TTAB

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I hereby certify that this correspondence is being deposited with the United States Postal Service, with adequate postage affixed thereon, as First Class Mail in an envelope addressed to: TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on May 5, 2004.

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

GOLDEN GATE FIREWORKS, INC.	)	
	)	
Opposer,	)	Opposition No. 91158743
	)	
vs.	)	Serial No. 78/206944
	)	
AMERICAN PROMOTIONAL EVENTS, INC.	)	Mark: IF IT'S NOT TNT, IT'S NOT FIREWORKS
	)	
Applicant.	)	

05-10-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS

I. INTRODUCTION

In its Response to Applicant's Motion to Dismiss ("Response"), Opposer fails to address the salient issues of why its Notice of Opposition filed in the above-referenced matter fails to state a claim upon which relied may be granted. While Opposer's brief raises more questions than it answers on the topic of "standing," it appears to confess the larger issue that there is no basis for the present Opposition and that the Board should enter an Order dismissing this Opposition with prejudice.

II. OPPOSER HAS CONFESSED THAT ITS NOTICE OF OPPOSITION FAILS TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED.

As with its Notice of Opposition, Opposer's Response to the present motion is far from the picture of clarity. However, Applicant makes a vague reference to "a claim of deceptiveness" under Section 2(a) of the Lanham Act. Opposer has apparently abandoned all other possible bases for its Notice of Opposition including dilution, disparagement and likelihood of confusion.

In Response to Opposer's deceptiveness reference, Section 2(a) of the Lanham Act provides that a trademark may not be registered if it "[c]onsists of or comprises . . . deceptive . . . matter." The Federal Circuit has established a three-part test to determine whether a mark is deceptive under Section 2(a):

(1) Is the term misdescriptive of the character, quality, function, composition or use of the Applicant's goods?

(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the Applicant's goods?

(3) If so, is the misdescription likely to affect the decision to purchase?

Hoover Co. v. Royal Appliance Manufacturing Co., 238 F.3d 1357, 1361 (Fed. Cir. 2001). Here, Opposer makes no allegation that Applicant's Mark is misdescriptive of *Applicant's* goods. As a result, Opposer has failed to plead facts necessary to satisfy this three-part test.

III. OPPOSER'S BRIEF RAISES MORE QUESTIONS THAN IT ANSWERS REGARDING WHETHER OPPOSER HAS STANDING TO ASSERT ANY CLAIMS AGAINST THE SUBJECT MARK.

As Opposer notes in its Response brief, an opposer can show standing by demonstrating that it has a "real interest" in such proceedings *and* by establishing a "reasonable basis" for its belief that it may be damaged by the registration of the subject mark. ***Ritchie v. Orenthal James***

Simpson, 170 F.3d 192, 195 (Fed. Cir. 1999). Opposer's brief and arguments therein, however, raise more questions than providing any answers as to whether Opposer has the requisite standing to pursue this matter.

1. Opposer has not established any "real interest in the proceedings."

As the basis for its alleged "interest" in this proceeding, Opposer originally pleaded that it "has held the exclusive right and license in the United States to use the Black Cat trademark on goods manufactured in the United States" (Notice of Opposition, par. 5) and " . . .to manufacture in the United States . . . products bearing the Black Cat trademark" (Notice of Opposition, par. 7) and "is an importer and distributor" of ZEBRA and BIG CHIEF fireworks (Notice of Opposition, pars. 8 and 9). In its Response brief, Opposer appears to backtrack from its pleaded "interest" and avers that it is only a licensee of Shiu Fung Fireworks Co., Ltd. with respect to the BLACK CAT mark and attaches excerpts of an alleged "license agreement" as proof thereof. The Response is totally silent with regard to any "real interest" related to the ZEBRA and BIG CHIEF marks, and that is as it should be. Opposer's standing claims failed for a multitude of reasons.

Opposer supports its alleged "standing" in this cause solely upon its status as a "licensee" of the pleaded BLACK CAT trademarks. Opposer claims that it has been, since August, 1989, the sole and exclusive domestic licensee of the BLACK CAT trademark. In the purported August 1989 license agreement, the parties infer that Li & Fung (Trading) Ltd. is the registered owner of U.S. Registration No. 828,730. *See* Exhibit A attached to Opposer's Response brief, first Whereas clause.

First, since there is no evidence that Shiu Fung Fireworks, Co., Ltd. signed the purported license agreement (*see* Exhibit A attached to Opposer's Response brief, page 8), there is no

evidence that it ever was in effect.[1] Second, even if the license was in effect, the attached purported "license agreement" shows that it expired, of its own terms, on July 31, 1992, as there is no evidence that the term was ever extended as provided by paragraph three (*see* Exhibit A attached to Opposer's Response Brief, 3). Third, assuming *arguendo* defects are not fatal, there is no evidence of either (a) any license agreement between Opposer's alleged licensor, Shiu Fung Fireworks Co., Ltd., and *its* alleged licensor, Li & Fung (Trading) Ltd. or (b) any assignment of the August 1998 license agreement from Li & Fung (Trading) Ltd. to the present owner of the subject mark, Li & Fung (B.V.I.) Ltd.

Most importantly, even a cursory review of the United States Patent and Trademark Office files relating to the BLACK CAT mark show that Shiu Fung Fireworks Co., Ltd. is ***not*** now nor has ever been the owner of the those marks[2] and therefore, could not possibly license any rights to Opposer regarding the same. In fact, the BLACK CAT federal registration alleged by Opposer in this cause are actually owned by Li & Fung (B.V.I.) Ltd.[3]

2. Opposer fails to allege any reasonable basis for its alleged damages.

Because Opposer has not been able to provide the Board with any support for its claims that it has a "real interest" in these proceedings, there is no need to discuss Opposer's claims that it has a "reasonable apprehension" that it may be damaged by the registration of the subject mark. *See* ***Richie***, 170 F.3d at 1095 (Opposer must show *both* a "real interest" in such proceedings *and* establishing a "reasonable basis" for belief of damage) (emphasis added).

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[1] The purported "license agreement" is unexecuted by the alleged licensor.

[2] Pending U.S. Application Serial Number: 76/578,958 filed March 3, 2004, U.S. Registration Number: 828,730, registered: May 16, 1967 (Notice of Opposition, Exhibit B); and PUERTO RICO Registration Number: 47976, registered: June 30, 2001.

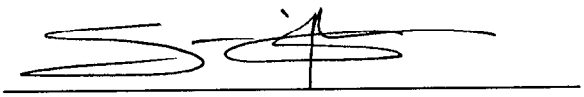
[3] Similarly, Li & Fung (V.V.I.) Ltd. is also the registered owner of the federal registrations for ZEBRA (U.S. Registration Number 1,421,838, registered December 23, 1986) and BIG CHIEF (U.S. Registration Number 1,788,853, registered: August 17, 1993), the other trademarks originally pled by Opposer as a basis for this Opposition. (Notice of Opposition, Exhibits C and D)

However, it is important to note that Applicant's mark is not a certification mark and, as such, its registration cannot serve to freeze Opposer out of the fireworks business. Clearly, the subject mark cannot serve to deceive the consuming public as to the nature of Applicant's goods. The mark contains the disclaimed term "fireworks" – the sale of which Applicant intends to use its mark.

In summary, without a real interest in these proceedings and failing to establish a reasonable belief that it would be damaged by Applicant's Mark, Opposer lacks standing to assert its claims. Accordingly, Applicant, American Promotional Events, Inc., respectfully reasserts its request for an Order of the Board dismissing Opposer's Opposition of Applicant's Mark for failure to state a claim upon which relief may be granted, or for judgment on the pleadings, or in the alternative, for a more definite statement by Opposer.

Respectfully Submitted,

BLACKWELL SANDERS PEPER MARTIN LLP



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CERTIFICATE OF SERVICE

This is to certify that the undersigned has served a true and correct copy of the foregoing upon counsel for Opposer, by United States First Class Mail, in a properly addressed envelope, with adequate postage affixed thereon, this 5th day of May, 2004, addressed as follows:

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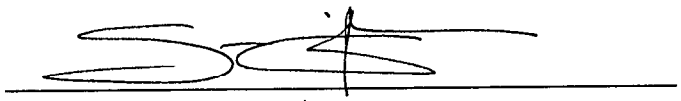

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