

This Opinion is Not a
Precedent of the TTAB

Hearing: February 21, 2018

Mailed: May 15, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Opposition No. 91219067 (parent)

New Jersey Turnpike Authority
v.
Jersey Boardwalk Franchising Co., Inc.

Cancellation No. 92059657

New Jersey Turnpike Authority
v.
Boardwalk Pizza, Inc.

Ronald L. Israel and Peter E. Nussbaum of Chiesa Shahinian & Giantomasi PC
for New Jersey Turnpike Authority

Justin M. Klein of Marks & Klein, LLP
for Jersey Boardwalk Franchising Co., Inc. and Boardwalk Pizza, Inc.

Before Wellington, Lykos, and Lynch
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

As explained more fully below, this consolidated proceeding involves an opposition and a cancellation action brought by the New Jersey Turnpike Authority (“Plaintiff”) against related companies Jersey Boardwalk Franchising Co., Inc. (“JB”), the applicant, and Boardwalk Pizza, Inc. (“BP”), the registrant, (collectively, “Defendants”). Defendant BP has also asserted a counterclaim for cancellation of a registration owned by Plaintiff.¹ These matters have been briefed by the parties and an oral hearing was held on February 21, 2018.

Defendants own and operate pizza restaurants in Florida. Plaintiff is an entity established by New Jersey statute primarily to maintain and operate the Garden State Parkway and the New Jersey Turnpike.²

A. The Cancellation Proceeding

In a petition filed July 22, 2014, and subsequently amended twice, Plaintiff seeks



to cancel Defendant BP’s registration of the mark _____, which includes

¹ Upon consolidation, the opposition became the “parent” case, in which all filings reside except for the amended petition to cancel and the answer and counterclaim thereto. Unless otherwise indicated, citations in this decision to TTABVUE refer to the record in the parent Opposition No. 91219067.

² 22 TTABVUE 16, 586-94 (O’Hern Deposition and Exhibit JBF-1, N.J. Stat. §§ 27:23-5, -5.8). Its predecessor was the New Jersey Highway Authority.

a disclaimer of “PIZZA SUBS CHEESESTEAKS PASTA”,³ for “Restaurants” in International Class 43. Plaintiff asserts grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1152(d), and abandonment under Sections 14(3) and 45 of the Trademark Act, 15 U.S.C. §§ 1064(3), 1127.⁴

Plaintiff pleaded:



- Plaintiff’s registration of the mark  , which is under Section 2(f)-in-part as to “GARDEN STATE PARKWAY,” for “highway management and maintenance services” in International Class 37 and “travel information services” in International Class 39;⁵

³ Registration No. 4056183 issued on the Principal Register on November 15, 2011, from an application filed April 12, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting first use and first use in commerce at least as early as April 1, 2011. The colors green and yellow are claimed as features of the mark, and the description of the mark states: “The mark consists of a green-colored annular ring surrounded by a yellow-colored border and surrounding a pair of yellow-colored semicircles separated by a green-colored strip. A green-colored area in the form of the state of New Jersey overlying and extending completely across the semicircles and strip. The yellow-colored text ‘BOARDWALK’ overlying an upper portion of the annular ring. The yellow-colored text ‘PIZZA’ overlying the green-colored strip. The yellow-colored text ‘SUBS · CHEESESTEAKS · PASTA’ overlying a lower portion of the annular ring.”

⁴ Cancellation No. 92059657, 34 TTABVUE (Second Amended Petition to Cancel).

⁵ Registration No. 2452349 issued on the Principal Register on May 22, 2001, from an application filed October 22, 1998, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1071(a), asserting first use and first use in commerce at least as early as 1956. The registration has been renewed, and a Section 15 declaration of incontestability has been acknowledged.



- Common law rights in the mark  as to the same services in its registration,⁶ and as to services related to its operation of “service areas along the Garden State Parkway that include restaurants, many of which feature pizza”.⁷
- Pending trademark applications, which matured into registrations during the pendency of this proceeding, for the same mark as in the registration above, with no Section 2(f) claims but with disclaimers of “GARDEN STATE,” for “coffee mugs” in International Class 21 and “T-shirts” in International Class 25.⁸

In its answer, Defendant BP denied the salient allegations of the petition and asserted various affirmative defenses.⁹ However, Defendants did not pursue the

⁶ Cancellation No. 92059657, 34 TTABVUE 3 (Second Amended Petition to Cancel), ¶ 1.

⁷ Cancellation No. 92059657, 34 TTABVUE 6 (Second Amended Petition to Cancel), ¶ 4. In both the cancellation and the opposition, generalized allegations of common law rights in connection with “a variety of goods and services,” without further specificity, are insufficient. *Id.* at ¶ 2; 1 TTABVUE 5 (Notice of Opposition), ¶ 2.

⁸ Cancellation No. 92059657, 34 TTABVUE 4 (Second Amended Petition to Cancel), ¶ 4. Plaintiff later introduced into evidence the registrations that issued during the course of this proceeding. *See* TBMP § 704.03(b)(1)(A) (June 2017). Registration No. 4964765 issued on the Principal Register on May 24, 2016 based on Section 1(a) of the Trademark Act, 15 U.S.C. § 1071(a), asserting first use and first use in commerce at least as early as March 4, 2016. Registration No. 4964764 issued on the Principal Register on May 24, 2016 based on Section 1(a) of the Trademark Act, 15 U.S.C. § 1071(a), asserting first use and first use in commerce at least as early as February 22, 2016. Both registrations resulted from intent-to-use applications under Section 1(b), 15 U.S.C. § 1071(b), filed on July 26, 2011.

⁹ 35 TTABVUE 2-10 (Answer to Second Amended Petition for Cancellation).

defenses and did not argue them in their briefing.¹⁰ Accordingly, we deem the asserted defenses of laches, equitable estoppel, unclean hands, acquiescence, “lack of damage” and “forum shopping”¹¹ waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014); *Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).¹²

Defendant BP also counterclaimed for cancellation of Plaintiff’s Registration No. 2452349 on the ground that the mark is an unregistrable traffic control device design, and for what Defendant BP characterizes as declaratory relief that Plaintiff has exceeded its authority under its enabling legislation and therefore “has no legal basis to seek cancellation of” Defendant’s registration.¹³

B. The Opposition Proceeding

In a Notice of Opposition filed October 28, 2014, Plaintiff opposes Defendant JB’s



pending application for the mark _____, which includes a disclaimer of

¹⁰ To the extent Defendants alleged naked licensing by Plaintiff, they pursued the allegation only in the context of alleging the resulting weakness of Plaintiff’s mark, as discussed *infra* in the likelihood of confusion section.

¹¹ The latter two appear to be mere amplifications of the denial of Plaintiff’s salient allegations.

¹² 5 TTABVUE 8-10 (Answer to Notice of Opposition).

¹³ Cancellation No. 92059657, 35 TTABVUE 10-21 (Answer to Second Amended Petition for Cancellation and Amended Counterclaim).

“PIZZA SUBS CHEESESTEAKS PASTA CO.,”¹⁴ for “Restaurant services” in International Class 43 based on likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1152(d).

Plaintiff has pleaded:



- The registrations of the mark  set forth above for “highway management and maintenance services” and “travel information services”, and for “mugs” and “T-shirts”;¹⁵



- Common law rights in the mark  for highway management and maintenance services and travel information services¹⁶ and services

¹⁴ Application Serial No. 86268185, filed on April 30, 2014, based on Section 1(a) of the Trademark Act, 15 U.S.C. § 1071(a), asserting first use and first use in commerce at least as early as March 4, 2013. The colors green and yellow are claimed as features of the mark, and the description of the mark states: “The mark consists of a green-colored annular ring surrounded by a yellow-colored border and surrounding a pair of yellow-colored semicircles separated by a green-colored strip. A green-colored area in the form of the state of New Jersey overlying and extending completely across the semicircles and strip. The yellow-colored text ‘JERSEY BOARDWALK’ overlying an upper portion of the annular ring. The yellow-colored text ‘PIZZA’ overlying the green-colored strip. The yellow-colored text ‘SUBS · CHEESESTEAKS · PASTA CO.’ overlying a lower portion of the annular ring.”

¹⁵ 1 TTABVUE 5 (Notice of Opposition), ¶¶ 3, 4. See TBMP § 704.03(b)(1)(A) (June 2017).

¹⁶ 1 TTABVUE 4 (Notice of Opposition), ¶ 1.

related to its operation of “service areas along the Garden State Parkway that include restaurants, many of which feature pizza”.¹⁷

In its answer, Defendant JB denied the salient allegations of the complaint and asserted the same affirmative defenses as in the cancellation.¹⁸ As indicated above, Defendants did not pursue the defenses or argue them in their briefing. Accordingly, we deem them waived in the opposition also.

II. Evidentiary Record

The record consists of:

- The pleadings.
- The files of challenged Registration Nos. 4056183 and 2452349.¹⁹
- Plaintiff’s pleaded Registration Nos. 2452349, 4964764, and 4964765, properly made of record.²⁰
- The file of opposed Application Serial No. 86268185.²¹
- The testimony deposition of John F. O’Hern, Plaintiff’s Deputy Executive Director and Chief Operating Officer, including numerous exhibits.²²
- Certain of Defendants’ discovery responses.²³

¹⁷ 1 TTABVUE 5 (Notice of Opposition), ¶ 4.

¹⁸ 5 TTABVUE 8-10 (Answer to Notice of Opposition).

¹⁹ *See* 37 C.F.R. § 2.122(b).

²⁰ 21 TTABVUE 9-22. *See* 37 C.F.R. § 2.122(d)(1).

²¹ *See* 37 C.F.R. § 2.122(b).

²² 22 TTABVUE and 23 TTABVUE (confidential version).

²³ 21 TTABVUE 23-100; 35 TTABVUE 239-42.

- Excerpts from the discovery deposition of Paul DiMatteo, an officer of Defendants, including numerous exhibits.²⁴
- Excerpts from the discovery deposition of Lauren Parratt, an officer of Defendants.²⁵
- The declaration of Ronald L. Israel, Plaintiff's counsel, with numerous exhibits that include official records from a civil action between the parties in the U.S. District Court for the District of New Jersey.²⁶
- Excerpts from Plaintiff's 2010-2013 Annual Reports.²⁷
- Excerpts from Plaintiff's 2014 and 2015 Comprehensive Annual Financial Reports.²⁸
- Certain of Plaintiff's discovery responses.²⁹
- Records from a civil action between the parties in the U.S. District Court for the District of New Jersey.³⁰

In a prior order on Plaintiff's Motion to Strike,³¹ the Board: (1) struck as duplicative Defendants' Exhibits 7 and 8 of their Notice of Reliance; (2) allowed Defendants time to file an amended notice of reliance to cure procedural defects relating to Exhibits 2-6 and 9-10; and (3) deferred ruling on the substantive objections to Defendants' Exhibits 9 and 10, proffered excerpts from the DiMatteo and Parratt deposition transcripts, because the nature of the objections would require a substantive

²⁴ 21 TTABVUE 101-189; 35 TTABVUE 209-25; 27 TTABVUE 227-243.

²⁵ 21 TTABVUE 190-202; 36 TTABVUE 226-38 (confidential); 27 TTABVUE 244-253.

²⁶ 35 TTABVUE 14-208.

²⁷ 35 TTABVUE 245-320.

²⁸ 35 TTABVUE 321-390.

²⁹ 27 TTABVUE 9-13.

³⁰ 27 TTABVUE 14-192.

³¹ 32 TTABVUE.

examination of the evidence. In accordance with the Board's order, Defendants submitted an Amended Notice of Reliance.³²

In its Brief, Plaintiff renews its objections to Exhibits 2-6 and 9-10 because it contends that despite the Amended Notice of Reliance, Defendants have not adequately explained the exhibits' relevance and failed to specify the particular page numbers to be read as required under Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g). As to Exhibits 9 and 10, Plaintiff also objects to these excerpts from the discovery depositions of Defendants' officers as unnecessary to make Plaintiff's submitted portions of these depositions "not misleading" under Trademark Rule 2.120(k)(4), 37 C.F.R. § 2.120(k)(4).

We have considered the objections, but find that the deposition excerpts are appropriate under the rule because they in fairness should be considered in conjunction with the excerpts offered by Plaintiff. We also find that Defendants have sufficiently met their obligations under the rules to identify the materials and their relevance. We therefore overrule the objections, but bear in mind Plaintiff's articulated concerns in weighing the relevance and strength or weakness of the objected-to testimony, including any inherent limitations therein.

III. Plaintiff's Standing

Plaintiff must show a real interest in the outcome of the proceeding and a reasonable basis for its belief of damage. *See* 15 U.S.C. §§ 1063, 1064; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed.

³² 33 TTABVUE.

Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999)). Plaintiff's pleaded registrations for a mark similar to Defendants' marks, with copies made of record showing current status and title as set forth above, establish its standing. *See Coach Serv. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (petitioner's prior registrations establish "direct commercial interest and its standing"). Plaintiff's use of its mark in connection with the operation of service areas that include restaurants also establishes Plaintiff's real interest and standing.

IV. Abandonment – Cancellation

We first turn to Plaintiff's claim that Defendants abandoned the mark in Registration No. 4056183. Section 14 of the Trademark Act provides for the cancellation of registrations if the registered mark has been abandoned. *See* 15 U.S.C. § 1064. Under Section 45 of the Trademark Act, a mark is considered abandoned:

[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

In a cancellation proceeding on the ground of abandonment, because registrations are presumed valid under the law, the party seeking cancellation bears the burden of proving a prima facie case of abandonment by a preponderance of the evidence. *See*

On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 13 USPQ2d 1307 (Fed. Cir. 1989). If the petitioner presents a prima facie case of abandonment, the burden of production then shifts to the trademark holder to rebut the prima facie showing with evidence. *Cerveceria Centroamericana*, 13 USPQ2d at 1311.

Defendants did not address the abandonment claim in their Brief,³³ despite Plaintiff advancing this pleaded ground for cancellation in its Brief. Defendants have conceded that they made a change from their registered mark to the mark in their opposed application. Specifically, they state in their Brief that “[i]n an effort to avoid potential litigation or other legal issues, Boardwalk Pizza [Defendant BP] adopted a slightly modified logo,” the mark in the opposed application.³⁴ Defendants’ corporate officer, Ms. Parratt, indicated in her deposition that this change occurred in 2012, which was the last time the mark in its registration was used.³⁵ Defendants’ corporate officer, Mr. DiMatteo, stated that they stopped using the registered mark slightly later, in 2013.³⁶ Defendants have admitted that the registered mark is not currently in use and that Defendant BP “has no current plans to use Registrant’s

³³ 42 TTABVUE (Defendants’ Brief).

³⁴ 42 TTABVUE 16 (Defendants’ Brief). Despite this characterization as a slight modification, Defendants have made no argument that the applied-for mark is legally equivalent to the registered mark or is not a material alteration of the registered mark. Defendants’ submission of its new application for the modified mark implicitly acknowledges that the new mark differs materially from the registered mark.

³⁵ 21 TTABVUE 198-99 (Parratt Deposition).

³⁶ 21 TTABVUE 136 (DiMatteo Deposition).

Mark in connection with the sale of goods or the provision of services.”³⁷ Defendant BP further stated in answering an interrogatory that it “has no current plans for future use of [its registered] Mark in connection with any goods and services.”³⁸ In the deposition of Defendants’ corporate officer, Ms. Parratt, when asked, “Is the Boardwalk Pizza logo still being used anywhere?” she testified, “No.”³⁹ She stated that Defendant BP was in the process of being dissolved.⁴⁰ In Mr. DiMatteo’s deposition, when asked, “As far as you’re concerned, you’re done with that mark?” he answered, “Yes.”⁴¹

This evidence establishes that Defendant BP discontinued use of the registered mark at least as of 2013, and intends not to resume use. Thus, we conclude that Defendant BP abandoned the registered mark, and grant the petition to cancel on this ground.

V. Section 2(d) Claim – Opposition

Our determination regarding abandonment suffices to grant the petition to cancel Defendants’ registered mark, so we need not reach the likelihood of confusion claim as to that mark, and it is dismissed as moot. However, as to Defendants’ applied-for mark, we address the likelihood of confusion claim in the opposition.

³⁷ 21 TTABVUE 47-48 (Defendants’ Responses to Requests for Admission).

³⁸ 21 TTABVUE 29 (Defendant BP’s Answers to Interrogatories).

³⁹ 21 TTABVUE 198-99 (Parratt Deposition).

⁴⁰ 21 TTABVUE 193 (Parratt Deposition).

⁴¹ 21 TTABVUE 137 (DiMatteo Deposition).

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.”). We address these and other relevant *du Pont* factors below. Plaintiff bears the burden of proving its Section 2(d) claim by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

A. Priority

To establish priority, Plaintiff relies on its registration for highway management and maintenance services and travel information services, as well as “longstanding and continuous use of [its] logo since 1956 in connection with a wide variety of goods and services, including restaurant services.”⁴²

⁴² 39 TTABVUE 36 (Plaintiff’s Brief).

As to the services in the registration,⁴³ Plaintiff clearly has priority. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1566 (TTAB 2007). However, with respect to its pleaded common-law rights in connection with services not covered by the registration, in particular the claimed restaurant-related services, Plaintiff must establish prior proprietary rights in the mark for those services. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). Defendants filed the opposed application on April 30, 2014, and have not established an earlier priority date. As to Plaintiff's alleged common law rights in the green-and-yellow version of its logo in connection with highway management and maintenance as well as travel information services, the record includes adequate proof of use dating back to 1956.⁴⁴

As noted above, however, while Plaintiff makes very general contentions about common law rights with respect to "a wide variety of goods and services," its focus for alleged likelihood of confusion rests on alleged common law restaurant services, with supporting evidence involving lease arrangements with third parties that operate restaurants on the Garden State Parkway. Plaintiff therefore must demonstrate that it owns a service mark that was used in connection with restaurant

⁴³ Plaintiff also has priority as to the goods in its other pleaded registrations – coffee mugs and T-shirts. However, Plaintiff does not rely on these goods in its likelihood of confusion analysis.

⁴⁴ 22 TTABVUE 41-43 (O'Hern Deposition).

services prior to Defendants' constructive use of its mark (i.e. the filing date of the application). *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008). Although the underlying activities relied on by Plaintiff in asserting rights in restaurant services (such as the lease agreements) clearly predate Defendants' priority dates,⁴⁵ as discussed more fully below, the activities fail to show that Plaintiff has common law rights in its mark as to restaurant services.

To support the alleged common law rights, Plaintiff points to: (1) its lease agreements with third parties such as McDonalds Corporation, Host Marriott Corporation, and Sunoco, Inc. that operate restaurants or snack shops at service areas along the Garden State Parkway;⁴⁶ and (2) a coupon shown below bearing the mark that expired on September 2, 1996 offering 50 cents off any extra value meal, "GOOD AT ALL GARDEN STATE PARKWAY SERVICE AREA RESTAURANTS."⁴⁷



At one point in his testimony, Mr. O'Hern answered affirmatively that Plaintiff provides restaurant services, and responded affirmatively that Plaintiff's mark is

⁴⁵ E.g., 22 TTABVUE 29-30 (O'Hern Deposition).

⁴⁶ Plaintiff's Brief cites to the agreements at 22 TTABVUE 254-319 (O'Hern Deposition, Exhibits 2-5).

⁴⁷ 22 TTABVUE 353-54 (O'Hern Deposition, Exhibit 12).

“used in connection with those restaurant services.”⁴⁸ However, these conclusory characterizations are not borne out by the record, which instead shows that Plaintiff merely acts as a landlord for third-party restaurant facilities located at service areas owned by Plaintiff.

Specifically, on cross-examination, Mr. O’Hern clarified that Plaintiff does not operate the restaurants at issue.⁴⁹ Rather, third parties operate restaurants at service areas leased to them by Plaintiff.⁵⁰ Such restaurants include Burger King, Pizza Hut, Starbucks, Popeye’s, Roy Rogers, and McDonalds.⁵¹

As background, the record reflects that the service areas along the Garden State Parkway are individually named, for example, “Vauxhall,” “Grover Cleveland” or “Brookdale South.”⁵² No evidence indicates that these service areas are identified by or display Plaintiff’s mark. Even more generally, as to signage bearing Plaintiff’s mark on the Garden State Parkway, Mr. O’Hern noted that unlike interstates that periodically display signage of the interstate being travelled, the Garden State Parkway does not “have those on our roads. We don’t just randomly put up Parkway logos up and down our roads.... Do you just randomly see Parkway trailblazers on the

⁴⁸ 22 TTABVUE 82-83 (O’Hern Deposition).

⁴⁹ 22 TTABVUE 18 (Mr. O’Hern, testifying that “[Plaintiff] owns the property, owns the buildings, but HMS Host has a contract ... to operate the food services....”).

⁵⁰ 22 TTABVUE 19-20 (O’Hern Deposition).

⁵¹ 22 TTABVUE 30, 113-14 (O’Hern Deposition).

⁵² 22 TTABVUE 19, 23, 30, 172 (O’Hern Deposition). Other names include Montvale, Cheesequake, Monmouth, and Forked River.

side of the road? No....”⁵³ Thus, the record fails to establish that Plaintiff’s mark is displayed at or near the service area restaurants.

The nature of Plaintiff’s business relationship with the third-party restaurants also undercuts any claim of restaurant service mark usage under Plaintiff’s mark. Mr. O’Hern testified that Plaintiff’s contractual arrangement with the third-party restaurant operators “[is] essentially landlord/tenant.”⁵⁴ He noted, for example, that in its lease agreement with McDonald’s Corporation, “[Plaintiff] acts as the landlord, McDonalds is the tenant.”⁵⁵ Consistent with that characterization, the 1981 lease provides for a “Landlord and Tenant” relationship at restaurant facilities at the “Brookdale South” and “Vaux Hall” service areas on the Garden State Parkway.⁵⁶ The agreement provides for Plaintiff to collect a guaranteed minimum rent or, if greater, a percentage of the gross receipts of the restaurants that operate at the service areas.⁵⁷ The agreements with HMS Host for restaurants and Sunoco, Inc. for snack shops have similar terms.⁵⁸

In its Brief, Plaintiff characterizes the third-party lessees as licensees, but points to no support from the record.⁵⁹ According to Mr. O’Hern, the service area restaurants do not use Plaintiff’s mark in connection with their services, but instead have “their

⁵³ 22 TTABVUE 146 (O’Hern Deposition).

⁵⁴ 22 TTABVUE 19 (O’Hern Deposition).

⁵⁵ 22 TTABVUE 30 (O’Hern Deposition).

⁵⁶ 22 TTABVUE 267 (O’Hern Deposition; Exhibit 4).

⁵⁷ 22 TTABVUE 116-17 (O’Hern Deposition); *see also id.* at 20, 23-24.

⁵⁸ 22 TTABVUE 20, 23 (O’Hern Deposition).

⁵⁹ 44 TTABVUE 17 (Plaintiff’s Rebuttal Brief).

own logos to identify their own” services.⁶⁰ For example, Mr. O’Hern noted, “Starbucks has a Starbucks sign, Auntie Anne’s has an Auntie Anne’s sign, Pizza Hut has a Pizza Hut sign.”⁶¹ Consistent with that approach, Plaintiff’s predecessor’s 1984-1996 contract with Marriott for its operation of restaurants at particular service areas provided that Marriott shall provide the restaurant signage “to identify the services and facilities furnished by Marriott to the public. Marriott may use a Big Boy/Roy Roger’s sign in [sic] its customary logo to identify its restaurant to users of the Parkway.”⁶² The lease agreement with McDonalds, which was still in effect in 2015,⁶³ states that McDonald’s “shall furnish and erect, at its own expense, such signs within each Service Area as Landlord [Plaintiff] may require to identify the services and facilities furnished by Tenant to the public. Tenant may use a McDonald’s sign in its customary logo to identify its restaurant to users of the Parkway, provided that the size thereof shall first have been approved in writing by Landlord....”⁶⁴ The contracts with the third-party restauranteurs do not include any provisions addressing the use of Plaintiff’s mark.⁶⁵ When asked if such permission was in place, although Mr. O’Hern testified that “if they asked to use [Plaintiff’s mark] just for a single specific

⁶⁰ 22 TTABVUE 115-16 (O’Hern Deposition).

⁶¹ 22 TTABVUE 116 (O’Hern Deposition).

⁶² 22 TTABVUE 231 (O’Hern Deposition; Exhibit 1).

⁶³ 22 TTABVUE 319 ((O’Hern Deposition; Exhibit 5).

⁶⁴ 22 TTABVUE 289 (O’Hern Deposition; Exhibit 4).

⁶⁵ 22 TTABVUE 220-322 (O’Hern Deposition Exhibits 1-5).

purpose, it could have just been a letter.”⁶⁶ However, he conceded that if such letters existed, they likely would have been produced in discovery,⁶⁷ and none were.

Turning to the coupon, although Plaintiff introduced it through Mr. O’Hern, he provided no accompanying testimony about its distribution, except that based on the “valid through September 2, 1996” date on its face, it was “likely distributed in 1996.”⁶⁸ We do not know how many coupons were printed or if any were actually distributed. Thus, we cannot find or infer any degree of consumer exposure to the coupon. This appears to be the sole piece of evidence in the record showing Plaintiff’s mark in connection with the service area restaurants, and it is insufficient to establish Plaintiff’s alleged common law rights as to restaurant services.

Considering the record in its entirety, we cannot conclude that Plaintiff has proven common law rights in its mark for restaurant services. It is undisputed that Plaintiff does not provide such services directly, and its lease arrangements with third parties who provide such services under their own marks are insufficient. We lack proof that consumers of these restaurants would have encountered Plaintiff’s mark in connection with these services. Therefore, Plaintiff has not established priority as to restaurant services.

⁶⁶ 22 TTABVUE 115-16 (O’Hern Deposition).

⁶⁷ 22 TTABVUE 115-16 (O’Hern Deposition).

⁶⁸ 22 TTABVUE 45-46 (O’Hern Deposition).

B. The Strength of Plaintiff's Mark

Plaintiff argues under the fifth *du Pont* factor that its mark should be deemed famous. The strength of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). This is not “an all-or-nothing factor,” but instead involves assessing the mark “along a spectrum from very strong to very weak” *Id.* (internal citations omitted). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See Palm Bay Imps.*, 73 USPQ2d at 1694 (strong marks “enjoy wide latitude of legal protection” and are “more attractive as targets for would-be copyists”). Strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the services identified by the marks; and the general reputation of the services. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength).

To demonstrate fame, Plaintiff relies on a variety of evidence, some of which is confidential and therefore will be discussed only in general terms. The evidence includes:

- Use of the mark since 1956 in connection with highway management and maintenance services.⁶⁹
- The level of traffic on the Garden State Parkway, “one of the busiest commercial roads in the United States,” whose passengers presumably encountered the mark on signage.⁷⁰
- The annual toll revenue (approaching or exceeding \$1 billion) and service area concessions revenue (ranging from \$33.8 million to \$38.9 million) for the Garden State Parkway from 2010 to 2015.⁷¹
- Third-party and media recognition of the mark, including an article in the Star Ledger referring to the logo as “iconic”.⁷²
- Alleged infringements of the mark and successful enforcement efforts.⁷³

⁶⁹ 22 TTABVUE 37, 41-43 (O’Hern Deposition) (including the statement that the mark has been used consistently since 1956).

⁷⁰ 22 TTABVUE 58; 35 TTABVUE 245-390 (Plaintiff’s annual reports and financial statements, reporting toll revenue approaching or exceeding \$1 billion each year); 22 TTABVUE 33 (O’Hern Deposition, individual tolls range up to \$1.50 per vehicle).

⁷¹ 35 TTABVUE 245-390 (Plaintiff’s annual reports and financial statements).

⁷² 22 TTABVUE 63-65, 532-41 (O’Hern Deposition) (media references in the Star Ledger and NJ.com to the Garden State Parkway’s “iconic” logo); 23 TTABVUE 48-51, 160-63, 170, 197-98 (confidential testimony and exhibits reflecting third-party recognition).

⁷³ 22 TTABVUE 72-75, 132-35 (O’Hern Deposition); 23 TTABVUE 1-734 (confidential testimony and exhibits regarding alleged infringements and enforcement efforts).

Defendants counter that this evidence merely establishes that the mark may be well known based on its “adorning one of the most-travelled toll roads in the United States for more than sixty years, [where] it is prominently displayed *as a traffic control marker*.”⁷⁴ Defendants also assert that Plaintiff’s use only within the state of New Jersey limits the mark’s strength.

Plaintiff’s evidence of length of use, the vehicle traffic where the mark is displayed, revenue statistics in connection with its services, media coverage highlighting its logo, and third-party efforts to use the mark or variations of it, reflects some degree of renown of the mark and shows widespread consumer exposure to Plaintiff’s mark. *See Weider Publ’ns*, 109 USPQ2d at 1354 (crediting fame-related evidence that millions of consumers per month were exposed online to the mark in question). While we agree that the most prominent use of the mark is on road signage, this does not undercut the mark’s ability to signify to consumers that the underlying highway management and maintenance and travel information services come from Plaintiff. Overall, we find Plaintiff’s mark reasonably strong for highway management and maintenance and travel information services, weighing in favor of likely confusion when considering those services.

C. The Number and Nature of Similar Marks for Similar Goods and Services

Also bearing on the strength of Plaintiff’s mark, Defendants argue under the sixth *du Pont* factor that Plaintiff’s mark is commercially weak due to third-party use

⁷⁴ 42 TTABVUE 30 (Defendants’ Brief) (emphasis in original).

of the same or similar logos. The Federal Circuit has held that evidence of the extensive registration and use of a mark or component of a mark by others can be powerful evidence of weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Third-party use evidence may reflect that consumers are accustomed to distinguishing among similar marks based on small differences. According to Defendants, Plaintiff has been lax in its enforcement of its mark, permitting some third-party uses and allowing other unauthorized uses to go unchallenged. In their brief, Defendants point to three authorized uses – one in connection with a job fair for New Jersey businesses, one license for use in connection with a toy truck, and one to the retailer Urban Outfitters.⁷⁵ With regard to these, Defendants also claim that Plaintiff showed a “lack of due diligence” before authorizing the third-party use. Defendants also point to an allegedly similar unauthorized logo used by the band Holme,⁷⁶ song lyrics that mention the Garden State Parkway, and news articles that included Plaintiff’s mark.⁷⁷ We find Defendants’ evidence and argument on this factor unpersuasive, as none of the uses are in connection with similar services. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017). Also, contrary to Defendant’s contention,

⁷⁵ 22 TTABVUE 141-43 (O’Hern Deposition).

⁷⁶ 22 TTABVUE 138-39 (O’Hern Deposition).

⁷⁷ 22 TTABVUE 139-41(O’Hern Deposition).

the evidence of a single unauthorized similar logo and a mention of the Garden State Parkway in song lyrics does not show inconsistent monitoring of Plaintiff's mark or diminish the scope of protection to which its mark is entitled, rendering this factor neutral.

D. Similarity of the Marks

Turning to the first *du Pont* factor, involving the comparison of the marks, we consider them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). We remain mindful that "marks 'must be considered . . . in light of the fallibility of memory' and 'not on the basis of side-by-side comparison.' [citation omitted]." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). We also bear in mind our finding that Plaintiff's mark is reasonably strong in the context of highway management and maintenance and travel information services. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1735 (this factor "warrants reasonable weight").



Plaintiff's registered mark, which is not limited to particular colors, appears above left, next to a depiction of its mark as used, showing Plaintiff's green and yellow color scheme, and Defendant BP's applied-for mark is shown above right. The overall

layout of the marks is very similar, each having a circular shape featuring two bands of identical width as a border. In each mark, the thicker, innermost band serves as a background for wording that appears in all capital letters at the top of the circle – GARDEN STATE in Plaintiff's mark and JERSEY BOARDWALK in Defendants' mark. In each mark, a horizontal cross-bar of similar width serves as the background for the most prominently-sized word – PARKWAY in Plaintiff's mark and PIZZA in Defendants' mark – and overlays a large image of the state of New Jersey. The silhouette of New Jersey in Plaintiff's mark includes a line delineating the Garden State Parkway, which does not appear in Defendants' mark. Defendants' mark also differs by featuring additional wording at the bottom of the mark, referring to food items served at Defendants' restaurants, as well as the "CO." entity designation. In comparing Plaintiff's green-and-yellow common law mark, the colors are nearly identical to those in Defendants' mark. Visually, Defendants' mark bears a strong similarity to Plaintiff's. However, because none of the wording is the same, there are visual differences, and the marks do not sound alike. The connotations of the marks share some commonality, by showing and referring to New Jersey, sometimes nicknamed "Jersey" or the "Garden State." However, the overall connotations differ in that Plaintiff's mark refers to a roadway while Defendants' mark refers to Italian food. Primarily because of the strong visual resemblance, we find the commercial impressions of the marks to be fairly similar. Considering the marks in their entireties, we find them similar.

E. Relatedness of the Goods and Services

As to the goods and services, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the parties' goods and services emanate from the same source. In making this analysis of the second *du Pont* factor, we look to the identifications of goods and services in the pleaded registrations and opposed application, as well as any goods and services for which Plaintiff has established prior use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Plaintiff focuses its relatedness arguments on its alleged common law rights in restaurant services,⁷⁸ but Plaintiff's failure to establish prior use of its mark in connection with such services renders these arguments moot.

Turning to the goods and services recited in Plaintiff's registrations, Plaintiff has not shown the relatedness of these goods and services, and has not introduced evidence that consumers would expect the same source that provides them to also provide restaurant services. We do not have, for example, evidence showing that those who manage and maintain highways frequently also offer or sponsor restaurant services under the same mark.

On this record, we do not find Plaintiff's goods and services related to Defendants' services.

⁷⁸ 39 TTABVUE 42 (Plaintiff's Brief).

F. Trade Channels

We presume that because Defendants' and Plaintiff's identifications as set forth in its registrations contain no trade channel restrictions, their services travel through all usual channels of trade therefor. *See Viterra*, 101 USPQ2d at 1908; *see also Cunningham*, 55 USPQ2d at 1846 (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"). The evidence of record shows that restaurant services are provided by third parties at service areas on the toll road operated by Plaintiff. The same travelers encountering road maintenance and management services, or travel information services, also stop to eat at restaurants. Thus, under the third *du Pont* factor, the services in Plaintiff's registration and Defendant's application move in at least partially overlapping channels of trade to some of the same classes of customers.

G. Purchasing Conditions

Plaintiff asserts that the relevant consumers of these services do not consider their purchasing decisions carefully. Defendants concede that "the decision to enter a pizzeria and order a slice may be impulsive," but they argue that the relevant purchasing conditions for Plaintiff's services cannot be considered conducive to impulse because consumers often lack alternatives to driving on the Garden State Parkway.⁷⁹ Neither party provided supporting evidence for their contentions, except

⁷⁹ 42 TTABVUE 39 (Defendants' Brief).

Mr. O'Hern's conclusory testimony, with no foundation laid therefor, that consumers do not exercise care.⁸⁰ We find this factor neutral.

H. Actual Confusion

Plaintiff "admits that there is minimal evidence of actual confusion in the record," pointing only to an individual who reported Defendants' use but clearly recognized that the pizza restaurants were not provided or sponsored by Plaintiff.⁸¹ This type of report does not show actual source confusion, as the consumer understood that Defendants' restaurants bore no relationship to Plaintiff and that the sources of the services are distinct. *See Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1479 (TTAB 2014) (inquiry is not evidence of confusion because the inquiry indicates that the prospective customer had a reason to suspect that there were two different companies); *Marshall Field & Co. v. Mrs. Field's Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992) (no actual confusion where the declarants were aware that there may be two different entities); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 164 (TTAB 1984) ("That questions have been raised as the relationship between firms is not evidence of actual confusion of their trademarks."). We find this factor neutral.

⁸⁰ 22 TTABVUE 35 (O'Hern Deposition).

⁸¹ 38 TTABVUE 45; 22 TTABVUE 541 (O'Hern Deposition, NJTA Exhibit 111).

I. Bad Faith

Under the thirteenth *du Pont* factor, Plaintiff maintains that Defendants acted in bad faith in adopting the mark, and that this weighs in favor of likely confusion. See, e.g., *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (“Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered.”); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) (“proof of intent to trade on another’s goodwill” can provide “persuasive evidence of likelihood of confusion”) (citation omitted).

Plaintiff points to Defendants’ desire to “call to mind the State of New Jersey in the marketing of their restaurants,” and to the display of replica signage of Plaintiff’s mark in Defendants’ restaurants.⁸² Also, Plaintiff alleges bad faith based on Defendants’ filing of the application even after a cease-and-desist letter from Plaintiff.⁸³

Defendants contend that they acted in good faith because Plaintiff does not have valid trademark rights in its mark, and regardless, the parties’ respective marks are not likely to cause confusion, especially in view of the distinct nature of their services and the differences in their marks.⁸⁴ Defendants’ officers testified that they did not consider the allegations in Plaintiff’s cease-and-desist letter credible.⁸⁵

⁸² 38 TTABVUE 46 (Plaintiff’s Rebuttal Brief).

⁸³ 38 TTABVUE 47 (Plaintiff’s Rebuttal Brief).

⁸⁴ 45 TTABVUE 19-20 (Defendant’s Reply Brief).

⁸⁵ 27 TTABVUE 239-40 (DiMatteo Deposition), 251 (Parratt Deposition).

While, as noted above, we find some similarity among the marks, that does not suffice to show bad faith in this case, when comparing such distinct services. Establishing bad faith requires a showing that a party intentionally sought to trade on the goodwill or reputation associated with another's mark. *See Big Blue Prods. Inc. v. Int'l Bus. Machs. Corp.*, 19 USPQ2d 1072, 1076 (TTAB 1991). Moreover, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). "A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy." *CareFusion 2200, Inc. v. Entrotech Life Sciences, Inc.*, 119 USPQ2d 1493, 1505 (TTAB 2016) (citing *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.")). The record in this case does not support the requisite intent to confuse consumers into a mistaken belief that Defendants' restaurants are provided by or affiliated with Plaintiff. We infer no bad faith from Defendants' creation of a New Jersey-themed motif for its restaurants, or from submission of the application even after Plaintiff's cease-and-desist letter, because as Defendants expressed in their response to the letter,⁸⁶ and as we find here, the applied-for mark is not likely to cause consumer confusion. *Compare L'Oreal S.A. v. Marcon*, 102

⁸⁶ 21 TTABVUE 97-100 (Defendants' response to Petitioner's cease-and-desist letter, stating that they dispute the allegations and "are prepared to defend and protect our client's rights").

USPQ2d 1434, 1441-42 (TTAB 2012) (finding bad faith based on demonstrated pattern of bad behavior of seeking registration of well-known marks for products with which the applicant had no industry-relevant experience). We find no bad faith on Defendants' part, rendering this factor neutral.

J. Conclusion on Likelihood of Confusion Claim

Considering all the relevant factors, we conclude that confusion as to source is unlikely. Although Defendants' mark is similar to Plaintiff's, the lack of relatedness of the restaurant services with which it is used to Plaintiff's goods and services is dispositive, regardless of some degree of strength of Plaintiff's mark, and some overlap in the trade channels. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive"). Accordingly, Plaintiff's Section 2(d) claim is dismissed.

VI. Defendant BP's Counterclaim Standing

Plaintiff's opposition of Defendant BP's application endows Defendant BP with standing to pursue its counterclaims to cancel Plaintiff's pleaded Registration No. 2452349. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007) (applicant subject to opposition has inherent standing to counterclaim for cancellation); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005) ("[a]pplicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations.") (citation omitted).

VII. Counterclaim – Unregistrable Traffic Control Device

Defendant BP counterclaims for cancellation of Plaintiff's registration on the ground that the Federal Highway Administration's Manual on Uniform Traffic Control Devices (MUTCD), adopted by New Jersey, provides that "[t]raffic control devices contained in this Manual shall not be protected by ... trademark...." MUTCD § Introduction-04.⁸⁷ According to the MUTCD, "[t]raffic control devices shall be defined as all signs, signals, markings, and other devices used to regulate, warn, or guide traffic, placed on, over, or adjacent to a street, highway, ... by authority of a public agency or official having jurisdiction...." Essentially, Defendants argue that the registered mark fails to function as a source indicator and belongs in the public domain. However, Plaintiff asserts that its mark lacks indicia to regulate, warn, or guide traffic, and therefore does not qualify as a traffic control device under the MUTCD. Mr. O'Hern testified that the mark does not, by itself, constitute a traffic control device.⁸⁸ Plaintiff further argues that regardless, its mark is not covered by the MUTCD provision at issue because the mark is not "contained in this Manual." Defendants point to no particular provision of the MUTCD or New Jersey law that identifies Plaintiff's mark as a traffic control device covered by this provision, but according to Defendants, the "contained in this Manual" language "refers to the *type*

⁸⁷ The MUTCD is available at https://mutcd.fhwa.dot.gov/htm/2009r1r2/html_index.htm. We reject Plaintiff's contention that this publication of the Federal Highway Administration under 23 Code of Federal Regulations (CFR), Part 655, Subpart F must be introduced into the record rather than merely cited.

⁸⁸ 22 TTABVUE 148 (O'Hern Deposition).

of traffic control device ... not to the specific devices depicted throughout the Manual....”⁸⁹

We conclude that Defendant BP has not met its burden to show that Plaintiff’s registered mark, which is entitled to the presumption of validity, fails to function as a mark. On this record, we are not persuaded that Plaintiff’s mark constitutes a “traffic control device[] *contained in* [the MUTCD]” (emphasis added), or that the mark does not qualify as a service mark under the Trademark Act. MUTCD § Introduction-04. Thus, we deny this counterclaim for cancellation.

VIII. Counterclaim – New Jersey Turnpike Act

Defendants next allege that Plaintiff’s registration must be cancelled because its enabling state statute, the New Jersey Turnpike Act, N.J. Stat. Ann. § 27:23-1 *et seq.*, does not provide Plaintiff the authority to acquire intellectual property rights. Specifically, Defendants point to a statutory provision that Plaintiff “shall not engage in the acquisition, construction or operation of any facility or any activity not directly or indirectly related to the use of a transportation project except as may be specially authorized by law.” N.J. Stat. Ann. § 27:23-5.9.

First, to the extent that Defendant BP seeks a declaratory judgment, as requested in its pleading, “the Board is not empowered to render such a judgment.” *Kelly Services Inc. v. Greene’s Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (declaratory judgment must be obtained from an appropriate court, not the Board). Second, to the extent we instead construe Defendants’ claim as an ownership

⁸⁹ 45 TTABVUE 16 (Defendants’ Reply Brief) (emphasis in original).

challenge to Plaintiff's registration, the claim is time-barred because Plaintiff's registration is more than five years old.⁹⁰ See 15 U.S.C. § 1064; *Kemin Ind. v. Watkins Prod., Inc.*, 192 USPQ 327, 328 (TTAB 1976) (“[A] registration extant for a period of five years may be cancelled only on the specific grounds enumerated,....none of which involves ownership of the registered mark ...”). Third, even were we to assume, *arguendo*, that this Board has the authority to interpret and apply the state statute,⁹¹ we find Defendant's statutory construction arguments unpersuasive. Instead, we view Plaintiff's registration and trademark rights as sufficiently related to its management of the Garden State Parkway to fall within the parameters of Plaintiff's statutory authority. For example, the services recited in Plaintiff's registration involve highway management and maintenance, as well as travel information that can encompass information about travel on the Parkway. Thus, we deny this counterclaim for cancellation.

IX. Decision

The petition to cancel Defendant's Registration No. 4056183 on the ground of abandonment is granted. Accordingly, the registration will be cancelled in due course.

⁹⁰ We deem irrelevant Defendants' reference in its Counterclaim Reply Brief to fraud, which was not pleaded or previously raised in this case, as an exception to incontestability under 15 U.S.C. § 1115(b). 45 TTABVUE 13.

⁹¹ See *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002), *aff'd*, 330 F.3d 1333, 66 USPQ2d 1811, 1813 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *cf. Am.-Int'l Travel Service, Inc. v. Aits, Inc.*, 174 USPQ 175 (TTAB 1972) (Board held that it was without jurisdiction to determine whether the acts of an opposer constituted a violation of a criminal statute).

Plaintiff's opposition to Defendants' Application Serial No. 86268185 based on Section 2(d) is dismissed.

Defendants' counterclaims are dismissed.