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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

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**Opposer SpiritLine Cruises's Reply to Applicant Tour Management Services's
Response to Opposer's Motion for Summary Judgement**

Introduction

This reply is in support of Opposer SpiritLine Cruises's Motion for Summary Judgment that the phrase "Charleston Harbor tours" is entirely and fundamentally descriptive of Charleston Harbor tour services in the Charleston Harbor that originate from the city of Charleston, South Carolina or nearby locations on the Charleston Harbor.

Brief Conclusions

Because common descriptive names cannot reach distinctive status (regardless of proffered evidence), many of Applicant's actual facts are irrelevant.

For purposes of summary judgment, and taking Applicant's response brief and Mr. Scribner's most recent declaration on their faces, Applicant admits that the terms "Charleston," "Charleston Harbor," "harbor tours," and "tours" are descriptive, and Applicant further admits that the designation "Charleston Harbor Tours" was: (1) used by Opposer well prior to any use by Applicant; (2) widely used by others prior to 2003 (Applicant's stated first use date); and (3) widely used by others during the interval between 2010-2015 (Applicant's 2(f) declaration interval).

In the context of summary judgment, Applicant's tardy declaration by its principal fails to serve as evidence for one or more of the following reasons: legally conclusory statements in Mr. Scribner's declaration are not facts and are thus irrelevant; Mr. Scribner's declaration offers self-serving uncorroborated statements rather than underlying

facts; Mr. Fenno's affidavit is "subject to an incredible amount of bias;" and the Board cannot give any weight to Mr. Fenno's testimony until or unless he withdraws.

The Admissions in Applicant's Response Brief

Applicant's Response Brief admits at least the following:

1. "Opposer used the term 'Charleston Harbor Tours' between the late 1990s and late 2014" ... "at tradeshows to vendors and professionals within the tour and travel industry." (Response Brief page 12). Applicant labels this admission as "undisputed."
2. Opposer's use of the term "The Charleston Harbor Tour" began as least as early as 1995 and continued "in the 1990s." (Response Brief page 11).
3. "Opposer used the phrase 'Charleston Harbor Tour' on an internal page of its website some dates between 2010 to 2012." (Response Brief page 13).
4. There are 75-100 different water-based tour or charter providers in the Charleston area (Response Brief page 7, paragraph 16; Scribner declaration, paragraph 27).
5. The Internet materials exchanged during discovery can be used "to demonstrate what the documents show on their face" (Response Brief page 13).
6. Applicant uses the phrases "harbor tours" and "harbor tour" descriptively (Response Brief page 21; Scribner declaration, paragraph 18).
7. The terms "Charleston," "Charleston Harbor," "harbor tours," and "tours," are all descriptive (Response Brief page 15).

The Arguments in Applicant's Response Brief

In the face of its own admissions, Applicant's July 12 Response Brief attempts several broad arguments.

1. Descriptive uses of "Charleston Harbor tours" by 70-100 third parties "do not compete with Applicant" (Response Brief at page 1, Scribner declaration at paragraphs 26 and 27).
2. The public doesn't know that "Charleston Harbor tours" means a tour of Charleston Harbor (Response Brief page 2, "Opposer has not cited any evidence

demonstrating that the relevant purchasing public understands the Mark to refer to the genus of which the particular services at issue are a species.”)

3. The commonly known history of Charleston, South Carolina is an untrustworthy allegation.

4. Web pages introduced during pleading and discovery and showing numerous and long-standing uses of "Charleston Harbor tours" by parties other than Applicant are inadmissible, and documents from the South Carolina Secretary of State's office are merely "purported" to be what they claim.

5. Mr. Scribner's opinions about the number of third party users, the relative sizes of third party users, and third party uses of "Charleston Harbor tours" became "facts" when written in his extremely untimely July 11, 2017 declaration.

6. Rearranged terms (e.g., "Harbor Tours of Charleston") or plurals versus singulars ("Charleston Harbor Tour" versus Charleston Harbor Tours") have no bearing on the numerous third-party descriptive uses of "Charleston Harbor tours."

7. Applicant has advertised and sold its services (Scribner declaration Paragraphs 9 and 12-16).

8. The numerous other uses of "Charleston Harbor tours" by third parties don't matter unless "Applicant knew of the use of the mark by any other entity" (emphasis in Applicant's Response Brief at page 9 footnote 5).

9. Applicant's own use of the descriptive phrase "A Charleston Harbor Tour" simply doesn't matter. (Response Brief page 21).

Descriptiveness

A descriptive mark "describes a feature or characteristic of Applicant's goods, which is hallmark evidence in a finding of descriptiveness." *In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796 at 1797 (T.T.A.B. 2017)(the term "Little Mermaid" held descriptive of a doll of a little mermaid).

A term is "merely descriptive" within the meaning of Section 2(e)(1) if it "immediately conveys knowledge of a quality, feature, function, or characteristic of the

goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (The phrase "National Chamber" was merely descriptive because "national" described services that were national in scope, and "chamber" described the purpose of the services: promoting the interests of businesses, "a purpose common to chambers of commerce").

When two or more merely descriptive terms are combined, the determination of whether the combined mark also has a merely descriptive significance turns on whether the combination of terms evokes a non-descriptive commercial impression. Generally, if each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *In re United Trademark Holdings, Inc.*, *Id* at 1798.

"A mark must perform the function of distinguishing the producer or provider of a good or service in order to have any legitimate claim to protection. A merely descriptive mark that has not acquired secondary meaning does not perform that function because it's simply 'describes the qualities or characteristics of a good or service.' No legislative purpose is served by granting anyone a monopoly in the use of such a mark." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 658, 83 L. Ed. 2d 582, 224 USPQ 327, 332 (1985) Page 668, Justice Stevens dissenting.

Substantially Exclusive Use

"If a mark is highly descriptive of the services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness. See *In re Noon Hour Food Prods., Inc.*, 88 USPQ2d 1172, 1181 (T.T.A.B. 2008) (Bond-Ost held descriptive for cheese generically referred to as "bondost"); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (T.T.A.B. 2007) ("Alpine Spring Water" held descriptive for spring water); *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989) (application for "Radio Controlled Buyer's Guide" denied as highly descriptive regardless of 2(f) declaration); *In re Gray Inc.*, 3 USPQ2d 1558, 1559-60 (TTAB 1987) (registration for "Protective Equipment" for security systems denied even in the face of

\$408,000 in advertising, \$8,112,000 in gross revenue and 11,700 installations of alarm systems over 8 years).

A descriptive use that is neither first nor distinctive is not registrable; *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed.Cir.1984), ("Levi's use of a tab on shoes has been neither first nor exclusive," and therefore not distinctive. *Id.* at 1405, 222 USPQ at 942. "When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful." *Id.* at 1403).

Applicant's use of the adjective "only" cannot, of course, minimize or limit the number of "vendors and professionals" (Applicant's terminology) at 15 years' worth of trade shows, nor can Applicant's use of the adjective "only" minimize Applicant's admission that Opposer's prior use extended for more than an entire decade ("between the late 1990's and late 2014; Response Brief at page 12).

Expenditures do not change the character of entirely descriptive terms

Expenditures of large sums of money do not in and of themselves create legal rights, and proof of an expensive (and even successful) advertising campaign does not establish secondary meaning, even if compared to very small expenditures by another party, *American Footwear Corporation Versus General Footwear Company*, 609 F.2d 655 at 663 (Universal Studios \$20 million investment in producing "The Bionic Man" television series as compared to opponent-manufacturer's \$3000 investment in advertising it's "Bionic" boots was insufficient to support an injunction against the boots or their manufacture).

"[C]ommon descriptive names cannot acquire trademarks status and evidence purporting to show acquired distinctiveness or secondary meaning is irrelevant," *In Re Louisiana Fish Fry Products Limited*, 797 F.3d 1332 (Fed. Cir. 2015) (a standard 2(f) Declaration from the company president combined with his second declaration providing gross sales over a four year interval were insufficient to support registration of an entirely descriptive mark).

"When a term is the common descriptive or generic name of the goods, "evidence of secondary meaning cannot change the result" 1338, ... "generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be" 1339, and "this is the established rule, for generic terms by definition are incapable of indicating a unique source." *Id* at 1338, Judge Newman concurring

Consideration of Evidence at Summary Judgment

Applicant argues that Opposer's Internet materials are inadmissible because they are not self-authenticating. In the opposition context, however, "printed publications in general circulation" are admissible *Raccioppi v. Apogee, Inc.*, 47 U.S.P.Q.2d 1368 (TTAB 1998) (telephone directories, the USPTO Gazette, and SEC 10-K forms were all self-authenticating).

Opposer's Internet materials produced during discovery and attached to its Motion for Summary Judgment Brief are merely offered to demonstrate what the documents show on their face and each document is both in "general circulation" and capable of being authenticated by affidavit or declaration of an officer of the Internet Archive where they were obtained. Because Opposer's Internet materials could be admissible at trial, they must be considered in deciding Opposer's Motion.

Ironically, Applicant argues points of admissibility in the face of Applicant's reliance on information disclosed long after the close of discovery (November 28, 2016) but requested at least as early as June 3, 2016 (e.g., Opposer's First Set of Interrogatories to Applicant).

Applicant likewise offers the nonsensical argument that Opposer failed to take advantage of "ample opportunity" (Response Brief page 5, footnote 4) to explore the facts underlying documents (e.g., TOU00710 and 711; Mr. Scribner's July 11, 2017 declaration) *that weren't even produced during discovery*, and one of which was offered for the first time concurrently with Applicant's Response Brief.

Applicant has now offered three new documents, all conveniently supplied well past the November 28, 2016 discovery deadline: (1) document TOU00711 (produced more than 2 months after the close of discovery and allegedly "merely an amended and expanded

summary of ... TOU00604); (2) document TOU00710 (produced on January 10, 2017; 43 days after the close of discovery and allegedly a transfer of trademark rights to Applicant TMS); and (3) the July 11, 2017 declaration of Robert Scribner (principal of TMS) reporting that he spends money on advertising and expressing his opinion that the many other long-standing third party descriptive uses of "Charleston Harbor tours" simply don't matter. In the context of summary judgment, however, Mr. Scribner's declaration, of which the salient portions are mere opinions, are at a minimum self-serving uncorroborated statements that are not facts and therefore are insufficient to create disputed issues of material fact at this stage of the proceeding; e.g., "I prepared" (paragraphs 10 and 11), "based on my review" (paragraphs 12, 13, 15, 16), "I was not familiar" (paragraphs 23 and 24), "Based on my research" (paragraph 27), "based on my knowledge" (paragraph 28), "to the best of my recollection" (paragraph 29).

Perhaps more accurately, and consistent with Judge Newman's opinion in *Louisiana Fish Fry Products*, Mr. Scribner's declaration statements are merely conclusory and thus are legally irrelevant in the context of summary judgment: "general averments [do not] embrace the 'specific facts' needed to sustain the complaint. ... The object of [Rule 56] is not to replace conclusory allegations of the complaint or answer with conclusory allegations of an affidavit." *Lujan v. Nat'l Wildlife Fed'n*, 497 U.S. 871, 888, 110 S. Ct. 3177, 3188, 111 L. Ed. 2d 695 (1990).

Mr. Fenno's declaration must be dismissed as well, unless Mr. Fenno and his firm decide to withdraw from this opposition in favor of acting as fact witnesses. The TTAB has given at least three reasons for denying probative value to an attorney's declaration or affidavit: (1) the Board cannot substitute counsel's opinion for its own; (2) counsel's statements are "subject to an incredible amount of bias;" and (3) it is improper for the Board to give weight to an attorney's affidavit unless or until the attorney withdraws. *In re Gray, Inc.*, 3 U.S.P.Q.2D 1558, 1560 (TTAB, 1987).

As for Mr. Benthall and Mr. Doyle, their declarations were at best perfunctory and without regard to the serious issues and consequences in this opposition. Both are business associates of Applicant TMS and both sell combination tours with TMS. They are thus

something other than relevant consumers in the trademark sense. Furthermore, most of their respective declarations are absolutely identical, and drafted by Mr. Fenno or his firm.

The value of the affidavits or declarations that assert recognition of the mark as a source indicator depends on the statements made and the identity of the affiant or declarant; e.g., *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1668 (TTAB 1988) ("The statements are form statements, undoubtedly prepared by counsel, which set forth a legal conclusion, that is, that the term "SUMO" acts as a trademark to identify applicant's goods. The existence of a relatively small number of people who associate the term "SUMO" with applicant is simply insufficient for us to find that the term functions as a trademark for applicant's goods.").

Proof of distinctiveness also requires more than a small number of people who associate a mark with the applicant, or parties in the relevant service business. *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) ("Turning to the direct evidence of acquired distinctiveness, the sixteen declarations ... have little persuasive value. They are nearly identical in wording and thus do not appear to have been prepared in the signer's own words. There is no evidence to suggest that this was a random selection of possible declarants. More importantly, none of the declarants, except possibly one, is described as an end consumer. They are almost exclusively either Mag Instrument's sales representatives or otherwise associated with a company in the flashlight retail business.").

Once again, Applicant's admissions (documents TOU00583-00593 submitted with Applicant's Response Brief) suffice to prove the point. Paragraphs 6 and 7 of each declaration are verbatim copies of one another. Paragraphs 3, 4, and 5 of each affidavit are identical other than "Boone Hall" versus "Palmetto Carriage" and "2004" versus "2008". At deposition, both Mr. Doyle and Mr. Benthall admitted that the affidavits were drafted by Mr. Fenno's law firm (Benthall deposition pages 52-54; Doyle deposition page is 77-80).

"Competition"

No requirement exists that Opposer or any member of the public be "competitive" (Applicant's term, Response Brief page 15, Scribner declaration page 16) with respect to a descriptive term. Competitiveness is not the issue, descriptiveness is the issue. An application for registration of an entirely descriptive term enjoys no presumption of distinctiveness and Applicant (here, TMS) bears the burden of proving distinctiveness. *In Re Louisiana Fish Fry Products, supra* at 1335.

Conclusion

Applicant has admitted everything necessary to establish "Charleston Harbor tours" as descriptive: extensive use by others prior to the application for registration; extensive use by others during the asserted 2(f) interval; Applicant's own descriptive use; and the descriptive nature of all of the words "Charleston," "harbor," and "tours." Because these admissions belong to Applicant, they are uncontested, cannot be contradicted by Applicant in an effort to create a factual dispute, and even if viewed most favorably to Applicant, these admissions establish the descriptiveness of "Charleston Harbor Tours."

Opposer's Motion for Summary Judgment should therefore be granted, and registration accordingly refused.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing *Opposer SpiritLine Cruises's Reply to Applicant Tour Management Services's Response to Opposer's Motion for Summary Judgement* was served on counsel for Applicant, this 1st day of August, 2017 by sending the same by first class mail, postage prepaid, and by electronic mail to:

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