

ESTTA Tracking number: **ESTTA673514**

Filing date: **05/21/2015**

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

Proceeding	91213584
Party	Defendant Toys Tekk
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Date	05/21/2015
Attachments	Opp.MSJ.Redac.pdf(85760 bytes)

Serial No. **85867803**

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

Jaguar Land Rover Limited,)	
)	Serial No. 85867803
Opposer,)	Opposition No. 91213584
)	
v.)	
)	
Toys Tekk Corporation,)	
)	
Applicant.)	

**APPLICANT’S OPPOSITION TO OPPOSER’S
MOTION FOR PARTIAL SUMMARY JUDGMENT**

Applicant, Toys Tekk Corporation, (“Applicant”), hereby opposes Opposer JLR’s Motion for Partial Summary Judgment (“Motion”):

1. The incontestability is irrelevant to a motion for abandonment. Even if a mark is incontestable, it can be adjudicated as abandoned.

2. There are abundant evidence in support of Applicant’s request for an order of abandonment, and as a minimum, material facts exist on whether Opposer abandoned the LAND ROVER mark on toys.

WHEREFORE, Applicant respectfully requests the Board to deny Opposers’ Motion.

Dated: May 15, 2015

Respectfully submitted,

By: /Shun C. Chen/
Shun C. Chen
Attorney for Applicant

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Toys Tekk Corporation,)	
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**BRIEF IN SUPPORT OF APPLICANT’S OPPOSITION TO
MOTION FOR PARTIAL SUMMARY JUDGMENT (redacted)**

I.

INTRODUCTION

The Motion only presented argument on the abandonment of LAND ROVER mark and did not present any fact and/or argument on RANGE ROVER mark. Opposer misinterpreted the notice of the Board dated January 30, 2014. The Board did not issue any notice to dismiss the counterclaim ‘825, nor a deadline to remit additional fee. Applicant will contact the Board to remit the additional fee. Throughout discovery, Opposer did not raise this issue, and fully participated in discovery on the mark RANGE ROVER.

From the outset, Opposer did not engage in any advertising and/or marketing on toys. Rather, Opposer seeks to mislead the Board by seeking to sneak in the expenditure on LAND

ROVER passenger vehicles to disguise as the expenditure on toy vehicles.

Opposer admitted it did not manufacture, market and sell any toys with LAND ROVER mark in the United States. Therefore, Opposer admitted it did not meet the “use” requirement on its LAND ROVER mark.

Rather, Opposer argued it licensed the LAND ROVER mark to a German company, Bruder, who had worldwide authority to market toys bearing LAND ROVER mark. Other than speculation, and legal conclusion, which are subject of Applicant’s evidentiary objection, Opposer did not present any evidence of any other licensee that purportedly used the LAND ROVER mark. Applicant further opposes Opposer to present any more evidence in its reply, because Applicant has no opportunity to rebut. Applicant also opposes Opposer to present any evidence that were not disclosed during discovery.

As to Bruder, there is no evidence it manufactured, marketed, and distributed any toy bearing LAND ROVER mark in the United States. The single evidence, a web page, is objectionable on the ground of lack of foundation, speculation, and legal conclusion, because there is no evidence presented the webpage ad was connected with Bruder, and there is absence of prior approval of licensor before Bruder could advertise on Internet. There is no competent evidence Opposer derived any profit from licensing for sales in the United States. In the purported license agreement, there are many mandatory reporting, but none was produced, because they do not exist.

Moreover, the “quality control” provision in the Bruder’s licensing agreement is merely boiler-plate. There is no evidence on any act performed, mandated by Section 6, by either licensor, and/or licensee. Therefore, it is a classical case of “naked” licensing.

The mark LAND ROVER has become generic, because there were endless “counterfeiters,” and Opposer did nothing.

Any evidence of use is within Opposer’s exclusive possession. When Opposer failed to produce any such evidence during discovery, nor any evidence in its Motion, the only logical conclusion is such evidence does not exist. Opposer did not use the mark required for maintaining its mark under the Lanham Act.

The only alleged licensee, Bruder, did not provide any declaration on how it marketed and/or distributed the licensed product in U.S., because no such marketing and/or distribution took place.

II.

ARGUMENT

A. STANDARD ON PARTIAL SUMMARY JUDGMENT:

Summary judgment is a drastic remedy and is therefore to be granted cautiously. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 2513-2514 (1986). When the application of a rule of law depends on resolution of underlying disputed historical facts, the cause of action must go to trial. *McDermott Int’l, Inc. v. Wilander*, 498 U.S. 337, 356, 111 S. Ct. 807, 818 (1991). The court must view the evidence presented on the motion in the light most favorable to the opposing party. “The evidence of the non-movnat is to be believed, and all justifiable inferences are to be drawn in his favor.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 255, 106 S. Ct. 2513.

As a moving party to seek summary adjudication on the use of the mark, the moving party

has to produce sufficient evidence to establish continuous use, and no reasonable trier of fact could find other than for the moving party. *Southern Calif. Gas Co. V. City of Santa Ana*, 336 F.3d 885, 888 (9th Cir. 2003).

In addition, at summary judgment stage, courts focus on admissibility of the evidence's content, not its form. *Fraser v. Goodale*, 342 F.3d 1032, 1036 (9th Cir. 2003); *Celotex Corp. v. Catrett*, 477 U.S. 317, 324, 106 S.Ct. 2548, 2553 (1986). Therefore, a declaration is properly considered when the declarant has personal knowledge, set forth facts that would be admissible in evidence, and show the declarant is competent to testify on the matters stated. FRCP 56(c)(4).

B. LAWS ON ABANDONMENT:

Abandonment is a complete defense to a charge of trademark infringement, even if the federally registered trademark is incontestable. 15 U.S.C. §1115(b)(2).

15 U.S.C. §1127 provides:

A mark shall be deemed to be 'abandoned' if either of the following occurs:

(1) when its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of such mark in the ordinary course of trade, and not merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or service on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph."

Grocery Outlet, Inc. V. Albertson's, Inc., 497 F.3d 949, 951, 83 U.S.P.Q. 2d 1949 (9th Cir. 2007).

B. OPPOSER FAILED TO SHOW USE, AND ANY EVIDENCE CONCERNING USE HAS FACTUAL DISPUTE:

Opposer relied exclusively on licensing to show use. "Use" of a trademark means the bona fide use of that mark in the ordinary course of trade, not a token use and not merely to reserve a right in the mark. Therefore, a salesman sold some samples on hand does not constitute continuation of use. *Uncas Mfg. Co. V. Clark & Coombs Co.*, 309 F.2d 818, 135 U.S.P.Q. 282 (1st Cir. 1962). Failure to sell trademarked cars in the U.S. for eight years constituted abandonment despite proof that, during this time, the car maker sold replacement parts in the U.S. *Shelby v. Ford Motor Co.*, 28 U.S.P.Q. 2d 1471 (C.D. Cal. 1993).

Opposer merely presented a licensing agreement to a German company, Bruder. Opposer presented no evidence that Bruder engaged in any U.S. sale of any toy vehicle bearing LAND ROVER. The royalty rate is —, (JLR000789), Opposer presented no evidence that Bruder paid any royalty to Opposer, based on U.S. sales. Needless to say, any sale outside U.S. is irrelevant.

Opposer failed to present the Royalty Report mandated by the licensing agreement, because no sales in U.S. (JLR000797.)

Opposer failed to produce any sample of licensed products pursuant to Section 6.2, because no licensed product was ever made for the U.S. market. (JLR000799.)

Opposer failed to produce any document on inspection of licensee's premises, pursuant to Section 6.7, because no such inspection took place. (JLR000800.)

Opposer failed to produce any document on first ship date of licensed product pursuant to

Section 6.11, because no such sale to the U.S. market took place. (JLR000801.)

Opposer failed to produce any sample that the licensee's name, trade name and licensee's address on licensed product pursuant to Section 6.12, because no such product entered into the U.S. market. (JLR000801.)

Opposer failed to produce any business plan pursuant to Section 6.14, because there is no business plan showing sales to the U.S. market. (JLR000801, JLR000820.)

Opposer failed to produce any projected sales pursuant to Section 6.15, because there is no projected U.S. sales. (JLR000802.)

Opposer failed to produce any document on Bruder's marketing and distributing of licensed product in the U.S. market pursuant to Section 9.1, because such marketing and distributing did not take place. (JLR000804.)

Opposer failed to produce prior written on any website posting on Internet pursuant to Section 10.1, because Opposer never approved any such posting. (JLR000805.)

Opposer failed to produce any evidence on who manufactured, and/or distributed any licensed product in U.S., nor the approval of any third-party manufacturing and distribution, pursuant to Section 11.1, Exhibits D and E, because the licensed product was never marketed and/or distributed in the U.S., since Opposer is a British company and the purported licensee is a German company, both located in the Europe and not even in American continent. (JLR000806, JLR000823-827.)

Opposer failed to produce any mandatory records kept by licensee on "all transactions relating to [the licensing] Agreement," which must be kept for 6 years and readily accessible by licensor "within forty-eight (48) hours," pursuant to Section 13.1, because there was no

marketing and/or distribution of any licensed product in the U.S. (JLR000807.)

Opposer failed to produce any mandatory records kept by licensee on “all transactions relating to [the licensing] Agreement,” which must be kept for 6 years and readily accessible by licensor “within forty-eight (48) hours,” pursuant to Section 13.1, because there was no marketing and/or distribution of any licensed product in the U.S. (JLR000807.)

Opposer failed to produce any evidence of payment by Bruder to Opposer, nor any audit record pursuant to Section 13.2, because there was no payment at all since there was no marketing and/or distribution of any licensed product in the U.S. (JLR000807.)

Opposer failed to produce any (vital) Annual Trademark Report, mandated by Section 13.1, because there was no marketing and/or distribution of any licensed product in the U.S. (JLR000808.)

Opposer failed to produce any quarterly Royalty Report mandated by Exhibit C of the purported Agreement. (JLR000818.)

Likewise, Opposer failed to produce any evidence on the compliance with the purported license agreement (JLR000752 to JLR000786), with similar and/or identical terms in JLR000787 to JLR000828.

Opposer failed to present evidence that the Amazon website posting was from Bruder, which is a German company, failed to produce prior approval of such posting, and failed to provide a sample showing the names, trade name and licensee’s address on licensed product. Clearing inventory does not constitute use. *Uncas Mfg. Co. V. Clark & Coombs Co.*, 309 F.2d

818, 135 U.S.P.Q. 282 (1st Cir. 1962).

Opposer failed to meet the definition of “use in commerce.” 15 U.S.C. §1127 defines “use in commerce” as “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” When applied to goods, the mark must be “placed on the goods..., and the goods are sold or transported in commerce.” *General Healthcare, Ltd. v. Qashat*, 364 F.3d 332, 335, 70 U.S.P.Q. 2d 1566 (1st Cir. 2004).

Opposer’s business is in selling passenger vehicles, and not toy vehicles. Opposer never affixed the mark on any toy vehicle, which were sold or transported in commerce. According to the Board’s record, Opposer first registered its mark in 1980. For 35 years, Opposer never used the mark in U.S. The intent not to resume is implied and obvious. Even after Opposer filed this opposition, and after Applicant’s Counterclaim for abandonment, Opposer did not bother to use the mark.

Opposer’s 80 page plus annual report, in Exhibit “A,” produced during discovery, does not mention sale of toy vehicles at all. The registration is merely for the sole purpose of seeking to reserve its name.

C. OPPOSER ABANDONED THE MARK THROUGH LOSS OF TRADEMARK SIGNIFICANCE:

The second situation for abandonment in 15 U.S.C. §1127 to render the mark generic does not require intent. *Barcamerica Int’l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596 (9th Cir. 2002). Rather, it is shown through omission and/or commission. There are two

reasons the second situation is satisfied in this case:

1. OPPOSER COMMITTED CLASSIC “NAKED” LICENSING:

Opposer’s alleged use of the mark is through “licensing” only. The only licensee was Bruder. As discussed in Section B hereinabove, Opposer made no effort to control the nature or quality of products. Ironically, the purported licensing agreement is comprehensive on what a licensor and a licensee shall do, but no control took place whatsoever. *Doebler’s Pennsylvania Hybrids, Inc. V. Doebler*, 442 F.3d 812, 823, 78 U.S.P.Q.2d 1509 (3d Cir. 2006). *Barcamerica*, 289 F.3d at 597-598. The quality of licensee’s good is immaterial. Opposer’s conduct and omission is identical to that in *Eva’s Bridal Ltd. v. Halanick Enterprises Inc.*, 639 F.3d 788, 98 U.S.P.Q. 2d 1662.

2. THE MARK HAS BECOME GENERIC AND OPPOSER FAILED COMPLETELY TO PURSUE “INFRINGEMENT”:

The mark LAND ROVER is generic, i.e., a vehicle for exploring the surface of land. See, definition of Webster’s collegiate Dictionary on “rover;” *Ty, Inc. V. Perryman*, 306 F.3d 509, 513, 64 U.S.P.Q.2d 1689 (7th Cir. 2002). In addition, Opposer took no effort to prevent the mark from losing its any significance as an indication of origin. Opposer did not place any ad, spend any money, or engage in any marketing campaign for toy cars, bearing the mark, or make any effort to educate the public of why its run-of-the mill toy car has any specific origin, in the United States, apart from its human-driven vehicles, which is registered under a different class.

Opposer presented a webpage on Amazon, with a search phrase of “land rover toys.” However, Opposer failed to include all toys found under that name. A search on May 15, 2015 revealed over 1,300 hits. Only a handful of Bruder toy vehicles were shown. Opposer barely produced one alleged licensing agreement. Opposer failed to show it took any action to enforce its mark.

IV.

CONCLUSION

Numerous material facts support cancellation. Opposer did not use the mark after registration. Opposer’s “naked” single licensing is insufficient to hold on to its mark. The mark is generic, and/or becomes generic. Opposer did not spend any sum of money, nor engaged in any effort to advertise, to market, to educate the public, or to take any action to prosecute widespread use of its mark without Opposer’s authorization. Therefore, Opposer’s motion must be denied.

Dated: May 15, 2015

Respectfully submitted,

By: /Shun C. Chen/
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CERTIFICATE OF SERVICE

I, Shun C. Chen, hereby certify that I served the

**APPLICANT'S OPPOSITION TO OPPOSER'S
MOTION FOR PARTIAL SUMMARY JUDGMENT
AND BRIEF IN SUPPORT**

in a sealed envelope, on May 15, 2015, by first-class mail, with postage fully affixed thereon, and deposited in the United States Postal Service Depository in Irvine, California, to

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075

The foregoing documents is also transmitted the aforesaid counsel by e-mail.

This certificate of service is signed on may 15, 2015.

/Shun C. Chen/
Shun C. Chen