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

Proceeding	92055269
Party	Defendant Tango Mango, LLC
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Two of the Petitioner's Marks were filed after the Registrant's Mark, and neither received a refusal based on the Registrant's Mark;

Neither Party knew of the other or its Marks until this proceeding, and neither Party is aware of any actual confusion between the Parties or their Marks;

Since February 2012, the Petitioner has filed seven other oppositions/cancellations and one request to extend time to file an opposition (which has not yet turned into an opposition) against marks including the term MANGO or MANGOS;

The Petitioner does not operate a specialty restaurant.

The Petitioner's Opposition fails to distinguish between its various Marks and the goods and services offered under each Mark. This "fudging" of the analysis belies the weakness of its allegations of a likelihood of confusion. In regard to its abandonment claim, the Petitioner provides no facts to dispute the Registrant's facts and offers no case law to support its position.

II. PETITIONER FAILED TO ALLEGE PRIORITY AND STANDING

The assertions that Mr. Wallack's declaration, "along with the exhibits attached thereto" demonstrates the Petitioner's priority of each of its pled Registrations are inaccurate. The priority at issue is when the Petitioner began use of each of its Marks, **not** when it opened its establishment. Nowhere in Mr. Wallack's declaration are there allegations of dates of first use for any of its Marks. *See Id.*, Ex. A. The Petitioner's citation to *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (C.C.P.A. 1974) is unfounded, as that case concerned an opposition. "With respect to [a] cancellation proceeding, because both parties have registrations, it is plaintiff's burden to demonstrate that its use of its [mark] is prior to defendant's use of its registered marks." *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 U.S.P.Q.2d 1213, 2011 TTAB LEXIS 259, *22 (T.T.A.B. Aug. 29, 2011).

For standing the Petitioner's belief of damages "must have a '**reasonable** basis in fact.'" *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 U.S.P.Q.2d 1023, 1027 (Fed. Cir. Mar. 15, 1999)

(emphasis added) (quotation omitted). Unlike the cases cited by the Petitioner, the Parties' Marks have co-existed for almost a decade without actual confusion, and each of the Parties had Marks registered without a likelihood of confusion citation based on the other Parties' prior registration(s).¹ Dkt. 30, Exs. 4, 5, and Spinetta Decl., Ex. C. These facts demonstrate that the Petitioner's claims of damages are unreasonable.²

III. THERE IS NO LIKELIHOOD OF CONFUSION³

Once more, the Petitioner fails to provide an analysis for each of its Marks and ignores any distinctions between them. The Petitioner's arguments throughout its Opposition also focus solely on its Marks for restaurant services. *See, e.g.*, p. 7, and p. 12. The Petitioner's silence on its Marks for goods supports a finding that the Petitioner concedes there is no likelihood of confusion between those Marks and the Registrant's Mark.⁴

A. The Parties' Marks Are Dissimilar and Prevent a Likelihood of Confusion

The Petitioner cannot dispute the fact that, barring one term, the Parties' Marks consist of different elements. Nor can the Petitioner dispute the legal principle, or distinguish the cases, that a likelihood of confusion is not created merely due to a shared term. *See* Dkt. 30, pp. 9, 14.

¹ The Petitioner's reliance on the Board's Order regarding the Petition to Amend is misguided. In that Order the Board was discussing whether to allow an amended petition to cancel, not whether the Petitioner would reasonably be damaged.

² The Petitioner's desire to purge all registrations with the term "mango" also supports this finding.

³ The Petitioner is wrong in its statement that the Registrant offers only four reasons for there being no likelihood of confusion. The Petitioner combines two reasons and ignores two additional reasons: the Petitioner's Marks are not famous, and there is a lack of actual confusion despite concurrent use. These two factors should be seen as conceded in the Registrant's favor.

⁴ Therefore, the following Marks are no longer at issue and judgment should be entered in the Registrant's favor: Registration No. 3,700,648; No. 3,512,984; and No. 3,649,192.

The argument that descriptive or disclaimed terms are immaterial in a likelihood of confusion analysis is inaccurate. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). “TANGO” is the dominant portion of the Registrant’s Mark. *See* Dkt. 30, p. 10. The Petitioner offers no real argument to the contrary. Any suggestion that “mango” is the dominant portion of the Registrant’s Mark because “tango” is descriptive is inaccurate and factually unsupported. The Registrant offered uncontroverted evidence that the “tango” dance is in no way associated with its services. Dkt. 30, Spinetta Decl. ¶ 16, and Exs. A, B, D, and E.

Throughout its Opposition the Petitioner attempts to “turn around” the Registrant’s arguments and apply interpretations and meanings equally to both Parties, completely disregarding the differences in the Parties’ Marks and the actualities of the services and how they are offered. This effort refuses to acknowledge the basic tenant of trademark law that it is **the impression of the mark as a whole** that matters, not the parts of a mark. *Massey Junior College, Inc. v. Fashion Institute of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Therefore, marks must be compared in their entirety and **not** dissected or split into their component parts with each part of the applied-for mark compared to a corresponding part of the cited marks.

The Petitioner tries to discount the alternative meaning of “mango,” as applied to its Marks. To do so, the Petitioner (1) ignores portions of the Registrant’s exhibit, (2) ignores the reality of how its services are advertised and offered, and (3) misapplies the applicable law. In addition to the one source discussed by the Petitioner, the Registrant provided a definition from COLLINS COMPLETE SPANISH ELECTRONIC DICTIONARY (HarperCollins), defining “mango” as a “good-looking lad” (Dkt. 30, Ex. 10), which also supports the Registrant’s Cross-Motion.

The Petitioner’s claims that there is no reason why “mango” would be translated ignores that, in light of the Petitioner’s services and how they are advertised coupled with the possessive

form the Petitioner's Mark ("MANGO'S"), consumers would apply the alternative meaning of "mango" to the Petitioner's Marks. *See, e.g.*, Dkt. 30, pp. 5, 11, and Exs. 10-12. The Petitioner's own case law supports this position. "[F]oreign words from common languages are translated" when "an American buyer [meaning someone knowledgeable in the foreign language] will translate the foreign mark." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 U.S.P.Q.2d 1689, 1696 (Fed. Cir. 2005), and *In re Mark Thomas*, 2006 TTAB LEXIS 135, 79 U.S.P.Q.2d 1021, 1024 (T.T.A.B. Apr. 26, 2006). A term need **not** be primarily considered a foreign term to be translated; rather, there must only be a likelihood that the term will be translated. *Palm Bay*, 396 F.3d at 1369.

The term "mango" has an alternative meaning in Spanish, a well-known modern foreign language. This meaning is appropriate for the Petitioner's Marks because the advertisements for and manners in which the Petitioner's services are offered are all sexualized and includes "good-looking" men and women. *See* Dkt. 29, Ex. A, Ex. 1, and Dkt. 30, Ex. 11. The relevant consumer who speaks Spanish, upon seeing the Petitioner's services, would be likely to think of this slang meaning for "mango." The context in which the Petitioner's Marks are encountered causes the foreign meaning to be applicable. In contrast, the context in which consumers encounter the Registrant's Mark makes it unlikely that the slang meaning would be considered. The Registrant's service is a family-friendly taqueria and is not offered in a sexualized manner by "good-looking" men and women. Dkt. 30, Spinetta Decl. ¶¶ 9-14, and Exs. A, B.

The Petitioner again over-generalizes and refuses to acknowledge differences between the Parties' Marks when it argues that any mark, including a type of dance, must be viewed in the same way. The Registrant's Mark consists solely of the terms "TANGO" and "MANGO." These terms, in this order, do not inherently suggest dancing is involved. In contrast, the

Petitioner's MANGO'S MAMBO BAR Mark does suggest dancing because (1) "MANGO'S" is possessive, (2) the combination of "MAMBO BAR" connotes precisely a bar where the mambo is performed, and (3) the Mark includes the design of two large drums that connote actual dancing. None of these terms or features is in the Registrant's Mark, and the analysis of "TANGO" in the Registrant's Mark is not the same as "MAMBO" in the Petitioner's Mark.

The Petitioner also argues the "Registrant does nothing to distinguish [the] 'tropical nature' [of the Petitioner's design elements] from the [Registrant's] 'bright, colorful, and playful atmosphere.'" Dkt. 32, p. 11. The Petitioner also, for the first time and with no citations to evidence, alleges that it views its Marks as "bright, colorful, and playful." The Petitioner's apparent position that anyplace that is bright, colorful and playful must be tropical is absurd.

B. The Parties' Services and Channels of Trade Are Dissimilar⁵

The Petitioner's argument that the Parties' services are legally identical ignores that the Petitioner's Marks are also for, and primarily advertised as, nightclub services. The Petitioner's "publicity" and advertisements all focus on, or only mention, the nightclub services offered by the Petitioner. Dkt. 29, Wallack, Ex. 2. Each of the Petitioner's Marks that are for restaurant services is also for bar services, and all its word Marks are also for nightclubs. Dkt. 29, Ex. B. The Petitioner's argument also ignores that the Registrant's Mark is for a specialized, taqueria-style, family-friendly restaurant, whereas the Petitioner's restaurant services are for a large menu, non-specific cuisine where scantily clad employees are prevalent. *See* Dkt. 30, p. 15.

The Petitioner bills itself as a "hotspot" and emphasizes its nightclub services. *See* Dkt. 30, pp. 17-18. This is in contrast to the Registrant's services and how they are advertised.

⁵ The Petitioner does not attempt to argue that the goods under its Marks and the services under the Registrant's Mark are similar. Their dissimilarity is considered conceded.

Id. The Parties' services are directed to different classes of customers and travel in different channels of trade. The Petitioner's emphasis on its nightclub and bar services would draw a consumer looking for a nightclub or bar. If the Petitioner's place is a "hotspot," consumers seeking out that type of service would be careful in choosing the location since one of main points of a "hotspot" is to see and be seen.

C. The Registrant's Level of Evidence Is Superior

The evidence of third-party use proffered by the Registrant is more than sufficient to show that the public is accustomed to the term "mango" in regard to a restaurant or related service. Specifically, the Registrant's evidence included: (1) nineteen registrations/applications based on use (and the Petitioner admits nine of these are for related goods or services); (2) more than 100 different restaurants (not including repeated locations under the same name or mark, such as RED MANGO, or any establishment identified as "closed") as identified in the yellow pages; (3) about 82,500,000 results returned in an online search for "mango" and "restaurant"; (4) numerous webpages; and (5) a representative sample of Yelp reviews for approximately 25 restaurants using "mango" in their marks, which also establish that these locations are active and well-known (as may be deduced from the number of comments/reviews). The nature of this evidence also affirms (1) that entities with marks using "mango" are open,⁶ (2) that the prevalence of such entities is extensive, and (3) that consumers can distinguish them based on slight differences in their marks.

⁶ Yellow pages and Yelp update their listings to note when an establishment is closed, reviewers on Yelp include the date of their review, and webpages for inactive companies would be expected either not to work or otherwise indicate the establishment was closed.

Similar levels of evidence have been held sufficient to establish a widespread use.

Indeed, as these cases establish, there is no requirement, in contrast to the Petitioner's suggestion, that there must be at least 500 third-party uses before third-party use may be considered.

Sports Authority Michigan Inc. v. PC Authority Inc., 2002 TTAB LEXIS 65, 63 U.S.P.Q.2d 1782 (T.T.A.B. Apr. 23, 2001) (26 third-party registrations with a variety of goods and services);

Steve's Ice Cream v. Steve's Famous Hot Dogs, 1987 TTAB LEXIS 53, 3 U.S.P.Q.2d 1477, 1479 (T.T.A.B. June 23, 1987) (110 verified uses of business names);

In re Hartz Hotel Services, Inc., 2012 TTAB LEXIS 75, 102 U.S.P.Q.2d 1150, 1155 (T.T.A.B. Aug. 11, 2012) (five third-party registrations);

In re Republic Clothing Corp., 2013 TTAB LEXIS 266 (T.T.A.B. May 16, 2013) (eight registrations on the Principal Register, one on the Supplemental Register).

The Registrant's level of evidence is also superior to the sparse evidence entered in the cases relied upon by the Petitioner:

In re MobileAria, Inc., 2004 TTAB LEXIS 161, *16 (T.T.A.B. Mar. 16, 2004) (two printouts of business listings plus four third-party registrations, including for unrelated goods);

In re Fourth Wall Rests., LLC, 2012 TTAB LEXIS 330, *17 (TTAB Aug. 29, 2012) (50 eating establishments identified by *Dun & Bradstreet* report insufficient);

In re Phillips, 2010 TTAB LEXIS 215, *15 (T.T.A.B. May 26, 2010) (four third-party registrations for related services, plus ten other third-party registrations);

In re Davey Products Pty Ltd., 2009 TTAB LEXIS 524, 92 U.S.P.Q.2d 1198, 1204 (T.T.A.B. Aug. 7, 2009) (two third-party registrations);

Kraft Foods Global Brands LLC v. Brown, 2009 TTAB LEXIS 569, *7 (T.T.A.B. Aug. 20, 2009) (no third-party registrations were considered because they were not properly brought; also, none of them was related to the parties' goods);

In re Fulltone Musical Prods., 2008 TTAB LEXIS 170, *14 (T.T.A.B. Sept. 16, 2008) (evidence of 39 third-party uses, with no third-party registrations); and

Health Quest of Farmington, 2003 TTAB LEXIS 331, *11-12 (T.T.A.B. July 10, 2003) (copies of 15 webpages where the terms were not necessarily used as marks, and not on services as closely related as the parties' services.)⁷

⁷ The Petitioner's footnote suggestion that a term must be geographically descriptive as well is unfounded. Additionally, it is disputed whether the Petitioner's Mark is descriptive since the alternative meaning for "mango's" applies directly to the Petitioner's Services.

D. The Petitioner's Marks Are Weak despite Its "Policing"

The Petitioner's lackluster efforts to police its marks is considered in conjunction with the quantity of third party mark using the common term "mango." The Petitioner's reliance on *Swiss Watch Int'l, Inc. v. Fed'n of the Swiss Watch Indus.*, 2012 TTAB LEXIS 3 (T.T.A.B. Jan. 30, 2012), and *Tea Board of India v. Republic of Tea Inc.*, 2006 TTAB LEXIS 330, 80 U.S.P.Q.2d 1881, 1888 (T.T.A.B. Jan. 12, 2006), is misplaced. In both cases the question was whether the registrant of a certification mark exercised sufficient control as required by 15 U.S.C. § 1064(5)(A). *Id.* Similarly, any argument that the Registrant had to show misuse or genericness from the Petitioner's policing efforts is irrelevant and a distraction.

As in *Sports Authority*, the Petitioner's assertions of policing actually support the finding that "many of the registered marks and web sites have been put to some use, because [the Petitioner] investigated the uses, in some instances, consented to particular uses, and in others monitors ongoing use."

IV. THE REGISTRANT'S MARK IS NOT ABANDONED

The Petitioner offers barely more than a page in its efforts to assert that the Registrant's Mark was abandoned. The brevity of the Petitioner's Opposition belies the complete lack of any legal or factual basis for an allegation of abandonment. The Petitioner argues the applicable case law regarding clerical errors in identifying a mark's owner is for applications only and cannot be for the Registrant's Mark because the mistake occurred in an assignment. The Petitioner offers no legal support for this extravagant theory or why the definition of "person" differs in applications and assignments. The Petitioner also fails to provide any legal support for its declaration that a valid corrective assignment duly recorded by the USPTO is insufficient.

The Petitioner also misrepresents the assignments at issue. The Registrant never stated Knightspin LLC was the same as Tango Mango, Inc., or Tango Mango, LLC. Rather, the facts clearly show – and the Petitioner offers no support to dispute the fact – that Tango Mango LLC was in fact Tango Mango, Inc. and was merely misidentified as an LLC in the assignment documents. The Petitioner’s spurious claim that the Registrant offered no evidence to support the statement that its Mark was always used in a controlled manner and by only two entities conveniently forgets Ms. Spinetta’s declaration. Dkt. 30, Spinetta, ¶¶ 3, 5, 11, and 18-19.

The Petitioner’s final argument, that Knightspin, LLC, could not have received the Registered Mark since it was received from the nonexistent Tango Mango, LLC, is logically absurd. If Tango Mango, LLC, did not exist and, therefore, the assignment to Knightspin, LLC, was invalid, then the legal effect would be that no assignment ever occurred and the Registrant (Tango Mango, Inc.) remained the owner of the Registered Mark since its registration.

There are no genuine issues of material facts regarding the Petitioner’s allegations of abandonment. Moreover, the law clearly establishes that the Petitioner’s allegations are spurious and on the verge of frivolous. Summary judgment should be entered in the Registrant’s favor.

VI. CONCLUSION

For the reasons set forth above and in its Cross-Motion, the Registrant requests the entry of summary judgment on all counts in its favor.

Respectfully submitted,

31 December 2013
Date

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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing REGISTRANT'S REPLY IN SUPPORT OF
CROSS-MOTION FOR SUMMARY JUDGMENT served this date via e-mail on the
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