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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

In the Matter of:  
Application Serial No. 86715985  
Published in the *Official Gazette*  
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HRHH IP, LLC

Opposer,

v.

VICE VERSA RECORDS, LLC

Applicant.

Opposition No. 91229467

Serial No. 86715985

**APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO  
APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS**

Opposer's Response is largely an exercise in misdirection. Instead of answering or even addressing Applicant's main arguments, Opposer instead argues that (1) Applicant's service of its Motion was improper, (2) Applicant relied on erroneous standards of law, (3) Applicant's case law centers on post-discovery rulings, and (4) Opposer did in fact plead plausible likelihood of confusion and dilution claims. Opposer's arguments are not persuasive.

## **I. SERVICE OF APPLICANT'S MOTION**

Opposer's objection to the means of service of Applicant's Motion for Judgment on the Pleadings is without merit. Service by electronic transmission is permitted "when mutually agreed upon by the parties." 37 CFR 2.119(b)(6).

### **A. The Parties Established Service by Email**

First, even though it is the understanding of Applicant's counsel that the parties explicitly established service by electronic mail over a phone call proceeding Opposer's filing of the Opposition, the parties irrefutably established communication and exchange of documents by email prior to Applicant filing its Motion for Judgment on the Pleadings. On July 26, 2016, Applicant's counsel sent its response to Opposer's July 6, 2016 demand letter via electronic mail. Opposer's counsel promptly received Applicant's formal response letter and the parties thereafter addressed the merits of the case over the phone. Applicant's counsel and Opposer's counsel thereafter regularly communicated via email, sending over a dozen email messages. Quite predictably, Opposer's counsel promptly received Application Motion for Judgment on the Pleadings the day Applicant sent it on September 14, 2016. *See* Declaration of Benjamin O. Aigboboh, Dkt. No. 7.

### **B. The Spirt and Purpose of The Rule of Service was Fulfilled**

In objecting to Applicant's service of its Motion, it is important to point out that Opposer does *not* argue that (1) it did not receive Applicant's Motion on the date that it was electronically delivered

(in fact Opposer admits to receiving the Motion on the day it was emailed), (2) the Motion was different than the one filed or was missing any parts or exhibits, or (3) that Opposer was sincerely and genuinely prejudiced in any way by Applicant's service by electronic mail.

Instead, Opposer states that it was not given the "five extra days" to respond that it would have been permitted had Applicant sent its motion by First Class mail. This is not a genuine objection for two reasons. First, the "five extra days" simply factors in the time that postal services usually take (3-5 business days) to ship a package. Had Applicant sent its Motion only by First Class mail, Opposer would have likely received the Motion five days later than it did. By getting Applicant's Motion via email, Opposer received Applicant's Motion the very day it was sent. In other words, Opposer would have had the same amount of time to respond to Applicant's Motion regardless of whether it was mailed or emailed. Second, just as Applicant was willing to grant Opposer an extension of time to file the original Opposition, Applicant would have readily granted Opposer a reasonable (five-day) extension if Opposer would have simply requested one. However, Opposer did not request one, most likely to in order to make this frivolous objection.

**C. Justice Clearly Favors Adjudicating Applicant's Motion on the Merits**

Opposer admits to receiving Applicant's Motion via email, acknowledges that it received Applicant's Motion the same day it was delivered, and was afforded to the proper time to file a response and did file a detailed, 15-page response. Because Opposer's receipt of Applicant's Motion, as well as the date of receipt are not in dispute, the spirit and purpose of the service requirement was achieved and the Board should not resort to the extraordinary recourse of denying Applicant's Motion. While Opposer will not be prejudiced by Applicant's means of service but if the Board denied Applicant's Motion based on the propriety of service, Applicant would be severely prejudiced, as it

would have to expend exceedingly more resources addressing this frivolous Opposition.<sup>1</sup> Furthermore, such a recourse would needlessly waste time and judicial resources, as Applicant would ultimately file a similar motion weeks later after the parties “exchange disclosures,” and the parties would likely have to build on the content of the arguments and case law in the current Motion and Responses.

## **II. PROPER LEGAL STANDARD**

In an attempt to confuse the issue, Opposer objects to and argues against Applicant’s legal standards for Motions for Judgment on the Pleadings. Specifically, Opposer argues that Applicant relies on outdated case law and Applicant relies on an incorrect “summary judgment” standard for its Motion for Judgment on the Pleadings, and Opposer need not *prove* its claims of likelihood of confusion and dilution. Opposer’s arguments are misplaced.

### **A. Applicant’s Case Law is Correct and Reliable**

While not objecting to most of the legal standards and case law Applicant cites in its “General Legal Standard” section Motion for Judgment on the Pleadings, Opposer takes issue with Applicant’s citation to *Lloyd’s Food Products Inc. v. Eli’s Inc.*, 987 F.2d 766 (Fed. Cir. 1993), *Hamlet v. U.S.*, 873 F.2d 1414, 1416 (Fed. Cir. 1989), and *B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 728 (Fed. Cir. 1988) because it “has not stood the test of time.” *See* Resp. Mot. J. Pl., Dkt. No. 6, page 5 (“Dkt. No. 6”). Opposer is mistaken on all three counts.

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<sup>1</sup> The non-binding case law Opposer cites focuses on circumstances entirely different and distinguishable from the present case. In *McKenna v. Nat’l Action Fin. Servs.*, the court declined to exercise the extraordinary remedy of dismissing a case based on the plaintiff’s failure to respond to a Fed.R.Civ.P. 68 offer of judgment that was not served properly. 2008 U.S. Dist. LEXIS 29791, at \*\*1-2 (S.D. Fla. Apr. 11, 2008). In *Wynn v. Amtrak*, in the context of a motion to show cause where the plaintiff neglected to respond to discovery requests after months and a court order, the court did not accept plaintiff’s purported unsuccessful attempts to call defendant’s counsel as evidence of its effort to respond to discovery requests. No. 12-CV-10770, 2008 U.S. Dist. LEXIS 8800, at \*8 n.2 (N.D.N.Y Feb.5, 2008). The only somewhat analogous case Opposer cites is *Reliable Carriers, Inc. v. Taylor Online Mktg.*, wherein the court refused to strike defendant’s motion to dismiss due to service via electronic service. 2012 U.S. Dist. LEXIS 82105 at \*3 (E.D. Mich. June 13, 2012). While the court in *Reliable Carriers*, focuses on the fact that defendant was *pro se*, it also decided that the justice favored ruling on the motion over striking it based on “procedural, technical rules.” 2012 WL 2154970, at \*2.

First, the TTAB regularly uses “summary judgment” type language to describe the standard for motions for judgment on the pleadings. *See Ava Enterprises Inc v. P.A.C. Trading Group, Inc.*, 86 U.S.P.Q.2d 1659, 1660 (TTAB. 2008) (“A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law.”); *Leeds Techs.*, 65 U.S.P.Q.2d 1303 (TTAB 2002 (citing *Baroid Drilling Fluids, Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992))); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992).

Indeed, as one court put it, “the Rule 12(c) standard, when invoked in an attempt to dispose of the case on the substantive merits, is analogous to the summary judgment standard, except that the court may consider only the contents of the pleadings.” *Burlington Ins. Co. v. Phillips-Garrett, Inc.*, 37 F. Supp. 3d 1005, 1010 (S.D. Ill. 2014) (citing *Alexander v. City of Chicago*, 994 F.2d 333, 336 (7th Cir.1993)). Second, Applicant’s reliance on *In Hamlet v. United States* for the proposition that it is “appropriate” for a district court to grant a motion for judgment on the pleadings if it is “beyond doubt that the non-movant can plead no facts that would support his claim for relief,” is correct. *In Hamlet v. United States*, 873, F.2d 1414, 1416, (Fed.Cir.1989).<sup>2</sup> Federal courts continue to use the same standard and language. *See e.g., Henry Hous. Ltd. P’ship v. United States*, 95 Fed. Cl. 250, 254 (2010) (*Owen v. United States*, 851 F.2d 1404, 1407 (Fed.Cir.1988) (“[A] motion for judgment on the pleadings should be granted only where it appears to a certainty that plaintiff is entitled to no relief under any state of facts which could be proved in support of his claim.”)); *Garner v. United States*, 85 Fed. Cl. 756, 758–59 (2009).<sup>3</sup> Again, Opposer’s objection is misplaced.

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<sup>2</sup> The quote in Applicant’s original motion is actually a combination of *Chance v. Armstrong*, 143 F.3d 698, 701 (2d Cir. 1998) and *In Hamlet v. United States*, 873, F.2d 1414, 1416, (Fed.Cir.1989).

<sup>3</sup> *Guantanamo Cigar Co., Inc.*, CANCELLATION 9205884, 2015 WL 10734138, at \*8 (Mar. 12, 2015) echoes the same point, but it is not citable precedent.

Third, the proposition in *B.V.D. Licensing* that the TTAB may consider in motions for judgment on the pleadings any fact of which the TTAB elects to take judicial notice is certainly a valid legal standard. *See Askew v. Sec’y of Health & Human Servs.*, No. 10-767V, 2012 WL 2061804, at \*5 (Fed. Cl. May 17, 2012) (quoting *Samuels v. Air Transport Local 504*, 992 F.2d 12, 15 (2d Cir.1993) (“The court may consider ‘documents attached as exhibits or incorporated by reference in the pleadings and matters of which judicial notice may be taken.’”)); *Sebastian v. United States*, 185 F.3d 1368, 1374 (Fed. Cir. 1999).<sup>4</sup> Opposer’s objection again is incorrect and without merit.

### **B. Applicant “Plausibility Standard” Is The Correct Legal Principle**

Throughout its Response, Opposer creates a straw man argument by falsely characterizing Applicant’s plausibility standard as a “proof” standard. *See e.g.*, Opposer’s Response, Dkt. No. 6, page 10-11. However, Applicant’s actual argument is that the facts in the pleadings and attached exhibits (as well as those of which the Court elects to take judicial notice) make it clear that Opposer’s alleged facts are insufficient to meet the plausibility standard. *See Ashcroft v. Iqbal*, 556 U.S. 662 (2009) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Opposer’s pleadings must support a facially “plausible” claim to relief in order to avoid dismissal and Applicant argues that the “factual content” in the pleadings and the judicially-noticed records does not permit the Board to draw a “reasonable inference” that there is a likelihood of confusion and dilution. *Iqbal*, 556 U.S. at 678.

### **III. APPLICANT’S ANALOGIES TO POST-DISCOVERY CASE LAW**

As the TTAB and other federal court regularly use summary judgment-like language and standards in the context of judgment on the pleadings (requiring “no genuine issue of material fact”), and as summary judgment rulings are particularly probative for judgment on the pleading cases when such rulings are based primarily if not exclusively on the similarity of the marks or other non-

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<sup>4</sup> Indeed, later in its Response, Opposer relies on the principle of judicial notice. *See* Dkt. No. 6, page 13n.11.

discovery-based considerations, Applicant's invocation of and citation to cases resolved on summary judgment (or other levels of resolution) is proper and persuasive.

Specifically, several of Applicant's cited cases were resolved primarily if not exclusively on non-discovery-based considerations. *See General Mills Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270, 1278 (T.T.A.B.1992) (finding that, "notwithstanding the identity of the goods, the marks [FIBER ONE and FIBER 7 FLAKES] are sufficiently dissimilar such that consumers are not likely to be confused"); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011) (affirming TTAB's holding that CAPITAL CITY BANK marks for banking and financial services and CITIBANK marks for banking and financial services are not likely to cause confusion based *solely* on dissimilarity of the marks and lack of actual confusion); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, based *solely* on the two marks' "appearance, sound, connotation, and commercial impression"), *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006) (overturning examiner's likelihood of confusion refusal based solely on the sophistication of the consumers and the appearance and commercial impression of the marks, despite the close similarity of the goods); *Hyloft, Inc. & Ke Investments, Inc.*, 2010 WL 4113161, at \*9 (Oct. 7, 2010) ("Despite the identity of the goods and channels of trade, we find that the differences between the marks warrant a finding that there is no likelihood of confusion . . . . [s]imply put, we find that the dissimilarity of the marks simply outweighs the other relevant factors."); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (same).

Additionally, there are number of TTAB and federal cases that have resolved likelihood of confusion claims in the dismissing party's favor based on a motion for judgment on the pleadings or

motion to dismiss standard. *See e.g., Fortres Grand Corp. v. Warner Bros. Ent't Inc.*, 763 F.3d 696 (7th Cir. 2014) (granting defendant's motion to dismiss because likelihood of confusion was implausible); *Red Bull GmbH v. Andale Energy Drink Co., LLC*, 2014 WL 11030991, at \*4 (Aug. 19, 2014) (granting Applicant's motion for judgment on the pleadings and dismissing Opposition based on the fact that "the marks are too dissimilar to find a likelihood of confusion").<sup>5</sup>

#### **IV. THE PLAUSIBILITY OF OPPOSER'S LIKELIHOOD OF CONFUSION AND DILUTION CLAIMS.**

The crux of Applicant's argument is as follows: Applicant's mark is not sufficiently similar to Opposer's marks to establish a *plausible* likelihood of confusion or dilution claim based on the differences between the marks, the services offered under the marks, the channels of trade, and the sophistication of consumers/purchasing conditions—in light of Opposer's admission in a USPTO filing that the marketplace is such that consumers are "savvy enough" to differentiate between the many VINYL-based registered marks, and that the marketplace is such that Opposer's VINYL mark (used in connection with live music performance services) is not likely to be confused with VINYL SOUL (used in connection with entertainment, namely, live performances by a musical band). *See* Dkt. No. 5, pages 2-12.

Most importantly, because the marks are conclusively dissimilar on their own and especially so *in light of Opposer's admissions*, the Board simply cannot draw a reasonable inference supporting a likelihood of confusion or dilution claim.<sup>6</sup>

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<sup>5</sup> Although *Kellogg Co. v. Pack'Em Enterprises Inc.* was resolved on summary judgment, the TTAB's holding directly applies to judgment on the pleadings. 14 U.S.P.Q.2d 1545 (TTAB 1990) (holding likelihood of confusion claim fails as a matter of law because FROOTEE ICE and FOOT LOOPS marks were conclusively dissimilar).

<sup>6</sup> Opposer's Office action response (and the statements and representations contained therein) is an "objective verifiable fact" that is "part of the public record," as well as the Opposer's "application records" of which this Board can and should take judicial notice pursuant to Fed. R. Evid. 201(b). *Nike, Inc. vs. Palm Beach Crossfit Inc.*, 116 U.S.P.Q.2d 1025 (T.T.A.B. 2015). Opposer cannot reasonably question the accuracy of its own verified statements and representations. *Id.*; *Terry v. United States*, 103 Fed. Cl. 645, 652 (2012) (citing *Wyser-Pratte Mgmt. Co. v. Telxon Corp.*, 413 F.3d 553, 560 (6th Cir.2005) ("In addition to the allegations

Opposer’s cited marks include a standard character VINYL mark and two special form VINYL LAS VEGAS & Design marks:



In contrast, Applicant’s mark is a special form mark consisting of a unique and creative design and the unitary phrase “VINYL FOR A CAUSE.”



Although the literal elements both marks contain the term “VINYL” and the design elements in both marks contain some kind of circle, those are the only similarities: the distinctive differences between the two marks (Applicant’s unitary phrase, Applicant’s vinyl record illustration, Applicant’s mirror skyline of Chicago, Opposer’s inclusion of “Las Vegas,” Opposer’s slanted wording), conclusively establish the dissimilarities of the marks—especially in light of the several other VINYL-based registration marks:<sup>7</sup>



in the complaint, the court may also consider other materials that are . . . otherwise appropriate for the taking of judicial notice.”)). Indeed, in its Response Brief, Opposer did not question (let alone address) them.

<sup>7</sup> While the Board ordinarily does not take judicial notice of third-party registrations, *see Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987), this is an exceptional case because the above third-party registrations were all listed by *Opposer* in its August 2015 Office action response, a response that Opposer verified by signature. *See Applicant Answer*, Exhibit B, Dkt. No. 4. Because Opposer’s Office action response (and the exhibits attached thereto) is a public document and part of Opposer’s application record (the accuracy or reliability of which cannot be reasonably questioned), *Nike, Inc. vs. Palm Beach Crossfit Inc.*, 116 U.S.P.Q.2d 1025 (T.T.A.B. 2015), the Board should take judicial notice.

VINYL LIFE



VINYL TEMPEST

Dusty Vinyl

Weekend Vinyl

VINYL FRONTIER



Both the literal elements are design elements between the marks readily dissimilar—particular in light of the other marks that Opposer admits affect the marketplace. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374–75 (Fed. Cir. 1998) (affirming the TTAB holding that no likelihood of confusion existed as a matter of law due to the “dissimilarity [between the marks], despite that fact that goods and channels of trade were the same).

Additionally, Applicant’s mark has a unique and distinct commercial impression. The phrase “VINYL FOR A CAUSE” is a coined phrase that alludes to Applicant’s services: recording vinyl records for a charitable purpose. It is inherently distinctive (which is why the examiner did not require Applicant to disclaim the term “VINYL). In contrast, the commercial impression of Opposer’s mark is either Las Vegas-related or simply indistinguishable from the numerous other third-party VINYL marks.

Simply put, the appearance, sound, and commercial impression of the mark are conclusively distinguishable. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374 (Fed. Cir. 1998) (affirming TTAB’s dismissal of opposition because the marks [CRYSTAL CREEK and CRISTAL/CRISTAL CHAMPAGN & Design] were conclusively dissimilar); *Omega Sa (Omega Ag) (Omega Ltd.)*, 118 U.S.P.Q.2d 1289 (T.T.A.B. Mar. 31, 2016) (determining as a matter of law that the applicant’s design mark was not likely to cause confusion with opposer’s word and design marks based solely on the dissimilarity of the marks even though both of the marks shared the term “OMEGA” and some design elements); *See Red Bull GmbH*, 91204861, 2014 WL 11030991, at \*4 (Aug. 19, 2014).

Opposer's likelihood of dilution claim, moreover is also conclusively defeated by the dissimilarity between the marks.<sup>8</sup> *See Hyloft, Inc. & Ke Investments, Inc.*, 2008, 2010 WL 4113161, at \*11 (Oct. 7, 2010) (stating that, given its finding that the marks are sufficiently dissimilar to preclude a likelihood of confusion claim, it we "must also find that the marks are not substantially similar in the context of dilution [because] the dissimilarity of the marks outweighs all the other factors").

### CONCLUSION

Here, the facts in the pleadings and attach exhibits, as well as the fact of which this Board should take judicial notice, demonstrate that Opposer's likelihood of confusion and dilution claims are implausible.

WHEREFORE, for the foregoing reasons and reasons set forth in the accompanying Memorandum of Law, Applicant respectfully request that this Board grant its Motion for Judgment on the Pleadings.

Respectfully submitted,

Date: October 19, 2016

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<sup>8</sup> Opposer's dilution claim also fails as a matter of law because the factual allegations it has pleaded are insufficient to plausibly establish a the necessary element of fame. *See Boarding Sch. Review, LLC v. Delta Career Educ. Corp.*, No. 11 CIV. 8921 DAB, 2013 WL 6670584, at \*7 (S.D.N.Y. Mar. 29, 2013) (dismissing on a motion to dismiss a dilution claim because defendants "failed to plead sufficient facts making it plausible that their marks are famous," even though defendants alleged years of use, number of consumers, money spent on marketing, public renown). Opposer dilution claim also fails as a matter of law because it did not properly plead a date when Opposer's mark became famous. *See Omega Sa (Omega Ag) (Omega Ltd.)*, 118 U.S.P.Q.2d 1289 (T.T.A.B. Mar. 31, 2016); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000).

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing RESPONSE TO OPPOSER'S REPLY TO APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS was served on Counsel for Opposer via electronic mail *and* First Class mail to the email addresses below:

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