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

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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'S REBUTTAL BRIEF

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APPENDIX I

I. INTRODUCTION

This is an opposition filed for the purpose of keeping the descriptive phrase "Charleston Harbor tours," available as a descriptive phrase, a status that has endured for decades.

The issues remain: (1) is "Charleston Harbor tours" generic for boat tours of the Charleston Harbor? (2) Is "Charleston Harbor tours" geographically (or "merely") descriptive of boat tours of the Charleston harbor? (3) Does ownership remain with the Kent Group Inc. rather than Applicant Tour Management Services ("TMS")?

In response to these issues, Applicant provides: (a) the uncorroborated testimony of Robert Scribner, principal of TMS; (b) colorful exhibits, various spreadsheets, uncorroborated spending figures, and lists of publications, radio stations and the like, all unconnected to one another and all lacking any connection to a single tourist or customer; and (c) an uncorroborated letter written by Mr. Scribner and addressed to himself.

Applicant does *not*, however, provide any direct testimony or evidence from any customers or potential customers.

II. DISTINGUISHING APPLICANT'S CASE LAW

Applicant's errors of law begin (fittingly enough) on page 1 in its "Introduction" in which Applicant asserts that marks such as (e.g.) AMERICAN AIRLINES® are geographically descriptive. In reality, terms such as "American" are (depending on context) considered arbitrary or suggestive. (THE AMERICAN GIRL used on women

shoes was "a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture;" 240 US 251 at 256-57 (1916); also distinguishing actual geographic marks such as "Lackawanna" for coal produced in Lackawanna Pennsylvania 240 US at 257).

Applicant misapplies *L.D. Kichler Co. v. Davoil, Inc.*, 52 U.S.P.Q.2D 1307, 192 F.3d 1349, (Fed. Cir.1999) (a denial of summary judgment) because the asserted mark was the design for an item of hardware, and the *Kichler* court noted "no analysis of the extent of the sales" in evaluating an infringing or inconsequential status.¹

Applicant misuses *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 U.S.P.Q.2D 1001 (Fed. Cir. 1988) in three ways. First, as with *Kichler*, *Yamaha* deals with the designs of physical objects (guitar peg heads) rather than a standard character word mark (840 F.2d at 1574). The issue of whether a guitar peg head functions as a source identifier is entirely different from whether "Charleston Harbor Tours" describes Charleston Harbor tours.

Second, Applicant misstates the *Yamaha* "presumption." In actuality, *Yamaha* reminds us that the Applicant bears the burden of "**establishing** acquired distinctiveness" (840 F.2d at 1576, emphasis added) and that an untested uncorroborated ex parte 2(f) declaration merely moves an application to publication.

¹ "Insubstantial" is a more rigorous test than Applicant has demonstrated here. In *Scott Paper company v. Scott's Liquid Gold* 589 F.2d 1125 (3d Cir. 1978), 14 misdirected consumer letters were considered insubstantial against 50 million cans of product (589 F.2d at 1231). Applicant's Brief tries to deflect the substantial use by others with diversions into boat bathrooms, type of Charleston Harbor tour, and the like (Applicant's Brief at e.g. pp. 39).

Because the purpose of publication is to give the public the right to demonstrate (for various reasons) that the ex parte applicant is *not* entitled to registration, no presumption of registrability exists based merely upon publication (e.g., "Irrespective of whether or not there is any new or additional evidence than was before the examiner, any ex parte ruling has no binding effect in an inter partes proceeding since Section 17 of the Act directs the Board to determine the respective rights of the parties." *Gruen Indus. v. Ray Curran & Co.*, 152 U.S.P.Q. 778, 779 (T.T.A.B. 1967)).

Third, the *Yamaha* court found both parties lacking in their proofs of source identification² and thus *Yamaha* cannot support the conclusion urged in Applicant's Brief.

Applicant's reliance on *Carter-Wallace, Inc. v. P&G Co.*, 434 F.2d 794, , 167 U.S.P.Q. 713 (9th Cir. 1970) is misplaced because the District Court held, and the Ninth Circuit affirmed, that the phrase "To Be Sure" for deodorant lacked distinctiveness and secondary meaning. With relevance to this opposition, *Carter Wallace* reaches two conclusions unfavorable to Applicant TMS. First, that the owner of the asserted trademark "made no objection to the sale of SURE deodorant" even though [the owner] "had notice of Lexicon's claim of ownership." 167 U.S.P.Q. 713 at 798. In the present opposition, three long-standing tour boat operators in the Charleston Harbor all testified

² "[T]he record is lacking in direct evidence of consumer testimony or perceptions as to whether the specific guitar heads employed by Hoshino function as significant indications of source, the record is also without any evidence of real substance to the contrary." 840 F.2d at 1583

that Mr. Scribner had never complained to them about their descriptive use of "Charleston Harbor tours."³

Second, *Carter Wallace* reaffirms the principle that "a large expenditure of money does not in itself create legally protectable rights" 167 U.S.P.Q. at 718 (quoting *Smith v. Chanel* 402 F.2d 562 (9th Cir. 1968)).

Applicant's reliance on page 1722 of *Mag Instrument* 96 U.S.P.Q. 2d 1701 is unfounded. First, *Mag Instrument* is not precedential. Second, the subject matter was "dual rings" on a flashlight barrel rather than standard characters for a descriptive term. Third, *Mag Instrument* held that the party in the position of Applicant TMS had failed to "ultimately [establish] that its mark has acquired distinctiveness" 96 U.S.P.Q. 2d at 1722. Fourth, Applicant TMS again confuses the ex parte presumption of entitlement to publication with the later burden of establishing distinctiveness. *Id.*

Scarves by Vera, Inc. v. Todo Imps., Ltd., 544 F.2d 1167, 192 U.S.P.Q. 288, 192 U.S.P.Q. 289, (2d Cir. 1976) is a likelihood of confusion case rather than a descriptiveness case, and because it dates from 1975 it illustrates the Second Circuit's analysis of a near-dilution circumstance prior to the adoption of the dilution aspects into 15 U.S.C Section 1125. Applicant TMS misapplies the decision. *Scarves by Vera* analyzed the trademark owner's right to preclude use of VERA by others on "non-competitive" products (e.g. 192 U.S.P.Q. at 293).

³ Borden declaration at 24 (ETTSa 935962), Collins Declaration at 11, and Appelbaum declaration at 16, both part of ESTTA 934964 filed 11/13/2018.

Because VERA is arbitrary in context, the Second Circuit's decision on (essentially) dilution in favor of the trademark owner offers no support to Applicant TMS's efforts to establish distinctiveness in a wholly descriptive mark.

To the extent that *Lovely Skin, Inc. v. Ishtar Skin Care Prods., LLC*, 745 F.3d 877, 110 U.S.P.Q.2D 1071 (8th Cir. 2014) supports any of Applicant's arguments, it also undercuts Applicant's argument that others' wide-ranging Internet use of a descriptive term ("Charleston Harbor tours") are insignificant or insubstantial. See, e.g., 110 U.S.P.Q. second at 1072-73 ("*Lovely Skin* began purchasing keywords from Internet search engine companies to drive customers to its website").

Of course, to repeat a salient point from Opposer's Trial Brief, Applicant went a step further and used *Opposer's* trademark to drive users to Applicant's website.

President & Trs. of Colby College v. Colby College-New Hampshire, 508 F.2d 804, 185 U.S.P.Q. 65 (1st Cir. 1975) is likewise unhelpful to Applicant because (1) it represents a likelihood of confusion analysis rather than a descriptiveness analysis; and (2) among other factors secondary meaning was established by a 1500 person professional survey (508 F.2d at 809). In reality *Colby College* highlights the weakness in Applicant's evidence because the First Circuit specifically pointed out that "the importance of qualified survey evidence in establishing secondary meaning is well recognized" (508 F.2d at 809) and in the present opposition, such consumer recognition evidence is conspicuously absent.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 U.S.P.Q.2D 1445, (Fed. Cir. 2015) presents Applicant with more problems than it solves. Applicant's principal Robert

Scribner has already admitted the importance of the Internet and search engine optimization in the travel-tourism-hospitality context: Scribner deposition at 39:13 to 39:20 and 42:6 to 42:15, ESTTA 925941 filed 10/3/2018.

Furthermore, Applicant poached Opposer's registered trademark (as well as that of sibling Fort Sumter Tours) for the express purpose of driving additional traffic to the charlestonharbortours.com website. Applicant cannot logically (or equitably) simultaneously (1) admit the importance of the Internet; (2) use Opposer's registered trademark on the Internet; and (3) deny the likelihood that relevant consumers use the Internet in the travel-tourism-hospitality industry. See, e.g., the respective cease and desist letters exchanged in June and July of 2014, ESTTA 873126 filed 01/24/2018.

Commerce Nat'l Ins. Servs. v. Commerce Ins. Agency, Inc., 55 U.S.P.Q. 2d 1098, 214 F.3d 432 (3d Cir. 2000) fails to buttress Applicant's arguments because (1) *Commerce National* recognizes that acquiescence weighs against secondary meaning (55 U.S.P.Q. 2d at 1103-04) ("To the contrary, CIA limited the mark's use to general insurance services, a use to which CBI consciously acquiesced for thirteen years." 214 F.3d at 440) and (2) *Commerce National* recognizes that business neighbors coexisting amicably weighs against secondary meaning 55 U.S.P.Q. 2d at 1105 ("the record reveals that, from 1983 through 1996, CBI and CIA coexisted amicably, even referred customers to one another, and operated in their respective spheres of interest without any confusion"). Mr. Scribner testified to this effect (Scribner deposition Pages 112:22 to 113:16, ESTTA 925941 filed 10/03/2018).

With respect to the URL issue (footnote 19 on page 43 of Applicant's Brief), Opposer raises it because it rebuts Applicant's claim that Applicant's spending generated consumer recognition and secondary meaning. Applicant intentionally commingled sales allegedly based on "consumer recognition" of a descriptive term with sales directly obtained by using a competitor's arbitrary (SPIRITLINE®) registered trademark in a URL and directing some number of customers (Mr. Scribner seems to offer an uncorroborated estimate of "none") to purchase a ticket from him on that basis. Under 15 U.S.C. Section 117(a) all of Applicant's sales are then presumed to be infringing of SPIRITLINE® unless and until Applicant proves otherwise.⁴

To the extent that the URL poaching casts Mr. Scribner in a bad light and ruins Applicant's spending arguments, it is a self-inflicted wound.

Curtis-Stephens-Embry Co. v. Pro-Tek-Toe Skate Stop Co., 199 F.2d 407, 95 U.S.P.Q. 130 (8th Cir. 1952) deals with likelihood of confusion of a registered mark rather than an application under opposition. The registrant lost the appeal. Perhaps more germane to this opposition, Applicant continues to argue or imply that its status as an opposed applicant matches that of a registrant. It does not.

Applicant's citation of *Princeton Vanguard, LLC v. Frito-Lay North Am., Inc.*, 786 F.3d 960, 114 U.S.P.Q.2D 1827 (Fed. Cir. 2015), *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, (D. Ariz. 2014), and *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 U.S.P.Q. 528 (Fed. Cir. January 23, 1986) merely highlights the

⁴ "In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed." 11USC 1117(a)

weaknesses of Applicant's position. *Princeton* debated the issue of genericness with the Federal Circuit remanding rather than affirming or overruling either of the parties. *Princeton* nevertheless highlights that—other than Mr. Scribner's opinion, uncorroborated documents produced by Mr. Scribner, and attorney arguments—Applicant TMS has offered no actual evidence from the relevant purchasing public. See, *Princeton* 786 F.3d 960 at 1833 (“... Evidence of the public's perception may be obtained from any competent source, such as consumer surveys, dictionaries, newspapers, and other publications”). Applicant TMS has offered no such evidence.

Elliott v. Google, 45 F.Supp. 3d 1156 (D Arizona 2014) besides having no more than suggestive authority with respect to the T.T.A.B. or the Federal Circuit, describes plaintiffs who used the federally registered mark GOOGLE in combination with other words, registered these as URLs, and then petitioned to cancel the GOOGLE registrations. Plaintiffs (unsurprisingly) failed to carry their burden.

H Marvin Ginn v. Int'l Ass'n of Fire Chiefs, Inc., 228 U.S.P.Q. 528, 782 F.2d 987 (Fed. Cir. 1986) represents another decision ending in remand (a cancellation proceeding), but evaluated the question of whether “Fire Chief” was descriptive of magazines. Judge Rich's comments in the opinion are instructive:

A generic term is the common descriptive name of a class of goods or services, and, while it remains such common descriptive name, it can never be registered as a trademark because such a term is “merely descriptive” within the meaning of § 2(e) (1) and is incapable of acquiring de jure distinctiveness under § 2(f). The generic name of a thing is in fact the ultimate in descriptiveness.” 782 F.2d at 989, 228 U.S.P.Q. at 530.

On page 45 of its Brief, Applicant appeals to the formal description of goods, conveniently silent on the fact that all of Applicant's services are carried out in the

Charleston Harbor, or roundtrips from the Charleston Harbor for a few miles up and down the Intracoastal Waterway for charter or repair (Scribner deposition e.g., 49:18, 50:5 ESTTA 972496 filed 10/03/2018). A short round trip from the Charleston Harbor fails to establish an arbitrary use (as advocated at page 46 footnote 22 of Applicant's Brief).

The asserted case law on the second paragraph of page 45 fails to give Applicant the desired support.

Magic Wand, Inc. v. RDB, Inc., 940 F.2d 638, 19 U.S.P.Q.2D 1551 (Fed. Cir. 1991) weighs against Applicant because it used Judge Learned Hand's "time-honored test" (Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921)): "What do the buyers understand by the word for whose use the parties are contending?" 940 F.2d 638, 640, 19 U.S.P.Q.2D 1551, 1552. Having applied Judge Hand's test, the Federal Circuit ruled that the relevant public was car owners buying carwashes rather than carwash owners and operators. The application of Judge Hand's test to the present opposition is clear-cut: Applicant cites its Charleston business partners (Doyle and Benthall) and its neighbor-competitors (SpiritLine, Fort Sumter Tours, Sandlapper, Aqua Safari, Geechee Girl) as "recognizing" Applicant as Charleston Harbor Tours ***but Applicant has failed to produce a single tourist or customer testifying to such recognition.***

Octocom Sys. v. Houston Computer Servs., 16 U.S.P.Q.2d 1783, 918 F.2d 937, offers Applicant no comfort because *Octocom* (which sustained a likelihood of confusion opposition) provides no support for Applicant's attempt to insist that it's alleged mark is arbitrary for some of the listed services. *Octocom* represents another decision proceeding

the adoption of anti-dilution into the Lanham Act and thus is more historically interesting than relevant to this opposition. All of Applicant's listed services either include the admittedly generic term "tour" or substitute some common synonyms (cruises, transport, charters) again illustrating Applicant's logical difficulty in attempting to escape descriptiveness. Applicant also attempts to bootstrap a double negative statement into affirmative proof, but as logic teaches us, two negative statements cannot establish a deduction (<https://plato.stanford.edu/entries/aristotle-logic/#PreStrAss> accessed June 6, 2019 at Section 5.5).

Of course, to the extent that Applicant admits that "Charleston" and "Harbor" are both descriptive and that "tour" is generic (e.g., page 46 of Applicant's Brief), Opposer has no objection.

Opposer is also willing to agree, of course, that "a voluminous amount of evidence of third parties using phrases such as 'Charleston Tours' indeed exists, and demonstrates the entirely descriptive nature of Applicant's mark."⁵

Applicant's footnote 10 on page 25 ("Applicant's registration would merely prohibit its competitors from branding their services under the CHARLESTON HARBOR TOURS mark *or a confusingly similar mark*)-seeking likelihood of confusion protection-defeats

⁵ Applicant seems to believe that Opposer must show evidence of non-descriptive use of the descriptive phrase at issue (i.e., as a source identifier); however, a "plaintiff may attempt to prove descriptiveness by showing its use or anticipated use of the designation at issue *in a descriptive manner*, or by showing this type of use by the defendant or by third parties." 3 Gilson on Trademarks § 9.03 (2019) *emphasis added*; See *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 U.S.P.Q.2d 1100 (T.T.A.B. 1997); *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 U.S.P.Q. 275 (C.C.P.A. 1961); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 U.S.P.Q. 627 (C.C.P.A. 1962).

all of Applicant's page 47 efforts to argue that "competitors can accurately describe their products and services without using the mark in question."⁶

Aromatique, Inc. v. Gold Seal, Inc., 31 U.S.P.Q.2D 1481, 1486, 28 F.3d 863, 871, 1994 rebuts Applicant's arguments rather than supporting them because the Eighth Circuit noted that in the 2(f) applicant's advertising, the claimed mark was never separate from a number of other identifying features 31 U.S.P.Q.2D at 1486 ("In none of the advertisements is the dress depicted without such identifying marks. The advertisements submitted with the application cannot establish secondary meaning because they do not separate the claimed dress of the products from the other marks that serve to identify the products as those of Aromatique").

Aromatique's co-mingling of names, logos, and designs, is, of course directly analogous to Applicant's proffered "advertising" exhibits many of which are dominated by elements—or brands—other than "Charleston Harbor Tours" in standard characters, and in many cases some other element is far more dominant than "Charleston Harbor Tours." Applicant's Exhibit F to Mr. Scribner's deposition—the only public exhibit⁷

⁶ Page 25, fn. 10 of Applicant's Brief demonstrates the untenable nature of Applicant's arguments. Applicant professes to "merely" desire control of "the Charleston Harbor Tours mark **or confusingly similar mark**" (emphasis added). Applicant thus highlights the very reason generic and descriptive marks are generally unregistrable—there are no "not confusing, not similar" marks available for the public to use.

⁷ Applicant now seeks to enter 472 pages of confidential documents as evidence of public use, stating that these 472 pages were "over-designated" under TBMP 412.01(c). Applicant has produced no evidence that any of these particular documents were anything other than digital designs. See e.g., TMEP 904.04(a)(digital designs "do not show actual use of the mark on or in connection with the goods or services in commerce" and cannot support registration. See also 15 U.S.C. §§1051, 1127; *In re Chica*, 84 USPQ2d 1845, 1848 (TTAB 2007); *In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986).

offered in support of Mr. Scribner's declaration is exemplary because it (i) uses "A Charleston Harbor Tour" descriptively and (ii) co-brands the logo version of "Bubba Gump" and the logo version of "Charleston Harbor Tours with equal prominence.

Without waiving its position that (e.g.) Applicant's TOU00001-00472 are not evidence of use, the wide variety of co-branding or multi-branding illustrated in TOU00001-00472 by Applicant similarly indicates that some fraction—evidently a large fraction—of Applicant's spending attempted to capture interested purchasers on the basis of items other than "Charleston Harbor Tours."

Page 25 footnote 10 demonstrates the untenable nature of Applicant's arguments. Having listed all sorts of suggestions for its competitors to use, Applicant professes to "merely" desire control of "the Charleston Harbor Tours mark *or a confusingly similar mark*" (emphasis added). Applicant TMS thus highlights the very reason generic and descriptive marks are generally unregistrable—there are no "not confusing, not similar" marks available for the public to use.

Applicant asserts *Deere & Co. v. FIMCO Inc.*, 260 F. Supp. 3d 830, 103 Fed. R. Evid. Serv. 360, (W.D. Ky. May 4, 2017) to argue the admissibility of the identical, hearsay "other people call Charleston Harbor Tours Charleston Harbor Tours" statements by Bentall and Doyle. Deere is not binding on the Board or even any other District Court, *Gasperini v. Center for Humanities, Inc.*, 518 U.S. 415, 116 S. Ct. 2211, 135 L. Ed. 2d 659 (1996): More fundamentally, Deere fails to cure the fact that (1) Bentall and Doyle are business partners of Mr. Scribner (i.e., biased and financially interested in the outcome) and (2) are not ordinary consumers of the services (*Magic Wand, supra*).

Applicant circumnavigates another of its arguments on pages 47 and 48 arguing that its generic use of the phrase "A Charleston Harbor Tour" (TOU00059; part of ESTTA 925941 filed 10/03/2018) was "one-time" and "only received limited circulation." Again, Applicant cannot concurrently (i) assert secondary meaning and (ii) argue against its admitted generic use using the same evidence at the same time.

Further on page 48 Applicant asserts that Opposer provided "no evidence that Applicant knew of the use of the mark by any other party in the same marketplace prior to its application."

Leaving the question of Opposer's evidence aside for a moment, Applicant's principal (Mr. Scribner) provided the relevant evidence during his discovery deposition (137:18 through 138 24; part of ESTTA 872251 filed 01/19/2018)

25 Q Tell me what you know about Aqua Safaris.
138

1 A They were a catamaran sailboat with a
2 capacity of 100 people that focuses on doing booze
3 cruises out of Shem Creek in conjunction with Red's
4 Oyster House or restaurant or whatever Red's is
5 called.

8 A They cruise on a boat that has as its
9 basic -- enticing people to come on with low-priced
10 alcoholic drinks.

17 A This is a different business. This is
18 somebody that's been operating this vessel out of
19 Shem Creek for a while. And they focus on getting
20 younger people on the boat to basically drink most
21 of the time. That's their business model.

22 Q And that's because you're familiar with
23 their business model?

24 A See them out in the harbor, yes.

Thus, although Applicant's Brief argues that Applicant was unaware of any other uses, Mr. Scribner testified to near-comprehensive knowledge of (at least) Aqua Safaris, immediately reciting the type of vessel ("catamaran sailboat"), its capacity ("100 people"), his opinion ("booze cruises"), its location ("Shem Creek")⁸, one of its restaurant associations ("Red's Oyster House"), its "business model" ("low-priced alcoholic drinks"), its target audience ("younger people"), and its duration in business in the Charleston Harbor ("for a while").

On page 92 of his deposition (e.g. lines 9-13) Mr. Scribner gives similar detailed knowledge about Sandlapper including the size ("49-passenger") and type ("pontoon boat") of Sandlapper's vessel and the nature of Sandlapper's tours ("they primarily do activities where they go into the marsh areas or to the islands near Ft. Sumter and let people off for picnics and that type of thing"). Mr. Scribner provided similar information about Geechee Girl (page 135:11 to 135:12: "They've got a small six-pack passenger vessel and they private charter it").

Theoretically, the possibility exists that Mr. Scribner knew none of this in March 2015 (the 2(f) declaration date), but achieved his comprehensive understanding by the time of his November 2016 deposition.

Applicant urges that *Univ. Book Store v. Bd. of Regents of the Univ. of Wis. Sys.*, 33 U.S.P.Q.2D 1385 (T.T.A.B. 1994), *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 214 U.S.P.Q. 327, 680 F.2d 755, *United States Jaycees v. Phila. Jaycees*, 639 F.2d 134,

⁸ Shem Creek is a tributary that empties into the Charleston Harbor directly across from the City of Charleston (e.g., Opposer's Exhibit C Document 37 Filed January 23, 2018 ETTSA 872729).

1981, 209 U.S.P.Q. 457, and *Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 486 F. Supp. 414, 206 U.S.P.Q. 70 (S.D.N.Y. 1980) support Applicant's argument that neither "complete exclusivity" nor immediate action against every "infringing use" defeats its 2(f) claims. As just noted, however, Applicant's principal was keenly aware of his competitors and their activities, but never raised the issue until Applicant's URL poaching came to light ESTTA 873126 filed 01/24/2018. Mr. Collins (ESTTA 934964, paragraph 11), Ms. Borden (ESTTA 935562 paragraph 24), and Mr. Appelbaum (ESTTA 934964 paragraph 16) all testified that Mr. Scribner had never objected to any of their uses of Charleston Harbor tours.

Univ. Book Store represents one of several collegiate logo and licensing cases that arose as colleges and universities began to recognize the potential value of licensed goods. *Univ. Book Store* doesn't help Applicant because "Bucky Badger" and similar logos were designs on (e.g.) shirts rather than descriptive of third-party sources per se.

Wallpaper Mfrs., Ltd. deals with cancellation of (rather than opposition to) an arbitrary mark (CROWN for wallpaper) rather than a descriptive one. *Wallpaper* does point out however, that (as here) charging another with infringement (e.g. Applicant's letter to Opposer of July 1, 2014 Exhibit E of ESTTA 873126 filed 01/24/2018) "can be disastrous" when the "infringer" or others have priority, 214 214 U.S.P.Q. at 336.

United States Jaycees v. Phila. Jaycees addresses neither genericness nor descriptiveness, but rather deals with a national organization's revocation of a local subsidiary's license based on the local subsidiary's failure to admit women to membership.

Playboy Enters. v. Chuckleberry Publ'g, Inc., deals with a suggestive trademark rather than a descriptive one (206 U.S.P.Q. at 76) and the trademark owner had been "diligent" in defending its mark against competing uses (*id* at 78). Other than Applicant's cross-accusation against Opposer (following Opposer's discovery of Applicant's URL poaching) Applicant has submitted no evidence of any enforcement efforts against anyone; e.g., Scribner, Robert, Pages 129:25 to 130:5 ESTTA 872251 filed 01/19/2018.

III. OWNERSHIP OF THE MARK

Opposer stands by its position that Tour Management Services does not own the mark. To the extent that Mr. Scribner testified that an assignment document existed, his testimony is uncorroborated. As for Applicant's disingenuous argument that, "at neither time did counsel for Opposer give a deadline," presumably the close of discovery (about three weeks after the November 9 deposition) was the deadline.

Putting aside the several requests made at Mr. Scribner's deposition, Opposer's original Requests for Production served on June 3, 2016 made the same request.⁹

Therefore, Applicant was well aware of its obligation to produce such documentation by the November 28, 2016 close of discovery.

Turning to Applicant's substantive argument, Opposer agrees that Applicant's principal testified that on December 10, 2010, The Kent Group, LLC assigned all of its

⁹ Opposer requested "[a]ll written agreements to which Applicant is or intends to be a party which relate to the acquisition of, and/or actual or intended use, promotion, and /or licensing of Applicant's Mark, or any mark utilizing the terms " CHARLESTON HARBOR" for Applicant's services." Request # 16.

assets and rights in the Mark to Applicant effective in the tax year 2011. See Scribner declaration, Exhibit B, Document 63 filed October 3, 2018.

Opposer argues, however, that this self-serving statement and the alleged assignment document ([REDACTED] to Scribner declaration, Document 63 filed October 3, 2018) are not only uncorroborated, but are contradicted by official government filings made by Applicant's principal after the alleged transfer of assets occurred. See Exhibit V, ESTTA935945 (evidencing that on March 22, 2017, The Kent Group, LLC is still identified as the owner of the Carolina Belle on United States Federal Communications Commission Ship Compulsory Equipped License # WDD7269).

Despite Mr. Scribner's assertions that The Kent Group, LLC "assigned all of its assets and rights to the mark" (Scribner Declaration, Paragraph 6, ESTTA 925941 filed 10/03/2018) prior to filing the instant application, official government records identify The Kent Group, LLC as the owner of the Carolina Belle well after the instant application's July 11, 2014 filing date. Exhibit V, ESTTA935945 filed 11/19/2018.

IV. MISSTATEMENTS OR MIS-IMPLICATIONS OF FACTS

A. *Opposer's descriptive use of the mark*

Applicant states (page 24 of Applicant's Brief) that Opposer *admits* that "there is no evidence of SpiritLine using the phrase 'Charleston Harbor Tours' from 1993-1997." In reality, Opposer testified SpiritLine Cruises was first formed in 1997 as a sister company to Fort Sumter Tours, and Opposer submitted evidence of use of the phrase from at least as early as 1995 (Mosteller Declaration at paragraphs 16-17, Document 42, ESTTA 874779).

Applicant argues (again on page 24) that “Opposer’s own cited evidence of use (and its testimony) demonstrate that between 2003 and the time when Opposer learned of Applicant’s application (late 2014), Opposer used the phrase “Charleston Harbor Tours” only once. See 30(b)(6) Mosteller Dep., 67 TTABVUE 283, Exh. 107.” In reality Opposer testified that it continuously advertised its “Charleston Harbor Tour,” from 2008 through 2012 via the combined Fort Sumter Tours and SpiritLine website (See Mosteller Affidavit Para. 61-64 and SLC000928, SLC000945, SLC001024 and SLC001025).

On page 20, paragraph 27 of Applicant’s Brief, Applicant further suggests that Opposer first used the “Charleston Harbor Tour” phrase on its website on October 19, 2014, after Applicant filed the instant application for federal registration. In reality, Opposer’s predecessor and sister company Fort Sumter Tours printed and distributed at least 100,000 rack cards using “The Charleston Harbor Tour” in 1995 and 125,000 more in 1997 (Harris Declaration, ESTTA 874797 filed 02/01/2018, paragraphs 15-19, Exhibit J). Opposer and Opposer’s predecessor also used the type of “confusing similar” language Applicant seeks to protect—footnote 10 of Applicants Trial Brief—descriptive phrases on at least 620,000 brochures or rack cards between 1993 and 2014. *Id* at paragraphs 20-25.

From late 2013 through 2014, Opposer updated its website to describe its Charleston Harbor tours with substantially similar terminology as “Charleston Sightseeing Harbor Tours,”(See Mosteller Affidavit Para. 65-66 and Document No. SLC001026-SLC001027).

Opposer also produced a 2014 trade show advertisement, of which numerous copies were distributed advertising Opposer’s “Charleston Harbor Tours.” (See 30(b)(6)

Mosteller Dep., 67 TTABVUE 283, Exh. 107; note that this is, for some reason, the only piece of evidence Applicant has properly acknowledged). As testified to by Joyce Lowe (ESTTA 974956 filed 05/20/2019), a witness proffered by Applicant, such trade shows were a large part of her work on behalf of SpiritLine Cruises and Fort Sumter Tours, she attended between 4 and 6 shows each year, with attendance ranging from hundreds to thousands at each show, and with 40-60 direct in-person meetings at each show.

In 2015, Opposer again updated its website to describe its Charleston Harbor tours with as "SpiritLine Cruises' Charleston Harbor Tour" (See Mosteller Affidavit Para. 70 and Document No. Document No. SLC001028 and SLC000970, all part of ESTTA 874779 filed 02/01/2018).

B. Admissibility of the Wayback Machine Webpages

Applicant argues that Opposer's Wayback Machine printouts have no probative value.

Opposer's Wayback Machine printouts, however, have been authenticated by multiple witnesses and prove what they show on their face—that the underlying words appeared on the page on the indicated date. With respect to a standard character mark and a 2(f) declaration, these words are sufficient regardless of the manner in which a browser and a printer render other elements such as photographs.

Therefore, Applicant's objections to Wayback Machine printouts lacks legal basis from both a trademark and an admissibility standpoint. (See Applicant's Brief, page 27).

C. Christopher Butler's testimony

Page 30 of Applicant's Brief misstates Christopher Butler's testimony as "a user may click on a particular date and actually be served data from the next closest point in time

to that date which they are seeing, from which statement Applicant argues that captured pages may not accurately reflect their indicated date.

As Mr. Butler testified, however, if a webpage was not captured for the date a user sought, the Internet Archive will produce the next most recent Web capture and display the capture time and date *of the produced page*. 84 TTABVUE 12:18-15:4. Therefore, the dates and time displayed on all Wayback Machine Webpage captures are, in fact, accurate.

D. Bryan Collins's testimony

Applicant states on page 40 of its Brief that "Sandlapper Tours' website has remained the same since 2011, and has not used the phrase 'Charleston Harbor Tours' at all during that time." In reality, and as set out clearly in the very pages cited by Applicant, Bryan Collins testified that Sandlapper Tours had not used the exact phrase "Charleston Harbor Tours" in plural form in its printed "rack cards and brochures," but that it may have used the singular form of the phrase in print advertising. (See 87 TTABVUE 39:11-40:3). Bryan Collins also repeatedly confirmed that the webpages in Exhibit Q were accurate printouts of the Sandlapper website from the indicated years. (See e.g., 87 TTABVUE 30:4 "it did look like this" and 30:12 "this looks to be exactly right").

On page on 40 of its Brief, Applicant attempts to argue and emphasize that the pages in Exhibit Q contained (in Applicant's words) "substantive differences, not just printing differences."

Bryan Collins, however, testified that the webpage printouts in Exhibit Q were, in fact, accurate representations of the Sandlapper website at the indicated dates according

to his recollection and merely omitted certain digital images and moving pictures, now indicated by a missing image icon. See 87 TTABVUE 32:20-24, "Minus the digital stuff that I mentioned, the shells in the background. · But as far as verbiage and the layout, it is -- I mean, that's basically -- that would -- it all looks pretty accurate to me;" See also 87 TTABVUE 33:21-23, "Well, right here on the left side you'll see that little icon thing, that's where there was a picture at one time;" See also 87 TTABVUE 34:7-8, "But as far as text goes, it would be the text minus the pictures;" See also 87 TTABVUE 28:6-29:5 regarding Sandlapper's use of moving pictures.

Web browsers and printers necessarily reformat and resize the underlying Web page content to fit on a printed page. Applicant somehow concludes that such minor variations between on-screen Web pages and printed pages amount to "substantive differences" such that said printouts are not accurate representations of the underlying pages. Applicant, however, has failed to point to a single case or reference in which the text on a printed Web page is deemed inadmissible because of these visual differences.

E. Abigail Cummings's testimony

Applicant misstates Abigail Cummings's testimony and concludes that the printed Web pages attached to her testimony as Exhibit R contained "major modification" from the Web pages she had viewed and printed and thus did not fairly and accurately reflect the pages as she saw them on Google Chrome.

Again, Applicant has failed to point to a single case or reference in which the text on a printed Web page is deemed inadmissible because of formatting and image display differences between online Web page displays and printed pages. Despite Applicant's

attempts to seek Ms. Cummings' denial that Web pages in Exhibit R were accurate, Ms. Cummings repeatedly authenticated the pages in Exhibit R as accurate.

Applicant suggests that the standard html tool of "Id_" to reveal the Web capture exactly as it was taken (without any archival-specific information), somehow amounted to "added new content" (See Applicant's Brief, page 32). This completely misstates the effect of the "id_" html tool, and is irrelevant because each document in Exhibit R attached to Ms. Cummings's affidavit reflects both the date Ms. Cummings accessed said page and the exact URL where it was accessed, including the "id_" html code.

F. All third-party witnesses

Applicant's attack on all of Opposer's third-party witnesses could support a lengthy rebuttal, but for brevity, Opposer points out the following.

First, it is entirely irrelevant if a third-party user of a descriptive phrase ever uses that phrase to refer to itself as "Charleston Harbor Tours." The issue is third-party *descriptive* uses of the phrase, not trademark uses. Second, contrary to Applicant's statement on page 43 of its Brief, Applicant has failed to provide any evidence of public's perception of the mark other than the Benthall and Doyle hearsay, including a lack of surveys of the relevant purchasing public or customer testimonials. Fed. R. Evid. 801 (c); See e.g., Applicant's Brief at page 41, paragraph 7 and page 19 number 20.

V. SUMMARY AND CONCLUSIONS

If one were to summarize or "theme" Applicant's case from discovery, through the summary judgment motion, through the trial intervals, and now into trial briefing, it is

the assertion of Mr. Scribner's uncorroborated opinion that he should win purely based on an "amount of" (use or spending) contest.¹⁰

Ultimately, however, Applicant's case fails because (i) Applicant's case law, when viewed properly, supports Opposer rather than Applicant; (ii) Applicant has failed to produce a single item of testimony or evidence from the relevant purchasing public supporting secondary meaning or distinctiveness; (iii) Applicant's spending assertions are unconnected to any actual use, are blended with co-promotions and brands of others, and are comingled with Applicant's own infringing use of Opposer's registered trademarks;¹¹ (iv) Applicant's digital "advertising" exhibits are unconnected to any proof that any actually were used in commerce in the trademark sense; and (v) Applicant's assertions that "everybody else was insubstantial" are merely the opinion of Applicant's principal and are contradicted by all of Opposer's witnesses.

For at least these reasons, the Board should refuse to register Serial No. 86337681.

Respectfully submitted,
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Philip Summa
Rebeca Harasimowicz

ATTORNEYS FOR OPPOSER
SPIRITLINE CRUISES, LLC

¹⁰ Mr. Scribner is the interested party in this opposition rather than an expert witness or a survey witness, or any other witness qualified to offer an opinion as to the significance or insignificance of his competitors or other boat tour operators and their descriptive use of Charleston Harbor tours.

¹¹ Not a single one of the exhibits proffered by defendant use "TM" or "SM" and many are based upon other marks or phrases that are far more dominant in those exhibits than is "Charleston Harbor Tours."

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Certificate of Service

This is to certify that I have this 10th day of June 2019 served a copy of the foregoing Opposer's Trial Brief upon all counsel of record by depositing the same in the US mail with sufficient postage affixed, addressed as follows:

Edward T. Fenno
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171 Church St., Suite 160
Charleston, SC 29401

Respectfully submitted,
SUMMA PLLC

/Philip Summa/
Philip Summa

APPENDIX I

Applicant's Objections to Applicant's Untimely Filing of Evidence

With respect to footnote 4 on page 13 of Applicant's trial brief, Applicant conveniently fails to mention that the submitted items—Nos. 83–92 in the TTABVUE record—were delivered to opposer on May 20, 22, and 24, 2019; i.e., approximately 3 1/2 weeks after Opposer filed its trial brief (April 26, 2019), ***more than 8 1/2 months*** after the August 31, 2018 close of Applicant's trial period, and more than eight (8) months after the September 15, 2018 close of Opposer's rebuttal period.

This late presentation of evidence without notice to or consent from Opposer, without motion to the Board, and without any stated rationale, would seem to be entirely in conflict with 37 C.F.R. 2.121 and TTAB Rule 701, and cannot possibly be “prompt.” The presumed remedy would be to preclude Applicant from relying on such evidence and Opposer respectfully requests this remedy.

Applicant's footnote likewise omits the inconvenient fact that items 83-92 (including exhibits) represent the deposition testimony of eight (8) witnesses and includes a total of 1438 pages. In submitting these items, Applicant relies on comments or footnotes to the CFR, or the TBMP, along with yet another footnote from *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2D 1390, (T.T.A.B. 1991).

None of (1) comments to the CFR, (2) footnotes to the TBMP, or (3) footnotes to a particular T.T.A.B. decision (apparently followed only once on this point in a non-precedential opinion, *Conde v. Operation Pedro Pan Group, Inc.*, 2009 TTAB LEXIS 705 (T.T.A.B. 2009)) should be binding on the T.T.A.B. in this opposition.

The Supreme Court acknowledged the analogous precedential distinction between district courts and the circuit courts of appeal in *Gasperini v. Center for Humanities, Inc.*, 518 U.S. 415, 116 S. Ct. 2211, 135 L. Ed. 2d 659 (1996): “If there is a federal district court

standard, it must come from the Court of Appeals, not from the over 40 district court judges in the Southern District of New York, each of whom sits alone and renders decisions not binding on the others," *id.* at 430 n.10, and in *Camreta v. Greene*, 131 S.Ct. 2020, 179 L. Ed. 2d 1118 (2011): "A decision of a federal district court judge is not binding precedent in either a different judicial district, the same judicial district, or even upon the same judge in a different case." *Id.* at 2033 n.7 (quoting 18 James Wm. Moore, *Moore's Fed. Practice* § 134.02[1][d], at p. 134-26 (3d ed. rev. 2011)).

Accordingly, Applicant's May 20, 2019 submission of documents to the Board at TTABVUE Nos. 83–92 are untimely without any explanation for their untimely submission.