

ESTTA Tracking number: **ESTTA701239**

Filing date: **10/09/2015**

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

Proceeding	91214649
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Attachments	MEMO - Reply Memorandum Supporting MSJ 10092015.pdf(113214 bytes )

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

**NOODLE TIME, INC.,**  
Opposer,

**Opposition No.: 91214649**

v.

Mark: **BENNY HUNNA**

**BENNY HODGE,**  
Applicant.

Serial No.: 85/920,599

Filing date: May 01, 2013

Publication Date: October 08, 2013

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**OPPOSER’S REPLY MEMORANDUM IN SUPPORT OF  
MOTION FOR SUMMARY JUDGMENT**

Opposer Noodle Time, Inc. (“Benihana” or “Opposer”), by and through undersigned counsel, hereby submits the following Reply Memorandum (“Reply”) in Support of Its Motion for Summary Judgment (“Motion”)<sup>1</sup> [D.E. 28]. Applicant filed its Opposition to Opposer’s Motion for Summary Judgment (“Opposition”) [D.E. 30] on September 24, 2015.

**I. INTRODUCTION**

Applicant Benny Hodge (“Applicant”) submitted his Opposition to Benihana’s Motion but fails to demonstrate the existence of a genuine issue of material fact on any of Benihana’s claims and fails to identify record evidence to support any of his arguments. Applicant did not conduct any discovery in this matter is precluded from introducing any evidence not produced as of December 26, 2014.<sup>2</sup> While he asserts arguments in his Opposition, Applicant ignores the requirements that the disputes raised by his Opposition be genuine, that the facts in dispute be material, and that the dispute be demonstrated by relevant competent evidence.

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<sup>1</sup> Benihana incorporates the facts and arguments set forth in its Motion and supporting documents as if fully set forth herein.

<sup>2</sup> The Board should disregard the Applicant’s Opposition since Applicant failed to conduct any discovery in this matter and has facts which are not based upon personal knowledge or are otherwise inadmissible. Fed. R. Civ. P. 56(e). Also, the Board entered sanctions against Applicant by Order Dated May 28, 2015 which prohibits Applicant from introducing at trial or relying upon any answers or documents not produced to Opposer prior to December 26, 2014. [D.E. 19]

Applicant either concedes or fails to dispute virtually every relevant fact entitling Benihana to summary judgment. Applicant does not dispute that (a) Benihana owns the **BENIHANA®** Marks, (b) Benihana has priority of use for the **BENIHANA®** Marks and has standing to bring this action; (c) the **BENIHANA®** Marks are famous, strong, and entitled to a broad scope of protection; (d) the similarity of the **BENIHANA®** Marks and the BENNY HUNNA marks such that it was “only a matter of time” before the marks were associated with each other; (e) the goods/services offered in connection with and/or otherwise connected with the **BENIHANA®** Marks are similar to the goods/services offered and/or to be offered with the BENNY HUNNA mark; (f) the advertising and trade channels used or to be used in connection with the parties’ respective marks are similar; (g) there are no third party applications, registrations, or uses in the record for marks consisting of the word **BENIHANA**; (h) Benihana has not consented or otherwise agreed to Applicant’s use of the **BENIHANA®** Marks; and (i) Applicant has not used the BENNY HUNNA mark in commerce, has no trademark rights in the BENNY HUNNA mark and thus no right to exclude others. All of these factors support granting summary judgment in favor of Benihana on its trademark infringement claim.

In addition, Applicant concedes and/or does not dispute any of the material facts related to Benihana’s dilution claim. Again, Applicant does not dispute that: (a) the **BENIHANA®** Marks are famous and entitled to “extra protection”; (b) the **BENIHANA®** Marks acquired fame prior to the filing of the Subject Application; (c) the **BENIHANA®** Marks are distinctive; (d) Benihana exercise exclusive use of the **BENIHANA®** Marks; (d) the **BENIHANA®** Marks enjoy a high degree of recognition; and (e) Applicant tried to create an association between the **BENIHANA®** Marks and the BENNY HUNNA mark after the filing of the Subject Application and was successful in creating such an association by reaching out to various news media sources like TMZ.com. There are no genuine issues of material fact with regard to Benihana’s dilution claim.

Applicant makes a number of red herring arguments in his Opposition that do nothing to genuinely dispute the material facts of this case and the logical conclusion that summary judgment is warranted in favor of Benihana.

## **II. ARGUMENT**

### **A. SUMMARY JUDGMENT STANDARD**

In order to avoid summary judgment, after the moving party has properly supported its motion, the party opposing the motion is required to satisfy the requirements of Rule 56(e), which provides in relevant part:

When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleadings, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial.

A party opposing summary judgment does not show the existence of a genuine issue of fact to be tried merely by making assertions that are conclusory or based upon speculation. *Malletier v. Hyundai Motor Co.*, 2012 U.S. Dist. LEXIS, \*10 (S.D. N.Y. 2012) *citing Major League Baseball Properties, Inc. v. Salvino, Inc.*, 545 F.3d 290 310 (2d Cir. 2008) (internal citation omitted); see also *Anderson*, 477 U.S. at 249-250 (“[t]he mere existence of a scintilla of evidence in support of the position will be insufficient; there must be evidence on which the jury could reasonably find for the [non-movant]”). The non-movant’s facts “must be material and of a substantial nature, not fanciful, frivolous, gauzy, spurious, irrelevant, gossamer inferences, conjectural, speculative, or merely suspicions.” *Contemporary Mission, Inc. v. U.S. Postal Serv.*, 648 F.2d 97, 107 n.14 (2d Cir. 1981). Here, Applicant’s factual assertions are just that --- frivolous, gauzy, irrelevant, and/or speculative.

The U.S. Supreme Court has described the non-movant’s burden as follows:

The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an essential element to that party’s case, and on which that party will bear the burden of proof at trial. In such a situation, there can be “no genuine issue as to any material fact,” since a complete failure of proof concerning an essential element of the nonmoving party’s case necessarily renders all other facts immaterial. The

moving party is “entitled to a judgment as a matter of law” because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.

*Celotex Corp. v. Catrett*, 477 U.S. 317, 322-323, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265, 273 (1986).

In its Opposition, Applicant fails to “set forth specific facts showing that there is a genuine issue for trial.” *Id.* Applicant fails to submit any evidence or an affidavit in support of Applicant’s alleged facts, upon which Applicant now wishes to rely. *See Pure Gold v. Syntex (USA) Inc.*, 739 F.2d 624, 626-627, 222 USPQ 741, 743 (Fed. Cir. 1984) (“The non-movant may not rest on its conclusory pleadings but, under Rule 56, must set out, usually in an affidavit by one with knowledge of specific facts, what specific evidence could be offered at trial.”). The Opposition makes it clear that Applicant lacks sufficient detail to dispute any of the material facts relating to Benihana’s claims. *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60, 61 (TTAB 1974) *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93, 94 (TTAB 1972); *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, 166 USPQ 493, 494 (TTAB 1970).

Here, there is no dispute of any of the material facts asserted in Benihana’s Motion and no genuine issues of material fact that would prevent the Board from granting summary judgment in favor of Benihana on its claims. Benihana addresses each of Applicant’s spurious arguments below.

**B. NO GENUINE DISPUTE THAT A LIKELIHOOD OF CONFUSION BETWEEN BENIHANA® AND BENNY HUNNA**

**1. APPLICANT ADMITS THE MARKS SOUND THE SAME**

Applicant admits the **BENIHANA®** Marks are famous and does not dispute this fact. (*Hodge Depo.* 94:24-95:9). Applicant also admits the similarity in pronunciation of the **BENIHANA®** Marks and the **BENNY HUNNA** mark (“[b]y the names **BENIHANA** and **BENNY HUNNA** being so similar in pronunciation, it will only be a matter of time before we come together”). *Means Decl.*, ¶ 24; *Hodge Depo.* 52:9-53:18, Ex. 3.

Despite his admission, Applicant now attempts to argue the minimal differences between the marks and claims that based upon the doctrine of foreign equivalents, there is no likelihood of confusion because

“BENIHANA, is one word of Japanese origin meaning red flower” and “BENNY HUNNA is not red flower or does not mean red flower.” *Opposition*, p. 2. The doctrine of foreign equivalents can assist likelihood of confusion in cases involving an English word and a foreign word with *the same or similar meaning*. Therefore, Applicant’s own argument contradicts the applicability of the doctrine of foreign equivalents. Further, Applicant has never previously raised the issue of the doctrine of foreign equivalents as an affirmative defense or counterclaim. Second, Applicant is precluded from introducing any evidence (*see* Order Dated May 28, 2015) and there is no evidence of record that demonstrates that the ordinary American purchaser would stop and translate the Japanese words in the **BENIHANA®** Marks to its English equivalent. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).

Applicant also conveniently argues against the aural similarity of the marks based upon the vowel-consonant-vowel rule. First, Applicant has never previously raised this issue, is precluded from introducing any evidence on this issue (*see* Order Dated May 28, 2015), and there is no evidence of record to demonstrate the applicability of this rule to the trademark matters pending before this Board. Applicant cites to one case in its entire Opposition; the case of *Mead Data Central, Inc. vs. Toyota Motor Sales, USA, Inc.*, 875 F.2d 1026 (2d Cir. 1989). Applicant cites to this case and claims that “even though the marks are virtually identical besides one letter, the I in LEXIS and the U in LEXUS, and ‘in everyday spoken English, LEXIS and LEXUS are virtually identical in pronunciation,’ if the words were pronounced correctly they would not sound the same.” *Opposition*, p. 2. Applicant then claims that, like the *Mead* case, the same should be true here --- that if the **BENIHANA®** mark and the BENNY HUNNA mark were pronounced correctly, they would not sound the same.

It is important to note that the Board has recognized that there is “no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.” *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1401-1402 (TTAB 2009) *citing Interlego AG v. Abrams/Gentile Entm’t Inc.*, 63 USPQ2d 1862, 1863 (TTAB 2002) (finding LEGO and MEGO similar).

Given that, if any difference exists in the sound of the **BENIHANA®** Marks and the BENNY HUNNA mark, it will likely go undetected by consumers and therefore, not be sufficient to distinguish the marks from each other.

Applicant's arguments fail for several, additional reasons. First, Applicant conveniently ignores that Applicant previously admitted to the similarity in pronunciation. Second, unlike in the *Mead* case, Applicant has not introduced any evidence by a speech expert that can testify to the pronunciation of the marks. Third, as alluded to, the only element that may create a pronunciation difference in the marks (and there is no evidence that such difference exists) is that the third syllable (of four) in the **BENIHANA®** Marks is "ha" and the third syllable (of four) in BENNY HUNNA is "hu" --- if a difference exists in the sound, it is negligible. Fourth, even if the Board were to conclude that the marks sound different (and there is no basis for this Board to do so particularly in light of Applicant's own admission), this factor is insufficient to overcome the other factors that clearly favor and establish a likelihood of confusion. *Earthquake Sound corp. v. Bumper Industries*, 1999 U.S. App. LEXIS 19968, \*13-14 (9<sup>th</sup> Cir. 1999) (finding that CARQUAKE infringed EARTHQUAKE and BASSQUAKE and that the similarity of marks including, without limitation, aural similarities favored the conclusion that the marks are similar.)

When the totality of the facts is considered, there can be no dispute that the similarity of the marks factor weighs in favor of Benihana. *Motion*, pp. 13-14; *Means Dec.*, ¶¶ 70-75; *Hodge Depo.* 52:9-53:18, 60:23-61:13, Ex. 3.

**2. ACTUAL CONFUSION CANNOT EXIST SINCE APPLICANT HAS NOT MADE A BONA FIDE USE OF MARK IN COMMERCE**

Applicant mistakenly concludes that because Benihana is not aware of any instances of actual confusion, that Benihana agrees that likelihood of confusion does not exist. *Opposition*, p. 3. Benihana concedes that it is not aware of any *actual* instances of confusion; and yet, posits that there could not be any instances of actual confusion given the fact that has not made a *bona fide* use of the BENNY HUNNA mark in commerce. *Motion*, pp.16; *Hodge Depo.* 97:4-98:15, Ex. 1. There is no genuine issue of material

fact relating to this factor and thus, the actual confusion factor weighs in favor of granting summary judgment for Benihana.

**3. APPLICANT'S HAD CONSTRUCTIVE NOTICE OF THE MARKS**

Applicant goes into detail about when he learned of the **BENIHANA®** Marks and the circumstances surrounding his knowledge. First of all, Applicant is precluded from introducing at trial or relying upon any answers or documents not produced to Opposer prior to December 26, 2014. [D.E. 19]. Further, Applicant's arguments miss the mark --- no pun intended --- since Benihana has the benefit of the constructive use and notice dates of its applications and registrations for the **BENIHANA®** Marks. See 15 U.S.C. § 1072. Applicant admits that Benihana has priority of the **BENIHANA®** Marks and Applicant does not oppose, offer any argument or evidence to rebut, and/or dispute that Applicant attempted to trade on the goodwill of the **BENIHANA®** Marks after the filing of the Subjection Application. *Motion*, p. 17. There is no genuine issue of material fact relating to the intent factor and thus, it weighs in favor of granting summary judgment for Benihana.

**C. BENNY HUNNA IS LIKELY TO CAUSE DILUTION OF THE BENIHANA® MARKS**

**1. APPLICANT'S USE OF BENNY HUNNA CONSTITUTES DILUTION BY BLURRING**

Applicant dedicates most of the argument in his Opposition to the fact that the **BENIHANA®** Marks appear in various entertainment media, such as films, music, and television shows, and that such third party uses tarnish the reputation of the **BENIHANA®** Marks. *Opposition*, pp. 3-4. Rather than offering any evidence as to why Applicant's use is *not* dilutive of the **BENIHANA®** Marks, Applicant appears to argue that other third party uses (not at issue here) are likely to dilute the **BENIHANA®** Marks or have diluted the **BENIHANA®** Marks such that Applicant's use cannot further tarnish Benihana's reputation. This argument is wholly illogical and baseless in law. Applicant also fails to note a very important distinction --- the use that Applicant intends to make (using BENNY HUNNA as a source identifier for Applicant's products/services) --- is very different than the third party uses made in creative

and expressive works (submitted as evidence of Benihana's fame) to make direct reference to Benihana as the source of the **BENIHANA®** Marks.

Applicant admits and does not oppose, offer any argument and/or evidence to rebut the multiple factors relevant to proving Benihana's dilution claim. Applicant concedes and/or does not dispute that Applicant's music consists of vulgar language and adult content. Third, Applicant has asserted no defenses in this action, has conducted no discovery, and its use of the BENNY HUNNA mark is intended as a source identifier for Applicant's products/services.

### **III. CONCLUSION**

As fully detailed herein, there are no genuine issues of material fact that would preclude summary judgment on the following issues: (1) Applicant's Subject Application for BENNY HUNNA was based upon an intent-to-use the mark in commerce (*Hodge Depo.*, 19:17-20:12, Ex. 1); (2) Applicant has never provided the services recited in the Subject Application (*Hodge Depo.* 97:1-98:14); (3) Benihana owns several federal registrations for the **BENIHANA®** Marks which are famous, strong, distinctive, and entitled to a broad scope of protection (*Means Decl.*, ¶¶ 15-16, 32-47); (4) Applicant acknowledges and admits that the **BENIHANA® Marks** are famous and accordingly are entitled to "extra protection" (*Hodge Depo.* 94:25-95:9); (5) given the multiple pop culture references to **BENIHANA®** in various entertainment media, the use of BENNY HUNNA for entertainment services would likely cause confusion as to the source, sponsorship or affiliation of Applicant's services (*Means Decl.*, ¶¶ 48-69); (6) Applicant expressed an interest in offering, promoting and selling his services in the same trade channels as **BENIHANA®** services --- namely, **BENIHANA®** restaurants (*Hodge Depo.* 52:9-53:18, Ex. 3); (7) Applicant admits to the similarities in the marks (*Id.*); (8) the marks are similar in appearance, sound, and overall commercial impression; (9) Applicant reached out to Benihana (and only Benihana) to seek corporate sponsorship because "it [would] only be right" and the association was likely to happen ("in a matter of time") (*Means Decl.*, ¶¶ 24-31; *Hodge Depo.* 75:13-15); (10) Applicant's BENNY HUNNA mark has been associated with certain musical videos (not for sale) which are posted online and consist of adult content (sex, drugs, and

violence) and adult language (*Means Decl.*, ¶¶ 70-75; *Hodge Depo.* 26:8-19; 92:12-22); (11) Applicant filed an application to register the BENNY HUNNA mark long after the **BENIHANA**® Marks acquired fame (*Means Decl.* ¶¶ 6-14, 32-69, 76-83; (12) Applicant's BENNY HUNNA Mark is likely to cause confusion with the **BENIHANA**® Marks, shall dilute the distinctiveness of the marks and will tarnish the goodwill symbolized by the marks.

For all the reasons discussed herein, Opposer's Motion for Summary Judgment should be granted, the Opposition should be sustained, and the registration of the BENNY HUNNA mark should be denied on the basis of Opposer's claims of likelihood of confusion and likelihood of dilution.

Dated: October 9, 2015

Respectfully submitted,

/s/ Janet C. Moreira

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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I HEREBY CERTIFY that a true copy of the foregoing OPPOSER'S REPLY MEMORANDUM IIN SUPPORT OF MOTION FOR SUMMARY JUDGMENT is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) on October 9, 2015.

/s/ Janet C. Moreira  
\_\_\_\_\_  
Janet C. Moreira

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and accurate copy of the foregoing OPPOSER'S REPLY MEMORANDUM IIN SUPPORT OF MOTION FOR SUMMARY JUDGMENT has been served on all counsel and/or parties of record as follows:

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