

ESTTA Tracking number: **ESTTA611376**

Filing date: **06/23/2014**

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

Proceeding	92057058
Party	Defendant Island Food & Fun, Inc.
Correspondence Address	ELIZABETH T RUSSELL LAW OFFICE 6907 UNIVERSITY AVE # 227 MIDDLETON, WI 53562-2767 UNITED STATES beth@erklaw.com
Submission	Reply in Support of Motion
Filer's Name	Elizabeth T Russell
Filer's e-mail	beth@erklaw.com, brussell@supranet.net
Signature	/elizabeth russell/
Date	06/23/2014
Attachments	Island reply FINAL with nonconfid exhibits.pdf(237356 bytes)

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

Fifty-Six Hope Road Music Limited, Petitioner, v. Island Food & Fun, Inc., Registrant.	Cancellation No.: 92057058 Registration No.: 3225517
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Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**REGISTRANT’S REPLY TO PETITIONER’S OPPOSITION TO REGISTRANT’S
MOTION FOR SUMMARY JUDGMENT AND TO PETITIONER’S MOTION
PURSUANT TO FED.R.CIV.P. 56(d)**

On May 2, 2014 Registrant filed a motion for summary judgment claiming that all three of Petitioner’s alleged bases for cancellation can and should be resolved in Registrant’s favor, as a matter of law. On June 6, 2014 Petitioner filed a brief in response and a motion pursuant to Fed. R. Civ. P. 56(d) seeking “to compel Registrant’s service of discovery responses without objection.” Registrant submits the following arguments in reply; requests denial of Petitioner’s motion Rule 56(d) motion; and asks the Board to grant the pending motion for summary judgment in Registrant’s favor, dismissing the cancellation proceeding in its entirety.

**PETITIONER MISLEADS THE BOARD BY CONTENDING THAT REGISTRANT HAS
“REFUSED TO PARTICIPATE IN DISCOVERY.”**

Nearly every page of Petitioner's brief in opposition decries Registrant's alleged "refusal to participate in discovery." Petitioner's overly dramatic representations on this issue are merely a smoke screen to conceal the inconvenient reality that Petitioner's arguments have no basis in law. Petitioner attempts to divert the Board's attention from the single question presently at bar: whether Registrant has satisfied the requirements for summary judgment.

Petitioner misleads the Board by failing purposefully to reference correspondence demonstrating Registrant's good faith. Here are the pertinent facts:

- Having received no discovery-related communication, Registrant's counsel (Elizabeth Russell) took the initiative, writing on July 19, 2013 to remind Petitioner's counsel of the upcoming deadline for the parties' mandatory discovery conference, and to propose a date for the conference (Exhibit A). Russell received no response, and the deadline passed.
- On August 6, 2013 Russell wrote again, advising that she had still received no response and that she remained available for the conference (Exhibit B). In that letter, Russell also advised, specifically, that Registrant believed it was entitled to judgment on the pleadings on at least the first two of Petitioner's claims for cancellation (fraud on the office and ownership of the mark); Russell expressly asked Petitioner to withdraw those claims voluntarily.
- The discovery conference finally took place on August 13, 2013 (Exhibit C). During that conference, Petitioner's counsel freely admitted she had not read Russell's letter of August 6, 2013 and was therefore unprepared to discuss Russell's request for voluntary withdrawal of the fraud and ownership claims. (Exhibit C). Russell requested a

substantive reply and advised – for the second time – that barring voluntary withdrawal Registrant would seek pre-trial judgment on those claims.

- In December 2013 Petitioner sought Registrant’s consent to an extension of time for discovery; Registrant consented and the extension was granted (ESTTA578174, of record).
- By letter dated January 28, 2014 Russell wrote again, advising – yet again – that Registrant intended to seek summary judgment, and inviting Petitioner to participate in settlement negotiations (Exhibit D). Petitioner’s counsel responded by email on February 12, 2014, requesting a “concrete settlement offer” (Exhibit E).
- By letter dated February 19, 2014 Russell delivered a concrete settlement offer and further stated, “I am in receipt of the discovery materials you served yesterday. However, I respectfully request your consent to a motion for suspension for purposes of settlement negotiation” (Confidential Exhibit F). Russell followed up by email on February 24, 2014 (Confidential Exhibit G). Hearing nothing, Russell again followed up by email on March 11, 2014 (Confidential Exhibit H). Finally, on March 27, 2014 Petitioner’s counsel responded on the settlement proposal, via email, but said nothing about Russell’s request for consent to a motion for suspension (Confidential Exhibit H). The discovery deadline (March 21, 2014) had already passed at the time of the March 27, 2014 email. Yet Petitioner’s counsel ignored it.

The remaining correspondence is already of record, and yes: Registrant missed the March 21 deadline. Given the foregoing chronology, however, this can hardly be characterized as a “refusal to participate in discovery.” Petitioner participated in settlement discussions, yet remained intentionally silent on Registrant’s repeated requests for consent to a suspension. Petitioner

continued to do so, even after the deadline had passed. Then, having made no prior inquiries, Petitioner went on the offensive, accusing Registrant of “wholesale failure to respond,” “inexcusable failure,” “refusal to participate” and now, “gamesmanship.” Registrant assumed, mistakenly, that the parties were continuing to negotiate in good faith and that consent to suspension would be forthcoming. Petitioner’s track record, after all, was of nonresponse or delayed response to nearly every communication. At worst, Registrant erred by according to Petitioner a misplaced mantle of good faith. But gamesmanship? Refusal to participate? No. The gamesmanship in this matter, if any, is Petitioner’s.

Petitioner complains that Registrant has somehow blindsided Petitioner by bringing the instant motion for summary judgment. As the foregoing chronology and attached Exhibits confirm, however, Registrant had for nine months been advising Petitioner of Registrant’s intent to do so, and had specifically shared the bases for relief upon which Registrant intended to rely.

PETITIONER’S MOTION PURSUANT TO FED.R.CIV.P. 56(d) IS PROCEDURALLY
DEFICIENT AND, IN ANY EVENT, MOOT, AND SHOULD BE DENIED

Petitioner fails absolutely to establish entitlement to relief under Rule 56(d) – which specifically requires the nonmovant to show, by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition. Please note: that means opposition to the motion for summary judgment. Petitioner nowhere references the specific points or Exhibits in Registrant’s motion as to which it is allegedly unable to present its opposition. Instead, Petitioner argues loudly (but weakly) that Rule 56(d) – alone – somehow provides a basis for denying the

motion outright and for compelling Registrant's service of all discovery responses in this matter, whether relevant to the motion or not.

Even if the Board were to interpret Petitioner's brief as making the required specific references, Rule 56(d) requires the reasons to be set forth by affidavit or declaration. Neither the declaration of Bost nor of that of Crujeiras contains the requisite showing, for specified reasons, how or why Petitioner lacks facts essential to justify its opposition to Registrant's motion. To the contrary, the declarations of Bost and Crujeiras both argue the merits of the motion. Petitioner submitted a full brief in response to the motion, along with voluminous exhibits. Having thus responded on the merits of the summary judgment motion, Petitioner's motion under Rule 56(d) must be dismissed as moot. *Roche Diagnostics GMBH, And Roche Diagnostics Operations, Inc., v. Minipumps, LLC*, 2013 WL 5467036 (TTAB 2013); see, *Thomas Sköld v. Galderma Laboratories, Inc.*, 2012 WL 5902083 (TTAB 2012); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, n8 (TTAB 2002).

Petitioner completely disregards the limited purpose of Rule 56(d) and the strict procedural requirements set forth therein. As Petitioner makes no credible attempt to establish entitlement to relief under Rule 56(d), its motion should be denied.

PETITIONER'S STATEMENTS ON ITS FRAUD CLAIM MISLEAD THE BOARD

The first two sentences in Petitioner's brief (Section III [A], p.6) are nothing short of astounding. Petitioner is apparently asking the Board, and Registrant, to ignore the plain language of the

Petition for Cancellation. Each and every allegation in the Petition (Claim “A,” paragraphs 1-9) asserts fraud based upon Registrant’s alleged misrepresentation of its dates of first use. Nowhere in the Petition does Petitioner allege or even suggest that its fraud claim arises from the statement of actual use set forth in Registrant’s Statement of Use. Nor does Petitioner present this new theory by affidavit or declaration; the self-serving about-face appears only in Petitioner’s brief.

In its motion, Registrant established that the dates of first use are not relevant to Petitioner’s fraud claim, because Registrant’s was an intent to use application. And that (the dates of first use) is the only basis upon which Petitioner asserts fraud. However, even if one were to accept that Petitioner asserts fraud based on the statement of use, Registrant submitted uncontroverted evidence that Registrant made actual use in commerce prior to submitting its Statement of Use (Declaration of Jeff Morris and Exhibits A, B and C to the motion for summary judgment.) In its response Petitioner supplies no evidence to refute the foregoing; nor, by affidavit or declaration, does Petitioner offer specific reasons why it cannot present facts opposing that evidence. Accordingly, upon the record before the Board, Registrant has satisfied the requirements for summary judgment and Petitioner’s fraud claim should be dismissed.

PETITIONER APPLIES THE WRONG LAW IN ITS ARGUMENTS ON LACHES

Petitioner argues that Registrant’s defense of laches is overcome by “inevitable confusion.” Registrant denies the existence of confusion or of false suggestion of a connection, and expressly reserves all defenses on the merits of that claim. At this time, however, the merits of the claim are not before the Board. The only issue is whether Registrant has established its entitlement to

summary judgment based on the defense of laches. For the reasons that follow, the Board should find in Registrant's favor and dismiss the claim.

In cases arising under Lanham Act section 2(d), inevitable confusion can trump a proffered defense of laches. This proceeding, however, arises under Lanham Act section 2(a). While there can be overlap when analyzing the merits of §2(d) and §2(a) claims, the two are entirely different when it comes to the issue of laches. Here's why. The concern in §2(d) cases is the protection of the public from confusion. *In re Kent Pedersen*, 109 USPQ2d 1185 (TTAB 2013), citing *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, 245 F3d 1359, 58 USPQ2d 1460, 1464 (Fed Cir 2001). In contrast, the concern in §2(a) cases is the protection of persons from exploitation of their persona. *Id.* The *Bridgestone* court explained, "[t]his protection of rights of personal privacy and publicity distinguish the §2(a) false suggestion of connection provision from the §2(d) likelihood of confusion provision." *Bridgestone/Firestone Research, Inc. v. Automobile Club De L'Ouest De La France*, supra, at 1363. Accordingly, on the question of whether laches was available as a defense, the *Bridgestone* court rejected "cases brought under §2(d), whereby a continuing and inevitable likelihood of confusion led the court to permit tardy challenge to a registered mark," holding instead that, "the equitable defenses of laches and estoppel are not barred in §2(a) false suggestion cases, absent misrepresentation or deceit." *Id.* The Board recently cited and reaffirmed this aspect of *Bridgestone*, in connection with §2(a) cases involving a single person. *Amanda Blackhorse, Marcus Briggs-Cloud, Philip Gover, Jillian Pappan, and Courtney Tsoy v. Pro-Football, Inc.*, 2014 WL 2757516, 30 (TTAB June 18, 2014).

Each and every case Petitioner cites in its opposition is a §2(d) case which, under *Bridgestone*, should be rejected as inapplicable. Moreover, despite being apprised of *Bridgestone* in Registrant's memorandum in support of the instant motion, Petitioner has made no attempt to distinguish *Bridgestone* or otherwise to establish entitlement to relief thereunder. Registrant respectfully submits, therefore, that its laches defense is viable and that, upon the record before the Board, it has been established and should operate as a matter of law to bar Petitioner's §2(a) claim of false suggestion of a connection.

ADDITIONAL POINTS IN REPLY

- Even if the “inevitable confusion” test were to apply (which it does not), the Board has held that both the marks and the goods need to be identical. See *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203, 2006 WL 337553, 12 (TTAB 2006); *Houdini, Inc. v. Metrokane, Inc.*, 2008 WL 1963601, n 14 (TTAB 2008). None of Petitioner's marks are identical (or even similar) to the distinctive design mark of the challenged registration.
- The inquiry is not whether facts giving rise to a claim or defense (involving §2[a]) exist now, but whether they existed when the challenged registration issued. *Terri Yenko Gould v. General Marketing Capital, Inc.*, 2013 WL 3168097 (TTAB 2013); *Consorzio Del Prosciutto Di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894 (TTAB 1992). In this matter, the challenged registration issued on April 3, 2007. Petitioner's arguments and exhibits addressing alleged confusion (or anything else) occurring post-registration should be disregarded and stricken.
- Petitioner's reliance on *Cuban Cigar Brands* (457 F. Supp. 1090 [S.D.N.Y. 1978]) is desperately misplaced. Petitioner would have us believe that *Cuban Cigar* supports the proposition that its

extraordinary delay in bringing this proceeding should be excused because Petitioner was busy suing other people. Hardly. For *Cuban Cigar* to excuse Petitioner's delay, Petitioner would need to establish circumstances equal or akin to its having been driven from its country of origin by a hostile political regime; consequent uncertainty regarding the very existence of its mark; and decades of litigation relating to its ouster and the need to rebuild its business from scratch. Suffice to say, Petitioner does not and cannot claim circumstances remotely approaching those present in *Cuban Cigar*. To the contrary, Petitioner is a sophisticated corporate entity with vast resources, represented by a parade of large global law firms. Registrant is represented by a solo practitioner. "We've been too busy" rings rather hollow.

- Petitioner offers no other excuse, and is "conspicuously silent" regarding its nearly eight-year delay. *Teledyne Technologies, Inc.*, supra.
- Registrant's original memorandum and uncontroverted exhibits establish prejudice sufficient to support the defense of laches.
- Petitioner's repeated references to having "successfully opposed" Registrant's Serial Number 85177921 are misleading. That matter (Opposition Number 91201188) settled by mutual agreement of the Parties.
- Petitioner failed in its opposition to include citations to official reporters, in violation of TBMP §101.03.

CONCLUSION

The purpose of a motion for summary judgment is judicial economy: to avoid an unnecessary trial where more evidence than is already of record could not reasonably be expected to change the result. The record before the Board establishes that Registrant is entitled to summary

judgment on all claims as a matter of law. Petitioner has not challenged the evidence of record; nor has Petitioner alleged by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition to the evidence of record. Nor, Registrant submits, would any amount of additional evidence change the result in this matter. Accordingly, the Petition to Cancel should be dismissed in its entirety, with prejudice.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT AND TO PETITIONER'S MOTION PURSUANT TO FED.R.CIV.P. 56(d) was served on Petitioner by mailing a copy by First Class Mail, postage prepaid, to Petitioner's counsel at the following address on this 23rd day of June, 2014:

Jill M. Pietrini
SHEPPARD MULLEN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

/elizabeth t russell/

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell
6907 University Ave., #227
Middleton, WI 53562
Telephone: 608-826-5007

EXHIBIT A

RussellLaw

49 Kessel Court Suite 200 Madison, WI 53711 608-285-5007 www.erklaw.com

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

July 19, 2013

Jill M. Pietrini, Esq.
SHEPPARD MULLEN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

Re: Cancellation No. 92057058

Dear Ms. Pietrini:

Deadline for a discovery conference in connection with the above-referenced is July 24, 2013. I write via US Mail, as you expressed an unwillingness to communicate via email.

I am available for a telephone conference on July 24 between noon and 4pm, central time. Please advise.

Sincerely,

Elizabeth T Russell

EXHIBIT B

RussellLaw

6907 University Ave. #227 Middleton, WI 53562 608-826-5007 www.erklaw.com

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

August 6, 2013

Jill M. Pietrini, Esq.
SHEPPARD MULLEN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

Re: Cancellation No. 92057058

Dear Ms. Pietrini:

Enclosed please find my change of correspondence address, filed today via ESTTA.

I remain available for the mandatory discovery conference and note that, despite my letter to you of July 19, 2013 and follow-up email of July 30, 2013 I have as yet received no communication from your office regarding same.

At this time I would like to request your withdrawal of claims "A" and "B" of the petition, namely, fraud on the office and registrant's ownership of the mark. As outlined in the answer, it seems clear that both claims are subject to dismissal on the pleadings. I intend to make a motion for partial judgment on the pleadings, if we are unable to agree upon your voluntary withdrawal of those claims. Please advise at your earliest convenience.

Sincerely,

Elizabeth T Russell

EXHIBIT C

From: [Elizabeth Russell](#)
To: "Whitney Walters"
Cc: jpietrini@sheppardmullin.com
Subject: Discovery conference summary: Island Food & Fun, Inc.
Date: Friday, August 16, 2013 3:31:00 PM

Re: Cancellation No. 92057058

Whitney:

Given that the deadline for initial disclosures is just a few days away, I provide this summary of our August 13 discovery conference via email rather than US Mail.

1. We conducted a discovery conference in the above-referenced, via telephone on August 13, 2013.
2. We agreed that the deadline for initial disclosures stands, at August 23, 2013.
3. Your client requests changes to the standard protective order. You will forward to me a redline of the requested changes, at your earliest convenience.
 - a. We did not discuss a date for this, but I would appreciate receiving the redline within the next week.
4. You will consult with your client about conducting this proceeding in accordance with the provisions for Accelerated Case Resolution (ACR).
5. You had not reviewed my letter of August 6, 2013. Accordingly, we were unable substantively to discuss my request that your client withdraw its claims regarding fraud on the office and ownership of the mark. You will respond substantively, as soon as possible. Again, I would appreciate a substantive reply within the next week. Barring that, I intend to make a motion for partial judgment on the pleadings, seeking the dismissal of these two claims.

Please advise if I have omitted or misstated anything.

Thanks very much,

Elizabeth

Elizabeth T Russell beth@erklaw.com

NEW MAILING ADDRESS:

6907 University Ave. #227
Middleton, WI 53562 USA

Voice Telephone: 1-608-826-5007

EXHIBIT D

RussellLaw

6907 University Ave. #227 Middleton WI 53562 608-826-5007 www.erklaw.com

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

January 28, 2014

Jill M. Pietrini, Esq.
Whitney Walters, Esq.
SHEPPARD MULLEN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

Via email: wwalters@sheppardmullin.com; JPietrini@sheppardmullin.com

Re: Cancellation No. 92057058

Legal Correspondence for Settlement Purposes Only. Not Admissible Under FRE 408.

My statements herein are made for the purposes of settling the dispute between our clients. Anything that I might say or propose is neither an admission of any allegations that you or your client might have made nor a waiver of any rights or defenses that my client may have.

Dear Ms. Pietrini and Ms. Walters:

Having reviewed the undisputed facts in this matter, I believe that the Registrant is entitled to judgment as a matter of law on all three of the claims raised in the petition for cancellation. Specifically:

1. **Fraud.** Registrant's alleged dates of first use were not material to registrability of the *intent-to-use* application that eventually matured into the challenged registration. As well, the required *Bose* factors are not present.
2. **Ownership of the Mark.** Non-ownership of a mark at the time of registration cannot be asserted against a registration more than five years old.
3. **False "Association."** This claim is barred on grounds of laches and estoppel, as your client expressly raised and failed to pursue identical claims over a period of at least eight years.

Accordingly, my client has instructed me to make a motion for summary judgment.

Before doing so, however, I write to ascertain your interest in discussing a settlement. I believe the likelihood of my client prevailing on summary judgment is very strong – even without discovery. However, the motion process will require both your client and mine to incur otherwise

unnecessary expenses. A confidential settlement would permit your client to avoid a public record of having failed to prevail on these issues; it would, as well, afford us an opportunity to negotiate terms finally disposing of the issues between our clients.

I draw your attention to Rule 3-510 of the California Rules of Professional Conduct, which require a lawyer promptly to inform the client of “all amounts, terms, and conditions of any written offer of settlement made to the client.” Accordingly, in any reply I request your affirmative representation that your client has received a copy of this letter; that it is aware of the unique facts of this matter; and that it has instructed you specifically to deliver the reply.

Thank you for your thoughtful consideration, and I look forward to hearing from you.

Sincerely,

Elizabeth T Russell

EXHIBIT E

From: [Whitney Walters](#)
To: [Elizabeth Russell](#)
Cc: [Jill Pietrini](#)
Subject: RE: 56 Hope Road v. Mormax
Date: Wednesday, February 12, 2014 4:50:39 PM
Sensitivity: Confidential

Elizabeth:

We are in receipt of your letter dated January 28, 2014.

While we strongly dispute that your client is entitled judgment as a matter of law on any of the three claims asserted in the cancellation petition and are prepared to vigorously defend against any motion along those lines, we would be happy to entertain the possibility of resolving this dispute without further expenditure of attorneys' fees and costs. Your letter indicates that your client is interested in pursuing this option, yet you propose no actual "amounts, terms, [or] conditions" of settlement for our client to consider.

If you have a concrete settlement offer that you would like our client to entertain, please forward it to us, and we will send it to our client for consideration.

Best,

Whitney

From: Elizabeth Russell [mailto:beth@erklaw.com]
Sent: Tuesday, January 28, 2014 9:58 AM
To: Whitney Walters
Cc: Jill Pietrini
Subject: RE: 56 Hope Road v. Mormax
Sensitivity: Confidential

Whitney and Jill,

Please confirm your receipt of the attached letter from me. I look forward to hearing from you at your earliest convenience.

Best,
Elizabeth

Elizabeth T Russell beth@erklaw.com