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

Proceeding	92058893
Party	Plaintiff Mayweather Promotions, LLC
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Date	06/13/2016
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 3565960
For the mark MONEY POWER RESPECT ENTERTAINMENT in Class 35
Registered on January 20, 2009.

Mayweather Promotions, LLC

Petitioner,

v.

Branch, Cahleb, Jeremiah, LLC,

Registrant.

Cancellation No.: 92058893

PETITIONER'S REPLY BRIEF

Petitioner Mayweather Promotions, LLC ("Petitioner"), by and through its attorneys of record, the law firm of Greenberg Traurig, LLP, hereby respectfully submits its Reply Brief as follows.

Respectfully submitted this 13th day of June, 2016.

Greenberg Traurig, LLP

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I. INTRODUCTION

Despite submitting a fifty-one page brief in this matter, Registrant has still failed to provide a single shred of evidence demonstrating that it made one sale through an online retail store *prior to* the date this proceeding began. Registrant tries to distract the Board from this fact by arguing that flyers, handbills, and other advertising materials featuring the terms “retail services” and t-shirts showing a URL to Registrant’s MySpace page are sufficient to show that Registrant actually and continuously provided “online retail store services in the field of clothing” under its MONEY POWER RESPECT ENTERTAINMENT mark. Registrant also argues that in-person sales and telephone sales are sufficient to show use of its mark for online retail store services. To the contrary, none of the voluminous photos, webpages, flyers, invoices, or testimony regarding in-person and telephone sales offered by Registrant in this case demonstrates any actual use in commerce of Registrant’s Mark in connection with online retail store services. Moreover, it appears that Registrant is confusing what constitutes a sufficient specimen to show use on *goods* with one that appropriately shows use of a mark in connection with *services*. Indeed, mere advertising without evidence of actual rendering of the services is insufficient to use in commerce of a service mark. Use of a mark on goods, such as t-shirts, is also insufficient to show use for services.

The utter lack of evidence showing any actual use of Registrant’s Mark for online retail store services should lead the Board to conclude that Registrant’s Mark has not been used in connection with online retail store services. Such nonuse means the mark cannot function as a source identifier for such services and Registrant is not entitled to maintain its registration in connection with those services. Further, based on the evidence (or lack thereof) before the Board, it is clear that Registrant had no use of its mark in connection with online retail store

services when it filed its Statement of Use. Even looking at the evidence in the light favorable to Registrant, the earliest date that Registrant's website might have had the ability to make an online sale on its website was on December 8, 2008. However, Registrant was unable to provide any corroborating evidence that it had the capability of carrying out an online sales transaction or made any internet sales at all, let alone during a short window of time that the website might have featured a link for a retail store. As such, the evidence warrants a finding of nonuse and cancellation of the registration as it applies to online retail store services.

While Registrant argues Petitioner's claim of non-use should not be considered by the Board because it was first raised by Petitioner in its trial brief, this is simply not true. Indeed, the Board hinted at such a claim in its Order Denying Registrant's Motion to Dismiss early in this proceeding. More importantly, the Board has previously held that such nonuse claims need not be separately or specifically pled as long as the defendant is sufficiently on notice of the claim. *See ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ.2d 1036 (TTAB 2012). Here, the petition for cancellation contains multiple allegations of nonuse by Registrant of its mark in connection with online retail store services at the time it filed its Statement of Use. Therefore, Registrant was on notice of such a claim. Moreover, Registrant is not prejudiced by this claim and would not have needed to conduct different or additional discovery as the factual basis of the claim is identical to Petitioner's claims for fraud and abandonment. Therefore, Petitioner requests that the Board consider its claim for nonuse and find that Registrant's registration is void *ab initio* for nonuse.

Even if Registrant began actual use of Registrant's Mark for online retail store services at some point after filing the Statement of Use, which Petitioner does not concede, such use was subsequently abandoned by Registrant with no intent to resume use. Tellingly, the evidence shows that Registrant removed the link to its "online retail store" from its website and did not put

any such links back on its website until after it was on notice of Petitioner's claim of abandonment for those services. Thus, even if the Board ultimately finds that Registrant did have use, Petitioner has at least shown evidence that Registrant affirmatively abandoned use of its mark in connection with online retail store services with no intent to resume use. Based on the evidence before the Board, Petitioner respectfully requests that, in the alternative, the Board find in favor of Petitioner on its claim for abandonment.

II. ARGUMENT

A. Registrant Had Sufficient Notice Of Petitioner's Claim That its Registration is Void *Ab Initio* Based On Nonuse And Has Not Produced Any Evidence Of Actual Use of Its Mark For Online Retail Store Services At The Time It Filed Its Statement Of Use.

Registrant argues that the Board should not consider Petitioner's claim that its registration is void *ab initio* because it did not have sufficient notice of such a claim. First, the Board alluded to this claim many months ago in its Order Denying Registrant's Motion to Dismiss. *See* Docket at Document No. 16, fn. 6. Moreover, the Board has expressly held that a claim for nonuse does not have to be separately or specifically pled so long as the defendant is on notice of such a claim. *See ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ.2d 1036 at *11 (TTAB 2012).

Here, the petition for cancellation clearly put Registrant on notice that Petitioner had alleged nonuse of Registrant's Mark in connection with online retail store services. In particular, Petitioner alleges that at the time Registrant filed its Statement of Use, Registrant had made "no such use on the listed goods." *See* Petition for Cancellation, on file herein, at ¶ 14. Further, Petitioner alleges "at the time it filed its Statement of Use, Registrant only had use of its mark in

connection with its management, advertising, and promotion services and did not actually provide online retail sales of clothing under its mark.” *See id.* at ¶ 15. As such, Petitioner submits that the issue of nonuse by Registrant at the time it filed its Statement of Use was clearly set out in the petition for cancellation and properly addressed during discovery. Further, Registrant would not be prejudiced in any way by the Board’s adjudication of the nonuse claim because discovery would not have been any different based on the claims of abandonment and fraud litigated in this matter.

Furthermore, the earliest date shown in the documents that Registrant may have provided online retail store services on its website is December 8, 2008. *See* Registrant’s Notice of Reliance at MPRE00307. Although Registrant filed its Statement of Use on November 25, 2008 and cited a date of first use of its mark in connection with all services recited in its application, Registrant has not produced a single document showing any actual use in connection with its online retail store services prior to June 2, 2008. As such, Petitioner submits that Registrant was not using its mark in connection with online retail store services when it filed its Statement of Use citing a date of first use of June 2, 2008 and the application is void *ab initio*. Accordingly, this claim should be considered by the Board and for the reasons set forth in Petitioner’s Trial Brief and herein, the Board should find that Registrant’s application is void *ab initio* for nonuse and order cancellation of the entire registration, or at the least the cancellation for “online retail store services in the field of clothing.”

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B. Evidence Showing Use of a Mark In Connection With Goods Is Insufficient To Show Use of a Mark For Services And As Such, Registrant's Registration Should be Cancelled For Nonuse.

Use of a mark on marketing collateral or promotional goods does not constitute service mark usage of Registrant's MONEY POWER RESPECT ENTERTAINMENT mark for online retail store services. Indeed, use of a mark in connection with services requires that the mark be "used or displayed in the sale or advertising of services" and that "the services are rendered in commerce." 15 U.S.C. § 1127. In other words, "use" of a service mark requires more than mere advertisement. As such, even if Registrant's flyers, t-shirts, and handbills could be considered an advertisement for its online retail store services, Registrant's Mark cannot be in use in connection with online retail store services if such services are not actually "rendered." *See Couture v. Playdom, Inc.*, 778 F.3d 1379, 1380, 113 U.S.P.Q.2D (BNA) 2042 (Fed. Cir. 2015) ("rendering of services" to obtain a trademark registration requires the actual provision of such services); *see also Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990) (promotional use of mark in sales of "incidental" items such as whiskey, pens, watches, sunglasses, and food did not constitute use of mark for cigarettes). Again, advertising a service is not synonymous with rendering a service. *See Couture*, 778 F.3d at 1381.

Here, Registrant cannot rely on flyers, business cards, and handbills showing the terms "retail services" or photographs of t-shirts displaying the URL for Registrant's MySpace page to show actual use of its mark in connection with online retail store services. Nor is Registrant's claim of "in-person" sales sufficient to show Registrant used its mark in connection with *online* retail store services. Rather, Registrant must put forth some evidence that Registrant actually

sold its clothing items online. Registrant has blatantly failed to do so. Even if Registrant's website did at one time provide the ability for customers to purchase clothing items online, Registrant still failed to provide any evidence that he actually made any sales. It is also unclear from looking at the screen shots of the website whether the website was actually capable of processing payment for an online sale and again, Registrant failed to provide any evidence to show that its website could tender an online sale. Nevertheless, even if the website had the capability to make an online sale for a brief period of time, it is clear that Registrant ceased featuring an online retail store on its website and did not take any steps to reinstitute the online shop until after it was on notice of this proceeding and Petitioner's claims. Unfortunately, subsequent use of a mark cannot retroactively cure past abandonment. *See Hornby v. TJJ Companies, Inc.*, 87 USPQ.2d 1411, 1422 (TTAB 2008). Accordingly, Registrant has failed provide any evidence of actual use of its more for online retail store services and its registration should be cancelled for nonuse. Alternatively, even if the Board finds there was some use, it should find that such use was abandoned.

C. In the Alternative, Petitioner Has Established That Registrant Abandoned Use of its Mark For Online Retail Store Services With No Intent To Resume Use.

Despite Registrant's claims to the contrary, Petitioner has provided sufficient evidence to demonstrate that Registrant affirmatively abandoned use of its MONEY POWER RESPECT ENTERTAINMENT mark for online retail store services with no intent to resume use. A mark is abandoned "[w]hen its use has been discontinued with intent not to resume use. Intent not to resume use may be inferred from circumstances." 15 U.S.C. § 1127 (emphasis added). "Nonuse for three consecutive years shall be prima facie evidence of abandonment." *Id.* Petitioner bears

the burden to prove abandonment by a preponderance of the evidence. However, as explained by the Court of Appeals for the Federal Circuit:

A showing of a prima facie case creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use. The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use.

Crash Dummy Movie LLC v. Mattel Inc., 601 F.3d 1387, 94 USPQ2d 1315, 1316 (Fed. Cir. 2010) (internal citations omitted). Once a mark has been abandoned, the abandonment cannot be undone, and a registration of the mark can be cancelled on that basis notwithstanding any later use or intent to resume use. *See Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1422 (TTAB 2008).

While Petitioner believes there was no use of Registrant's Mark for online retail services, for the sake of discussion, if there ever was any actual use, it was subsequently abandoned. The evidence produced in this case shows merely that there was potential use after Registrant filed its Statement of Use in the form of screen shots from the Way Back Machine showing that Registrant's website had a link to a retail store. What is not shown in the documents is whether Registrant's website was even capable of making an online sale, as there is no evidence any online sales occurred. Nevertheless, even if the Board determines that this scant evidence is enough to show use for online retail store services, the use was affirmatively abandoned. Indeed, although Registrant's website featured a link to its "MPR Store" until approximately April of 2011, sometime prior to April 26, 2012, the website no longer featured any links relating to an online retail store. *See* Petitioner's Notices of Reliance at May-B000094-97; *see also* Branch Tr. at Exhibit A. Registrant's website also had no links relating to online retail store services through at least May 17, 2014, but possibly until December 18, 2014 when the "Gear" tab first

appeared in the Way Back Machine printouts, both of these dates are after this cancellation action began on March 18, 2014 . *See* Petitioner’s Notices of Reliance at May-B000098-111. Therefore, Petitioner submits that in the alternative, it has at least established by a preponderance of the evidence (which was not rebutted by Registrant through any documentary evidence) that Registrant abandoned use of its mark for more than three consecutive years (April 2011 through December 2014).

Even if the Board finds that Petitioner did not establish three consecutive years of nonuse sufficient to create a rebuttable presumption of abandonment, at a minimum, Petitioner has met its burden to show that Registrant abandoned use of its mark for online retail store services with no intent to resume use. Indeed, Registrant affirmatively acknowledged that he redesigned his website on several occasions and that for a period of time the website featured no links to purchase clothing items directly from the website. Registrant’s argument that he was continuously providing online retail store services during this period when he actively took steps to remove any ability to purchase clothing from the site is nonsensical. Put simply, there is no other reasonable conclusion that can be drawn from these circumstances other than a clear intention by Registrant to stop offering online retail store services. When asked in discovery to produce documents evidencing continued use of its mark for online retail store services, Registrant failed to provide any evidence of a single online sale. *See* Petitioner’s Notices of Reliance. Furthermore, it was not until Registrant had notice of Petitioner’s abandonment claims that Registrant’s website again featured the “Gear” tab and an online shopping cart. However, at that point, it was too late remedy the abandonment and as such, Registrant’s registration must be partially cancelled for “online retail store services in the field of clothing.”

...

III. CONCLUSION

Based on the facts and evidence before the Board, Petitioner respectfully requests that the Board either cancel Registrant's federal registration for the mark MONEY POWER RESPECT ENTERTAINMENT (U.S. Reg. No. 3565960) on the grounds that Registrant was not actually using Registrant's Mark in connection with online retail store services in the field of clothing as of the date of first use alleged Statement of Use. Alternatively, the Board should partially cancel Registrant's registration on the grounds that Registrant abandoned use of Registrant's Mark for "online retail store services in the field of clothing."

Dated this 13th day of June, 2016.

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CERTIFICATE OF SERVICE

I hereby certify that on June 13, 2016, I served the foregoing **PETITIONER'S REPLY BRIEF** on:

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by causing a full, true, and correct copy thereof to be sent by first class United States mail, postage prepaid.

/s/ Cynthia L. Ney

An employee of Greenberg Traurig, LLP