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

Proceeding	92057403
Party	Plaintiff Bamboula 8, LLC
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Date	01/07/2015
Attachments	Aston Barrett TTAB opposition.pdf(421461 bytes )

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

\_\_\_\_\_  
Bamboula 8, LLC )  
 )  
Plaintiff, )  
 )  
vs. )  
 )  
The Original Wailers, LLC )  
 )  
Defendant. )  
\_\_\_\_\_

Cancellation No. 92057403  
Registration No. 4332360

**Attorney Reference: 127283-360953**

**PLAINTIFF’S OPPOSITION TO DEFENDANT’S MOTION FOR JUDGMENT**

Plaintiff respectfully submits the following opposition in response to Defendant’s Motion for Judgment under 37 C.F.R. § 2.132(b). Defendant’s motion should be denied because (i) it is untimely; (ii) the U.S. Patent and Trademark Office records submitted by Plaintiff in its Notice of Reliance constitute satisfactory evidence that sets forth Plaintiff’s prima facie case for cancellation; and (iii) Defendant’s motion was made in bad faith.

I. DEFENDANT’S MOTION FOR JUDGMENT IS UNTIMELY.

A defendant seeking a Section 2.132(b) dismissal must file its motion prior to the opening of the defendant’s testimony period. 37 C.F.R. § 2.132(c). While the Trademark Trial and Appeal Board (the “Board”) has discretion to permit a late-filed motion for dismissal made under Section 2.132(a), the Board does *not* have this discretion with respect to motions made under subsection (b). *Id.* (“A motion filed under paragraph (a) or (b) of this section *must* be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under *paragraph (a)* even if the motion was filed after the opening of the testimony period of the moving party.”) (emphasis added). In

the present case, Defendant's motion was filed under paragraph (b), and was filed subsequent to the opening of its testimony period. As a result, Defendant's motion is untimely and should be denied.

II. PLAINTIFF'S NOTICE OF RELIANCE CONTAINS SUFFICIENT EVIDENCE TO SHOW ITS RIGHT TO RELIEF.

While a defendant in a Board proceeding may move for a judgment of dismissal when a plaintiff submits no evidence other than records of the U.S. Patent and Trademark Office ("USPTO"), such a motion should not be granted when the USPTO records succeed in setting forth the plaintiff's prima facie case for relief. *See* 37 C.F.R. § 2.132(b); *see also* *Skincode AG v. Skin Concept AG*, 109 U.S.P.Q.2d 1325 (TTAB 2013) ("The purpose of the motion under Rule 2.132(b) is to save the defendant the time and expense of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not set forth a prima facie case."). The Board has the discretion to deny a Rule 2.312(b) motion when the USPTO records support the plaintiff's claim of a right to relief. 37 C.F.R. § 2.132(b); *Merker Counter Co. v. Central Counter Co.*, 310 F.2d 746, 770 (CCPA 1962) ("Rule 2.132(b) gives the board discretionary powers to grant or deny motions for judgment thereunder.").

In the present case, the USPTO records submitted by Plaintiff show evidence of Plaintiff's priority of use and registration, as well as evidence that Defendant's mark is confusingly similar to Plaintiff's mark. These records were submitted in Plaintiff's October 29, 2014 Notice of Reliance, which serves as Plaintiff's evidence and testimony in support of its petition for cancellation. The records included a copy of Plaintiff's U.S. Registration No. 4,031,818, as well as Office Actions issued by the USPTO in connection with Plaintiff's pending applications, Serial Numbers 85/736,052 and 85/736,051. Because these documents are

sufficient to demonstrate Plaintiff's prima facie case for cancellation, Defendant's Section 2.132(b) motion should be denied.

A. Registration No. 4,031,818 (Class 25): Plaintiff's Priority

Plaintiff's Reg. No. 4,031,818 shows that Plaintiff has maintained a federal trademark registration for the mark THE WAILERS in connection with short-sleeved t-shirts and shirts in Class 25 since September 27, 2011, and that this mark has been in use since as early as 1973. The registration documents submitted in Plaintiff's Notice of Reliance supports Plaintiff's contention in its Petition for Cancellation that Plaintiff has priority over Defendant with respect to both its use and registration of THE WAILERS in Class 25.

B. Office Action on Serial No. 85/736,052 (Class 25): Likelihood of Confusion

The Office Action issued on Plaintiff's application Serial No. 85/736,052, for the mark THE WAILERS in connection with clothing, namely, hats, baseball caps, sweatshirts, jackets, shorts, sweatpants and scarves in Class 25, shows that the USPTO has determined that there is a likelihood of confusion between this applied-for mark and Defendant's subject registration for T.O.W. THE ORIGINAL WAILERS FEATURING AL ANDERSON (and design). At the time the Office Action was issued, Defendant's registration had not yet issued and was still pending under application Serial No. 85/263,866. The USPTO determined that if this application registered, the registration of Plaintiff's mark would likely be refused due to a likelihood of confusion between the two marks. Plaintiff's pending Class 25 application, though filed subsequent to Defendant's application, cites a date of first use as early as 1985, indicating Plaintiff's priority of use of THE WAILERS (Defendant's first use dates back only to July 2012). Because Plaintiff's earlier Class 25 registration is almost identical to its pending Class 25

application, the USPTO's conclusions regarding a likelihood of confusion with Defendant's mark can be applied with equal force to Plaintiff's registration.

Plaintiff's submission of this Office Action is evidence that Defendant's registration is confusingly similar to Plaintiff's own prior registration as well as its pending Class 25 application. Since Plaintiff has priority of both use and registration for this mark, Defendant's registration should be cancelled.

C. Office Action on Serial No. 85/736,051 (Class 9): Likelihood of Confusion

The Office Action issued on Plaintiff's application Serial No. 85/736,051, for the mark THE WAILERS in connection with phonograph records featuring music, prerecorded CDs, DVD and audio cassettes featuring music, downloadable music files, and headphones in Class 9, shows that the USPTO has determined that there is a likelihood of confusion between this applied-for mark and Defendant's subject registration for T.O.W. THE ORIGINAL WAILERS FEATURING AL ANDERSON (and design). At the time the Office Action was issued, Defendant's registration had not yet issued and was still pending under application Serial No. 85/263,866. The USPTO determined that if this application registered, the registration of Plaintiff's mark would likely be refused due to a likelihood of confusion between the two marks. Plaintiff's pending Class 9 application, though filed subsequent to Defendant's application, cites a date of first use as early as 1970, indicating Plaintiff's priority of use of THE WAILERS (Defendant's first use dates back only to April 2012).

Plaintiff's submission of this Office Action is evidence that Defendant's registration is confusingly similar to Plaintiff's pending Class 9 application. Since Plaintiff has priority of use for this mark, Defendant's registration should be cancelled.

III. DEFENDANT'S MOTION FOR JUDGMENT WAS MADE IN BAD FAITH.

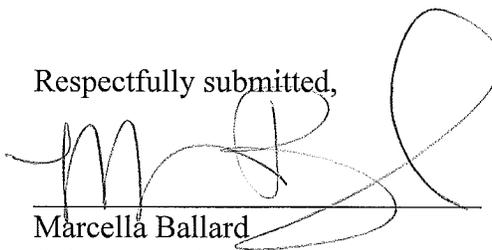
It should be noted that Defendant never took any testimony or propounded any evidence in support of its own position. Therefore, its present motion seeking dismissal due to Plaintiff's failure to submit more than USPTO records appears to be made in bad faith, given Defendant's own failure to submit any evidence at all. Furthermore, Plaintiff's counsel wishes to point out that while the Certificate of Service on Defendant's Motion is dated December 19, 2014, the envelope in which it was mailed to Plaintiff's counsel indicates that the motion was not actually mailed until at least December 22, 2014. An image of this envelope showing the United States Post Office date stamp is attached as Exhibit A. This discrepancy has the result of giving Plaintiff fewer days in which to timely respond to Defendant's motion, and is further suggestive of Defendant's bad faith. Therefore, the Board's discretion should disfavor Defendant in deciding this motion.

IV. CONCLUSION

For the foregoing reasons, Plaintiff respectfully requests that Defendant's Motion for Judgment under 37 C.F.R. § 2.132(b) be denied, and that judgment be rendered in favor of Plaintiff.

Dated: January 7, 2015

Respectfully submitted,



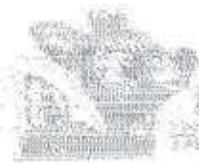
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# **EXHIBIT A**

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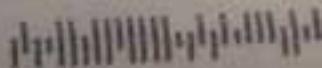
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