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

Proceeding	91224000
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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

**RESPONSE IN OPPOSITION TO OPPOSER'S MOTION FOR  
LEAVE TO FILE A SECOND AMENDED NOTICE OF OPPOSITION**

By Order of May 31, 2017, the Board permitted Opposer limited leave to submit a second amended notice of opposition stating a legally sufficient claim of nonownership. In addition to exceeding the scope of that permission, Opposer's proposed Second Amended Notice of Opposition (the "Third Notice") still fails to include any factual nexus between the factual allegations and the allegation that Opposer is not the owner of the Mark. Instead, Opposer *again* relies on wholly unconnected facts before leaping to the legal conclusion that Applicant was not the owner of the Mark – just as it did in its First Amended Notice of Opposition (the "Second Notice") which was refused by the Board as legally insufficient.

The Third Notice also seems to be an attempt by Opposer to exceed the permission granted by the Board and to further muddy the waters by adding previously un-pleaded claims unrelated to acquired distinctiveness, genericness, abandonment or even ownership of the Mark.<sup>1</sup>

The simple fact is that Opposer has not been able to comply with the Board's instruction

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<sup>1</sup> The proposed new allegations, particularly in Paragraphs 22 and 23 of the Third Notice, appear to allege insufficiencies in Applicant's application or §2(f) claim rather than issues relating to nonownership.

and advance any factual allegations that would support a claim that Applicant is not the owner of the mark – because Applicant is the owner of the Mark. Opposer does not dispute Applicant’s chain of title to the Mark, does not allege that another party owns the Mark, and does not state that Opposer lacked sufficient control over any of the companies that Opposer alleges used the Mark. Opposer simply has not and cannot state a claim that Applicant is not the rightful owner of the mark.

None of Opposer’s amendments state “a statutory ground which negates the applicant’s entitlement to registration.” Young v. AGB Corp., 152 F.3d 1377, 1380 (Fed. Cir. 1998). Opposer’s amendments fail to satisfy the pleading standard, would be subject to dismissal for failure to state a claim, are futile, and are untimely to the extent they exceed the scope of permission granted by the Board.

## **ARGUMENT**

### **I. Opposer’s vague allegations regarding other companies and documents do not affect Applicant’s claim of ownership.**

Opposer still fails to advance a coherent theory for its claim that Applicant is not the owner of the mark. Again, Opposer still does not allege that any other entity owns the Mark or dispute Applicant’s chain of title to the Mark.

Instead, the Third Notice only alleges use by “unrelated companies” and that “Applicant is one of at least seven (7) intentionally separate companies that use the mark.” (Third Notice, ¶¶ 21-23.) Opposer does not identify any of the “unrelated companies” or the “intentionally separate companies.”<sup>2</sup> While Applicant maintains that Opposer’s allegations with respect to

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<sup>2</sup> Opposer referenced five “commonly owned companies” in the language previously refused by the Board as insufficient to support a claim for nonownership in its Second Notice. Opposer now appears to be contradicting itself by re-labeling those companies as “unrelated” and “intentionally separate.”

those companies is insufficient because of the failure to identify them, Opposer also does not allege any facts which connect the existence of these companies to Applicant's claim of ownership. The mere existence of such companies does not negate Applicant's claim of ownership. Even assuming that such companies existed *and* used the Mark, Opposer has not alleged how such use would affect Applicant's claim of ownership. Opposer has not alleged that such use did not inure to the benefit of Applicant or that Applicant did not control those companies' use of the Mark with respect to the nature and quality of the services. Thus, the allegation of the mere existence of such companies and a blank allegation that they use the Mark is insufficient to allege that Applicant is not the owner of the Mark.

Opposer also makes vague reference to some documents to supposedly support its allegations in Paragraphs 21-23, but none of those documents appear to even mention the Mark or use of the Mark. Specifically, Opposer references (but does not attach to the Third Notice): 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. Assuming the first two sets of documents are the purported records attached to Opposer's Motion for Summary Judgment, they do not mention use of the Mark and Opposer does not make any factual allegations that connect those records to any facts that may conflict with Applicant's claim of ownership. Opposer also provides no explanation for its references to the "public records of the Federal Communications Commission," has not filed or produced any such records, and makes no connection between those records and the Mark. Opposer fails to provide any factual nexus between the purported documents and its claim of nonownership.

**II. With respect to Opposer’s apparent new claims regarding sufficiency of the application, Applicant was not required to make a statement regarding use by a predecessor in interest or related party.**

Rather than actually alleging a claim for nonownership, Opposer seems to try to allege new claims that Applicant had some duty to include a statement that it was relying on use by another company. Opposer seems to allege that because the application did not specify such reliance, Applicant’s application is *void ab initio*. (Third Notice, ¶¶22-23.) No such duty existed.

First, an applicant can assert dates of first use by a predecessor in title and is not required to include a statement to that effect. Trademark Rule 2.38(a) states that “if the first use of the mark was by a predecessor in title or by a related company ... and the use inures to the benefit of the applicant, and the dates of first use ... *may* be asserted with a statement that first use was by the predecessor in title or by the related company.” 37 C.F.R. § 2.38(a) (emphasis added). In interpreting this rule, TMEP § 903.05 states that “the dates of first use *may* specify that the use on this date was by the applicant’s predecessor in title, or by a related company of the applicant.” (emphasis added). Both use the permissive “may,” so such a statement is not required and failure to include it is not fatal to an application. Thus, to the extent that Applicant may have relied on use by a predecessor in title, Applicant was not required to state that it was.

Second, even assuming (as apparently alleged) that Applicant’s application relies on use of the Mark by other parties, Opposer has not alleged any facts to demonstrate that such use did not inure to the benefit of Applicant or that Applicant was not entitled to rely on that use. Even if Opposer did rely on such use, “[t]he USPTO does not require an application to specify if the applied-for mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under §5 of the Act.” TMEP § 1201.03(a). In the present case, Opposer does not allege that Applicant was not also making use

of the Mark, so even interpreting the allegations in a light most favorable to Opposer, Applicant was entitled to rely on its own use in the application. In such circumstances, even where there is use by a related company, the TMEP clearly states that “the application does not have to refer to use by a related company.” TMEP § 1201.05.

Thus, even assuming such use and reliance existed, Applicant is not required to refer to the related parties or any predecessor in title in the application, and Opposer’s allegations fail to state a claim that there is any defect in the application.

### **III. Opposer’s “Other Matters” are untimely and inappropriately filed.**

Within Opposer’s Motion, Opposer raises even more issues outside the scope of the permission granted by the Board. While Applicant believes that a Motion to Amend is not the proper location to raise such unrelated issues, Applicant will respond briefly to each of those issues.

First, Opposer seems to seek reconsideration on the Board’s previous holdings that insufficiency of specimens (which Opposer included in its Motion for Summary Judgment but has never even tried to plead) does not constitute grounds for opposition. Reconsideration would be untimely, because Opposer has never requested leave to plead such a claim. In any event, Opposer cannot in good faith allege that Applicant made *no* use of the Mark at the time the application was filed, so Opposer still cannot assert a ground for opposition relating to the specimens.

Second, Opposer is correct that Applicant requested Opposer rectify several factual misstatements in Opposer’s Reply on the last motion to amend. Applicant does not agree that Opposer corrected all of the misstatements with its replacement page, but appreciates Opposer’s acknowledgment that the revisions were made to rectify at least one of those misstatements.

Third, Opposer seems to be requesting that discovery be re-opened for additional discovery on two pages produced by Applicant. The present Motion to Amend is not the appropriate forum to raise a dispute about document production. This is just another attempt by Opposer to delay and unnecessarily complicate this proceeding.

**CONCLUSION**

For the foregoing reasons, Opposer's Motion for Leave to File a Second Amended Notice of Opposition should be as legally insufficient, futile and untimely.

Respectfully submitted,

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ATTORNEYS FOR APPLICANT TOUR  
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June 8, 2017  
Charleston, South Carolina

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TOUR MANAGEMENT  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing *Brief in Response to Opposer's Motion for Leave to File a Second Amended Notice of Opposition* was served on counsel for Applicant, this 8th day of June, 2017, by sending the same by first class mail, postage prepaid, and by electronic mail to:

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