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

Proceeding	91212921
Party	Plaintiff The Co-Executors of the Michael J. Jackson Estate
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____	)	
THE CO-EXECUTORS	)	
OF THE MICHAEL J. JACKSON	)	
ESTATE,	)	
	)	
<b>Opposer,</b>	)	
	)	
v.	)	<b>Opposition No. 91212921</b>
	)	
GOURMETGIFTBASKETS.COM,	)	
INC.,	)	
	)	
<b>Applicant.</b>	)	
_____	)	

**OPPOSER’S REPLY IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY  
JUDGMENT AND RESPONSE IN OPPOSITION TO  
APPLICANT’S CROSS MOTION FOR SUMMARY JUDGMENT**

**I. Introduction**

The Board resolves trademark registration disputes based on objective facts and black-letter law, not hyperbole and hypotheticals. Trademark Act § 2(a) and the opposition process affect only the registration of a mark. The Board cannot create “monopolies” over marks or preclude *use* of a mark. The Board’s sole duty in Trademark Act § 2(a) cases is to prevent the registration of marks that falsely suggest a connection between the applicant and a third party. The Board will fulfill its duty here by granting the Estate’s opposition and refusing registration of the applied-for mark (the “Mark”).

**II. Reply to GourmetGiftBaskets, Inc.’s Arguments**

**1. The likelihood-of-confusion analysis does not apply to the Estate’s false-association cause of action.**  
*(Replies to GGB Response Section I)*

On page 4 of the Objection to Opposer’s Motion for Summary Judgment and Cross-Motion for Summary Judgment (the “GGB Response”), GourmetGiftBaskets.com, Inc. (“GGB”)

quotes *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ 505, 507 (Fed. Cir. 1983): “In order to prevail under the Lanham Act § 2(a) an opposer must show a § 2(d) situation plus an intent, implied or actual, on the part of applicant to trade on the goodwill possessed by opposer in the mark.” GGB argues, based on this quote, that because the Estate cannot show a likelihood of confusion, the Estate’s Lanham Act § 2(a) opposition is meritless and instead the Board should grant summary judgment to GGB.

GGB’s quote does not represent the Federal Circuit’s holding in *Notre Dame*. Rather, the Federal Circuit is quoting the Board’s decision, which the Federal Circuit concludes is a misstatement of Lanham Act § 2(a). *Id.* (“In dismissing this claim, the **board** stated . . .”) (emphasis added). The Federal Circuit held that a showing of § 2(d) likelihood of confusion is **not** a prerequisite to a finding of § 2(a) false suggestion of a connection:

With respect to the University’s argument that a different standard must be applied under § 2(a), the legislative history does indicate that § 2(a) was intended to preclude registration of a mark which conflicted with another’s rights, **even though not founded on the familiar test of likelihood of confusion.**

\* \* \*

Although not articulated as such, it appears that the drafters sought by § 2(a) to embrace concepts of the right of privacy, an area of the law then in an embryonic state. Our review of case law discloses that the elements of a claim of invasion of one’s privacy may have emerged as distinctly different from those of trademark or trade name infringement. **There may be no likelihood of such confusion as to source of goods even under a theory of “sponsorship” or “endorsement,” and, nevertheless, one’s right of privacy, or the related right of publicity, may be violated.**

It is a right of this nature, a right to control the use of one’s identity, which the University also asserts under § 2(a).

*Id.* at 508-509 (internal citations omitted) (emphasis added); *See also The Board of Trustees of The University of Alabama v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013) (“Evolving out of

the rights of privacy and publicity, the false suggestion of a connection under § 2(a) of the Trademark Act was intended to preclude registration of a mark which conflicts with another's rights, even though not founded on the familiar test of likelihood of confusion").

Because the § 2(a) false-association analysis does not, in any way, incorporate a § 2(d) likelihood-of-confusion analysis, it is not relevant or material to the Estate's motion for summary judgment whether there is a likelihood of confusion. Therefore, GGB's argument regarding likelihood of confusion should be dismissed in its entirety.

**2. The alleged past, present, and future third-party uses of "King of Pop" are not probative.**  
*(Replies to GGB Response Section II)*

GGB argues that honorific titles are common in the entertainment industry. Under Lanham Act § 2(a), there is no legal significance to the fact that King of Pop is an "honorific title" as opposed to any other word, term, name, symbol, or device. In addition, there is no legal significance to the fact that many different entertainers use honorific titles. A title, honorific or otherwise, can (1) identify someone and (2) point uniquely and unmistakably to a person. So Lanham Act § 2(a) governs the registration of honorific titles.

Notably, GGB does not dispute the voluminous affirmative evidence that Michael Jackson is currently recognized by fans and the media as the King of Pop. Rather, GGB's argument focuses primarily on the hypothetical possibility that someone else could be the King of Pop some time in the future. *See* GGB Response at pg. 5-6 ("[W]hat is apparent is that the title is not eternally and exclusively toed to Michael Jackson, but rather, specifically contemplates other Kings of Pop"). GGB also introduces evidence that King of Pop has sporadically been used in a few articles that are not explicitly about Michael Jackson.

There is no legal significance to the fact that King of Pop *could*, over time, become associated with another entertainer. In *Hornby v. TJJX Companies, Inc.*, the Board recognized

that the material facts surrounding a Trademark Act § 2(a) claim can change over time and that the Board must only focus on the meaning of the term at the time of application or registration:

As previously discussed, the fame or reputation of petitioner must be determined as of the time respondent's registration for TWIGGY issued. Thus, although petitioner may have been a major celebrity in the late 1960s, the burden on petitioner is to show that she had sufficient fame and/or reputation as of July 4, 2000.

87 USPQ2d 1411, 1424 (TTAB 2008).

It is not relevant whether King of Pop *could* be associated with another person. King of Pop *is not* associated, by any meaningful segment of consumers, with any person or product other than Michael Jackson. Ignoring volumes of evidence of what King of Pop actually means to pontificate on what it *could* (but does not currently) mean completely undermines Trademark Act § 2(a), which addresses consumer expectations at the time of application or registration. Illustrative of this point, it is *possible* that a future celebrity could be named Frank Sinatra. That did not prevent the Board from refusing registration of FRANKS ANATRA in *Frank Sinatra Enterprises, LLC v. Bill Loizon*, slip op. 91198282 (Sept. 12, 2012) (not precedential).

Moreover, even if one or two article authors referred to other entertainers as the King of Pop this fact would not be material to the Estate's false-association claim. *See, Hornby*, 87 USPQ2d at 1426 ("The requirement that a respondent's mark point 'uniquely' to petitioner does not mean that TWIGGY must be a unique term"); *In re Debbie Sauer*, 27 USPQ2d 1073, 1074 (TTAB 1993) ("While these other people named 'Bo' have been in the public eye to varying degrees, the record does not show that any of them is famous to nearly the same degree as Bo Jackson is, or that any of them is famous as both a baseball and football star like Bo Jackson is. Further, there is no evidentiary support for the proposition that any of the other people named by applicant has ever commercially exploited his or her nickname in connection with the sale of

products as Bo Jackson has”). Justin Timberlake and Justin Bieber are famous, but GGB has not introduced any evidence showing that the general public, or any segment of the general public other than one or two authors, recognizes either as the King of Pop or that either has exploited the title King of Pop. Therefore, the Board should ignore these red herrings.

GGB relies heavily on an article titled “Michael Jackson wasn’t the first King of Pop, nor the last.” GGB Response at pg. 5. GGB’s reliance on this article is misplaced. The article does not discuss the public’s understanding of the *term* King of Pop. Rather, the article discusses whether, if the king of pop is defined as “the most popular artist of the time [and] the most influential and innovative,” whether, Michael Jackson was factually the King of Pop. The article implicitly recognizes that (1) the term King of Pop refers, rightfully or wrongfully, to Michael Jackson, and (2) Michael Jackson commercially exploited this nickname. Therefore, the article supports the conclusion that King of Pop uniquely and unmistakably refers to Michael Jackson.

For the same reason, the other articles that GGB refers to in its response are not probative of whether King of Pop falsely suggests a connection with Michael Jackson. For example, the article titled “The Top Seven Contenders for the New King of Pop” (GGB Response at pg. 5) does not discuss whether the *term* King of Pop will be used to identify another entertainer; rather, the article discusses a list of entertainers that could become iconic pop music performers like Michael Jackson. Likewise, the article titled “Who’s King of Pop Now?” (GGB Response at pg. 5) does not discuss the general public’s understanding of the *term* King of Pop.

It is not relevant whether Michael Jackson was, in fact, the King of Pop. There is no literal *king* of popular music. For the purposes of Trademark Act § 2(a), the Board must only analyze the public’s understanding of the term King of Pop, not the academic accuracy of the term. GGB’s apparent attack on whether Michael Jackson is *literally* the King of Pop rather than

*figuratively* the King of Pop is irrelevant to the Board's consideration of the Estate's motion.

3. **The literal element dominates the commercial impression of the Mark.**  
*(Replies to GGB Response Sections III and IV)*

In its response, GGB states the long-standing principle that the Board must review the mark as a whole, then immediately proceeds to eviscerate this rule in its analysis by dissecting the Mark into its components. GGB Response at pg. 6-7.

GGB argues that the Mark “consists of a highly stylized and fanciful design consisting of particular colors (yellow, brown, green, gold, and red), several popped popcorn kernels, as well as a ‘crown’ over the letter ‘O’ in the capitalized ‘POP.’” GGB Response at pg. 2. GGB also argues that “the design elements have great emphasis on the word ‘POP’—by way of larger font size, colors, and placement of other design elements – including the cartoonish crown (in reference to the word ‘king’) and several large popped popcorn kernels.” GGB Response at pg. 6-7.

The stylization of the literal element and the addition of design elements do not obscure the dominant impression of the literal element KINGOFPOP.COM. GGB's claim that its mark is *highly* stylized is farcical. The literal element, KINGOFPOP.COM, appears in plain block lettering with red outlining. As a result, the minimal stylization does not affect the consumer impression of the mark. In addition, GGB's claim that POP appears in a larger font size is misleading. While slightly larger, the word “POP” hardly appears in a meaningfully-different size than the remaining words. Moreover, GGB's claim that the mark contains “several large popped popcorn kernels” is also misleading. The popcorn kernels may be visible, but they are hardly *large* vis-a-vis the literal element of the Mark. Finally, it is unclear why it would matter that the crown is “cartoonish,” and what the basis of this claim is.

If there is a dominant element within a mark containing multiple elements, it is dominant

because it is “most likely ‘to be impressed upon the mind of a purchaser and remembered.’” *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013), quoting, *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). As a result, “[i]n the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products.” *Id.* at 1431.

GGB applied to register the Mark, in part, in connection with online retail stores. Online retail stores are accessed by entering a unique and specific URL into a web browser, not by selecting a product off of a grocery store shelf. Therefore, the capitalization of “POP,” the slight enlargement of “POP,” the crown design, and the popcorn kernel designs are completely irrelevant to a consumer’s general recollection of how to access GGB’s services. Consumers cannot recall or request GGB’s services using “POP” alone. Nor would consumers recall GGB’s services to others by identifying GGB’s brand as “the brand with popcorn kernels in the logo” or “the brand with the crown logo.” The complete literal element, KINGOFPOP.COM, is necessary to recall and request GGB’s services, and, as a result, KINGOFPOP.COM is the dominant element of the Mark. KINGOFPOP.COM is almost identical to King of Pop.

**4. GGB’s intent in adopting the Mark.**  
***(Replies to GGB Response Section IV)***

For the purposes of the Estate’s motion for summary judgment, the Board must accept, as true, GGB’s claim that it filed its application *without* the intent to falsely suggest a connection with Michael Jackson. *See* GGB Response at pg. 3 (“There was no intent to suggest any affiliation with Michael Jackson”) and 8 (“This is a far cry from a company trying to capitalize on some indirect suggestion of an affiliation with Michael Jackson based upon some perceived nickname”). But even if GGB did not file its application in bad faith, the Board may still find that GGB’s application falsely suggests a connection with Michael Jackson. *See In re Kent*



*Pedersen*, 109 USPQ2d 1185, 1202 (TTAB 2013) (stating that the test for false suggestion does not require an inquiry into the intent of the applicant). Therefore, GGB's intent is largely irrelevant to the Board's consideration of the Estate's motion for summary judgment.

For the purposes of GGB's cross motion for summary judgment, the Board must infer that GGB filed its application *with* the intent to falsely suggest a connection with Michael Jackson. As a result, the Board cannot grant GGB's cross motion for summary judgment. *See id.* ("Because any evidence of applicant's intent to identify with the Lakota people is highly persuasive that the public will make the intended false connection, *Notre Dame*, 217 USPQ at 509, we consider the evidence relating to applicant's intent").

It is rare that an opposer can find a "smoking gun" or direct evidence of bad-faith intent. Therefore, the Board must review the available evidence and make reasonable inferences. The undisputed evidence shows that the website GGB uses to offer its services – kingofpop.com – was previously used as a Michael Jackson fan site and GGB was aware of this fact. The undisputed evidence also shows that GGB was aware that King of Pop was a nickname associated with Michael Jackson at the time GGB adopted the Mark.

It is also highly relevant to the Board's analysis of GGB's intent that GGB's KINGOFPOP.COM brand does not resemble any of GGB's other affiliated brands – gourmetgifts.com, gourmetcookies.com, strawberries.com, and cheesecake.com, none of which contain a title or a nickname. *See* GGB Response pg. 2; Abood Affidavit at ¶ 4, 5. GGB did not add "King of Pop" to a portfolio that previously included king of cheesecake, king of strawberries, and other "king of" marks. Rather, GGB appears to have adopted the "King of Pop" mark for some other reason than its consistency with GGB's already-established brands. Likewise, GGB does not use a "nickname" – pop – in any of its other brands; it uses the full

words cookies, strawberries, and cheesecake. The Board can reasonably infer, therefore, that GGB adopted “King of Pop” because of its already-existing meaning as a well-known nickname for arguably the most famous musician of all time.

**5. GGB’s recitation of services.**  
***(Replies to GGB Response Section IV)***

GGB relies heavily on its argument that Michael Jackson is not directly connected to popcorn. *See* GGB Response at pg. 1-2, 3, 6, 7, and 8. GGB’s argument fails because it rests on the faulty position that a mark cannot simultaneously refer to popcorn and Michael Jackson.

It is undisputed that Michael Jackson’s King of Pop persona was used to promote many goods and services, including soft drinks. Michael Jackson could also easily be connected to King of Pop-branded popcorn. Moreover, completely contrary to GGB’s argument, it is far more likely that a consumer would associate King of Pop-branded popcorn with Michael Jackson than SmartPop, Pop Secret, Boom Chicka Pop. Therefore, GGB’s argument is meritless.

Furthermore, it is not necessary that Michael Jackson or the Estate have used King of Pop specifically with popcorn or any other snack food to preclude GGB’s registration of Michael Jackson’s persona for popcorn. *See Pedersen*, 109 USPQ2d at 1202 (“We hasten to note that this fourth factor does not require proof of a reputation that is closely related to an applicant’s goods”); *University of Alabama*, 107 USPQ2d at 2025 (“An opposer may prevail on the false suggestion of a connection ground when its right to control the use of its identity is violated, even if the name claimed to be appropriated was never commercially exploited by the opposer as a trademark or in a manner analogous to trademark use”).

Just as this flimsy argument failed for the applicant in *Frank Sinatra*, GGB’s flimsy argument that Michael Jackson’s fame and reputation do not extend to popcorn must fail. Slip op. 91198282 at pg. 13-14 (not precedential). The Estate is entitled to protection against the

hijacking of Michael Jackson's persona regardless of whether it chooses to use King of Pop on snack food or popcorn.

### III. Conclusion

Michael Jackson is one of the most famous entertainers of all time, and consumers worldwide know him as the King of Pop. GGB's use and registration of King of Pop for popcorn retail stores violates Michael Jackson's right to control the use of his identity in connection with goods and services.

As artfully stated in *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, "[f]urther litigation in this case not only would put the parties to unnecessary expense but also, equally importantly, would be wasteful of judicial resources." 222 USPQ 741, 744 (Fed. Cir. 1984). In the interest of judicial economy, based on the undisputed evidence in this proceeding and black-letter trademark law, the Board should grant summary judgment in the Estate's favor on the issue of false suggestion of a connection and refuse registration of GGB's application.

Date: September 17, 2014

Respectfully submitted,  
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**CERTIFICATE OF ELECTRONIC TRANSMISSION**

Date: September 17, 2014


I certify that this Opposer's Reply in Support of Opposer's Motion for Summary Judgment and Response in Opposition to Applicant's Cross Motion for Summary Judgment is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, on the date indicated above, through the ESTTA electronic filing system at the web site <http://estta.uspto.gov/>.

By:   
\_\_\_\_\_  
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**CERTIFICATE OF SERVICE**

I certify that on September 17, 2014, I served the foregoing Opposer's Reply in Support of Opposer's Motion for Summary Judgment and Response in Opposition to Applicant's Cross Motion for Summary Judgment by electronic mail only (by agreement) to:

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