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

Proceeding	91227586
Party	Defendant All Aboard Florida - Operations LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRIGHT RAIL ENERGY, INC.,)	
)	
Opposer,)	Opposition No. 91227586
)	Serial No. 86/791,916
v.)	
)	
ALL ABOARD FLORIDA - OPERATIONS)	
LLC)	
_____ Applicant.)	

APPLICANT’S ANSWER TO OPPOSER’S NOTICE OF OPPOSITION

All Aboard Florida – Operations LLC (“Applicant”) denies Opposer will be damaged by registration of Applicant’s mark and hereby answers Opposer’s Notice of Opposition (“Opposer’s Complaint”) herein as follows:

1. On October 19, 2015, Applicant filed intent-to-use based U.S. Trademark Application No. 86/791,916 directed to a design mark containing BRIGHTLINE as applied to “Management of railroad systems” in International Class 35, “Construction of railroad systems” in International Class 37, “Transportation of passengers and goods by rail; passenger and freight transportation by rail services” in International Class 39, and “Design and development of railroad systems; planning, design and implementation of railroad computer technology systems for others” in International Class 42.

Answer

Applicant admits it filed Application Serial No. 86/791,916 for the mark “BRIGHTLINE & design” covering the services specified in Paragraph 1 of Opposer’s Complaint.

2. Upon information and belief, Applicant is in the business of providing passenger rail services in the state of Florida and intends to use the BRIGHTLINE mark in connection with a passenger rail service that operates solely between central and southern Florida. *See* Exhibit A, attached hereto. The initial phase of the rail line would operate between Miami, Florida and West Palm Beach, Florida – with an approximate travel distance of 65 miles solely within southern Florida. *See* Exhibit B, attached hereto. A proposed future rail station in Orlando, Florida, would be located approximately 200 miles from the nearest state line. *See id.*

Answer

Applicant admits it intends to provide passenger rail services within the state of Florida and intends to use its “BRIGHTLINE & design” mark in connection therewith. Applicant also admits the initial rail line would operate between Miami, Florida and West Palm Beach, Florida. Applicant denies the remaining allegations in Paragraph 2 of Opposer’s Complaint.

3. Since any passenger rail services provided by Applicant under the BRIGHTLINE mark will occur solely within the state of Florida, Applicant cannot be said to have a bona fide intent to use the BRIGHTLINE mark in interstate commerce for the identified services. Therefore, U.S. Trademark Application No. 86/791,916 for BRIGHTLINE should be refused under Trademark Act Section 1(b).

Answer

Applicant denies the allegations set forth in Paragraph 3 of Opposer’s Complaint.

4. Opposer uses the trademarks BRIGHT RAIL and BRIGHT RAIL ENERGY in connection with rail and railroad-related services, including business management of railroad systems; storage, distribution, transportation, shipping, and delivery of fuels for the rail industry; manufacturing services for others in the field of rail vehicles, trains and locomotives; manufacturing services for others in the field of control systems comprised of electronic controllers for railroad power units; and design and development of railroad systems and power units for the rail industry; design and development of control systems for railroad power units; planning, design and implementation of railroad computer technology systems. Opposer's rail and railroad-related services are provided throughout the United States.

Answer

Applicant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 4 of Opposer's Complaint, and therefore denies the same.

5. Opposer first began advertising its rail and railroad-related services under the BRIGHT RAIL and BRIGHT RAIL ENERGY marks at least as early as April 5, 2012, on which date Opposer offered its rail and railroad-related services for sale under the BRIGHT RAIL and BRIGHT RAIL ENERGY marks to Fortress Investment Group LLC. Upon information and belief, Applicant is a wholly owned subsidiary of Fortress Investment Group LLC.

Answer

Applicant admits Opposer's pleaded applications contain an alleged First Use and First Use in Commerce date of April 5, 2012, but denies any bona fide use of the marks by

Opposer. Applicant denies the remainder of the allegations set forth in Paragraph 5 of Opposer's Complaint.

6. Opposer continues to use the BRIGHT RAIL and BRIGHT RAIL ENERGY marks throughout the United States and has spent significant time and money promoting and advertising its services under the BRIGHT RAIL and BRIGHT RAIL ENERGY marks to potential customers nationwide.

Answer

Applicant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 6 of Opposer's Complaint, and therefore denies the same.

7. Opposer owns common law trademark rights to the BRIGHT RAIL and BRIGHT RAIL ENERGY marks.

Answer

Applicant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 7 of Opposer's Complaint, and therefore denies the same.

8. Opposer's common law rights in its BRIGHT RAIL and BRIGHT RAIL ENERGY marks predate the October 19, 2015 filing date of Applicant's U.S. Trademark Application No. 86/791,916 and Applicant's rights (if any) in the BRIGHTLINE mark.

Answer

Applicant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 8 of Opposer's Complaint, and therefore denies the same.

9. On June 25, 2015, Opposer filed U.S. Trademark Application No. 86/674,234 to register the mark BRIGHT RAIL for “Business management of railroad systems” in International Class 35, “Storage, distribution, transportation, shipping, and delivery of fuels for the rail industry” in International Class 39, “Manufacturing services for others in the field of rail vehicles, trains and locomotives; manufacturing services for others in the field of control systems comprised of electronic controllers for railroad power units” in International Class 40, and “Design and development of railroad systems and power units for the rail industry; design and development of control systems for railroad power units; planning, design and implementation of railroad computer technology systems” in International Class 42.

Answer

Applicant admits Opposer filed U.S. Trademark Application Serial No. 86/674,234 covering the services specified in Paragraph 9 of Opposer’s Complaint. However, Applicant submits that Opposer’s current Class 42 description reads as follows: “Design and development of railroad power unit computer software systems and power units for the rail industry; design and development of control systems for railroad power units; planning, design and implementation of railroad computer technology systems for others; installation, maintenance and repair of control system software for railroad power units.”

10. On June 25, 2015, Opposer filed U.S. Trademark Application No. 86/674,243 to register the mark BRIGHT RAIL ENERGY for “Business management of railroad systems” in International Class 35, “Storage, distribution, transportation, shipping, and delivery of fuels for the rail industry” in International Class 39, “Manufacturing services for others in the field of

rail vehicles, trains and locomotives; manufacturing services for others in the field of control systems comprised of electronic controllers for railroad power units” in International Class 40, and “Design and development of railroad systems and power units for the rail industry; design and development of control systems for railroad power units; planning, design and implementation of railroad computer technology systems” in International Class 42.

Answer

Applicant admits Opposer filed U.S. Trademark Application Serial No. 86/674,243 covering the services specified in Paragraph 10 of Opposer’s Complaint. However, Applicant submits that Opposer’s current Class 42 description reads as follows: “Design and development of railroad power unit computer software systems and power units for the rail industry; design and development of control systems for railroad power units; planning, design and implementation of railroad computer technology systems for others; installation, maintenance and repair of control system software for railroad power units.”

11. The filing of Opposer’s BRIGHT RAIL and BRIGHT RAIL ENERGY U.S. Trademark Applications predates the filing of Applicant’s mark.

Answer

Applicant admits Opposer’s pleaded applications were filed before Applicant’s Application, but Applicant denies that Opposer has priority in this case.

12. In view of the similarity of the respective marks in sight, sound, and commercial impression, and the related nature of the railroad-related services of the respective parties, it is alleged that Applicant’s mark, BRIGHTLINE, so resembles Opposer’s BRIGHT RAIL and

BRIGHT RAIL ENERGY marks previously and currently used by the Opposer in the United States as to be likely to cause confusion, or to cause mistake, or to deceive.

Answer

Applicant denies the allegations in Paragraph 12 of Opposer's Complaint.

13. The rail and railroad-related services rendered under Opposer's marks, BRIGHT RAIL and BRIGHT RAIL ENERGY, are similar to those services envisioned by Applicant under the mark BRIGHTLINE. Consumers may assume that Opposer has sponsored, licensed, or otherwise approved of Applicant's mark and the related services; such an assumption is incorrect.

Answer

Applicant denies the allegations in Paragraph 13 of Opposer's Complaint.

14. While U.S. Trademark Application No. 86/791,916 is a composite mark consisting of both words and designs, the literal portion of the mark is the wording BRIGHTLINE, which is dominant feature of the mark. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). Here, the literal portion of Applicant's mark is identical in appearance, sound and meaning to Opposer's marks other than Applicant's inclusion of LINE

and Opposer's inclusion of RAIL and RAIL ENERGY. The addition of the design element in Applicant's mark does not obviate the clear similarity between Applicant's mark and Opposer's marks in this case. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975); TMEP §1207.01(c)(ii).

Answer

Applicant denies the factual allegations in Paragraph 14 of Opposer's Complaint.

Applicant affirmatively avers that Opposer's legal arguments are improper and should be stricken.

15. Upon information and belief, Applicant is legally related to AAF Holdings LLC, the applicant of pending U.S. Trademark Application No. 86/197,939 (BRIGHT LINE), which includes identical services to those of U.S. Trademark Application No. 86/791,916 and a disclaimer for the term "line.

Answer

Admitted.

16. As is evidenced by the disclaimer of the term "line" in U.S. Trademark Application No. 86/197,939 (BRIGHT LINE), the use of the term "line" is merely descriptive of the type of services sought to be registered for by Applicant under the BRIGHTLINE mark, namely services related to railroad systems (i.e., rail or train "lines").

Answer

Applicant denies the allegations in Paragraph 16 of Opposer's Complaint.

17. Upon information and belief, Applicant intends to use the BRIGHTLINE mark in connection with railroad services provided in brightly colored trains. *See* Exhibits A and C, attached hereto. Accordingly, Applicant's intended use of the BRIGHTLINE mark is merely descriptive of a characteristic or attribute of such services.

Answer

Applicant intends to use its "BRIGHTLINE & design" mark in connection with railroad services provided in trains; the color of the trains is not a factor in Applicant's intended provision of its services. Applicant denies the allegations set forth in Paragraph 17 of Opposer's Complaint.

18. The dominant feature of Applicant's mark is the wording "BRIGHTLINE." As is evidenced by the facts set forth in Items 16 and 17 and incorporated herein, the wording BRIGHTLINE is merely descriptive. However, Applicant has not disclaimed any portion of the mark. Permitting Applicant to register its mark without requiring a disclaimer would create a false impression of the extent of the registrant's right with respect to the certain elements of the mark. *See Horlick's Malted Milk Co. v. Borden Co.*, 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924); TMEP § 1213. As Applicant has not disclaimed any portion of the wording BRIGHTLINE in U.S. Trademark Application No. 86/791,916, the dominant feature of the mark is merely descriptive. Therefore, U.S. Trademark Application No. 86/791,916 for BRIGHTLINE should be refused under Trademark Act Section 2(e)(1).

Answer

Applicant admits that it did not disclaim the wording “BRIGHTLINE”, as the mark is not descriptive of Applicant’s services, and disclaiming part of a one word mark is not appropriate. Applicant denies any remaining allegations in Paragraph 18.

19. In written correspondence sent to Applicant three months prior to Applicant’s filing of U.S. Trademark Application No. 86/674,234, Opposer made reference to its common law trademark rights to the BRIGHT RAIL and BRIGHT RAIL ENERGY marks.

Answer

Applicant admits it received correspondence from Opposer before filing its Application, claiming Opposer has common law trademark rights in its “BRIGHT RAIL” and “BRIGHT RAIL ENERGY” marks. Applicant denies any remaining allegations in Paragraph 19.

20. U.S. Trademark Application No. 86/674,234 includes the sworn statement that to the best of Applicant’s “knowledge and belief”, no other persons have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons to cause confusion or mistake, or to deceive. Applicant’s sworn statement is false in that Applicant was aware of Opposer’s common law trademark rights prior to the application date of the BRIGHTLINE mark and Applicant is not the true owner of the BRIGHTLINE mark. Said false statement was made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant a trademark registration, and constitutes fraud on the United States Patent and Trademark Office.

Answer

Applicant admits that its Application includes a sworn statement similar to that provided in Paragraph 20 of Opposer's Complaint. Applicant denies the remainder of the allegations set forth in Paragraph 20 of Opposer's Complaint.

21. If Applicant were to be granted registration for BRIGHTLINE in International Classes 35, 37, 39, or 42, such registration would negatively impact Opposer's on-going common law rights in the marks BRIGHT RAIL and BRIGHT RAIL ENERGY, and any future use of the marks BRIGHT RAIL and BRIGHT RAIL ENERGY by Opposer could be inhibited due to potential conflict with Applicant's mark.

Answer

Applicant is without sufficient information to form a belief as to the truth or falsity of the allegations in Paragraph 21 of Opposer's Complaint concerning alleged common law rights, and therefore denies the same. Applicant denies any remaining allegations in Paragraph 21.

22. If Applicant were to be granted registration for BRIGHTLINE in International Classes 35, 37, 39, or 42, the registration would constitute a *prima facie* exclusive right to use its mark. Such registration would become a source of injury and damage to the Opposer.

Answer

Applicant admits its registration would constitute a *prima facie* exclusive right to use its mark. Applicant denies all remaining allegations in Paragraph 22 of Opposer's Complaint.

AFFIRMATIVE DEFENSES

In addition to the denials set forth above, Applicant asserts the following affirmative defenses against the allegations set forth in Opposer's Complaint:

FIRST AFFIRMATIVE DEFENSE

Opposer's Complaint fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

The mark which is the subject of this application when used in connection with the services identified in the application is not likely to cause a likelihood of confusion with Opposer's marks identified in the Notice of Opposition.

THIRD AFFIRMATIVE DEFENSE

Upon information and belief, Opposer does not have trademark rights in the "BRIGHT RAIL" and "BRIGHT RAIL ENERGY" marks.

FOURTH AFFIRMATIVE DEFENSE

Opposer's Complaint is barred by estoppel or laches, as Applicant's related company, AAF, owns a pending application for the mark "BRIGHT LINE", published August 26, 2014 (Appln. Ser. No. 86/197,939), covering identical services as those included in the subject application; Opposer did not oppose the published application. Opposer is estopped from challenging the instant application, or such Opposition is barred by laches.

FIFTH AFFIRMATIVE DEFENSE

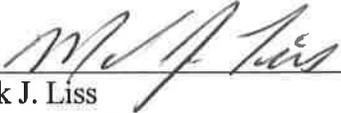
Registration of Applicant's "BRIGHTLINE & design" mark will not cause any injury or damage to Opposer.

Wherefore, Applicant respectfully requests that Opposer's Complaint be dismissed.

Respectfully submitted,

Date: June 6, 2016

By:



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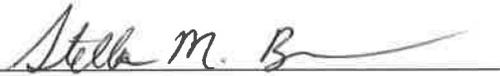
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Attorneys for Applicant

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the attached APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION was filed electronically with the Trademark Trial and Appeal Board on June 6, 2016:


Stella M. Brown

CERTIFICATE OF SERVICE

I hereby certify that a copy of this APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION was served upon the following individual by email and First Class Mail on June 6, 2016:

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