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

Proceeding	91224000
Party	Plaintiff Spiritline Cruises LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SPIRITLINE CRUISES, LLC,  
Opposer,  
v.  
TOUR MANAGEMENT SERVICES,  
INC.  
Applicant.

Opposition No. 91224000  
Mark: CHARLESTON HARBOR  
TOURS  
Serial No.: 86334681  
Published in the Official Gazette  
05/26/2015

MOTION FOR LEAVE TO FILE A *SECOND AMENDED NOTICE OF OPPOSITION*

This is in response to the order mailed May 31, 2017. Opposer seeks leave to amend its initial *Notice of Opposition* to plead claims consistent with the facts and with Opposer's position that Applicant Tour Management Services (TMS) is not entitled to Federal registration of the fully descriptive<sup>1</sup> phrase "Charleston Harbor tours."

In the May 31 order, the Board took the position that the *Amended Notice of Opposition* lacked a factual nexus between the existence of at least five (5) commonly owned companies and Opposer's pleading that Applicant (TMS) is not the owner of the mark.

Opposer incorporates its previous arguments that amendment should be liberally granted when both timely and in the interest of justice, factors that Applicant has demonstrated here and already placed on the record.

Opposer has accordingly amended the notice of opposition to specify selected publicly-available sources--more such sources may likewise exist--that show the use of "Charleston Harbor Tours" by numerous entities that are intentionally and specifically legally separate from one another. Such separate uses and entities raise a number of

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<sup>1</sup> Applicant's 2(f) declaration is a binding admission that the phrase "Charleston Harbor tours" is entirely descriptive.

issues to which Applicant has referred as "inconsistent with trademark ownership."

Admittedly, this is a less precise category than generic-descriptive-suggestive-arbitrary-coined-abandoned-naked license, but as the May 31 order points out, the borders between these concepts tend to be blended and transitional rather than widely separated.

There are a number of reasons why an Applicant for federal registration might not be the owner of a mark. For example:

- The Applicant has not used the mark in interstate commerce, or in some cases not at all;
- The Applicant seeks to register a fully descriptive mark in the presence of many other users of the same mark to describe the same services;
- The mark may be generic;
- The mark may be the subject of a naked transfer (assignment or license);
- The Applicant may have abandoned the mark; or
- The Applicant's course of conduct is fully inconsistent with trademark ownership (estoppel).

Applicant does not have a registration, and does not enjoy any legal presumption that attaches to registration, and therefore the cited case law should be applied in that context. Prior to the filing of Serial No. 86334681, all parties in the Charleston Harbor were free to use both "Charleston Harbor" and "Charleston Harbor tours" descriptively. No need existed for litigation or any other legal action. Indeed, Applicant seemed content with the status quo for eleven (11) years. Serial No. 86334681, however, has

forced Opposer to use the proper procedure—an opposition—to maintain the status quo use of this entirely descriptive mark.

#### Other Matters

Specimens: Opposer respectfully submits that the Board's intermediate conclusion that unacceptable specimens do "not constitute grounds for opposition," but that "adequacy of use of the mark" is the "proper ground for opposition," is a distinction without a difference. The failure to submit proper specimens with an original registration is perhaps better classified as no use whatsoever in the trademark registration context, and Opposer should be entitled to develop facts on this point (which it has) and challenge registration on this basis.

Replacement Page 2: On February 20, 2017, Applicant's counsel complained by letter that Opposer's *Reply to Applicant's Response to Opposer's Motion for Leave to File an Amended Notice of Opposition* contained a factual inaccuracy as to the order of events. Opposer corrected this with replacement page 2. Thus, replacement page 2 arguably benefits Applicant rather than Opposer.

Discovery: The May 31, 2017 order states that Opposer has refrained from requesting further discovery. To differ slightly, Opposer has pointed out (and the May 31 order agrees) that Applicant needs no further discovery of its own corporate, financial, ownership, and licensing records. Applicant has, however, produced two documents long after the close of discovery, presumably for the purpose of introducing them as evidence, and Opposer should be granted the opportunity at some point to test these documents in the discovery process.

Summary and Conclusion:

Accordingly, by specifying at least four types of publicly available information, Opposer's *Second Amended Notice of Opposition* gives Applicant concise, direct, and fair notice of Opposer's grounds for this opposition, and Opposer requests that the *Second Amended Notice Of Opposition* be entered at an early opportunity.

Respectfully submitted,

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ATTORNEYS FOR OPPOSER  
SPIRITLINE CRUISES, LLC

Certificate of Service

This is to certify that I have this 5th day of June 2017 served a copy of the foregoing MOTION FOR LEAVE TO FILE A *SECOND AMENDED NOTICE OF OPPOSITION* and a copy of *SECOND AMENDED NOTICE OF OPPOSITION* upon all counsel of record by depositing the same in the US mail with sufficient postage affixed, addressed as follows:

Edward T. Fenno  
Christina B. Humphries  
Tekesha Geel  
171 Church St., Suite 160  
Charleston, SC 29401

/PhilipSumma/  
Philip Summa

20170605\_1500

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

SPIRITLINE CRUISES, LLC,

Opposer,

v.

TOUR MANAGEMENT SERVICES, INC.

Applicant.

Opposition No. 91224000

Mark: CHARLESTON HARBOR TOURS

Serial No.: 86334681

Published in the Official Gazette

05/26/2015

**SECOND AMENDED NOTICE OF OPPOSITION**

SpiritLine Cruises, LLC, a limited liability company existing under the laws of South Carolina, with its principal place of business at 360 Concord Street, Suite 201, Charleston, South Carolina, 29201 ("Opposer"), believes it would be damaged and injured by the registration of the mark CHARLESTON HARBOR TOURS for "arranging of travel tours and cruises; boat transport; conducting boat charters; conducting power boat charters; conducting sightseeing travel tours by boat; conducting sightseeing travel tours for others; travel tour conducting; travel tour guide services; yacht and boat charter services" in International Class 39, as shown on Application Serial Number 86334681, filed July 11, 2014, by Tour Management Services, Inc. ("Applicant").

Opposer hereby alleges as follows:

1. Opposer is the registrant and owner of U.S. Registration No. 2380801 for FORT SUMTER TOURS used in connection with "cruise ship and tour guide services" in International Class 39 and of U.S. Registration No. 3093475 for SPIRITLINE CRUISES used in connection with "cruise ship and tour guide services" in International Class 39.
2. Applicant has applied for registration of the standard character mark

CHARLESTON HARBOR TOURS for "arranging of travel tours and cruises; boat transport; conducting boat charters; conducting power boat charters; conducting sightseeing travel tours by boat; conducting sightseeing travel tours for others; travel tour conducting; travel tour guide services; yacht and boat charter services" in International Class 39.

3. Applicant offers its services in the Charleston Harbor in Charleston, South Carolina.
4. Opposer offers similar services, including cruise ship and tour guide services, through the same or similar channels of trade to the same consumers in the same geographical area, the Charleston Harbor in Charleston, South Carolina.
5. Opposer has been offering its services since 1961, long before Applicant began operating its business as CHARLESTON HARBOR TOURS and filed the application now being opposed. Over the years, Opposer has invested substantial time, effort and money into promoting its businesses under its marks and has developed goodwill in its businesses and in its marks. Opposer has used the descriptive phrase CHARLESTON HARBOR TOURS in all manner of advertising of its cruise ship and tour guide services. Examples of such uses, on print advertising, on Opposer's website and in keyword search terms, printed informational brochures, promotional flyers, and signage, are attached hereto as Exhibit 1.
6. Opposer believes it would be damaged by the registration of Applicant's mark on the Principal Register. Opposer believes that if Applicant's application is allowed, Applicant will attempt to prevent Opposer from continuing to use

CHARLESTON HARBOR TOURS in the manner demonstrated in Exhibit 1<sup>1</sup>, by asserting that such uses infringe their registered trademark.

7. Opposer has previously conflicted with Applicant. In June, 2014, Opposer was forced to defend its registered trademarks from infringement and unfair competition from use in domain names registered by Applicant as explained in Exhibit 2.
8. Applicant acquiesced to Opposer's demand to cease use of Opposer's registered trademarks to direct web traffic and "parked" the domain names.
9. Applicant had not previously attempted to register CHARLESTON HARBOR TOURS as a trademark and only filed the application now being opposed on July 11, 2014, after receiving Opposer's letter regarding the domain name registrations.
10. The mark for which Applicant seeks registration is so plainly and highly geographically descriptive that many boat transport and tour companies are currently using the exact mark in Charleston to describe the boat tour and transport services they are offering in the same geographical area, as confirmed through the results of a Google search for the phrase, attached as Exhibit 3. Many others are also using CHARLESTON HARBOR descriptively, as demonstrated in Exhibit 4. Further, many others are using marks that are highly similar to Applicant's mark in connection with the same or similar services in other geographic locations, *i.e.*, "[name of city] HARBOR TOURS," as demonstrated in Exhibit 5. Highly similar marks substituting CRUISE for HARBOR are also in use.

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<sup>1</sup> Several of the pages scanned in Exhibit 1 are the front and back of a one-sided advertisement or brochure. Thus, the phrase at issue does not appear on every scanned page.

11. Applicant's mark is clearly descriptive of the services offered by Applicant and not inherently distinctive, as the Examining Attorney recognized when refusing the registration under section 2(e)(3) and Applicant has conceded.
12. Applicant is not entitled to registration because there has been no demonstration of proof that Applicant's mark has acquired distinctiveness as to Applicant's services in commerce. 15 U.S.C. §1052(f); TMEP 1212.
13. Applicant's mark lacks any design element that would add distinctiveness to the mark.
14. Applicant has produced no evidence demonstrating that CHARLESTON HARBOR TOURS is functioning as a trademark for Applicant's services nor the existence of secondary meaning through acquired distinctiveness indicating origin of the services.
15. Applicant has merely claimed use of the phrase for over five years but produced no evidence establishing long-term use of the phrase CHARLESTON HARBOR TOURS in connection with its services or use for a longer period than Opposer. Opposer has located and attached hereto as Exhibit 6 a brochure showing use of the phrase in 1995.
16. Applicant has failed to establish that CHARLESTON HARBOR TOURS has become distinctive of Applicant's services in commerce. Applicant has produced no proof that CHARLESTON HARBOR TOURS has acquired a primary significance in the minds of the consuming public as identifying Applicant's services.
17. Applicant has produced no evidence of large-scale advertising expenditures in

promoting and advertising services under the mark. There have been no affidavits or declarations produced asserting recognition of Applicant's mark as a source indicator. Applicant has not shown any survey evidence, market research or consumer reaction studies showing that the consuming public views the mark as an indication of source of Applicant's services.

18. The large number of other users concurrently using Applicant's exact mark or a similar variation to describe similar services (as demonstrated by the exhibits attached to this Notice) establishes the highly descriptive, if not generic, nature of the mark.
19. Registration of the mark will provide means for Applicant to claim superior rights in a plainly and highly geographically descriptive, if not generic, phrase that is currently used in its descriptive manner by many parties in addition to Opposer. Ultimately, Opposer believes that registration will lead Applicant to file litigation against Opposer alleging trademark infringement for descriptive use of the phrase, to Opposer's irreparable damage and loss.
20. In view of the highly descriptive nature of the phrase CHARLESTON HARBOR TOURS, Applicant is not entitled to registration of the mark. Applicant's registration should be refused under Section 2(e) of the Lanham Act, 15 U.S.C. §1052(d) for being merely descriptive.
21. On information and belief, including the public use of the mark by unrelated companies, the public records of the South Carolina Secretary of State, the public records of the United States Coast Guard, and the public records of the Federal

Communications Commission, Applicant is not the owner of and was never assigned any assets or goodwill in the alleged mark. Application Serial No. 86334681 is thus *void ab initio* because Applicant was not the mark owner when it filed the application.

22. On information and belief, including the public use of the mark by unrelated companies, the public records of the South Carolina Secretary of State, the public records of the United States Coast Guard, and the public records of the Federal Communications Commission, Applicant likewise failed to build trademark rights in the mark as of the date of filing the application. Applicant is one of at least seven (7) intentionally separate companies that use the mark. Applicant's 2(f) declaration improperly claims reliance upon use by unrelated companies, but on information and belief these companies are kept intentionally separate from one another for numerous business and legal purposes.
23. On information and belief, including the public use of the mark by unrelated companies, the public records of the South Carolina Secretary of State, the public records of the United States Coast Guard, and the public records of the Federal Communications Commission, Applicant, a corporation, began conducting business in 2011, but Applicant claimed first use in February of 2003. Therefore, Applicant's application for registration under § 2(f) based on five or more years' use immediately prior to Applicant's March 23, 2015 claim of acquired distinctiveness is false and Application Serial No. 86334681 is *void ab initio*.
24. Applicant failed to assert or enforce its alleged trademark rights for years in the

presence of multiple users. Applicant's failure to assert or enforce its alleged trademark rights precludes federal registration.

25. Applicant regularly uses the mark to describe its own services. Applicant's own descriptive use renders the mark generic.

26. In view of Applicant's own conduct, Applicant is not entitled to registration of the mark. Applicant's registration should be refused under 15 U.S. Code § 1127 because the mark has become the generic name for the goods or services with which it is used.

WHEREFORE, Opposer requests that Application Serial No. 86334681 be denied and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

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June 5, 2017

ATTORNEYS FOR OPPOSER  
SPIRITLINE CRUISES, LLC

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