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

Proceeding	91229467
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p><i>In re Matter of Application No. 85/715,985</i> for the mark: VINYL FOR A CAUSE & Design in Class 41</p> <p>HRHH IP, LLC,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>Vice Versa Records, LLC,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91-229467</p> <p>OPPOSER HRHH IP, LLC’S OPPOSITION TO APPLICANT VICE VERSA RECORDS, LLC’S MOTION FOR JUDGMENT ON THE PLEADINGS</p>
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Pursuant to Fed.R.Civ.P. Rule 12(c) and TBMP § 504, Opposer HRHH IP, LLC (“Opposer”) hereby submits its brief in opposition to Applicant Vice Versa Records, LLC’s (“Applicant”) Motion for Judgment on the Pleadings (the “Motion”). (Dkt. 5.)

I. INTRODUCTION

Applicant seeks judgment on the pleadings based on its purported contention that Opposer has not appropriately plead the grounds for opposition in its Notice of Opposition (the “Notice”). (Dkt. 1.) The Motion, however, is devoted to presenting “evidence” and argument in support of Applicant’s contention that Opposer cannot *prove* its claims rather than addressing the *legal sufficiency* of the pleadings. As such, the Motion is a premature attempt to seek judgment on the merits.¹ When the proper standard is considered, it is clear that Opposer has pled standing and grounds to oppose registration of the mark VINYL FOR A CAUSE & Design.

¹ Indeed, Applicant repeatedly contends that there is “no material issue of fact”—a standard that applies to summary judgment. (Dkt. 5 at 3, 9, 12.)

II. SUMMARY OF RELEVANT FACTS

A. Opposer

Opposer is the entity responsible for operating the highly-successful live performance venue Vinyl Las Vegas at the Hard Rock Hotel & Casino Las Vegas in Las Vegas, Nevada. (Dkt. 1 at ¶ 1.)

B. Opposer’s Marks

Opposer first used the marks VINYL and VINYL LAS VEGAS & Design for entertainment, restaurant, bar, and related services as early as August 2012. (Dkt. 1 at ¶ 3.) Since then, Opposer has continuously used the marks VINYL and VINYL LAS VEGAS & Design for its various entertainment and related services. (*Id.*) Opposer’s Vinyl Las Vegas venue has hosted performances by up-and-coming and established national and international entertainers, and other entertainment-related events. (*Id.*) Opposer promotes and sells tickets to live events held at Vinyl Las Vegas, including musical performances, through its website and at its box office. (*Id.*) Opposer advertises and markets Vinyl Las Vegas and the marks VINYL and VINYL LAS VEGAS & Design extensively including, but not limited to, through its social media accounts available on Facebook, Twitter, and Instagram. (*Id.*) Vinyl Las Vegas has received considerable media attention. (*Id.*)

Opposer owns the following federal trademark registrations of marks containing VINYL (collectively, the “VINYL Marks”):

<u>MARK</u>	<u>REG. NO.</u>	<u>CLASS</u>	<u>GOODS AND SERVICES</u>	<u>APP. DATE</u>	<u>REG. DATE</u>
	4,891,535	35	Promoting, marketing, and advertising live musical performances and theatrical performances of others.	12/6/14	1/26/16

<u>MARK</u>	<u>REG. NO.</u>	<u>CLASS</u>	<u>GOODS AND SERVICES</u>	<u>APP. DATE</u>	<u>REG. DATE</u>
VINYL	4,897,330	41	Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services.	12/6/14	2/9/16
	4,897,331	41	Arranging and conducting of concerts; concert booking; entertainment services, namely, live musical performances, comedy performances, and theatrical performances; provision of information relating to live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; entertainment services, namely, conducting contests; nightclub services.	12/6/14	2/9/16

(Dkt. 1 at ¶ 2.)

C. Applicant

On August 5, 2015, Applicant filed U.S. Trademark Application Serial No. 86/715,985 seeking registration, on an intent-to-use basis, of the mark VINYL FOR A CAUSE & Design for “entertainment services in the nature of recording, production, and post-production services in the field of music” in Class 41 (the “Application”). (*Id.* at ¶ 4.) The Application was published for opposition on April 12, 2016, and Opposer was extensions of time to oppose. (*Id.* at ¶ 5.)

D. Procedural History

Opposer filed the Notice on August 10, 2016 opposing the Application under Sections 2(d) and 43(c) of the Lanham Act. (Dkt. 1.) On September 13, 2016, Applicant filed its Answer to the Notice. (Dkt. 4.) Applicant filed the Motion on September 14, 2016. (Dkt. 5.)

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III. THE MOTION SHOULD BE DENIED FOR IMPROPER SERVICE

Applicant purports to have served the Motion by email. (Dkt. 5.) Service by email is improper without prior agreement. TBMP § 113.04 (service by “electronic transmission” proper only “when mutually agreed upon by the parties”); 37 CFR § 2.119(b) (same). There is no such agreement. (Declaration of Benjamin O. Aigboboh (“Aigboboh Decl.”) ¶ 2.) The Motion has not been properly served, and should be denied.²

Even if the Motion is not denied based on improper service, the method of service remains relevant because service by email eliminates the 5-day enlargement of time to respond. TBMP § 113.05. Given that there is no agreement for email service and in an abundance of caution, Opposer has responded within the time period applicable to service by mail. *Id.* (If “the paper is served by first-class mail, Priority Mail Express®, or overnight courier, the time for taking action is enlarged by 5 days.”)

IV. EVEN IF THE MOTION WERE PROPERLY SERVED (IT WAS NOT), THE MOTION SHOULD BE DENIED ON THE MERITS

A. Standard for Motion for Judgment on the Pleadings

To defeat a motion for judgment on the pleadings, the non-moving party need only allege *sufficient facts* that, if proven, would establish that (1) the non-moving party has standing to maintain the proceeding, and (2) a valid ground exists for opposing or canceling a registration.

TBMP § 503.02; *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011);

² See, e.g., *Reliable Carriers, Inc. v. Taylor Online Mktg.*, 2012 U.S. Dist. LEXIS 82105, at *3 (E.D. Mich. June 13, 2012) (finding that improper electronic service is grounds to “strike [*pro se* defendant’s] motion to dismiss in its entirety,” but refusing to do so because of the liberal application of rules to *pro se* parties); *McKenna v. Nat’l Action Fin. Servs.*, 2008 U.S. Dist. LEXIS 29791, at **1-2 (S.D. Fla. Apr. 11, 2008) (service of Fed.R.Civ.P. 68 offer of judgment ineffective where plaintiff’s counsel did not consent to service by facsimile); *Wynn v. Amtrak*, 2008 U.S. Dist. LEXIS 8800, at *8 n.2 (N.D.N.Y Feb. 5, 2008) (absent “consent[] in writing to electronic service, such means of service is improper.”).

Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536, 1538 (TTAB 2007).³ This requires the non-moving party to plead facts sufficient to “state a claim to relief that is plausible on its face,” TBMP § 503.02; *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009), meaning that the factual allegations need only “be enough to raise a right to relief above the speculative level.” *Bell Atlantic Corp v. Twombly*, 550 U.S. 544, 555 (2007); *see also Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010); *Cary v. U.S.*, 552 F.3d 1373, 1376 (Fed. Cir. 2009) (cited by Applicant) (pleading not required “to set out in detail the facts upon which the claim is based....”).⁴

Whether the non-moving party can *prove* its allegations is *irrelevant* to whether the *allegations are sufficient to withstand a motion for judgment on the pleadings*. *See, e.g., Wager v. Pro*, 575 F.2d 882, 884 (D.C. Cir. 1976) (“The law is settled that a judgment on the

³ As Applicant confirms (Dkt. 5 at 2), the same legal standard applies motion for judgment on the pleadings and motions to dismiss under Fed.R.Civ.P. 12(b). *See, e.g., Cafasso v. Gen. Dynamics C4 Sys., Inc.*, 637 F.3d 1047, 1055 n.4 (9th Cir. 2011) (“[T]he same standard of review” applies to motions for judgment on the pleadings and motions to dismiss); *W. Worldwide Enter. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1140 (TTAB 1990) (same).

⁴ Applicant, in addressing the standard applicable to a motion for judgment on the pleadings, cites to, relies on, and misquotes irrelevant and outdated case law. For example, Applicant cites *Lloyd’s Food Products Inc. v. Eli’s Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993) for the standard applicable to motions for judgment on the pleadings (Dkt. 5 at 2), but *Lloyd’s* only addresses the standard applicable to summary judgment motions. Applicant also “quotes” *Hamlet v. U.S.*, 873 F.2d 1414, 1416 (Fed. Cir. 1989) for the proposition that “it is ‘appropriate for a district court to ‘grant the motion if it is beyond doubt that the non-movant can plead no facts that would support his claim for relief.’” (Dkt. 5 at 2.) Not only is this “quote” inaccurate, the actual language in *Hamlet* (which is based on the Supreme Court’s decision in *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957)) was expressly overruled by the Supreme Court. *Twombly*, 550 U.S. at 561-563 (“The phrase [inaccurately quoted by Applicant] is best forgotten as an incomplete, negative gloss on an accepted pleading standard: once a claim has been stated adequately, it may be supported by showing any set of facts consistent with the allegations in the complaint.”). Similarly, *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727 (Fed. Cir. 1998) “has not stood the test of time and appears to have been subsequently rejected by the Federal Circuit in *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 354 (Fed. Cir.), *cert. denied*, 121 L. Ed. 2d 126, 113 S. Ct. 181 (1992).” *M’Otto Enters. v. Redsand, Inc.*, 831 F. Supp. 1491, 1501 (W.D. Wash. 1993).

pleadings is not appropriate where the complaint raises issues of fact which if proved would defeat recovery. This is so even if the trial court is convinced that the party opposing the motion is unlikely to prevail at trial.”) (internal citations omitted).⁵

When ruling on a motion for judgment on the pleadings, the trier of fact must accept the non-moving party’s factual allegations as true, must construe all disputed issues in favor of the non-moving party, and must draw all reasonable inferences in favor of the non-moving party.

Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit CityPlace, 116 U.S.P.Q.2d 1025, 1030 (TTAB 2015) (precedential); *Advanced Cardiovascular Sys.*, 26 USPQ2d at 1041.

“Additionally, under the simplified notice pleading rules of the Federal Rules of Civil Procedure, the allegations of a complaint should be ‘construed so as to do justice.’” *Corporacion Habanos, S.A.*, 99 USPQ2d at 1874 (citations omitted).

B. Opposer Has Pled Standing

To plead standing, an opposer must allege facts sufficient to establish that it has a direct and personal stake in the proceeding, and a reasonable basis for its belief that it will suffer damage. TBMP § 303.03; *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) (citing 15 U.S.C. § 1063). Both are satisfied when an opposer alleges that it owns prior rights in a mark, and has a “non-frivolous” claim of potential harm—for example, a likelihood of confusion between opposer’s and applicant’s marks. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

⁵ *See also* TBMP § 503.02 (“Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective position.”); *Advanced Cardiovascular Sys. v. SciMed Life Sys.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (“A motion made under Rule 12(b)(6) challenges the legal theory of the complaint, not the sufficiency of any evidence that might be adduced”).

There is no dispute that Opposer has standing and has properly pled it. (*See, e.g.*, Dkt. 5 at 12-13.) Opposer owns common law rights in the VINYL Marks dating back to August 2012, and owns registrations for the VINYL Marks that establish a presumptive first use date of December 6, 2014. (Dkt. 1 at ¶¶ 2-3); 15 U.S.C. § 1057(c); *Brookfield Comm'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1051 n.13, 50 USPQ2d 1545, 1555 n.13 (9th Cir. 1999). Opposer's actual and presumptive first use dates both predate the Application's filing date. (Dkt. 1 at ¶4.) Opposer has also alleged facts establishing likely damage should the Application mature to registration—that (1) Opposer has priority, (2) Opposer's marks are famous, (3) the parties' marks are similar and the services related, and (4) likelihood of confusion and dilution are the likely result. (Dkt. 1 at ¶¶ 2-3, 6-13.) These allegations are sufficient to establish a “non-frivolous” claim of potential harm. *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1029.

C. Opposer Has Pled Valid Grounds For Opposition

Pursuant to Section 13(a) of the Trademark Act,

[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may...file an opposition in the Patent and Trademark Office, stating the grounds therefor....

15 U.S.C. § 1063(a); TBMP § 303.1.

Opposer has alleged two statutory grounds for its opposition to the Application: (1) likelihood of confusion, confusion, mistake, or deception as to the source, origin, affiliation, association, connection, or sponsorship pursuant to Section 2(d) of the Lanham Act; and (2) likelihood of dilution pursuant to Section 43(c) of the Lanham Act. 15 U.S.C. §§ 1052, 1125. Applicant does not dispute that each is a valid basis for opposing an application to register a mark. (*See* Dkt. 5 at 12-13.) Opposer has pled both. Thus, the Motion should be denied.

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1. Opposer Has Pled A Ground For Opposition Under Section 2(d)

In order to plead a Section 2(d) ground for opposition, an opposer must allege that (1) it has valid prior rights, and (2) applicant's mark is likely to cause confusion with opposer's mark. 15 U.S.C. § 1052(d); *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030; *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). An opposer need not *prove* either; instead, all that is required is that opposer allege facts *sufficient* to suggest "a claim to relief that is plausible on its face." *Iqbal*, 556 U.S. at 678; *Twombly*, 550 U.S. 544, at 55-56; *Totes-Isotoner Corp.*, 594 F.3d at 1354; *see also Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030 ("The elements of a claim should be stated precisely and directly, and include enough detail to give the defendant fair notice.").

Opposer has pled priority. Applicant filed the Application in Class 41, on an intent-to-use basis, on August 5, 2015. (Dkt. 1 at ¶ 4.) Opposer began using the VINYL Marks for entertainment services and related services in August 2012. (*Id.* at ¶ 3.) Opposer owns federal registrations for the VINYL Marks in Classes 35 and 41 with presumptive first use dates of December 6, 2014. (*Id.* at ¶ 2, Ex. B); *see also Am. Throwing Co. v. Famous Bathrobe Co.*, 250 F.2d 377, 379-80, 116 USPQ 156, 158 (CCPA 1957) ("[R]egistrations...constitute prima facie evidence of ownership...which ownership is prima facie evidence of use.... The presumption of use created by the registration is deemed to relate back to the filing date thereof.") (internal citations omitted). Because Opposer's actual first use and presumptive first use dates predate the Application, Opposer has properly pled priority. (Dkt. 1 at ¶¶ 2-4.)

Opposer has also sufficiently pled likelihood of confusion. *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030. Opposer has alleged facts sufficient to establish that the parties' marks are similar. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The VINYL Marks and Applicant's VINYL FOR A CAUSE & Design mark both

prominently feature the word VINYL—indeed, Applicant’s mark incorporates Opposer’s VINYL mark. Furthermore, Opposer’s VINYL LAS VEGAS & Design mark and Applicant’s VINYL FOR A CAUSE & Design mark both feature black circles with the word VINYL prominently featured within the circle in nearly identical fonts:

Opposer’s VINYL LAS VEGAS & Design Mark	Applicant’s VINYL FOR A CAUSE & Design Mark
	

(Dkt. 1 at ¶¶ 2-4.)

Opposer has also alleged that the services are similar. *DuPont*, 177 USPQ at 567.

Opposer has provided entertainment services related to music and the music industry under the VINYL Marks since at least August 2012. (Dkt. 1 at ¶ 3.) Opposer owns registrations for the VINYL Marks in Classes 35 and 41 for entertainment services related to music and the music industry. (*Id.* at ¶ 2, Ex. B.) Applicant intends to provide “entertainment services in the nature of recording, production, and post-production services in the field of music” in Class 41 under the VINYL FOR A CAUSE & Design mark. (*Id.* at ¶ 4.)

As a result of these, and other factual allegations in the Notice, Opposer has alleged that:

- Applicant’s proposed mark VINYL FOR A CAUSE & Design is confusingly similar to Opposer’s VINYL Marks;
- Applicant’s mark likely to cause confusion, mistake, or deception as to the source, origin, affiliation, association, connection, or sponsorship of Applicant’s services offered or to be offered under the VINYL FOR A CAUSE & Design mark with Opposer’s VINYL Marks, Vinyl Las Vegas, the Hard Rock Hotel & Casino Las Vegas, and/or with Opposer or Opposer’s activities; and

- Opposer would be damaged by the registration of the mark shown in the Application in that such registration would give Applicant a *prima facie* exclusive right to the use of VINYL FOR A CAUSE & Design, despite the likelihood of confusion, mistake, or deception with Opposer and Opposer’s VINYL Marks.

(*Id.* at ¶¶ 7-8, 13.)

These allegations in the Notice are more than sufficient to plead likelihood of confusion and survive a motion for judgement on the pleadings. *See, e.g., Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030 (likelihood of confusion sufficiently pled where marks alleged to be similar and services alleged to related); *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405-06 (TTAB 2010) (denying motion to dismiss Section 2(d) ground for cancellation because “petitioner has alleged that respondent’s mark is likely to cause confusion, mistake, or deception with Petitioner’s [mark], and/or to cause the mistaken belief by consumers of the parties’ respective goods and services and by others that Respondent or its goods or services are in some way affiliated with, sponsored by, or approved by Petitioner in violation of Lanham Act § 2(d).”) (internal quotations omitted).

Instead of addressing whether Opposer has pled a likelihood of confusion under the plausibility standard, Applicant spends the entirety of the Motion arguing that Opposer cannot *prove* a likelihood of confusion exists. (*See* Dkt. 5.) Not only are Applicant’s arguments regarding the merits of a likelihood of confusion claim unpersuasive, ***they are completely irrelevant to a determination of a motion for judgment on the pleadings.*** *See, e.g.,* TBMP § 503.02; *Advanced Cardiovascular Sys.*, 26 USPQ2d at 1041; *Wager*, 575 F.2d at 884 (D.C. Cir. 1976). As the Board has repeatedly held, Applicant’s argument regarding the merits of Opposer’s likelihood of confusion claim:

reflects a misunderstanding of the rules regarding notice pleading. Applicant has confused the requirements for pleading...with the requirements for proving...at trial or on a summary judgment. As is often stated, the purpose of notice pleading is to obviate the need to allege particular “magic words.”

Fair Indigo LLC, 85 USPQ2d at 1538.⁶

In fact, the Board recently rejected arguments identical to Applicant's in the precedential

Palm Beach Crossfit Inc. decision:

The essence of Applicant's argument is that the parties' marks are so dissimilar that the proceeding should be dismissed on this basis. Applicant is correct that, in certain circumstances, marks may be found to be so dissimilar that likelihood of confusion cannot be found as a matter of law. *See Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).⁷ However, in this case, Opposer's marks and Applicant's marks both contain silhouettes of figures with one arm extended, and we cannot say that the marks are so dissimilar that as a matter of law likelihood of confusion cannot be found. Applicant also argues that its services in Class 41 are not related to any of Opposer's goods. Because the services pertain to sports, and Opposer's goods also include sporting goods, we cannot state that the goods and services are so dissimilar that they are unrelated on their face. Whether Opposer is able to prove its allegations regarding the relatedness of the parties' respective goods and services is not a matter for determination on a motion to dismiss.

⁶ Indeed, each authority cited by Applicant to support its contention that "there is no material issue of fact or plausible claim as to a likelihood of confusion" (Dkt. 5 at 3) was decided after the introduction of evidence, and fails to address whether a likelihood of confusion has been *pled* in a manner sufficient to survive a motion for judgment on the pleadings—a fact that reflects Applicant's flawed analysis and application of Fed. R. Civ. P. 12(c). In its analysis, Applicant cites cases addressing (Dkt. 5 at 3-9): (1) appeals of a refusal to register under Section 2(d), *In re St. Helena Hosp.*, 774 F.3d 747 (Fed. Cir. 2014); *In re Viterra, Inc.*, 671 F.3d 1358 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010), *In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378 (TTAB 2006); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987); (2) appeals after a full trial and extensive discovery, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261 (Fed. Cir. 2002); (3) appeals of final decisions after full opposition proceedings and extensive discovery, *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *Murray Corp. of Am. v. Red Spot Paint & Varnish Co.*, 280 F.2d 158 (CCPA. 1960); and (4) appeals of orders granting summary judgment. *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555 (Fed. Cir. 1991); *Gen. Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1278 (TTAB 1992).

⁷ Although the Board cited *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) in support of its statement that "marks may be found to be so dissimilar that likelihood of confusion cannot be found as a matter of law," *Kellogg* was a decision on summary judgment after submission and consideration of evidence and was not determined based on the "plausibility" standard applicable here.

Palm Beach Crossfit Inc., 116 USPQ2d at 1030 (footnote added).⁸

Even if the Board were to consider Applicant's improper arguments regarding the "merits" of Opposer's claims under some standard other than the "plausibility" standard, the Motion would still be denied.⁹ Notwithstanding Applicant's argument to the contrary, there are undeniable similarities between the parties' marks and services. Even if Applicant could rely on the voluminous documentation attached to its Answer (which is blatant attempt to seek summary judgment), it would be insufficient. For example, **registrations** of third-party marks are **insufficient** alone to establish **actual use** of third-party marks.¹⁰ *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347 (Fed. Cir. 2010) (cited by Applicant) ("[T]he PTO states that the mere presence of similar third-party registrations, without more, is of only limited value for showing whether additional entrants would lead to confusion in use.") Applicant, of course, ignores that there is not a single third-party registration that has anything approximating Applicant's mark's visual

⁸ The facts alleged in *Palm Beach Crossfit Inc.* were even more favorable to the applicant than they are here. In *Palm Beach Crossfit Inc.*, the applicant sought to register its mark in Class 41 for "athletic training services." *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1027. Opposer opposed based on its registrations of its marks for **goods** in Classes 18, 25, and 28. *Id.* As discussed above, applicant argued that the opposition should be dismissed because opposer did not provide athletic training services or own a registration in Class 41. The Board has rejected this argument, as noted above. Here, Opposer has alleged that the parties' marks are used for entertainment services related to music, Opposer owns registrations in Class 41, and Applicant seeks a registration in Class 41. Clearly Applicant's argument that the "services at issue are dissimilar" cannot be taken seriously, particularly in light of the standard application to a motion for judgment on the pleadings. (Dkt. 5 at 6-7.)

⁹ Applicant's repeated references to "material issue[s] of fact" and reliance on summary judgment authority suggests that Applicant intends the Board to convert the Motion into a summary judgment motion. This improper because, *inter alia*, Applicant filed the Motion before initial disclosures were served. TBMP § 504.03 ("Treatment of a motion for judgment on the pleadings as a motion for summary judgment generally would result in a premature motion for summary judgment if the moving party had not served its initial disclosures prior to filing the motion."); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment premature where movant had yet to serve initial disclosures).

¹⁰ And, given the procedural posture, Opposer is precluded from introducing any evidence of use or lack thereof.

similarity to Opposer's VINYL Marks. Furthermore, Applicant contends that the "consumer" for its services are "bands and other music artists," and not the consumers who will purchase the records created by Applicant. (Dkt. 5 at 8.) However, this argument is contrary to the evidence of which Opposer is aware.¹¹ Nevertheless, such an inquiry is not one that should be done on a motion for judgment on the pleadings.

2. Opposer Has Pled A Ground For Opposition Under Section 43(c)

A claim for dilution by blurring under Lanham Act § 43(c), 15 U.S.C. § 1125(c), requires that an opposer allege that: (1) the opposer owns a famous mark that is distinctive; (2) the applicant is using a mark in commerce that allegedly dilutes opposer's mark; (3) the applicant's use of its mark began after opposer's mark became famous; and (4) applicant's use of the mark is likely to cause dilution by blurring. *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030-31; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001).

Opposer has properly pled this ground for opposition. Opposer has properly alleged that its VINYL Marks are famous and distinctive because, *inter alia*, Opposer has extensively

¹¹ Applicant sells recorded music and related merchandise under the VINYL FOR A CAUSE & Design mark through its website available at the domain <<http://www.vinylforacause.com/shop>> and related domains. (Aigboboh Decl. ¶ 3, Ex. A.) Opposer is not aware of any Board authority permitting judicial notice of a party's website, but federal courts authorize judicial notice "of information publicly announced on a party's website." *Volpe v. Am. Language Commun. Ctr., Inc.*, 2016 U.S. Dist. LEXIS 103850, at **5-6 (S.D.N.Y. July 29, 2016) ("[F]or purposes of a 12(b)(6) motion to dismiss, a court may take judicial notice of information publicly announced on a party's website, as long as the website's authenticity is not in dispute and it is capable of accurate and ready determination.") (internal quotations and citations omitted). As such, Opposer requests that the Board take judicial notice of the true and correct copies of relevant portions of the webpages available at the domain <<http://www.vinylforacause.com/shop>> and related domains attached to the Aigboboh Declaration as **Exhibit A**. Regardless of whether the Board takes judicial notice, the issue related to Applicant's website clearly illustrates *why* Applicant's attempt to adjudicate the merits of Opposer's claims based solely on the "pleadings" is improper. Neither the Board nor Opposer are required to rely on Applicant's arguments regarding Opposer's claims, and it would be folly to do so, given Applicant's misrepresentation of the facts.

promoted them, they have received considerable media attention, and they are associated with the venue Vinyl Las Vegas located in the world-famous Hard Rock Hotel & Casino Las Vegas that has hosted events established national and international entertainers, and other entertainment-related events including awards shows. (Dkt. 1 at ¶¶ 1-3, Exs. A-B.) Opposer has alleged that its VINYL Marks were famous before Applicant used its VINYL FOR THE CAUSE & Design mark (in fact, the Application was filed on an intent-to-use basis meaning that Applicant has not yet used its mark). (*Id.* at ¶¶ 1-4.) Opposer has alleged that the parties' marks are similar and goods are similar and, that, as a result of such similarity dilution is likely. (*Id.* at ¶¶ 10-13.) These allegations are sufficient to state a claim for dilution. *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1030-31.

As with likelihood of confusion, Applicant argues that Opposer cannot *prove* dilution because Opposer “just began using its marks four years ago,” “Applicant [and] Applicant’s counsel...never heard of Opposer’s marks,” and “Applicant’s mark is sufficient dissimilar to Opposer’s mark,” (Dkt. 5 at 9-12), as opposed to whether Opposer has alleged facts sufficient to meet the plausibility standard. This is improper,¹² and the Board recently rejected identical arguments in the precedential decision *Palm Beach Crossfit Inc.*, 116 USPQ2d at 1031:

¹² Applicant’s arguments are also unavailing. Applicant’s arguments meritless—there is no “temporal” limitation on fame, whether Applicant or its counsel aware of marks has no bearing on whether they are famous and, contrary to Applicant’s contentions, the parties’ marks are not “dissimilar”. They also ignore relevant factors necessary to a determination of dilution and the fact that dilution is a fact-intensive inquiry that cannot be decided based solely on the pleadings. *See, e.g.*, 15 U.S.C. § 1125(c)(2)(A). (fame factors include “the duration, extent, and geographic reach of advertising and publicity of the mark” and “the amount, volume, and geographic extent of sales of goods or services offered under the mark”); *Research in Motion Ltd. v. Defining Presence Mktg. Group, Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012) (fame determined “based on th[e] extensive record”); *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1887 (TTAB 2011) (determining fame after review of “non-exhaustive factors” in §1125(c)(2)(A)); *Rolux Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1191–93 (TTAB 2011) (same).

Applicant's arguments . . . again focus on whether Opposer will prevail on its claims rather than the sufficiency of those claims. Applicant argues similarity is an integral element of the dilution by blurring claim, and the lack of similarities between the marks means there can be no dilution by blurring. Again, however, because both marks involve silhouettes of figures with one arm extended, we cannot say that the marks are so dissimilar that as a matter of law there can be no dilution. We find that Opposer's pleading of dilution is sufficient.

That Applicant attempts, improperly, to require Opposer to prove its claims at this stage is made clear by the authority on which it relies. Each authority cited by Applicant is a determination of the merits of a dilution claim after *evidence has been introduced*.¹³ None address motions for judgment on the pleadings, or have any bearing on whether Opposer has *pled* a likelihood of dilution sufficient to meet the minimal notice pleading standards of Fed.R.Civ.P. 8.

In sum, Applicant has presented a brief in support of its Motion that is replete with errors of law and violations of Board procedures. Procedurally and substantively, Applicant's Motion is defective and must fail.

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¹³ *Coach*, 668 F.3d 1356, (appeal after trial and discovery); *Top Tobacco, LP v. N. Atl. Operating Co.*, 509 F.3d 380 (7th Cir. 2007) (same); *Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 763 (8th Cir. 2005) (appeal of order on post-trial motion); *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011) (decision after extensive discovery); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1167 (TTAB 2001) (decision after final hearing and submission of briefs, trial testimony, exhibits, and discovery responses).

V. **CONCLUSION**

Based on the foregoing, Opposer requests that the Board deny the Motion in its entirety.

Respectfully submitted,

Dated: October 4, 2016



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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 4th day of October, 2016.

/LaTrina Martin/

LaTrina Martin

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **OPPOSER HRHH IP, LLC'S OPPOSITION TO APPLICANT VICE VERSA RECORDS, LLC'S MOTION FOR JUDGMENT ON THE PLEADINGS** is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

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on this 4th day of October 2016.

/LaTrina Martin/

LaTrina Martin

SMRH:479262262.10