

ESTTA Tracking number: **ESTTA608631**

Filing date: **06/06/2014**

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

Proceeding	92057058
Party	Plaintiff Fifty-Six Hope Road Music Limited
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN ET AL 1901 AVENUE OF THE STARS STE 1600 LOS ANGELES, CA 90067 6017 UNITED STATES wwalters@smrh.com, mdanner@smrh.com
Submission	Opposition/Response to Motion
Filer's Name	Paul A. Bost
Filer's e-mail	pbest@sheppardmullin.com, lthompson@sheppardmullin.com, jpietrini@sheppardmullin.com, lmartin@sheppardmullin.com
Signature	/s/ Paul A. Bost
Date	06/06/2014
Attachments	Opposition Brief.pdf(233707 bytes) Doreen Crujeiras Declaration with exhibits.pdf(2983057 bytes) Bost Dec and Exhibits (1).pdf(5004998 bytes) Bost Dec and Exhibits (2).pdf(1285005 bytes)

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

*In re Matter of Application Registration No.
3,225,517 for the mark: MARLEY'S A TASTE
OF THE CARIBBEAN & Design*



Fifty-Six Hope Road Music Limited,

Petitioner,

vs.

Island Food and Fun, Inc.,

Registrant.

Cancellation No. 92-057058

**PETITIONER FIFTY-SIX HOPE ROAD
MUSIC LIMITED'S OPPOSITION TO
REGISTRANT ISLAND FOOD AND FUN,
INC.'S MOTION FOR SUMMARY
JUDGMENT; AND**

**MOTION PURSUANT TO FED.R.CIV.P.
56(d) FOR AN ORDER COMPELLING
REGISTRANT'S SERVICE OF
DISCOVERY RESPONSES WITHOUT
OBJECTION**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. FACTUAL BACKGROUND.....	2
III. THE BOARD SHOULD DENY REGISTRANT’S MOTION FOR SUMMARY JUDGMENT AND GRANT PETITIONER RELIEF UNDER FED.R.CIV.P. 56(d).....	5
A. Registrant’s Refusal to Participate in Discovery Has Precluded Petitioner from Presenting Facts in Support of its Claim for Fraud.....	6
B. Registrant is Not Entitled to Summary Judgment on Petitioner’s False Suggestion of a Connection Claim	8
1. Petitioner Adequately Pleaded its False Suggestion of a Connection Claim	8
2. Registrant’s Defense of Laches is Overcome by the Inevitable Confusion Engendered by Use and Registration of its Mark	9
3. Registrant Has Not Established that it Suffered Prejudice as a Result of Petitioner’s Alleged Delay	14
4. Registrant Cannot Establish Any Acquiescence on the Part of Petitioner	17
5. Petitioner’s Delay is Justified by the Press of Other Litigation.....	18
IV. CONCLUSION.....	19

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>Cases</u>	
<i>Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.</i> 19 U.S.P.Q.2d 1401 (11th Cir. 1991)	17
<i>Crane Co. v. Shimano Industrial Co.</i> 184 U.S.P.Q. 691 (TTAB 1975)	5
<i>Creative Gifts, Inc. v. UFO</i> 57 U.S.P.Q.2d 1321 (10th Cir. 2000)	17
<i>Cuban Cigar Brands N.V. v. Upmann Intern., Inc.</i> 199 U.S.P.Q. 193 (S.D.N.Y. 1978).....	16, 18
<i>In re North American Free Trade Association</i> 43 U.S.P.Q.2d 1282 (TTAB 1997)	9
<i>In re Peter S. Herrick P.A.</i> 91 U.S.P.Q.2d 1505 (TTAB 2009)	8
<i>Pro Football, Inc. v. Harjo</i> 90 U.S.P.Q.2d 1593 (Fed. Cir. 2004).....	15
<i>Reflange Inc. v. R-Con International</i> 17 U.S.P.Q. 1125 (TTAB 1990)	10
<i>Swank, Inc. v. Ravel Perfume Corp.</i> 168 U.S.P.Q. 723 (CCPA 1971)	9
<i>The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann</i> 231 U.S.P.Q. 408 (TTAB 1986)	10
<i>The Chun King Corp. v. Genii Plant Line, Inc.</i> 159 U.S.P.Q. 649	9
<i>The Coach House Restaurant, Inc. v. The Coach and Six Restaurants, Inc.</i> 223 U.S.P.Q 176 (TTAB 1984)	10
<i>The Ultra-White Company, Inc. v. Johnson Chemical Industries, Inc.</i> 175 U.S.P.Q. 166	10
<i>The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.</i> 217 U.S.P.Q. 505 (Fed. Cir. 1983).....	11
<i>Tisch Hotels, Inc. v. Americana Inn, Inc.</i> 146 U.S.P.Q. 566 (7th Cir. 1965)	16

<i>Turner v. Hops Grill & Bar Inc.</i> 52 U.S.P.Q.2d 1310 (TTAB 1999)	10, 11
--	--------

Statutes

15 U.S.C. § 1052.....	10
15 U.S.C. § 1052(a)	2, 8
15 U.S.C. § 1069.....	10
15 U.S.C. § 1069.....	9
Lanham Act § 2(d).....	9

Other Authorities

37 C.F.R. § 2.120(e)(1).....	4
Fed.R.Civ.P. 37(c)	1
Fed.R.Civ.P. 56(a)	11
Fed.R.Civ.P. 56(d)	1, 5, 8
<i>McCarthy on Trademarks and Unfair Competition</i> , 4 th Ed. § 19:76.....	9
TBMP § 405.04(a)	5
TBMP § 523.....	4

I. INTRODUCTION

Registrant Island Food and Fun, Inc.'s ("Registrant") motion for summary judgment is, at best, without merit and, at worst, evidence of gamesmanship. Registrant entirely failed to provide responses, much less objections, to Petitioner Fifty-Six Hope Road Music Limited's ("Petitioner") timely-served first set of discovery requests, which sought information and documents relevant to the parties' claims and defenses. While Petitioner, pursuant to its obligation under Fed.R.Civ.P. 37(c), was meeting and conferring with Registrant due to its abject failure to comply with its discovery obligations, Registrant filed this motion for summary judgment, stating – remarkably – that if its motion is denied, it will then serve its belated discovery responses. Registrant's refusal to participate in discovery and subsequent filing of a motion for summary judgment is clearly designed to unfairly prejudice Petitioner. Fortunately, Fed.R.Civ.P. 56(d) anticipates such tactics, and Petitioner is a prime candidate for relief thereunder. Specifically, given Registrant's inexcusable failure to respond to Petitioner's discovery responses, the Board should deny Registrant's motion and, further, order Registrant to respond, without objection, to Petitioner's interrogatories and requests for production ("RFPs").

Furthermore, and leaving aside Registrant's discovery abuses, Registrant's motion is, on balance, entirely meritless. Most importantly, Registrant does not account for the fact that its affirmative defenses of laches and acquiescence are neutered and ineffective in light of the inevitable confusion engendered by its mark's false suggestion of a connection with Bob Marley. Below, Petitioner cites numerous instances of Registrant specifically seeking to draw a connection between its mark and Bob Marley and actual confusion resulting therefrom, none of which Registrant disputes – or even addresses – in its motion. Under these circumstances, Petitioner's false suggestion of a claim clearly survives summary judgment.

Registrant misconstrues the nature of Petitioner's fraud claim, which alleges that Petitioner fraudulently claimed it was using its mark at the time it submitted its Statement of Use when, in fact, it was not. As noted, Registrant has refused to respond to Petitioner's discovery requests seeking information relevant to this very issue.

Finally, Petitioner voluntarily withdraws its claim that Registrant's mark is subject to cancellation on the grounds of non-ownership.

II. FACTUAL BACKGROUND

Petitioner filed its petition to cancel Registrant's registration of MARLEY'S A TASTE OF THE CARIBBEAN & Design for "family oriented restaurant and lounge featuring Caribbean decor, menu and entertainment" ("Registration") on April 4, 2013. [Docket No. 1.] Petitioner's petition to cancel sets forth three bases for cancellation of the Registration: (1) the mark that is the subject of the Registration is likely to falsely suggest a connection with Bob Marley in contravention of 15 U.S.C. § 1052(a); and (2) Registrant committed fraud by representing to the U.S. Patent & Trademark Office ("PTO") that it was using its mark in commerce at the time it submitted its Statement of Use. Petitioner is withdrawing its third basis for cancellation, i.e., non-ownership of the mark at issue.

Petitioner is composed of the heirs of Bob Marley, the late, world-famous musician, activist, and performer, and is the undisputed owner of his rights of publicity, which it – and its successors – have successfully licensed for a variety of goods and services since 1986. (Declaration of Doreen Crujeiras ("Crujeiras Decl.") ¶¶ 3-7, 9-12, Ex. A.) Petitioner owns numerous federal trademark registrations of and relating to Bob Marley and his identity. (Crujeiras Decl. ¶ 17, Ex. D.) Petitioner licenses use of the BOB MARLEY mark to Universal City Development Partners for operation of the restaurant "Bob Marley: A Tribute to Freedom" at Universal Citywalk in Orlando, Florida. The restaurant opened on February 6, 1999 and is frequently referred to as "Marley's." (Crujeiras Decl. ¶ 13, Ex. B.) Marley was and continues to be closely associated with the Caribbean, as he was from Jamaica and popularized reggae, a genre of music descended from the Caribbean. (Crujeiras Decl. ¶ 6, Ex. A.) Marley was and continues to be known by his last name. In fact, in April 2012, Magnolia Pictures released the well-reviewed and widely-released documentary *Marley* about Bob Marley and his legacy. (Crujeiras Decl. ¶ 14.)

Despite Registrant’s refusal to participate in discovery (as set forth in greater detail below), Petitioner has uncovered substantial evidence supporting its false suggestion of a connection claim. Registrant prominently uses the MARLEY name in conjunction with an establishment specializing in Caribbean food, décor, and entertainment. As Bob Marley – a Rastafarian – famously did, the individuals depicted in Registrant’s mark appear to sport dreadlocks, and Registrant sells merchandise on its website reflecting images of dreadlocks in connection with the term MARLEY’S and other Rastafarian themes. (Declaration of Paul Bost (“Bost Decl.”) ¶ 2, Ex. E.) Registrant’s specimens submitted in support of its Statement of Use and Section 8 and 15 Affidavit both refer to Bob Marley’s musical legacy. Namely, the menus submitted by Registrant include “jammin” fries. (Bost Decl. ¶ 3, Ex. F.) “Jammin” is not a generic description of a food item, but, rather, an allusion to Bob Marley’s famous song of essentially the same name, “Jamming.”¹ (Crujeiras Decl. ¶ 8.) Prior to the issuance of its Registration but during the pendency of its underlying application, Registrant admitted it was selling Bob Marley merchandise at the restaurant it operated, and continues to operate, under its mark. (Morris Decl., Ex. D, October 21, 2005 letter from Paul D. Polacek to Timothy J. Ervin.) Registrant continues to associate its services with Bob Marley to this day. For example, for at least the past two years, Registrant has advertised on its Facebook page food and drink specials on February 6th in celebration of Bob Marley’s birthday, and has used a photograph of Marley in said promotional efforts. (Bost Decl. ¶ 4, Ex. G.) Registrant’s use of the Marley photograph to promote its restaurant is without a license or permission from Petitioner. Also, Registrant’s use of its mark has resulted in actual confusion amongst consumers as reflected in comments made regarding Registrant’s restaurant on various third party websites. (Bost Decl. ¶ 5, Ex. H.) Likewise, in April 2012, Petitioner received an email from a consumer who patronized

¹ In Registrant’s letter to Petitioner of October 21, 2005, it advises that the jammin’ fries “menu item has been discontinued by the supplier and is no longer available.” (Morris Decl., Ex. D, October 21, 2005 letter from Paul D. Polacek to Timothy J. Ervin.) As evidenced by the items inclusion on the menu submitted in support of Registrant’s Section 8 and 15 Affidavit, this is not true.

Registrant's restaurant based on his belief that it was connected with Marley. (Crujeiras Decl. ¶ 15, Ex. C.)

On February 14, 2014, Petitioner served Registrant with its first set of discovery requests – interrogatories, RFPs, and requests for admission – by first class mail in order to discover facts probative of its claims and of Registrant's defenses. Registrant's written responses to the requests were due to be served on Petitioner no later than March 21, 2014, the discovery deadline. Registrant never requested nor was granted an extension of this deadline. To date, Registrant has not served any responses to the discovery requests. (Bost Decl. ¶ 6, Exs. I and J.) On April 15, 2014, and pursuant to its meet-and-confer obligations under 37 C.F.R. § 2.120(e)(1) and TBMP § 523, Petitioner sent Registrant a letter notifying Registrant of its waiver of objections to Petitioner's RFPs and interrogatories for its failure to timely respond or object, and requested Registrant's service of responses, without objection, to the RFPs and interrogatories. (Bost Decl. ¶ 7, Ex. K.) On April 16, 2014, Registrant responded to Petitioner's letter and stated, without authority, that the parties' participation in settlement discussions excused Registrant from its discovery obligations. Furthermore, Registrant admitted therein that it had sought Petitioner's consent to suspend the matter for purposes of negotiating settlement, but that Petitioner "never responded to [its] request for consent." (Bost Decl. ¶ 8, Ex. L.) By letter of April 28, 2014, Petitioner explained the foregoing to Registrant and, *again*, requested its service of responses without objection, to Petitioner's RFPs and interrogatories by May 6, 2014, failing which Petitioner would file a motion to compel Registrant's compliance with its discovery obligations. (Bost Decl. ¶ 9, Ex. M.) Registrant did not comply – and, to date, has not complied – with its discovery obligations, and has not provided any written responses or document production to Petitioner's discovery requests. Instead, on May 2, 2014, and with its discovery responses outstanding, Registrant filed its motion for summary judgment, and stated that it would provide discovery responses if this motion is denied. (Russell Decl. ¶ 11.)

Registrant never served any discovery on Petitioner. (Bost Decl. ¶ 10.) Discovery in this matter closed on March 21, 2014.

III. THE BOARD SHOULD DENY REGISTRANT’S MOTION FOR SUMMARY JUDGMENT AND GRANT PETITIONER RELIEF UNDER FED.R.CIV.P. 56(d)

The Board must deny Registrant’s motion for summary judgment in light of its complete refusal to comply with its discovery obligations and disclose to Petitioner information relevant to and supportive of its claims for cancellation. When, under circumstances such as these, the party opposing a motion for summary judgment “shows by affidavit or declaration that . . . it cannot present facts essential to justify its opposition, the court may: (1) defer considering the motion or deny it; (2) allow time to obtain affidavits or declarations or to take discovery; or (3) issue any other appropriate order.” Fed.R.Civ.P. 56(d). There can be no dispute that Petitioner served timely discovery requests on Registrant relevant to its claims for cancellation; Registrant never provided timely responses or objections to Petitioner’s discovery requests; and Registrant filed its motion for summary judgment while Petitioner – per its obligations under the Rules – was in the process of meeting and conferring with Registrant regarding its failure to comply with its discovery obligations. Accordingly, in addition to denying Registrant’s motion for summary judgment, the Board should order Registrant to provide Petitioner with responses to Petitioner’s outstanding interrogatories and RFPs without objection, as Registrant has waived its objections for failing to serve timely objections or responses. *See* TBMP § 405.04(a) (“A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits”); 406.04(a) (same); *Crane Co. v. Shimano Industrial Co.*, 184 U.S.P.Q. 691, 691 (TTAB 1975) (“Inasmuch as applicant failed to respond to the interrogatories on or before December 10, 1974, or to request an extension of its time to do so prior to the aforesaid date, applicant has waived its right to object to the interrogatories on their merits and must reply to them as put.”)

A. Registrant's Refusal to Participate in Discovery Has Precluded Petitioner from Presenting Facts in Support of its Claim for Fraud

Petitioner's fraud claim is not based on Registrant's misrepresentation to the Board that it first used its mark in commerce as early as July 2000. Instead, Petitioner claims that Registrant fraudulently misrepresented to the Board in its Statement of Use that it was using the mark in commerce in connection with the services identified in its application, and Petitioner points to Registrant's misrepresentation of its date of first use as evidence of Registrant's proclivity towards making misrepresentations. Notably, in his declaration supporting Registrant's motion, Registrant's president does not declare under the penalty of perjury that Registrant's claimed date of first use is accurate and not a misrepresentation. Likewise, Registrant's president does not deny that Registrant used MARLEY'S alone or MARLEY'S A TASTE OF JAMAICA in lieu of its mark during the time it claims to have already been using its mark. Instead, Registrant's president merely states that Petitioner "made actual use in commerce of the challenged Registration, well before the November 2006 Statement of Use that was filed and accepted in this matter." (Morris Decl. ¶ 7.) While this self-interested statement might be relevant to the ultimate issue, it is well short of rehabilitating Registrant's credibility lost by claiming a false date of first use.

More importantly, Registrant cannot refuse to participate in discovery and simultaneously present evidence in support of its motion purportedly establishing that it used its mark at the time it submitted its Statement of Use. Information regarding Registrant's first use of its mark is solely in the possession of Registrant. Accordingly, Petitioner propounded discovery requests on Registrant seeking such information, including, but not limited to, the following:

- Interrogatory No. 2: "For each of the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services or other goods and services offered under any other name containing MARLEY or MARLEY'S ('MARLEY Goods and Services'), state the date that MARLEY'S A TASTE OF THE CARIBBEAN or any other name containing MARLEY or MARLEY'S was first used anywhere and first used in interstate commerce on or in connection with each such product or service."

- Interrogatory No. 6: “State the date(s) that Registrant selected and/or adopted the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other name containing MARLEY or MARLEY’S.”
- Interrogatory No. 7: “Identify all persons who were involved in, participated in, decided upon, or offered suggestions for, the selection and/or adoption of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other name containing MARLEY or MARLEY’S by Registrant.”
- RFP No. 2: “All documents relating to the date(s) of first use anywhere and in interstate commerce by Registrant of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S.”
- RFP No. 3: “All documents relating to the date of first sale of each product bearing or sold under the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S.”
- RFP No. 4: “Specimens of all of website pages, press releases, promotions, labels, invoices, billboards, tags, markings, nameplates, coupons, and the like, and/or advertising material that constitute the first use claimed for or intended first use of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S.”
- RFP No. 9: “All documents relating to the selection and adoption of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S by Registrant and of the availability or clearance of such mark(s) for use and/or registration by Registrant.”
- RFP No. 35: “All documents relating to any alternate marks that were considered by Registrant for use as a trademark, service mark, or trade name instead of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark, including but not limited to any marks including the term(s) MARLEY or MARLEY’S (e.g., MARLEY’S A TASTE OF JAMAICA, WE BE JAMMIN’ MARLEY’S, THE REEF AT MARLEY’S, etc.).”
- RFP Nos. 61-67: All documents related to, supporting, or negating Registrant’s denial of paragraphs 1, 4-9, i.e., the paragraphs setting forth Petitioner’s fraud claim.
- RFP Nos. 100 and 104: “All documents reflecting, referring, or relating to Registrant’s use of the mark MARLEY or MARLEY’S on or in connection with the website <marleysclub.com>” and “<clubmarleys.com>.”
- RFP Nos. 101 and 105: “All documents reflecting, referring, or relating to Registrant’s use of the mark MARLEY’S A TASTE OF JAMAICA on or in connection with the website <marleysclub.com> and <clubmarleys.com>.”

(Bost Decl. ¶ 6, Exs. I and J.) Additionally, Petitioner propounded numerous requests for information relating to business conducted by Registrant from its alleged date of first use to the

present, the divulgement of which is likely to reflect the names and marks under which Registrant has offered its services at issue.

Registrant never responded to these discovery requests. Instead, while Petitioner was meeting and conferring with Registrant regarding its abject failure to comply with its discovery obligations, Registrant filed its motion in an obvious attempt to avoid responding to Petitioner's discovery requests. Clearly, Petitioner is entitled to relief under Fed.R.Civ.P. 56(d), as Registrant's refusal to conduct discovery according to the Rules has precluded Petitioner from "present[ing] facts essential to justify its opposition," namely, information and documents relevant to the date that Registrant first used its mark and the truth of the statements made by Registrant in its Statement of Use. Accordingly, the Court should compel Registrant's service of discovery responses without objection to Petitioner's interrogatories and RFPs.

B. Registrant is Not Entitled to Summary Judgment on Petitioner's False Suggestion of a Connection Claim

1. Petitioner Adequately Pleaded its False Suggestion of a Connection Claim

Registrant cannot seriously contend that Petitioner has failed to state a claim for false suggestion of a connection pursuant to 15 U.S.C. § 1052(a). In its Petition, Petitioner specifically pleads the elements necessary to establish a claim for false suggestion of a connection: (1) ownership of "all intellectual property rights in the name, likeness, and persona of Bob Marley"; (2) "[t]he use of MARLEY in Registrant's Mark would be and is recognized as the same as, or a close approximation of, the name Bob Marley"; (3) "[t]he name Marley is associated with, and points uniquely to, Bob Marley"; (4) "Registrant is not connected with any activities of Petitioner or of Bob Marley when he was living"; and (5) "[t]he fame and/or reputation of Bob Marley is such that, when [Registrant's] mark is used with Registrant's services, a connection with Bob Marley and/or Petitioner is presumed." [Docket No. 1, ¶¶ 16, 31-35.] *See also In re Peter S. Herrick P.A.*, 91 U.S.P.Q.2d 1505, 1507 (TTAB 2009) (setting forth the elements necessary to establish a claim for false suggestion of a connection.) Registrant

cannot escape liability on the pleadings merely because Petitioner included a heading reading “False Association with Bob Marley,” particularly given Petitioner’s *express* pleading of the elements necessary to establish a false suggestion of a connection and *express* pleading that “Registrant’s registration of [its mark] is likely to continue to draw a false association, sponsorship, connection, or affiliation with Petitioner, its MARLEY Marks and with Bob Marley.” [Docket No. 1, ¶ 37.] (emphasis added.)

2. Registrant’s Defense of Laches is Overcome by the Inevitable Confusion Engendered by Use and Registration of its Mark

It is well established that the defenses of laches and acquiescence are inapplicable when use of a mark inevitably or clearly results in a likelihood of confusion.² See *The Chun King Corp. v. Genii Plant Line, Inc.*, 159 U.S.P.Q. 649, 651 (“we are not persuaded that this record is sufficient to support the invocation of [laches]. As has been noted, the marks are identical, applied to the same goods, sold through the same channels to the same purchasers for the same use. We have, therefore, no debatable issue as to likelihood of confusion. Moreover, appellant has failed to adequately show its lack of knowledge and good faith in the adoption of the mark of a competitor. While not imputing bad faith on the part of appellant, the facts and circumstances of record tend strongly to show that appellant must have known of appellee’s use of LIVING EARTH prior to its adoption of that mark”); *Swank, Inc. v. Ravel Perfume Corp.*, 168 U.S.P.Q. 723, 725 (CCPA 1971) (“Where the competing marks are identical or are closely similar, the equitable principles defined by [15 U.S.C. § 1069] have been held not to be applicable inasmuch

² “The terminology ‘falsely suggest a connection with’ in Lanham Act § 2(a) is equivalent in effect to the words ‘to be likely . . . to cause confusion’ in § 2(d).” *McCarthy on Trademarks and Unfair Competition*, 4th Ed. § 19:76; see also *In re North American Free Trade Association*, 43 U.S.P.Q.2d 1282, 1286 (TTAB 1997) (“The question is not whether its members, after learning who applicant is and what it does, realize that applicant is not connected with the NAFTA institution, but whether, upon seeing the trademark used in connection with applicant’s services, the potential consumers of such services are likely to believe that there is a connection.”) (emphasis added.) Accordingly, while the types of confusion underlying claims under Sections 2(a) and 2(d) differ, the ultimate determination – i.e., whether the mark is likely to cause confusion – is the same.

as the public interest in the dominant consideration”); *The Ultra-White Company, Inc. v. Johnson Chemical Industries, Inc.*, 175 U.S.P.Q. 166, 167 (“it appears to us that confusion or mistake here is not only likely but inevitable in light of the virtual identity of the parties’ marks and goods, as well as the similarity of trade channels, market areas and advertising media. In such a situation, notwithstanding the equities between the parties and the equitable principles of [15 U.S.C.] § 1069, the public interest expressed in § 1052 is the dominant consideration”); *The Coach House Restaurant, Inc. v. The Coach and Six Restaurants, Inc.*, 223 U.S.P.Q 176, 178 (TTAB 1984) (“the establishment of the defense of acquiescence does not necessarily preclude a judgment for the plaintiff after trial if the Board determines that likelihood of confusion is inevitable. [citations omitted.] The reasoning for such a principle is that the public interest necessitates the elimination or avoidance of situations that could reasonably give rise to confusion in the marketplace”); *Reflange Inc. v. R-Con International*, 17 U.S.P.Q. 1125, 1131 (TTAB 1990) (“a well-taken defense of acquiescence would not preclude a judgment for plaintiff if it is determined that confusion is inevitable, and confusion between identical marks used for identical goods is inevitable”); *Turner v. Hops Grill & Bar Inc.*, 52 U.S.P.Q.2d 1310, 1313 (TTAB 1999) (“laches will not prevent cancellation where the marks and goods or services of the parties are substantially similar and it is determined that confusion is inevitable. This is so because any injury to respondent caused by petitioner's delay is outweighed by the public's interest in preventing confusion in the marketplace.”)

Petitioner has set forth above the many reasons why Registrant’s mark falsely suggests a connection with Bob Marley and, indeed, that such a false suggestion is inevitable. Notably, a claim for false suggestion of a connection is strengthened where the registration at issue is for goods and services that are closely related to the activities for which the person at issue is known. *See The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 U.S.P.Q. 408, 410 (TTAB 1986) (petitioner university had used BAMA mark at issue on socks, which were identified as a good in the registration at issue.) This is the case here. The services identified in the Registration are restaurants featuring Caribbean entertainment, and, as

set forth above, Bob Marley was – and remains – a world famous Caribbean entertainer. Additionally, Petitioner has licensed use of his name and image for restaurant services. Also weighing in favor of a finding of inevitable confusion is the evidence offered by Petitioner that Registrant has intentionally falsely suggested a connection with Bob Marley, including naming one of its products after a Marley song, selling Marley merchandise, and invoking the name and image of Marley in its promotional efforts. *See The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 U.S.P.Q. 505, 509 (Fed. Cir. 1983) (the court’s conclusion that selection of the name NOTRE DAME does not uniquely identify petitioner university “could be changed if the evidence showed that [the registrant] intended to identify the [petitioner] . . . Evidence of such intent would be highly persuasive that the public will make the intended false association.”) Finally, Petitioner has elicited evidence of actual consumer confusion as to Registrant’s mark’s connection with Bob Marley. (Bost Decl. ¶ 5, Ex. H; Crujeiras Decl. ¶ 15, Ex. C.)

Much like the movant in *Turner*, Registrant has not presented any evidence or argument regarding the elements constituting Petitioner’s false suggestion of a connection claim, only Registrant’s laches and acquiescence affirmative defenses. Registrant has not borne, or attempted to bear, its burden of “demonstrat[ing] the absence of any genuine issue of material fact” with respect to Petitioner’s false suggestion of a connection claim. Fed.R.Civ.P. 56(a). Thus, under no circumstances can Registrant claim or the Board find that there is no genuine issue of material fact as to the false suggestion of a connection claim. Furthermore, even if Registrant has established its affirmative defenses (it has not, as noted below), summary judgment cannot be entered given the issues of fact remaining as to Petitioner’s false suggestion of a connection claim. *See Turner*, 52 U.S.P.Q.2d at 1313 (“we find that while, there is no genuine issue as to laches, there is a genuine issue of material fact as to whether confusion is inevitable. Thus, respondent has not shown it is entitled to summary judgment as a matter of law.”)

If the above was not enough, Registrant has obstructed Petitioner's timely attempt to discover additional facts supportive of its claim that confusion is inevitable. Nearly all of Petitioner's discovery requests, in one way or another, relate to and are probative of likelihood of confusion. Furthermore, Petitioner propounded interrogatories – and corresponding RFPs – requiring Registrant to state all facts relating to, supporting, or negating the four elements necessary to establish a false suggestion of a connection claim. (Bost Decl. ¶ 6, Exs. I and J, Interrogatory Nos. 30-33, RFP Nos. 73-78.) Petitioner also requested Registrant to “[s]tate all facts that relate to, support, or negate Registrant's Affirmative Defense that ‘its adoption and use of the mark does not create a false suggestion of a connection with Bob Marley’ as stated in Paragraphs 19(a)-(e) of Registrant's Answer,” and requested that Registrant produce all documents related thereto. (*Id.*, Interrogatory No. 41, RFP No. 84.) Petitioner also propounded the other discovery requests relevant to confusion:

- Interrogatory No. 14: “Identify and describe in detail all instances in which Registrant received any requests, inquiries, or statements from any person relating to whether there is or was some relationship, association, affiliation, or license between Petitioner and Registrant, between Registrant and Bob Marley, or between any of the MARLEY Marks or Registrant, on the one hand, and the goods or services offered by Petitioner or the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, on the other hand. For each instance, identify all individuals who have knowledge of the facts thereof, the context of each instance, and the date of each instance.”
- Interrogatory No. 15: “Identify all surveys, public opinion polls, or any other forms of consumer or market research known to Registrant which refer, relate to, or pertain in any way to the MARLEY'S A TASTE OF THE CARIBBEAN & Design Mark or any other name containing MARLEY or MARLEY'S, Petitioner, the MARLEY Marks, or any other trademark or name containing the terms MARLEY or MARLEY'S.”
- Interrogatory No. 29: “State all facts that relate to, support, or negate its denial in Paragraph 4 of its Answer that ‘Registrant displays images of Bob Marley at its restaurant and has a Jamaican theme to its restaurant[;] Registrant sells various merchandise at its restaurant with the name MARLEY appearing alone or in prominent display on the merchandise[; and] Registrant's use of MARLEY in its restaurant name is also the dominant feature of the mark and prominently displayed to catch the attention of consumers.’”
- Interrogatory No. 47: “Identify any use by Registrant of the name ‘Bob Marley’ or any picture, photograph, name, image, likeness, signature, or other indicia of the late

- Bob Marley, including but not limited to, on restaurant signage (exterior or interior), wall art, food or bar menus, tabletop tent signs, email blasts, internet advertisements, posters, video streams in Registrant's facilities, drink coasters, table placements, flyers, coupons, and newspaper ads."
- RFP No. 14: "All documents relating to surveys, public opinion polls, or any other forms of consumer or market research that relate in any way to the MARLEY'S A TASTE OF THE CARIBBEAN & Design Mark, the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services, the MARLEY Marks, any marks including the term(s) MARLEY or, MARLEY'S (e.g., MARLEY'S A TASTE OF JAMAICA, WE BE JAMMIN' MARLEY'S, THE REEF AT MARLEY'S, etc.), or Petitioner."
 - RFP No. 21: "Photographs of the décor and each wall of the restaurant(s) or bar(s) operated under MARLEY'S A TASTE OF THE CARIBBEAN with or without a design or under any name containing MARLEY or MARLEY'S."
 - RFP No. 33: "All documents evidencing, suggesting, or relating to any confusion between Registrant's MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, on the one hand, and any products or services offered under the MARLEY Marks, on the other hand, or any perceived sponsorship, license, or approval by Petitioner or Bob Marley of the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, or any perceived affiliation of any kind between Petitioner or Bob Marley, on the one hand, and the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, on the other hand."
 - RFP No. 52: "Documents sufficient to identify the electronic tags or markings, or search terms attached to, associated with, or flagged for the MARLEY'S A TASTE OF THE CARIBBEAN Goods and Services and the MARLEY Goods and Services."
 - RFP No. 60: "All documents reflecting the meaning or connotation of the MARLEY'S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY'S."
 - RFP No. 111: "All documents reflecting, referring, or relating to any use by Registrant of the name 'Bob Marley' or any picture, photograph, name, image, likeness, signature, or other indicia of Bob Marley, including but not limited to, on restaurant signage (exterior or interior), wall art, food or bar menus, tabletop tent signs, drink coasters, table placements, local flyers, coupons, and newspaper or internet ads."
 - RFP No. 112: "All advertisements, promotions, or marketing material of any kind relating to the celebration of Bob Marley's birthday or date of death at Registrant's facilities."
 - RFP No. 113: "All documents reflecting, referring, or relating to Registrant's use of any of Bob Marley's songs, music, or album titles, including One Love, Buffalo Soldier, No Woman, No Cry, etc."
 - RFP No. 114: "All documents that relate to, support or negate the type of theme of the restaurant located at 750 Wisconsin Dells Parkway South, Lake Delton, WI 53913, including without limitation, whether it has a Caribbean theme."
 - RFP No. 115: "All documents that relate to, support or negate the fact that the restaurant located at 750 Wisconsin Dells Parkway South, Lake Delton, WI 53913 has a Jamaican theme, including any visual or other cues that are Jamaican in nature,

e.g., the Rastafari flag, the green-yellow-red colors used in the Rastafari flag, other Rastafarian themes, etc.”

(Bost Decl. ¶ 6, Exs. I and J.) Accordingly, the Board should deny Registrant’s motion and order Registrant’s service of responses, without objection, to Petitioner’s RFPs and interrogatories, including the above.

3. Registrant Has Not Established that it Suffered Prejudice as a Result of Petitioner’s Alleged Delay

As set forth above, even if Registrant could establish no genuine issue of material fact as to its laches affirmative defense, summary judgment would be inappropriate given the outstanding issues of material facts as to inevitable confusion. Nonetheless, Registrant has not established that there is no issue of fact as to laches. First, Registrant’s failure to abide by its discovery obligations has precluded Petitioner from eliciting evidence challenging Registrant’s claim of prejudice. Among other relevant discovery requests, Petitioner propounded the following interrogatories and RFPs relevant to Registrant’s claim that it suffered prejudice by Petitioner’s alleged delay in instituting this proceeding:

- Interrogatory No. 11: “State separately the annual and total amount spent by or on behalf of Registrant for advertising, promoting, or marketing the MARLEY’S A TASTE OF THE CARIBBEAN Goods and Services and the MARLEY Goods and Services from the date of first use to present. If Registrant does not maintain records of the amounts spent on the advertisement and promotion of the MARLEY’S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, state the annual and monthly amount spent by or on behalf of Registrant for the advertisement and promotion of all of Registrant’s products or services regardless of the mark or name applied to such products or services from the earliest date of first use of the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or MARLEY or MARLEY’S to the present.”
- Interrogatory No. 22: “Separately state the total amount of sales, in units and dollars, of each product bearing, sold under, or offered under the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other name containing MARLEY or MARLEY’S, and the total revenue generated from the services offered under the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other name containing MARLEY or MARLEY’S.”
- Interrogatory No. 39: “State all facts that relate to, support, or negate Registrant’s Affirmative Defense that ‘Petitioner’s claims should be dismissed on equitable grounds of laches and estoppel’ as stated in Paragraphs 17(a)-(h) of Registrant’s Answer.”

- RFP No. 17: “Documents sufficient to reflect the total sales in units and dollars of the goods offered under or bearing the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S.”
- RFP No. 18: “Documents sufficient to reflect the total revenue earned from the sale or offering of any services under the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark or any other trademark or name including MARLEY or MARLEY’S.”
- RFP No. 28: “All documents, for each year from the date(s) of first use to present, showing or from which it can be ascertained, the total amount Registrant has spent to market, advertise and/or promote the MARLEY’S A TASTE OF THE CARIBBEAN Goods and Services and the MARLEY Goods and Services. If Registrant does not maintain records of such amounts spent regarding the MARLEY’S A TASTE OF THE CARIBBEAN Goods and Services or the MARLEY Goods and Services, specifically, produce all documents relating to the total amount spent by Registrant or on behalf of Registrant to market, advertise and/or promote all of Registrant’s goods and services regardless of the mark or name applied to such goods and services.”
- RFP No. 42: “All lease agreements for facilities operated under the MARLEY’S A TASTE OF THE CARIBBEAN & Design Mark, or any other trademark or name including MARLEY or MARLEY’S, and renewals, extensions, or termination thereof, and all correspondence relating thereto.
- RFP No. 85: “All documents that relate to, support or negate Registrant’s Affirmative Defense that ‘Petitioner’s claims should be dismissed on equitable grounds of laches and estoppel’ as stated in Paragraphs 17(a)-(h) of Registrant’s Answer.”

Registrant’s failure to participate in discovery precludes Petitioner, to its great prejudice, from challenging the evidence offered by Registrant in this motion in support of its laches defense. Petitioner specifically sought documents from Registrant supporting its laches defense, documents reflecting Registrant’s earnings under its mark, and documents reflecting Registrant’s advertising expenditures under the mark. These are precisely the figures that Registrant relies on to establish the alleged prejudice it endured due to Petitioner’s alleged delay. The Board should not allow Registrant to shield such figures, and their underlying documents (which were not included in support of the motion for summary judgment), from Petitioner’s scrutiny during discovery but then use them as convenient.

Registrant’s failure to participate in discovery precludes Petitioner from considering whether Registrant would have made the same alleged “investment” in its mark and any goodwill therein had Petitioner taken action sooner. *See Pro Football, Inc. v. Harjo*, 90

U.S.P.Q.2d 1593, 1596 (Fed. Cir. 2004) (“to be sure, a finding of prejudice requires at least some reliance on the absence of a lawsuit. If Pro-Football would have done exactly the same thing regardless of a more timely complaint, its laches defense devolves into claiming harm not from [petitioner’s] tardiness, but from [petitioner’s] success on the merits.”) In fact, the circumstances of the parties’ dispute suggest that Registrant would have continued its use of its mark even if Petitioner had acted more promptly. Registrant does not note or cite to any decrease or leveling of its alleged investment in its mark due to Petitioner’s threat of a lawsuit in 2006. Likewise, Petitioner’s successful opposition to Registrant’s THE REEF AT MARLEY’S application does not appear to have slowed or leveled Registrant’s alleged investment in its mark. Thus, there is good reason to believe— and certainly an issue of material fact exists – that Registrant would have made its alleged investment in its mark regardless of Petitioner’s actions and the promptness thereof. Also, by not including its sales³ and advertising numbers prior to 2006, Registrant cannot establish that it, in fact, made any alleged investment in its mark as opposed to simply continuing to operate its business. See *Cuban Cigar Brands N.V. v. Upmann Intern., Inc.*, 199 U.S.P.Q. 193, 200 (S.D.N.Y. 1978) (“[T]he defense of laches requires more by way of showing prejudice than the simple fact that the business continued during the period of delay”); *Tisch Hotels, Inc. v. Americana Inn, Inc.*, 146 U.S.P.Q. 566, 571 (7th Cir. 1965) (if prejudice for laches “could consist merely of expenditures in promoting the infringed name, then relief would have to be denied in practically every case of delay.”)

Furthermore, the confidential declaration of Jeff Morris is the *first* time in this case Registrant has identified third party T.F. Food Court, L.L.C. (“T.F. Food Court”) as a witness Registrant intended to rely on in this matter. T.F. Food Court is neither identified nor mentioned in Registrant’s initial disclosures. (Bost Decl. ¶ 11, Ex. N.) Of course, Registrant has not

³ Mr. Morris’ statement that “[b]etween 2005 and 2010 the Restaurant saw an increase in sales of [redacted for confidentiality reasons]” is vague, ambiguous, and lacking in context. (Conf. Morris Decl. ¶ 10.) The statement does not identify what periods are being compared, among other things. In general, Mr. Morris’ declarations are simply conclusory and without necessary context or foundation.

produced any documents or organizational charts – despite Petitioner’s request for them – reflecting the purported relationship between Registrant and T.F. Food Court, whose expenditures Registrant relies on to establish prejudice.

Finally, Registrant has not cited any authority establishing that its alleged charitable donations or expended attorneys’ fees are at all relevant to the issue of prejudice. The question of Registrant’s investment in the goodwill of its mark is separate from any alleged goodwill it has towards its community or humanity. Of course, Registrant cannot claim to have been prejudiced by attorneys’ fees it expended defending the THE REEF AT MARLEY’S application, which Petitioner successfully opposed.

4. Registrant Cannot Establish Any Acquiescence on the Part of Petitioner

Registrant’s acquiescence defense is resoundingly dissonant. Acquiescence, unlike laches, requires active consent on the part of the claimant to the alleged infringer’s activities at issue. *See Creative Gifts, Inc. v. UFO*, 57 U.S.P.Q.2d 1321, 1327 (10th Cir. 2000) (“Acquiescence is an affirmative defense that requires a ‘finding of conduct on the plaintiff’s part that amounted to an assurance to the defendant, express or implied, that plaintiff would not assert his trademark rights against the defendant’ [internal citations omitted] . . . [It] requires proof even more demanding than [laches]”); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 19 U.S.P.Q.2d 1401, 1408-09 (11th Cir. 1991) (“Acquiescence to one’s use of a trademark is analogous to an implied license to use the mark . . . The same three elements applied in the acquiescence in registration are applicable to the acquiescence in use issue: (1) That petitioner actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused the registrant undue prejudice.”) Registrant asks the Board to construe Petitioner’s threat of legal action against Registrant and success in the THE REEF AT MARLEY’S opposition as acts of consent. Such an interpretation of Petitioner’s words and

actions is entirely irrational and turns the concept of consent – even implied consent – on its head. Registrant’s acquiescence defense is therefore without merit.

5. Petitioner’s Delay is Justified by the Press of Other Litigation

In *Cuban Cigar*, the court properly excused the plaintiff’s alleged delay in asserting its rights because of its engagement in other litigation. *See Cuban Cigar*, 199 U.S.P.Q. at 199 (“it was only in 1973, after prevailing at trial and on appeal in the bitterly contested and extended litigation with the Cuban government and others that plaintiff was even assured it still had a mark to protect. Indeed, that very litigation, which extended over a period of more than ten years, establishes that plaintiff was a vigilant defender of its rights. Under the circumstances, whatever delay may be charged to plaintiff in asserting its rights was certainly excusable.”) Here, Petitioner has been involved in numerous litigations before various courts and agencies in furtherance of protecting its ownership of Bob Marley’s rights of publicity and identity since 2006. For example, Petitioner has filed more than 20 proceedings before the Board since 2008. (Crujeiras Decl. ¶ 16.) Most notably, in 2007, Petitioner filed suit against a mass infringer of Bob Marley’s rights in the District of Nevada, which case it pursued again in 2008 when the infringement recommenced. Petitioner prevailed before a jury in January 2011 and vindicated its rights in Bob Marley’s identity and persona, which ruling – and subsequent award of profits and attorneys’ fees for Petitioner – is on appeal before the Ninth Circuit Court of Appeals. (*Id.*) Petitioner cannot be said to have not vigilantly defended its rights, and Petitioner has no obligation – much less the resources – to make a full-court press against every alleged infringer of the rights associated with Bob Marley at once.

More importantly, it is obvious from the correspondence relied upon by Registrant in its motion that it had no intention of stopping its use of the mark at issue or otherwise infringing Petitioner’s rights associated with Bob Marley in 2006 or at any time thereafter. In short, Registrant has not shown – and cannot show – detrimental reliance on Petitioner’s alleged

actions or inaction. Accordingly, any delay on the part of Petitioner should be excused for its concurrent enforcement of its rights in other actions.

IV. CONCLUSION

For the reasons asserted above, the Board should deny Registrant's motion for summary judgment in full and order Registrant to serve responses, without objections, to Petitioner's interrogatories and RFPs.

Respectfully submitted,

Dated: June 6, 2014

/s/Paul A. Bost
Jill M. Pietrini
Whitney Walters
Paul A. Bost
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067
Telephone: 310.228.3700

Attorneys for Petitioner

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO REGISTRANT ISLAND FOOD AND FUN, INC.'S MOTION FOR SUMMARY JUDGMENT; AND MOTION PURSUANT TO FED.R.CIV.P. 56(d) FOR AN ORDER COMPELLING REGISTRANT'S SERVICE OF DISCOVERY RESPONSES WITHOUT OBJECTION** is being submitted electronically to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 6th day of June, 2014.

/s/Lynne Thompson

Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO REGISTRANT ISLAND FOOD AND FUN, INC.'S MOTION FOR SUMMARY JUDGMENT; AND MOTION PURSUANT TO FED.R.CIV.P. 56(d) AN ORDER COMPELLING REGISTRANT'S SERVICE OF DISCOVERY RESPONSES WITHOUT OBJECTION** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Elizabeth T Russell
Russell Law
6907 University Avenue, #227
Middleton, Wisconsin 53562

on this 6th day of June, 2014.

/s/Lynne Thompson

Lynne Thompson

SMRH:424714139.1