

This Opinion is not a  
Precedent of the TTAB

UNITED STATES PATENT AND  
TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
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General Contact Number: 571-272-8500

CME

Mailed: September 17, 2014

Cancellation No. 92057058

Fifty-Six Hope Road Music Limited

v.

Island Food & Fun, Inc.

**Before Kuhlke, Lykos, and Hightower,  
Administrative Trademark Judges.**

**By the Board:**

Island Food & Fun, Inc. (“Respondent”) owns Registration No. 3225517 for the mark below for “family oriented restaurant and lounge featuring Caribbean decor, menu and entertainment” in International Class 43:<sup>1</sup>



On April 8, 2013, Fifty-Six Hope Road Music Limited (“Petitioner”) filed a petition for cancellation of Respondent’s mark on grounds of fraud, non-ownership and false suggestion of a connection. In its answer, Respondent

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<sup>1</sup> Filed on November 3, 2003, issued on April 3, 2007, and based on a claim of first use anywhere and first use in commerce of July 2000.

admits that it is “not connected with any activities of Petitioner or of Bob Marley when he was living.” Answer, ¶ 2 and Notice of Opposition (“NOO”), ¶ 34. Applicant denies the remaining salient allegations in the petition for cancellation and asserts a number of affirmative defenses, including failure to state a claim upon which relief can be granted, laches and estoppel.<sup>2</sup>

This case now comes up on (i) Respondent’s motion for summary judgment, filed May 2, 2014, which we construe as a combined motion for summary judgment on Petitioner’s claim of fraud and Respondent’s affirmative defenses of laches and acquiescence and a motion for judgment on the pleadings seeking dismissal of the petition for cancellation for failure to state a claim; and (ii) Petitioner’s combined response and cross-motion for Fed. R. Civ. P. 56(d) discovery.

***Motion for Judgment on the Pleadings***

We address first Respondent’s motion for judgment on the pleadings. Respondent argues that Petitioner has failed to state a claim for fraud because even if, as Petitioner alleges, the dates of first use asserted in Respondent’s underlying application are false, dates of first use are immaterial to the USPTO’s decision to issue a registration, Motion, pp. 4-5; that Petitioner’s non-ownership claim is time barred, *see id.* at pp. 6-7; and

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<sup>2</sup> Paragraph 17 of Respondent’s answer referring to “estoppel” adequately alleges the elements of both equitable estoppel and acquiescence, which is a type of estoppel. *See Christian Broadcasting Network, Inc. v. SBS-CBN Int’l*, 84 USPQ2d 1560, 1573 (TTAB 2007) (“Acquiescence is a type of estoppel that is based upon the plaintiff’s conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant, that is not objected to.”).

that Petitioner has not properly pleaded false suggestion of a connection, but instead has pleaded “false association” in a “veiled attempt to advance a claim of likelihood of confusion, which is not a permissible ground for cancellation of a registration more than five years old.” *Id.* at pp. 7-8.

In response, Petitioner has withdrawn its claim of non-ownership. *See* Combined Response/Cross-Motion, p. 2. Petitioner also argues that it has adequately pleaded a claim for fraud based on non-use of the mark as of the filing date of Respondent’s Statement of Use and that it has adequately alleged each element of a false suggestion of a connection claim even though its petition for cancellation includes a heading that reads “False Association with Bob Marley.” *Id.* at pp. 1, 6 and 8-9.

If a defendant files a motion for judgment on the pleadings under Fed. R. Civ. P. 12(c) that is based on the assertion that the complaint fails to state a claim upon which relief can be granted, as is the case here, the standard for adjudicating the motion is the same as that of a motion filed under Fed. R. Civ. P. 12(b)(6). *See Western Worldwide Enters. Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990). Accordingly, we consider whether Petitioner has alleged such facts as would, if proven at trial or on summary judgment, establish that Petitioner has standing to petition for the cancellation of the registered mark and that a statutory ground exists for canceling such registration. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Specifically, a complaint “must

contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, a plaintiff must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 556 U.S. 662 (citing *Twombly*, 550 U.S. at 555). Further, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See, e.g., *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007).

**a. Standing**

Petitioner has sufficiently pleaded its standing by alleging (i) that it “is owned and operated by a majority of the children and widow of the world-renowned reggae artist, Bob Marley, and is the owner of all of the intellectual property rights in the name, likeness, and persona of Bob Marley,” NOO, ¶ 16; and (ii) a plausible claim of false suggestion of a connection as discussed *supra*, p. 7. See *Association pour la Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1841 (TTAB 2007) (standing established where (1) individual named in the mark died in 1985, (2) representative is

the granddaughter of the named individual and one of the heirs, (3) representative is a member of the petitioner committee and the purpose of the committee is to defend the rights and the work of the named individual, and (4) petitioners claim that the mark at issue falsely suggests a connection with the named individual).

**b. Fraud**

Petitioner bases its claim of fraud on the following allegations:

- “On November 6, 2006, [Respondent] filed a Statement of Use for [its underlying application] in which it claimed first use of the mark anywhere since at least as early as July 2000, and first use of the mark in commerce since at least as early as July 2000.” NOO, ¶ 2;
- “[Respondent] knowingly misrepresented its dates of first use to the Office. The dates of first use in the Statement of Use are material facts.” *Id.* at ¶ 4;
- “[Respondent] misrepresented its date[s] of first use to the Office to obtain an earlier date of first use based on a different mark with the intent to deceive the office.” *Id.* at ¶ 8; and
- “The Office relied upon the first use dates alleged in the SOU in issuing the registration.” *Id.* at ¶ 9.

Contrary to Petitioner’s allegations, the date of first use is not material to the USPTO’s issuance of a registration. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009) (“[T]he claimed date of first use, even if false, does not constitute fraud because the first use date is not material to the Office’s decision to approve a mark for publication.”); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983) (“The Examining Attorney gives no consideration to alleged dates of first use in

determining whether conflicting marks should be published for opposition.”). Instead, the critical question is whether Respondent’s mark was in use with the identified services as of November 6, 2006, which is the date Respondent filed its Statement of Use. *See Higara*, 90 USPQ2d at 1107. The petition for cancellation does not include any allegations that can be construed as alleging non-use of the involved mark as of the filing date of Respondent’s Statement of Use. Accordingly, Petitioner’s alleged claim of fraud is futile and does not provide a basis upon which relief can be granted.

**c. Non-ownership**

Petitioner has withdrawn its claim of non-ownership and rightly so as such a claim cannot be brought against a registration more than five years old such as the registration involved here. *See Combined Response/Cross-Motion*, p. 2 and 15 U.S.C. § 1064. Accordingly, Paragraphs 10 -14 of the petition for cancellation are **STRICKEN**.

**d. False Suggestion of a Connection**

With respect to false suggestion of a connection, Petitioner alleges in pertinent part that:

- “Robert ‘Bob’ Nesta Marley (aka Bob Marley) was a Jamaican singer, songwriter, guitarist, and activist. Bob Marley is also known by the name MARLEY.” NOO, ¶ 17;
- “[Respondent’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.” *Id.* at ¶ 30;
- “The name MARLEY is associated with, and points uniquely to, Bob Marley.” *Id.* at ¶ 31;

- “[Respondent] is using MARLEY as a key part of the mark, which is the same as, or a close approximation of, the name Bob Marley.” *Id.* at ¶ 32;
- “The use of MARLEY in [Respondent’s] purported mark would be and is recognized as the same as, or a close approximation of, the name Bob Marley.” *Id.* at ¶ 33;
- “[Respondent] is not connected with any activities of Petitioner or of Bob Marley when he was living.” *Id.* at ¶34;
- “The fame and/or reputation of Bob Marley is such that, when the mark is used with [Respondent’s] services, a connection with Bob Marley and/or Petitioner is presumed.” *Id.* at ¶ 35; and
- “[Respondent’s] mark MARLEY’S A TASTE OF THE CARIBBEAN & Design is a false association with Bob Marley or is likely to be perceived as a false association with Bob Marley. Many consumers have already falsely associated [Respondent] and its restaurant with Bob Marley.” *Id.* at ¶ 36.

Although Petitioner refers to a “false association” and some of its allegations focus on the “MARLEY” portion of Respondent’s mark rather than the mark as a whole, the foregoing allegations are sufficient to put Respondent on notice that Petitioner is alleging a claim of false suggestion of a connection.<sup>3</sup> *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports*

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<sup>3</sup> Notably, Section 2(a) of the Lanham Act provides that a mark may not be registered if it “consists of **or comprises** .... matter which may ... falsely suggest a connection with persons, living or dead....” 15 USC § 1052(a) (emphasis added). However, to prevail on its claim of false suggestion of a connection, Petitioner will need to prove that Respondent’s mark, *as a whole*, is a close approximation of Bob Marley’s identity. *See Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2027-28 (TTAB 2013) (recognizing that the determination of whether a defendant’s mark is a close approximation of a plaintiff’s identify is “a stringent one, requiring a greater degree of similarity between the two designations. Indeed, the similarity required for ‘close approximation’ is akin to that required for likelihood of confusion under 2(d) and is more than merely ‘intended to refer’ or ‘intended to evoke....’”).

*Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

**e. Summary**

In view of the foregoing, Respondent's motion for judgment on the pleadings is **GRANTED** with respect to Petitioner's fraud claim, but **DENIED** with respect to Petitioner's false suggestion of a connection claim. If the facts so warrant, Petitioner is allowed until **October 13, 2014** to file an amended complaint which includes an adequately pleaded claim for fraud, failing which the existing allegations regarding fraud will be stricken and the fraud claim will be given no further consideration.<sup>4</sup> In the event that Petitioner files an amended complaint, Respondent is allowed until **November 3, 2014** to file its answer or to otherwise respond to the amended complaint.

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<sup>4</sup> Whether Petitioner in good faith can allege facts sufficient to plead a claim of fraud is uncertain given that a declaration of Respondent's co-owner and President attached to Respondent's motion suggests that the involved mark was in use for the involved services as of the filing date of Respondent's Statement of Use. *See* Docket # 13, Morris Declaration, ¶ 7 (attesting that Respondent's predecessor-in-interest "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"). Pursuant to Fed. R. Civ. P. 15(a)(2), Petitioner may file a motion to amend its complaint outside of the deadline provided herein if Petitioner uncovers evidence to support a fraud claim through discovery. Any such "motion for leave to amend should be filed as soon as any ground for such amendment, e.g., newly discovered evidence, becomes apparent." *ChaCha Search Inc. v. Grape Tech. Group Inc.*, 105 USPQ2d 1298, 1300 (TTAB 2012) (recognizing that "[a] long delay in filing a motion for leave to amend may render the amendment untimely"); *Int'l Finance Co. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002).

Respondent's motion is **MOOT** to the extent it addresses Petitioner's claim of non-ownership, which has been withdrawn. Paragraphs 10-14 of the petition for cancellation are **STRICKEN**.

***Motion for Fed. R. Civ. P. 56(d) Discovery***

A motion for Fed. R. Civ. P. 56(d) discovery must be supported by an affidavit or declaration showing that the non-moving party cannot, for the reasons stated therein, present facts essential to justify its opposition to the motion. *See* Fed. R. Civ. P. 56(d). Respondent submitted two declarations in support of its combined response and cross-motion, but neither declaration includes any specified reason as to why Petitioner needs discovery to respond to Respondent's motion for summary judgment. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (finding mere assertion in brief of need for discovery insufficient). Moreover, Petitioner has responded to the merits of Respondent's motion, at least with respect to laches and acquiescence. *See Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002) (denying motion for Rule 56(f) discovery where responsive brief on merits to summary judgment filed); *see also* TBMP § 528.06 (2014) ("A request for Fed. R. Civ. P. 56(d) discovery should be clearly made, and certainly not buried somewhere in a responsive brief or other paper, and should not be filed as a 'throw away' alternative accompanying a response to the motion for summary judgment on

the merits.”). For these reasons, Petitioner’s motion for 56(d) discovery is **DENIED**.

***Summary Judgment***

As an initial matter, Respondent marked as confidential a second declaration of Jeff Morris (Docket # 14) and Exhibits F, G and H to its reply brief (Docket # 20), but it did not submit redacted copies of these documents for public inspection as required by Trademark Rule 2.126(c). *See* TBMP § 412.04 (“[F]or confidential submissions filed either via ESTTA or by paper, two versions are required – a confidential version as well as a redacted version available for public view.”). Accordingly, Respondent is allowed until **THIRTY DAYS** from the mailing date of this order to file redacted copies of the second Morris declaration and Exhibits F, G and H to its reply brief, failing which these documents will become part of the public record. *See Morgan Creek Productions Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009).

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions*, 4 USPQ2d at 1796. This burden is greater than the evidentiary burden at trial.

See TBMP § 528.01 and cases cited therein. A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

We need not consider Respondent's motion to the extent it seeks summary judgment on the unpleaded claim of fraud. Accordingly we consider Respondent's motion only to the extent it seeks summary judgment on the affirmative defenses of laches and estoppel by acquiescence. Such equitable defenses are not barred in § 2(a) false suggestion cases, absent misrepresentation or public deceit. See *Bridgestone/Firestone Research, Inc. v. Auto. Club*, 245 F.3d 1359, 58 USPQ2d 1460, 1463-64 (Fed. Cir. 2001).

The elements of a laches defense are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. See *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes*

*Inc.*, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). The defense of acquiescence is similar to that of laches and requires proof of the following three elements: (1) that the claimant 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 defendant undue prejudice.<sup>5</sup> See *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 USPQ2d 1401, 1409 (11<sup>th</sup> Cir. 1991); *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ 1057 (TTAB 1981). With regard to delay, the focus is on reasonableness and the Board must consider any excuse offered for the delay. See *A.C. Aukerman Co. v. R. L. Chaides Constr. Co.*, 960 F.2d 1020, 22 USPQ2d 1321, 1329 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of Petitioner as the non-movant, we find that genuine disputes of material fact preclude granting summary judgment in favor of Respondent. At a minimum, there are genuine disputes of material fact regarding whether Petitioner's delay in bringing this action was reasonable or excusable and whether

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<sup>5</sup> The elements of equitable estoppel are: (1) misleading conduct which leads another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. See *Lincoln Logs*, 23 USPQ2d at 1703 (citing *A.C. Aukerman Co. v. R. L. Chaides Constr. Co.*, 960 F.2d 1020, 22 USPQ2d 1321 (Fed. Cir. 1992)). Respondent, however, has not moved for summary judgment on its defense of equitable estoppel. Indeed, there is no evidence in the record regarding any reliance by Respondent on Petitioner's alleged misleading conduct.

Petitioner expressly or by clear implication represented that it would not assert a claim against Respondent.<sup>6</sup> Moreover, Respondent has not satisfied its burden of showing a lack of misrepresentation or public deception based on its use of the involved mark. Accordingly, Respondent's motion for summary judgment is **DENIED**.<sup>7</sup>

Proceedings are resumed and disclosure, trial and other dates are reset as follows:

Deadline to File an Amended Complaint	<b>10/13/2014</b>
Deadline to Answer any Amended Complaint	<b>11/3/2014</b>
Plaintiff's Pretrial Disclosures Due	<b>11/17/2014</b>
Plaintiff's 30-day Trial Period Ends	<b>1/1/2015</b>
Defendant's Pretrial Disclosures Due	<b>1/16/2015</b>
Defendant's 30-day Trial Period Ends	<b>3/2/2015</b>
Plaintiff's Rebuttal Disclosures Due	<b>3/17/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>4/16/2015</b>

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<sup>6</sup> Respondent argues that on December 5, 2008, Petitioner sent Respondent a letter attaching a draft complaint alleging trademark infringement based on Respondent's use of the mark involved here, but that no such complaint was ever filed. *See* Motion, p. 13. In support of this assertion, Respondent submits a copy of Petitioner's December 5, 2008 letter but the referenced complaint is not attached to the letter, *see id.* at Exhibit D, and the declarations attached to Respondent's motion do not make any reference to a threatened lawsuit.

<sup>7</sup> The fact that we have identified genuine disputes of material fact as a sufficient basis for denying Respondent's motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remains for trial. In addition, the parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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