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

Proceeding	91215246
Party	Defendant Empire Resorts, Inc.
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THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

LVGV LLC Opposer v. Empire Resorts, Inc. Applicant	: Opposition 91215246 : : Application 85/736,471 : : Mark: "M (stylized)" : : Class: 28 : : Interlocutory Attorney: Andrew P. Baxley

EMPIRE'S REPLY BRIEF IN SUPPORT OF EMPIRE'S MOTION
FOR PARTIAL JUDGMENT ON THE PLEADINGS

I. Introduction

This is a Reply by Applicant, Empire Resorts, Inc. ("Empire") in support of Empire's 15 September 2014 Motion for Partial Judgment on the Pleadings.

II. Summary of Empire's Argument

In its opposition brief, Opposer, LVGV, LLC ("LVGV") relies on non-precedential, readily distinguishable Board decisions, together with irrelevant pleading allegations, in a desperate effort to divert the Board's attention away from (i) applicable precedential law and (ii) comparison of the marks at issue, both of which unquestionably support Empire's position. Empire's motion should be granted.

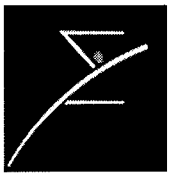
Where, as here, the mark at issue is strikingly dissimilar in appearance, sound, connotation, and commercial impression as respecting the opposer's marks, *duPont* factor 1 is controlling and is case dispositive; as a matter of law there is no likelihood of confusion; and there is no need to explore any of the other *duPont* factors.[1]

[1] *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990); *aff'd* 951 F.2d 330 (Fed. Cir. 1991) "We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive. [T]he Board correctly held that here a single *duPont* factor-- the dissimilarity of the marks--was dispositive of the likelihood of confusion issue." See also *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ 1253 (Fed. Cir. 2011)

Here is Empire's mark:

Here are LVGV's six marks encompassing the twelve federal registrations at issue:

M IS FOR ME



M RESORT

As set forth at length in Empire's motion, each of LVGV's marks is strikingly different from Empire's mark in appearance, sound, connotation, and commercial impression. Because nothing in LVGV's opposition brief or the pleadings detracts from the striking dissimilarity of the marks or the applicable precedent set forth by the Federal Circuit, the Board should grant Empire's motion and dismiss twelve of LVGV's federal registrations from this proceeding.

III. Argument

1) Empire's Mark and LVGV's Marks[2] are so Different in Appearance, Sound, Connotation and Commercial Impression that *duPont* Factor 1 is Case Dispositive -- There is No Likelihood of Confusion.

As set forth at length in Empire's Motion, Empire's mark is so different in appearance, in sound, in connotation, and in commercial impression from each of the LVGV's marks at issue in this motion that

[2] LVGV's purported common law marks and federally registered marks are identical. If the Board determines there is no likelihood of confusion between Empire's mark and LVGV's federally registered marks, then *ipso facto* there can be no likelihood of confusion between Empire's mark and LVGV's purported common law marks.

duPont factor 1 is case dispositive, and as a matter of law there is no likelihood of confusion. The Federal Circuit made it clear in *Kellogg*, cited above, that where marks are highly dissimilar and completely different in appearance, sound, connotation, and commercial impression, *duPont* factor 1 is controlling and case dispositive. In other words, when marks are so different in appearance, sound, connotation, and commercial impression that there is no possibility of confusion of anyone, even if the marks are used on the same product sold in the same trade channels, as a matter of law there is no likelihood of confusion because no one could possibly be confused, in any way or for any purpose, as between the respective marks.

Under *Kellogg*, the Board is free to, and should, conclude that LVGV's marks at issue are simply too dissimilar in every way from Empire's mark to give rise to any likelihood of confusion. LVGV wrongly argues that the Board should deny Empire's Motion because a factual determination is allegedly necessary regarding the similarities of the marks. As is clear from *Kellogg* however, the Board is free to conduct its own analysis[3] regarding the visual, aural, connotation and commercial impression of competing marks in deciding a dispositive motion for judgment on the pleadings, such as Empire's.

LVGV concedes that its Notice of Opposition is grounded on alleged similarities as between Empire's mark and the asserted LVGV marks, the alleged relatedness of Empire's and LVGV's goods and services, and the alleged overlapping channels of trade and prospective purchasers for the goods to be offered by Empire and the services offered by LVGV. The difficulty with LVGV's position is that even if there is relatedness of Empire's goods in class 28 to LVGV's services, whatever those services may be, the dispositive nature of *duPont* factor 1 — striking dissimilarities between the competing marks and resulting impossibility of any likelihood of confusion — trumps any overlapping trade channels and any arguable relatedness of LVGV's services to Empire's class 28 goods.[4]

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[3] Judicial notice by the Board is appropriate in making a *Kellogg* determination that *duPont* factor 1 is dispositive. See *Kellogg, supra.*

[4] Empire's class 28 goods for which registration of Empire's mark is sought pursuant to this proceeding are: "Playing cards; dice; other playthings and sporting articles, namely, dolls, baby rattles, miniature toy cars, boats, trains, airplanes, rockets and spaceships; molded toy figurines; toy guns; water pistols; rubber balls; spinning tops; tennis balls and racquets; golf clubs and golf balls; beach balls; croquet mallets and balls; table tennis paddles and

Empire has asserted that Empire's mark has no connotation and no correct or defined pronunciation. LVGV does not dispute this.

LVGV halfheartedly points to the "break" in the "m" in each party's mark(s) as grounds for possible likelihood of confusion. But LVGV ignores visible aesthetic differences between LVGV's marks and Empire's mark. For instance, LVGV's design marks have an "m" that includes a characteristic long downwardly diagonal stroke. LVGV's sweeping diagonal downward stroke in LVGV's "m" design marks is separated by breaks on both sides from the remainder of LVGV's "m". LVGV conveniently omits that Empire's mark lacks any such long sweeping diagonal downward stroke or breaks on either or both sides of any such diagonal downward stroke.

LVGV's design "m" marks all have characteristic wispy strokes, including a taper, such as drawn by a fountain pen. Empire's mark on the other hand has uniform thickness. Empire's mark has thick, almost military stencil-style lettering forming the letter "m". LVGV's design marks have nothing of the sort.

Unlike Empire's mark, LVGV's marks at issue contain additional lettering and wording besides a letter "m", creating an utterly different appearance, sound, connotation and commercial impression relatiave to Empire's mark. For instance, LVGV's mark "M IS FOR ME" mark is a complete sentence. Empire's mark, consisting of an encircled stylized letter "m", has no connotation and hence cannot have a connotation similar to that of any of LVGV's marks. Similarly, Empire's mark has no commercial impression and hence cannot have a commercial impression similar to any of the LVGV marks at issue.

Some of LVGV's allegations regarding likelihood of confusion stretch beyond the elastic limit. LVGV asserts that the dominant element in Empire's mark and each of LVGV's alleged "m" marks is the letter "m." However, LVGV fails to note that Empire's mark is contained within a circle and is in a block letter form, whereas LVGV's so-called "m" marks are, as noted above, formed with what might be called

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balls; lawn bowling balls; lacrosse sticks and balls; footballs; hockey pucks and sticks; board games; baseball bats, balls and gloves; softball bats, balls and gloves; badminton racquets; shuttlecocks; water polo balls; billiards and pool cues."

"sweeping brush strokes", such as an artist might form with a fine brush. This is far, far different from Empire's stylized "m in a circle" mark formed in block letters.

None of LVGV's marks include a circle. Although LVGV attempts to characterize the letter "m" as the dominant portion of Empire's mark, as the Board can plainly see the circle is larger than Empire's stylized letter "m" and is at least as dominant as a feature of Empire's mark.

LVGV's opposition brief fails even to address most of Empire's arguments set forth in Empire's motion regarding strikingly differing appearance, sound, connotation, and commercial impression as between Empire's mark and each of LVGV's twelve marks at issue. For this reason, and pursuant to the rationale set forth in *Kellogg*, the Board should grant Empire's motion.

LVGV argues that some of the pleadings purportedly put into issue allegedly relevant other *duPont* factors. However, this ignores the Court of Appeals for the Federal Circuit's teaching in *Kellogg*, where if marks are sufficiently different in appearance, sound, connotation, and commercial impression, *duPont*'s factor 1 is controlling and case determinative. There is no need to consider any of the other twelve *duPont* factors, LVGV's contention to the contrary.

2) The Pleadings are the Only Relevant "Evidence" for this Motion

LVGV wrongly brings into play certain of Empire's other pending applications for registration of the same mark for use in connection with different goods and services. The issue in this case and in this motion is the registrability of Empire's mark vis-à-vis twelve of the marks LVGV has asserted against Empire. LVGV asserts that there are allegations in the pleadings creating disputed issues of fact concerning the similarity of the parties' marks, the potential purchasers for the parties' goods and services, and other *duPont* factors. Even if the pleaded allegations by LVGV were accepted as true and all reasonable inferences from the pleadings were drawn in favor of LVGV, this still would not defeat Empire's Motion. Anyone looking at the marks and considering the sound and appearance of those marks, as set forth in Empire's Motion, would immediately conclude that Empire's mark is so different from the twelve LVGV marks at issue that *duPont* factor 1 is case dispositive.

As is clear from Empire's motion, with respect to the twelve LVGV marks for which Empire seeks judgment on the pleadings, no reasonable argument can be made that those LVGV marks are anything other than far, far removed from Empire's mark in appearance, sound, connotation, and commercial impression. There certainly is no similarity in appearance, no similarity in sound, no similarity in connotation, and no similarity in commercial impression that could possibly justify considering any of the other *duPont* factors in evaluating Empire's instant motion for Partial Judgment on the Pleadings. Accordingly, *Kellogg* applies, *duPont* factor 1 is case dispositive, and as a matter of law there is no likelihood of confusion. Judgment on the pleadings is appropriate and should be entered as respecting all twelve of LVGV's marks to which Empire's motion is directed.

3) LVGV argues common law rights which LVGV did not plead

LVGV wrongly argues that LVGV has common law rights in its marks and asserts the same in LVGV's opposition to Empire's Partial Motion for Judgment on the Pleadings. This is wrong. The words "common law" cannot be found in LVGV's Notice of Opposition. There is no allegation in LVGV's Notice of Opposition that LVGV has any common law rights in any of LVGV's marks.

4) **Discovery Issues and Other Proceedings Between the Parties are Irrelevant**

LVGV seeks to divert attention from the issues at hand and asserts that Empire has made a high number of duplicative and harassing discovery requests, allegedly multiplying the proceedings to increase the cost and burden on LVGV. When Empire's marks were published for opposition purposes, LVGV could have filed a single consolidated opposition proceeding against all of Empire's pending applications. However LVGV chose not to do so, for reasons of its own. Having made that choice, LVGV is the author of its own misfortune as respecting the burdens of dealing with discovery in six separate proceedings.

Furthermore, LVGV's suggestion that Empire has served "634 duplicative and harassing discovery requests" in this proceeding is untrue. In this proceeding, Empire has served a single interrogatory, a single request for production of documents, and twenty-six requests for admissions. Those twenty-eight discovery requests are a far cry from the 634 that LVGV alleges. The Board should

keep in mind that LVGV initiated the six proceedings; it was not Empire. LVGV deceptively presents the 634 number in a cumulative manner regarding discovery requests by Empire made over six proceedings. What LVGV fails to include is the fact that LVGV has served somewhere in the neighborhood of 400 discovery requests in the six different opposition proceedings, **all of which were initiated by LVGV**.

LVGV should be more careful as respecting the facts of this opposition, and should be cautioned against improperly comingling issues from other oppositions involving these parties with this opposition. Empire seeks to register its mark in class 28 for the goods set forth and seeks judgment on the pleadings against twelve of the sixteen United States registrations LVGV has asserted against Empire in this proceeding. Other pending proceedings are irrelevant.

LVGV goes to great lengths respecting details of all of the six proceedings LVGV initiated. The issue before this Board is whether judgment on the pleadings should be entered in favor of Empire and against twelve of LVGV's registrations in this proceeding, not whether there has been duplicative and vexatious discovery by one side or by the other or both in other co-pending proceedings.

5) LVGV's Services are Unrelated to Empire's Goods; There is No Trade Channel Commonality

In arguing against Empire's Motion, LVGV takes the low road and characterizes Empire's description of Empire's class 28 goods as being "disingenuous." Lest there be any question about Empire's goods, Empire's goods are set forth in a footnote above.

LVGV alleges that Empire misrepresents Empire's recited goods as being children's toys and sporting equipment. LVGV carefully points out that playing cards and dice are included in Empire's goods and contends that Empire's goods "are the foundation of table gaming". Regrettably and unfortunately LVGV's counsel apparently has never had the pleasure of playing a rubber of "Bridge" with other adults or "Fish" with one's children, or enjoying a hot game of "Sorry" or "Monopoly"

following a family holiday dinner[5]. LVGV's suggestion that Empire's goods "are the foundation of table gaming" is laughable.

LVGV goes to great length to contend, without basis, that Empire has made fallacious factual representations concerning the channels of trade and prospective purchasers for Empire's class 28 goods. LVGV alleges there are no restrictions on channels of trade for Empire's class 28 goods and that Empire's class 28 goods and opposer's services are allegedly intended to be marketed through overlapping channels of trade and intended to be sold to overlapping classes of purchasers. Even if this were true, *Kellogg* trumps LVGV's position. If the marks were identical, which they are not, then trade channel analysis might be appropriate. However, these marks are so different in appearance, sound, connotation, and commercial impression, all as clearly set forth in Empire's Motion, that LVGV's bleating about trade channels is irrelevant and should be summarily discounted.

6) LVGV's Connotation Postion is Illogical

LVGV further argues that "the overall commercial impression of Empire's M logo and LVGV's M marks is the same: the thirteenth letter of the alphabet." Alphabetic letters are not the stuff of commercial impression or connotation. Connotation is something that is suggested by the letter or word of interest. To contend that marks having a literal element consisting of the letter "m" have the same (unstated) connotation is circular reasoning. A letter cannot connote itself. LVGV's brief on this point is nonsensical.

7) LVGV's Cited Authorities Support Empire's Position, not LVGV's

LVGV's legal authorities, the majority of which are non-precedential, are factually inapplicable and set forth legal principles supporting Empire's motion, not LVGV's opposition.

Abercrombie & Fitch Trading Co. v. Artemides Holdings Pty. Ltd., No. 91194275 (TTAB Sept. 6, 2013) and *Balenciaga v. Flora Pharmica, LLC*, No. 91214074 (TTAB Sept. 25, 2014), are both non-precedential. Both *Abercrombie* and *Balenciaga*, involved competing marks with very substantial visual, aural, connotation and commercial impression similarities. Hence, *duPont* factor 1 was not dispositive,

[5] "Bridge" and "Fish are both played with playing cards; "Sorry" and "Monopoly" are played with dice.

the *Kellogg* rule did not apply, and neither judgment on the pleadings nor summary judgment was appropriate. *Abercrombie* and *Balenciaga* are entirely consistent with Empire's position as stated above. Specifically, when there are no *duPont* factor 1 similarities (as is the case where comparing Empires mark with the twelve LVGV marks at issue), under the authority of *Kellogg*, *duPont* factor 1 is dispositive and further inquiry into the facts is a waste of judicial resources and client dollars[6].

IV. Conclusion and Prayer for Relief

For the foregoing reasons, and on the basis of the authorities cited, Empire respectfully submits that partial judgment on the pleadings should be entered in favor of Empire, against LVGV, and that this opposition should be in part dismissed as respecting twelve of the LVGV registrations asserted against Empire.

Date: November 28, 2014

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[6] LVGV's other cited case authorities, having no applicability to the issues involved in Empire's instant motion, are not further addressed herein.

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LVGV LLC	:	Opposition 91215246
	:	
	:	Application 85/736,471
Opposer	:	
v.	:	Mark: "M (stylized)"
	:	
Empire Resorts, Inc.	:	Class: 28
	:	
	:	Interlocutory Attorney:
Applicant		Andrew P. Baxley

CERTIFICATE OF SERVICE

I, Charles N. Quinn, Esquire, hereby certify that a true and correct copy of the foregoing Reply Brief in Support of Motion by Empire Resorts, Inc. for Partial Judgment on the Pleadings was served on Opposer's Counsel via electronic mail on 28 November 2014 at the addresses below:

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