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

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| Proceeding | 91188462 |
| Party | Plaintiff NITE LIFE OF SANTA BARBARA |
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| Nitelife of Santa Barbara, | : | |
| | : | |
| Opposer | : | |
| | : | |
| v. | : | |
| | : | |
| Nite Life Car Club Association, | : | Opposition No. 91188462 |
| | : | |
| Applicant | : | |

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OPPOSER’S BRIEF

Opposer Nitelife of Santa Barbara, an unincorporated association, having a business address of 4963 Pebble Hill Lane, Santa Barbara, CA, (hereinafter “Opposer”) requests that the Trademark Trial and Appeal Board refuse

registration of Application Serial Number 78/864321 for the trademark  (hereinafter “Applicant Mark” or “the Trademark”) filed by Nite Life Car Club Association (hereinafter “Applicant”) on the following bases: (A) Applicant is not the exclusive owner of the Trademark; (B) Applicant’s mark is identical to Opposer’s established common law trademark and is likely to cause confusion among consumers; (C) Applicant has not used and does not use the Trademark for the goods claimed in its application; (D) Applicant did not use the Trademark on the dates as claimed in its application; and (E) the Application was fraudulent because of Applicant’s intentional material misstatements.

Opposer’s brief in support thereof follows.

PROCEDURAL HISTORY

On April 18, 2006 Applicant filed Application Serial Number 78/864321 for blazers, denim jackets, fur coats and jackets, fur hats, hat bands, hats, jackets, leather jackets, light-reflecting jackets and T-shirts (hereinafter “the Goods”). The application was based on alleged use of the mark in commerce since October 1, 1980 and was signed by attorney for Applicant, W. Douglas English, III on April 18, 2006.

The application was published for opposition on September 23, 2008 and the opposition was filed on January 21, 2009 on the grounds that Opposer owns the Trademark; Opposer has exclusive rights to use the design portion of the Trademark; Applicant’s Trademark when applied to the Goods is likely to cause confusion, mistake or deception among consumers; and, Applicant’s declaration that it has exclusive rights to the mark is knowingly false.

On May 14, 2009, Applicant filed an Answer denying Opposer’s claims and asserting its exclusive rights of ownership of the Trademark.

Opposer submitted two sets of interrogatories to Applicant during its Discovery period . Based on Applicant’s responses, Opposer filed a Motion to amend its Notice of Opposition on August 12, 2009 and said motion was granted on November 5, 2009. In the Amended Notice of Opposition, in addition to the grounds of opposition set forth in the first Notice of Opposition, additional grounds were added including, that Applicant’s declaration and claim of exclusive rights to the Trademark was knowingly false and made in bad faith.

Applicant filed its answer to the Amended Notice of Opposition on December 2, 2009, wherein Applicant admitted Opposer’s prior use of the Trademark, and yet claimed

it has exclusive rights to the mark. Applicant denied any likelihood of confusion, bad faith and harm to Opposer. In addition Applicant denied that its use of the Trademark is merely as a trade name and is merely decoratively used.

I. OPPOSER'S EVIDENCE

On December 21, 2009, Opposer submitted, via Notice of Reliance, Applicant's responses to Opposer's interrogatories and request for documents and Applicant's Response to Opposer's Amended Notice of Opposition. On December 26, 2009, Opposer submitted, via Notice of Reliance, additional documents received from Applicant in response to Opposer's interrogatories.

II. APPLICANT'S EVIDENCE

Applicant did not conduct discovery in this case. Applicant responded to some of Opposer's discovery requests.

III. STATEMENT OF FACTS

1. Applicant acknowledges Opposer's use of the mark NITE LIFE both with and without the design ("Opposer's Trademarks") that is incorporated as part of the Trademark since at least as early as 1980. (See Response to Notice of Opposition, Page 1, paragraph #1 and Page 2, paragraphs 4 and 7).

2. Applicant acknowledges Opposer's California Trademark registration and its common law rights in the Trademark and Opposer Trademarks. (See Response to Notice of Opposition, Page 2, paragraph # 5).

3. Applicant admits that the word portion of its Trademark is nearly identical to Opposer's Trademarks and that the design portion is identical to Opposer's Trademark. (See Response to Notice of Opposition, Page 2, paragraph #8).

In sum, the facts in the record establish that:

- Applicant is not the exclusive user or owner of the Trademark.
- Opposer has well established common law rights in the Trademark.
- Applicant has not and does not use the Trademark on all the goods claimed in the application.
- Applicant did not use the mark as of the date of first use claimed in the application, because Applicant entity did not exist as of 1980.
- Applicant's Application contains material misstatements of facts and is therefore fraudulent.

For the reasons elaborated upon below, it is respectfully requested that registration to Applicant be refused.

ARGUMENT

A. The Application should be refused because Applicant is not the exclusive owner of the Trademark.

Applicant stated in its responses to Opposer's Amended Notice of Opposition that both Opposer and Applicant had adopted and continuously used the mark since at least as early as 1980. (*See* Applicant's Response To Opposer's Amended Notice of Opposition, Page 2, Lines 4-10, Lines 44-45 filed by Notice of Reliance on December 22, 2009). Applicant cannot therefore legitimately claim to be the exclusive user or owner of the Trademark.

Section 1051(a) of the Trademark Act provides that:

In an application under §1 of the Trademark Act, an applicant may base its claim of ownership of a trademark or a service mark on: (1) its own exclusive use of the mark; (2) use of the mark solely by a related company whose use inures to the applicant's benefit; or (3) use of the mark both by the applicant and by a related company whose use inures to the applicant's benefit. 15 U.S.C. § 1051(a).

None of these conditions is met by the evidence in the record, nor in the claims set forth in the Application, wherein the Applicant claims exclusive use and ownership of the Trademark based on its own use of the Trademark. Moreover, since Applicant and Opposer are not "related" use of the Trademark by Opposer has not and would not inure to the benefit of applicant.

In addition, Opposer is the exclusive licensee of the owner of the copyright in the design element of the Trademark. In response to Opposer's request for information about Applicant's claim of rights to the design, no documentary evidence was proffered.

For these reasons, registration to Applicant should be refused.

B. The Application should be refused because Applicant's Trademark is likely so resembles Opposer's established common law trademark as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

Applicant stated in its responses to Opposer's Amended Notice of Opposition that both Opposer and Applicant use the Trademark for the same goods and services. (*See* Applicant's Response To Opposer's Amended Notice of Opposition, Page 2, Lines 5-10, filed by Notice of Reliance on December 22, 2009). There can be no doubt that use of identical marks for the same or related goods and services is likely to cause confusion among consumers as to the source from which those goods and services emanate. Section 1052(d) of the Trademark Act provides that:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--
(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. §1052(d).

Applicant admitted that Opposer has established rights in its trademark which is identical to Applicant's Trademark. (*See* Applicant's Response To Opposer's Amended Notice of Opposition, Page 2, Lines 44-45, filed by Notice of Reliance on December 22, 2009). Applicant admits that Opposer has used its mark in conjunction with same goods and services as Applicant. (*See* Applicant's Response To Opposer's Amended Notice of

Opposition, Page 2, Lines 4-9, filed by Notice of Reliance on December 22, 2009).
Incredibly Applicant denies that confusion is likely to result from use of its Trademark.

The issue of likelihood of confusion is determined by analyzing the similarity or dissimilarity of the marks and the relatedness of the goods or services. (*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, C.C.P.A. 1973). In this case, a subjective analysis is not required: the marks are identical and the goods and services are identical. Consumers, when confronted by goods bearing Applicant's Trademark, are likely to believe erroneously that the goods emanate from Opposer given its long term use of its common law trademark on clothing and in advertising in conjunction with its charitable services.



Given the likelihood of confusion, registration to Applicant should be refused.

C. The Application should be refused because Applicant has not used and does not use the Trademark for all the goods claimed in its application.

In an application based on use in commerce under §1(a) of the Trademark Act, the applicant must specify the goods on which the mark is in use in commerce. 15 U.S.C. §1051(a)(2) provides:

The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

Applicant filed its application under §1(a) declaring that the mark was in use in commerce with Goods, namely blazers, denim jackets, fur coats and jackets, fur hats, hat bands, jackets, leather jackets, light-reflecting jackets and T-shirts.

During Discovery Opposer sought information and documentation showing Applicant's use of the Trademark on all the Goods, namely blazers, denim jackets, fur coats and jackets, fur hats, hat bands, jackets, leather jackets, light-reflecting jackets and T-shirts. Opposer responded "1980 as supported by Applicant's Responsive Discovery Disclosures submitted 13 May 09" (*See Applicant's First Responses to Opposer's First Set of Interrogatories*, Page 2, Lines 8 and 9, filed by Notice of Reliance on December 26, 2009). Opposer in its Second Set of Interrogatories to Applicant requested that Applicant identify with specificity the items submitted as part of its Responsive Discovery Disclosures that supported its claim of use of the Trademark with all of the named Goods. Applicant responded "All items of Applicant's Goods and Services provided in Applicant's Responsive Discovery Disclosures with dates thereon inherently demonstrate a date of first use and of first use in commerce of Applicant's TradeMark and/or concomitant ServiceMark" (*See Applicant's Second Set of Responses to Interrogatories*, Page 2, Lines 12-14, filed by Notice of Reliance on December 26, 2009). As can be seen from the documents submitted by Applicant which were filed by Notices of Reliance on December 21, 2009 and December 26, 2009, no such evidence was tendered. Applicant was nonresponsive and apparently unwilling and unable to provide evidence that it is using the Trademark as claimed in its application.

Applicant does not use the Trademark in conjunction with all the Goods claimed in the trademark application and for this reason registration to Applicant should be refused.

D. The Application should be refused because Applicant did not use the Trademark on the dates of first use claimed in its application.

Applicant in its Trademark Application claims use of the Trademark since 1980 in conjunction with blazers, denim jackets, fur coats and jackets, fur hats, hat bands, hats, jackets, leather jackets, light-reflecting jackets and t-shirts. Opposer in its first set of Interrogatories to Applicant requested information and evidence supporting the claimed dates of first use of the Trademark. Applicant replied, “1980 as supported by Applicant’s Responsive Discovery Disclosures submitted 13 May 09” (*See Applicant’s First Response to Opposer’s First Set of Interrogatories*, Page 2, lines 8-9, filed by Notice of Reliance on December 26, 2009). Applicant’s discovery disclosures comprised numerous pages of irrelevant documents, namely photocopies of articles from local newspapers featuring stories about Opposer and its charitable activities in Santa Barbara dated 1982, 1983 and 2003 (*See Second Set of Documents*, pages 10, 22 & 23, filed by Notice of Reliance on December 26, 2009); photocopies of flyers advertising Opposer’s events in Santa Barbara that took place in 1980 and were conducted under the name NITELIFE CAR CLUB (*See Second Set of Documents*, Pages 26 and 27, filed by Notice of Reliance on December 26, 2009); flyers advertising Opposer’s Santa Barbara events dated 1983 and 2003 (*See Second Set of Documents*, pages 18, 20, 21, 35 and 36, filed by Notice of Reliance on December 26, 2009); a photocopy of an invoice received by Opposer from a monogramming company dated 1982 (*See Second Set of Documents*, Page 6, filed by Notice of Reliance on December 26, 2009); documents relating to Applicant’s business formation dated 2004 (*See Second Set of Documents*, Pages 2, 3 & 7, filed by Notice of Reliance on December 26, 2009); a undated and unattributed photograph of a car with a window attachment showing the Trademark (*See Second Set of Documents*, Page 9, filed by Notice of Reliance on December 26, 2009); flyers and

advertisements dated 2004 to 2009 for events sponsored by Applicant showing the mark NITELIFE VENTURA COUNTY and Design (*See* Second Set of Documents, Pages 13-16, 28-34 & 37, filed by Notice of Reliance on December 26, 2009). The closest example of use of the Trademark on clothing of any kind is an undated, unattributed photograph of a man wearing a shirt with the Trademark ornamentally displayed on his shirt back (*See* Second Set of Documents, Page 8, filed by Notice of Reliance on December 26, 2009).

Moreover, Applicant could not have used the mark as early as 1980 because Applicant as an entity did not exist at that time. While Applicant admitted that Opposer was formed in 1980 (*See* Response to Notice of Opposition, Page 1, line 21), Applicant's documentary evidence about the date of its own formation shows that it was formed in 2004 (*See* Second Set of Documents, Pages 2, 3 & 7, filed by Notice of Reliance on December 26, 2009). This supports the conclusion that it did not exist in 1980 and therefore could not have used the mark in 1980.

Applicant failed to provide evidence showing that it used the Trademark on any or all of the goods in 1980 or any time since and for this reason registration to Applicant should be refused.

E. The Applicant should be refused because the Application was fraudulent.

Section 1051 (a)(3)(D) of Trademark Act provides that a US federal trademark application must be supported by a statement verified by the applicant. Applicant submitted a signed declaration as required stating:

“The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section

1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”

Applicant submitted its signed declaration claiming (1) exclusive rights when Applicant knew that Opposer also had rights to the mark; and (2) that the mark was in use with goods such as fur coats and jackets and fur hats. As stated above, Applicant was unable to offer any proof, through documents or testimony, of such use in response to Opposer’s discovery requests.

In re Bose Corp., 580 F.3d 1240, 91 USPQ 2D 1938 (Fed. Cir. 2009) clarified the standard for proving a case of fraud before the United States Patent and Trademark Office. In *Bose* the Board cited *Kemin Indus., Inc., v. Watkins Prods., Inc.*, 192 USPQ 327, 329 (T.T.A.B. 1976) for the proposition that a ‘fraudulent’ representation involves an intent to deceive, while a ‘false’ representation may be the result of inadvertence, negligence or inadvertence. In *Bose* the court said that to constitute fraud, deception must be willful, meaning that the applicant or registrant knowingly makes a false material representation with the intent to deceive the PTO.

Applying the standard in *Bose* to this case, fraud is clearly apparent in the blatantly false material representations made by Applicant in its Application. Applicant by its own admission knew that Opposer had valid rights to the Trademark. Its claim of

exclusive rights is therefore false. Applicant also willfully mislead the PTO by asserting its use of the Trademark began in 1980, when in fact Applicant did not exist at that time, and by asserting that it used the Trademark for all the goods listed in the application when no evidence of such use exists. As stated above, Opposer asked for evidence of use of the Trademark with all the Goods, but such evidence was not provided. These misstatements are material since they establish the strength and extent of trademark rights resulting from the registration of the Trademark.

Applicant submitted material false statements and for this reason registration to Applicant should be refused.

CONCLUSION

The evidence in this case establishes conclusively that Applicant does not have exclusive rights to the Trademark, that the Trademark is confusingly similar to Opposer's common law trademark and that Applicant knowingly submitted an application with material misstatements of facts.

Since 1980 Opposer has engaged in numerous and regular community and charitable events in Santa Barbara and Ventura counties in California to raise money for charity. Opposer has used its trademark, including the identical design used in Applicant's mark, to advertise its club services and charitable events on posters and other advertising and on clothing. Although Applicant succeeded in registering the word mark NITE LIFE at a time when Opposer did not have adequate funds to defend its trademark rights, that insufficiency should have no bearing on the present case. The Trademark in this case involves a unique design used by Opposer since 1980, a design to which it owns exclusive rights. Applicant's claim of exclusive rights to use the

Trademark interferes with Opposer's conduct of its charitable activities, including use of its trademark on items including clothing to promote its charitable services.

Applicant's material misstatements of fact in its application (that it is the exclusive owner, etc) show that its members are trying to foreclose Opposer from using its mark on clothing and for charitable activities. If that is not the case, then an application for concurrent use should have been filed.

WHEREFORE, in view of the foregoing, registration to Applicant should be refused.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S BRIEF was served by first class mail; postage prepaid this ____ day of June 2010 upon the following:

W. Douglas English, III
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674 County Square Dr., Ste 101
Ventura, CA 93003

Victoria Carver, Esq.

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WHEREFORE, in view of the foregoing, registration to Applicant should be refused.

Respectfully submitted,

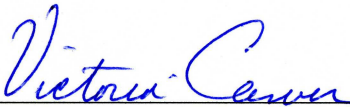


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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S BRIEF was served by first class mail; postage prepaid this 10 day of June 2010 upon the following:

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Victoria Carver, Esq.