEBB, LLC)	For the Mark M WEBB
)	
Applicant.)	

APPLICANT’S RESPONSE TO OPPOSER’S OBJECTIONS

Pursuant to the Board’s August 8, 2015 Order, Applicant M Webb, LLC (“M Webb”) files this Response to Opposer Mappin & Webb, Limited’s (“Opposer”) evidentiary objections.

I. OBJECTIONS REGARDING EXPERT TESTIMONY

Throughout Opposer’s objections, it reiterates that neither Randy Kercho nor Marissa Webb is qualified as an expert, requesting exclusion of their testimony on that basis. Neither witness is proffered as an expert witness, of which Opposer is well aware given that the parties stipulated to forego presentation of expert testimony. (Stipulation for Accelerated Case Resolution [“ACR Stip.”] ¶ 1.) As detailed below, each witness’ testimony is rationally based on his or her own perception, helpful to determining a fact in issue, and not within the exclusive province of expert witness testimony under Rule 702 of the Federal Rules of Evidence. FED. R. EVID. 701. These objections should be “overruled inasmuch as it is obvious that [each] witness was not testifying as an expert on the matters on which [each] expressed his [or her] opinions.” *Califon Productions, Inc. v. Bob Stupak*, 2004 WL 390937, at *2 n.9 (TTAB Feb. 26, 2004) (non-precedential).

II. OBJECTIONS REGARDING LAY TESTIMONY

Opposer asserts common objections against the testimony of Mr. Kercho and Ms. Webb on the basis that their fact testimony and/or lay opinions regarding the dissimilarity of the marks at issue and the absence of actual confusion are impermissible legal conclusions. (Opp.'s Objections, Kercho ¶¶ 4, Webb ¶¶ 16-20.¹) Opposer also commonly asserts that fact testimony and/or lay opinions regarding perception of the marks at issue, the reputations of Ms. Webb and Opposer, and common practices in the fashion industry are inadmissible under Rules 602 and/or 701 of the Federal Rules of Evidence. (*Id.*, Kercho ¶¶ 5, 8, 10-11, 14-26, Webb ¶¶ 6, 8, 14-15, 18.) As a threshold matter, neither witness testifies to the ultimate issue of likelihood of confusion. (*See generally* Kercho. Decl.; Webb Decl.) Rather, they offer their lay testimony as fashion consumers, company executives, and long-standing figures within the fashion industry as to (1) the dissimilarity of the marks at issue; (2) likely and actual abbreviations of the marks at issue; (3) their perceived uniqueness of the surnames included in the marks at issue; (4) their own behaviors in abbreviating brands; (5) their perception of "M WEBB" as identifiable with "Marissa Webb"; (6) whether they themselves would associate certain abbreviations with either party; (7) their personal experience with branding conventions within the fashion industry; (8) the reputations of Marissa Webb and Opposer within the fashion industry; and (9) the absence of actual confusion to their knowledge, among other subjects.² (*Id.*) Both Mr. Kercho and Ms.

¹ References to Opposer's Objections correspond to the objected-to paragraph and/or exhibits in the Declaration of Randy Kercho ("Kercho"), the Declaration of Marissa Webb ("Webb"), and the Declaration of David Diamond ("Diamond") cited in Opposer's Objections (e.g., (Opp.'s Objections, Kercho ¶¶ ____, Webb ¶¶ ____.)).

²The parties have stipulated that "Opposer and Applicant are not aware of any instances of any actual confusion between each other's marks," which moots much of Opposer's objections to testimony regarding absence of actual confusion. (Factual Stipulations for Accelerated Case Resolution ¶ 11.)

Webb establish adequate foundation to testify on these subjects, and these subjects are either issues of fact or permissible lay opinions.³ (Kercho Decl. ¶¶ 2-11, 15-23; Webb Decl. ¶¶ 2-4.)

The fact that both witnesses are affiliated with M Webb does not preclude their testimony or wholly eviscerate its evidentiary weight. *See Taiwan Semiconductor Manuf. Co., Ltd.*, 2010 WL 1791171, at *3 (overruling applicant’s Rule 701 objection to opposer’s employees’ lay opinion testimony that “members of the relevant public could be misled into associating applicant with opposer due to the alleged similarities between the parties’ marks”). Opposer’s own authority is inapposite in that it addresses testimony on the ultimate issue, lay opinion testimony for which the witness had no personal knowledge, or whether testimony suffices to establish “fame” and the legal significance that term carries.⁴ None of these issues are present here, and in the *Wolverine Outdoors* decision on which Opposer frequently relies, the Board in

³ *See Cold Steel, Inc. v. Escobar*, 2014 WL 4381095, at *3 (TTAB Aug. 22, 2014) (non-precedential) (holding lay testimony of company officer on prevailing norms for retail industry had adequate foundation where officer was personally involved in all of the company’s significant marketing and promotional activities and was familiar with other retailers in the field); *Miller v. Miller*, 105 U.S.P.Q.2d 1615, 1618 (TTAB 2013) (overruling hearsay and personal knowledge objections to party officer and third party declarations regarding surname usage and related Google searches); *Taiwan Semiconductor Manufacturing Co., Ltd. v. Semiconductor Manufacturing International (Shanghai) Corp.*, 2010 WL 1791171, at *3 (TTAB Feb. 9, 2010) (non-precedential) (admitting lay opinion testimony that “members of the relevant public could be misled into associating applicant with opposer due to the alleged similarities between the parties’ marks”); *High Sierra Food Services, Inc. v. Lake Tahoe Brewing Company, Inc.*, 2003 WL 21206252, at *2 (TTAB May 14, 2003) (non-precedential) (admitting lay testimony about what a particular area was “not known for” and noting “[m]ost courts have permitted the owner or officer of a business to testify on various aspects of the business without qualifying the witness as an expert in various fields, and such opinion testimony is admitted not because of experience, training or specialized knowledge within the realm of an expert, but because of the particularized knowledge that the witness has by virtue of his or her position in the business”) (quotations omitted).

⁴ *Quaker Oats Co. v. St. Joe Processing Co.*, 232 F.2d 653, 655 (CCPA 1956) (“we deem it necessary to comment on the weight to be given the witnesses’ opinions that the marks would be likely to cause confusion”); *Varian Associates, Inc. v. Leybod-Heraeus Gesellschaft mit Beschränkter Haftung*, 219 U.S.P.Q. 829, 832 (TTAB 1983) (noting that witness testimony on ultimate issue of likelihood of confusion “has very little, if any, probative value”); *In-N-Out Burgers v. Peak Harvest Foods, LLC*, 2008 WL 4674604, at *4 (TTAB Sept. 29, 2008) (non-precedential) (witness testimony had “no probative value” when witness “did not testify from personal knowledge, nor was he qualified as an expert”); *Pitonyak Mach. Corp. v. Brandt. Indus.*, 2010 WL 1619442, at *3 (TTAB Apr. 5, 2010) (non-precedential) (“Given the great deference that is given to a famous mark, one asserting that its mark is famous must clearly prove it. . . . [T]he testimony of opposer’s president that its mark is ‘well known’ is self-serving and does not establish the fame of the mark.”); *Optimize Techs., Inc. v. Wicom GmbH*, 2006 WL 2927856, at *5 (TTAB Sept. 28, 2006) (non-precedential) (“[Witness] has offered only self-serving and unsupported testimony that opposer has established goodwill in its marks and a reputation in the industry, . . . [t]his evidence is far from sufficient to establish fame”).

fact admitted lay opinion testimony on common industry practice, comparison of the marks at issue, and whether the marks were confusingly similar. *Wolverine Outdoors, Inc. v. Marker Volkl GMBH*, 2013 WL 5655832, at *5 (TTAB Sept. 30, 2013) (non-precedential). While the Board may afford these witnesses' testimony the weight it deems fit, none of Opposer's objections warrant its wholesale exclusion or the negation of all evidentiary weight.

III. OBJECTIONS REGARDING THE NAME & MARK "MARISSA WEBB"

Opposer asserts a blanket relevance objection to testimony and evidence regarding the MARISSA WEBB mark and recognition of Ms. Webb and the MARISSA WEBB mark. (Opp.'s Reply ACR Brief at 23; Opp.'s Objections, Kercho ¶¶ 12-13, Webb ¶¶ 8-13, 20, Exs. 1-23.) As M Webb argues in its Main ACR Brief, Ms. Webb's personal name, her MARISSA WEBB mark, and the M WEBB mark create a continuing commercial impression within the U.S. fashion marketplace. (M Webb's Main ACR Brief at 26-27.) This continuing commercial impression and the absence of actual confusion among Opposer, its marks, Ms. Webb, and the MARISSA WEBB mark are germane for the Board's consideration. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q.2d 1645, 1660-61 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011) (finding absence of actual confusion probative where applicant made prior use of its design registrations that were materially different from its pending application at issue, but which shared a common dominant element and created the same commercial impression). Opposer's only cited authority, *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 U.S.P.Q. 1022 (TTAB 1983), does not address this issue and therefore is not instructive on the admissibility of this evidence. The testimony and exhibits regarding Ms. Webb and the MARISSA WEBB mark are relevant to this proceeding, and Opposer's objection should be overruled.

IV. OTHER SPECIFIC OBJECTIONS

To the extent Opposer's other evidentiary objections are not addressed above, M Webb responds as follows:

A. Opposer's Objections to the Declaration of Randy Kercho

Paragraphs 5, 8: Opposer attempts to improperly cabin Mr. Kercho's personal knowledge by objecting to his testimony regarding Marissa Webb's motivations in launching her MARISSA WEBB brand and the reasoning and motivations for selecting the M WEBB mark. Mr. Kercho testified that he, as part of Bedrock Brands I, LLC, invested in the MARISSA WEBB brand and that he personally assisted Ms. Webb "in completely organizing her company, including, but not exclusive to, legal formation [and] trademarks," and was "closely involved with Marissa in the selection of the company name," as well as in the selection of the MARISSA WEBB and M WEBB marks. (Kercho Decl. ¶¶ 5-6, 8-9.) As an initial investor and one integrally involved in the formation of Ms. Webb's company, Mr. Kercho had personal knowledge of Ms. Webb's motivations for creating her brand. His role in the launch of the company is a sufficient foundation for his personal knowledge of Ms. Webb's motivations for starting her brand. Regarding the selection of the M WEBB mark, Opposer objects to Mr. Kercho's testimony that the mark "was chosen because it was immediately identifiable as an abbreviation of Marissa Webb's name" as lacking in foundation and impermissible as lay opinion testimony under Rule 701. But Mr. Kercho's own reasoning and perceptions, and those of his team, in selecting the M WEBB mark are well within his personal knowledge.

Mr. Kercho's fact testimony does not rise to the level of lay opinion, and even if it did, it would satisfy the requirements of Rule 701. *See Cold Steel, Inc.*, 2014 WL 4381095, at *3 (holding lay testimony of company officer on prevailing retail norms had adequate foundation

where officer was personally involved in all of the company's significant marketing and promotional activities and was familiar with other retailers); *High Sierra Food Services, Inc.*, 2003 WL 21206252, at *2 (“Most courts have permitted the owner or officer of a business to testify on various aspects of the business without qualifying the witness as an expert in various fields, and such opinion testimony is admitted not because of experience, training or specialized knowledge within the realm of an expert, but because of the particularized knowledge that the witness has by virtue of his or her position in the business.”) (quotations omitted). Opposer’s objection should thus be overruled.

Paragraphs 15-24, Exs. 2-18: Opposer objects to Mr. Kercho’s testimony and exhibits regarding likely abbreviations within the fashion industry, recognized abbreviations of the marks at issue, the relative frequency and weakness of surnames included in the marks at issue, and government publications and internet materials related to these subjects. As a threshold matter, this testimony is within his personal knowledge and within the province of admissible lay opinion testimony under Rule 701. *See Cold Steel, Inc.*, 2014 WL 4381095, at *3; *Wolverine Outdoors, Inc.*, 2013 WL 5655832, at *5 (admitting lay opinion testimony on common industry practice, comparison of the marks at issue, and whether the marks were confusingly similar). The Board may of course afford this testimony the weight it deems appropriate, but Opposer’s objections are not grounds for its wholesale exclusion.

Opposer further requests that Exhibits 2-18 be stricken because they “are offered only in support of Kercho’s improper opinions.” First, much of these internet materials and official publications are the very types of evidence normally submitted through notice of reliance, but the ACR framework for this proceeding allows that they be submitted through witness declarations. *See TBMP* § 704.08(b). (ACR Stip. ¶ 4.) Their exclusion based on the nature of Mr. Kercho’s

testimony therefore would be inconsistent with ACR procedure.⁵ Second, these materials are relevant on their face to demonstrate the prevalence of certain surnames, and apart from the official U.S. Census data otherwise excepted from hearsay, these exhibits are not submitted for the truth of the matters asserted therein. In *Miller v. Miller*, the Board admitted highly similar evidence of Google search results, U.S. Census data, Yellow Pages listings, and accompanying testimony regarding the prevalence of the surname “Miller.” 105 U.S.P.Q.2d 1615, 1618-20 (TTAB 2013). As in *Miller*, such evidence is admissible and germane to this proceeding, and Opposer’s objections should be overruled.

Opposer further objects to the U.S. Census data submitted in Exhibits 4-6 as inadmissible hearsay, and objects in its Reply ACR Brief that this data does not reflect the current population. (Opp.’s Reply ACR Br. at 13 n.7.) As a publication of the U.S. Census Bureau, the “Top 1000 Names” from the 2000 Census is an official public record for which Opposer has not shown any lack of trustworthiness, and therefore it is excepted from hearsay. FED. R. EVID. 803(8); TBMP § 704.07. The printouts from the U.S. Census Bureau website are provided to lay the foundation for the governmental source of the “Top 1000 Names” file and to provide Opposer the opportunity to verify these exhibits as is appropriate under the TBMP.⁶ See TBMP § 704.08(b). This U.S. Census data was recognized by the Board in *Miller* as “[t]he most relevant evidence on the question of how rare (or common) MILLER is as a surname” after being submitted into evidence in a similar manner. 105 U.S.P.Q.2d at 4. Opposer is therefore incorrect that no hearsay exception applies, and this evidence should be admitted by the Board, as it has done before.

⁵ Though, as noted above, Mr. Kercho’s testimony is nonetheless admissible.

⁶ Though Opposer criticizes that this data is from the 2000 Census, it is the most recent data of its kind made publicly available by the U.S. Census Bureau on the internet, as Mr. Kercho testified. (Kercho Decl. ¶ 18.) Notably, Opposer offers no argument that the surname “Webb” has become *less* common in the interim. In any event, this U.S. Census surname data remains relevant as the most recent such data ostensibly available.

Paragraph 17: Opposer objects to Mr. Kercho’s testimony on the basis that it purportedly implies that M WEBB is a recognized acronym for Applicant and its designer Marissa Webb. To illustrate that a search for “M Webb” results in a general Google search on the *All Acronyms* website, Opposer provides a screenshot of this search that tracks with the appearance of Exhibit 3 to Mr. Kercho’s declaration cited in the objected-to averment, including the plainly visible language “Google custom search” and results similar to a search on <google.com>, which unambiguously contrasts with the appearance of the *All Acronyms*’ result for a recognized acronym. (*Compare* Kercho Decl. Ex. 2 *with* Opp.’s Objections, Kercho ¶ 17 *and* Kercho Decl. Ex. 3.) M Webb certainly does not fault Opposer for emphasizing the very point of Mr. Kercho’s testimony – that “M Webb” is not a recognized acronym for Opposer’s Marks – but Opposer needlessly belabors the nature of the search results that are transparently submitted in Exhibit 3 to Mr. Kercho’s declaration.

B. Opposer’s Objections to the Declaration of Marissa Webb

Paragraphs 6, 8, 18: Ms. Webb’s testimony on how she is known and identifies herself is patently within her own personal knowledge. Indeed, few issues can fall more squarely within a witness’s personal knowledge than her own identity and how others refer to her.⁷ Similarly, her testimony about why she selected her mark and how she is identified by others are legitimate factual statements and opinions within the province of Rule 602 and 701 of the Federal Rules of Evidence. *See High Sierra Food Services, Inc.*, 2003 WL 21206252, at *2. Her estimation of her reputation in her industry is likewise squarely within the province of lay opinion testimony, and a witness’ knowledge of a subject as intimate as her own identity and reputation is readily

⁷ Opposer also mischaracterizes Ms. Webb’s testimony, objecting to her purported testimony that she “is known by the initial ‘M’ in the marketplace.” (Opp.’s Objections, Webb ¶ 6.) Ms. Webb’s testimony did not include the specific language “in the marketplace,” though it would have been within her personal knowledge and proper lay testimony to have done so.

distinguishable from *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, in which the Board sustained objections to a witness' opinion of consumer perception of the cigarette brand RICH LIGHTS. 230 U.S.P.Q. 172, 175 (TTAB 1986). The Board may of course afford the weight to this testimony it deems appropriate, but in no event should this testimony be excluded.

C. Opposer's Objections to the Declaration of David Diamond

Exhibits 21-23: Opposer is simply misleading in its objection to the inclusion of TESS printouts of Opposer's existing applications and cancelled registration. In paragraph 8 of the Declaration of David Diamond, he transparently delineates that the chart of TESS printouts that follows his averment includes three distinct types of TESS evidence, and he certainly does not conflate Opposer's applications and canceled registration with the group of fifteen (15) third-party registrations and applications that precede them. In its Main ACR Brief, M Webb specifically omits Exhibits 21-23 from the evidence cited in support of its statement regarding third-party marks. (M Webb Main ACR Br. at 13.) Opposer again attempts to manufacture controversy where none exists, and its objection to the use of these exhibits should be overruled.

Exhibits 24, 27-29: M Webb's evidence of foreign websites using "Webb" surname marks is probative of U.S. consumers' exposure to this surname and the relative trademark weakness of the surname within the classes of goods at issue, and these websites are indeed accessible from the United States. Opposer's authority is inapposite in that it addresses the sale of insurance goods in the case of *In re Max Capital Group*, in which the Board deemed it unlikely that U.S. customers would be aware of European purveyors of such services, and in the *In re Canada Enterprises* decision, the Board deemed foreign internet evidence to have no probative value for a case turning on the U.S. pronunciation of a certain word. *In re Max Capital Group Ltd.*, 93 U.S.P.Q.2d 1243, 1245 (TTAB 2010); *In re Canada Enters., LLC*, 2013 WL

5498161, at *4 (TTAB Sept. 27, 2013) (non-precedential). Insurance services and domestic pronouncement are a far cry from the sale of consumer goods such as jewelry and clothes at issue here. Opposer's objection should be overruled.

V. CONCLUSION

For the foregoing reasons, Applicant M Webb, LLC respectfully requests that the Board overrule Opposer Mappin & Webb Limited's evidentiary objections.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 12th day of September, 2015, a true and correct copy of the foregoing document was served upon Opposer through its counsel of record, Douglas A. Rettew, via U.S. First Class Mail, postage prepaid, to the following address:

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