

ESTTA Tracking number: **ESTTA792539**

Filing date: **12/30/2016**

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

Proceeding	91226018
Party	Plaintiff G. Michael Roebuck, P.C.
Correspondence Address	G MICHAEL ROEBUCK MICHAEL ROEBUCK PC 6750 WEST LOOP SOUTH SUITE 920 BELLAIRE, TX 77401 UNITED STATES mroebuck@roebuckiplaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	G. Michael Roebuck
Filer's e-mail	mroebuck@roebuckiplaw.com
Signature	/G. Michael Roebuck/
Date	12/30/2016
Attachments	Motion to AMEND Notice of Opposition Final.pdf(22052 bytes) AMENDED Notice of Opposition Final.pdf(40989 bytes)

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

G. Michael Roebuck, PC,
Opposer,

vs

Wild Rabbit, LLC

§ Mark: RABBIT WILDE
§
§
§ Serial No. 86609919
§
§ Filed: April 25, 2015
§
§ Opposition No. 91226018

**OPPOSER’S MOTION FOR LEAVE TO AMEND PLEADINGS
NOTICE OF OPPOSITION**

Pursuant to Fed. R. Civ. P. 15 (c) (1) (B), Opposer moves for Leave to Amend Pleadings and to submit an Opposer’s First Amended Notice of Opposition. In the original Notice of Opposition, Opposer stated, “Opposer owns 1 trademark registration, 4 trademark applications and common law rights, in the Marks ‘Wild Rabbit Salad’ and ‘Wild Rabbit’ in classes 9 and 41, and the Wild Rabbit Logo”. After the instant Opposition was filed, Opposer submitted trademark applications for Wild Rabbit and Wild Rabbit Salad in Class 9. The mark for Wild Rabbit has registered. Thus, Opposer has amended the notice of Opposition to include this trademark registration and trademark application. Opposer has also added grounds relevant to Applicant’s acts that diminish the good will in the Opposer’s marks.

The amended portion for the added trademark application and registration states:

1. Opposer owns 1 trademark registration, 4 trademark applications and common law rights, in the Marks “Wild Rabbit Salad” and “Wild Rabbit” in classes 9 and 41, and the Wild Rabbit Logo described below and hereinafter collectively referred to herein as “The Opposer’s Marks”. Opposer owns the trademark registration no 4055935 “Wild Rabbit

Salad” for “Entertainment, namely, live performances by a musical band” Registered on November 15, 2011. Opposer has used the mark” Wild Rabbit Salad” in commerce in the class 41 for “Entertainment, namely, live performances by a musical band” continuously at least as early as September 18, 2009. Opposer filed for the registration on March 29, 2011. Opposer owns trademark application no 87107414 for Wild Rabbit Salad for “Entertainment, namely, live performances by a musical band” in class 9. Opposer began using the mark in class 41 at least as early as August 17, 2014.

2. Opposer owns the trademark registration no 4999853 for Wild Rabbit for “Entertainment, namely, live performances by a musical band” in class 9 and trademark application 87107471 for Wild Rabbit “Entertainment, namely, live performances by a musical band” in class 41.

Respectfully submitted,

Date: December 30, 2016

/G. Michael Roebuck/
G. Michael Roebuck
Reg. No. 35,662
Frost Bank Building, Suite 920
6750 West Loop South
Bellaire, Texas 77401
Telephone: 713-400-1100
Facsimile: 713-349-8755
OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer's Motion to Amend Notice of Opposition has been served on opposing counsel by emailing and mailing said copy on December 30, 2016, via first class mailed, postage prepaid to:

Derek Quick
Strasburger & Price, LLP
720 Brazos Street, Suite 700
Austin, TX 78701

/G. Michael Roebuck/

G. Michael Roebuck

December 30, 2016

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

G. Michael Roebuck, PC, Opposer,	§	Mark: RABBIT WILDE
	§	
	§	
vs	§	Serial No. 86609919
	§	
Wild Rabbit, LLC	§	Filed: April 25, 2015
	§	
	§	Opposition No. 91226018

OPPOSER’S FIRST AMENDED NOTICE OF OPPOSITION

Pursuant to Fed. R. Civ. P. 15 (c) (1) (B), Opposer Submits this First Amended Notice of Opposition. In the matter of application Serial No. 86609919 filed on April 25, 2015 by Applicant, Wild Rabbit, LLC (Applicant), a Colorado Corporation to register Rabbit Wilde as trademark for use in connection with “Entertainment, namely, live music concerts” in Class 41 and “Audio and video recordings featuring music and artistic performances” in Class 9, which was published in the Official Gazette on October 27, 2015. Opposer G. Michael Roebuck, PC, a Professional Corporation whose address is 6750 West Loop South, Suite 920, Bellaire, Texas 77401, Opposer timely file a Notice of Opposition to initiate this opposition.

Opposer pleads and avers as follows:

1. Opposer files this First Amended Notice of Opposition.
2. Opposer owns 2 trademark registrations, 3 trademark applications and common law rights, in the Marks “Wild Rabbit Salad” and “Wild Rabbit” in classes 9 and 41, and the Wild Rabbit Logo described below and hereinafter collectively referred to herein as “The Opposer’s Marks”. Opposer owns the trademark registration no 4055935 “Wild Rabbit Salad” for “Entertainment, namely, live performances by a musical band” Registered on

November 15, 2011. Opposer has used the mark "Wild Rabbit Salad" in commerce in the class 41 for "Entertainment, namely, live performances by a musical band" continuously at least as early as September 18, 2009. Opposer filed for the registration on March 29, 2011. Opposer owns trademark application no 87107414 for Wild Rabbit Salad for "Entertainment, namely, live performances by a musical band" in class 9. Opposer began using the mark in class 41 at least as early as August 17, 2014.

3. Opposer owns the trademark registration no 4999853 for Wild Rabbit in class 9 and trademark application 87107471 for Wild Rabbit in class 41.
4. Opposer owns the trademark application no 86574463 for Wild Rabbit Logo.
5. Opposer owns the common law rights in the mark "Wild Rabbit Salad" for "Audio and video recordings featuring music and artistic performances" in Class 9. Opposer has used the mark Wild Rabbit Salad in commerce in the class 9 for "Audio and video recordings featuring music and artistic performances" continuously. Opposer owns the proprietary common law rights to the Opposer's marks, Wild Rabbit, Wild Rabbit Salad and Wild Rabbit Logo based on Opposer's use of the marks in commerce in the classes of Live Musical Performances by a band, Musical Recordings and Tee shirts.
6. There is no issue as to priority as the Applicant has not alleged use of mark Rabbit Wilde in its Intent to Use Trademark Application serial number serial number 86609919, opposed herein. Moreover, Opposer has been using the mark since 2009, long before the Applicant adopted the mark. Opposer expanded into a natural zone of expansion for live performance of music by a band in class 41 to live recordings of its music in class 9 at least as early as August 17, 2014 and intends to introduce evidence to establish use in class 9 as early as 2012.

7. The Applicant is seeking registration in same classes 9 and 41 as described above that the Opposer possesses registered and common law rights in the Opposer's Marks, "Wild Rabbit Salad" and "Wild Rabbit" and the Wild Rabbit Logo.
8. The Opposer's marks are strong arbitrary marks deserving broad protection. The Opposer's mark are strong also because the Opposer has continuously promoted and advertised the Opposer's marks on good and services for live musical performances in class 41 and musical recordings in class 9 using the mark.
9. **Actual confusion** between the registered mark "Wild Rabbit Salad" and the proposed mark "Rabbit Wilde" has already occurred in both class 9 and class 41.
10. The dominant feature of the Opposer's Marks "Wild Rabbit Salad" and "Wild Rabbit" is "Wild Rabbit". Applicant's proposed mark is "Rabbit Wilde". Applicant's proposed mark and the dominant feature of the Opposer's marks are essentially identical. Reversing the order of elements in a mark, does nothing to avoid confusion between the reversed elements from the mark. i.e., changing "Wild Rabbit" to "Rabbit Wilde", does not address the Applicant's obligation to avoid confusion with a senior mark. Moreover, Applicant has admitted that Wild Rabbit is confusingly similar to Rabbit Wilde by threatening to sue Opposer for use of Wild Rabbit as confusingly similar to Rabbit Wilde.
11. The Applicant has an obligation to avoid confusion with a senior mark, however, instead of avoiding confusion, the Applicant is inducing confusion between the Opposer's mark and the Applicant's proposed mark. Applicant is using all three marks currently on the same products. Searches for Wild Rabbit on Google and Bing point to Rabbit Wilde. Applicant is redirecting traffic for example, the Applicant's web site and music using the meta tag "Wild Rabbit" in its Rabbit Wilde website and has apparently created meta tags

“Wild Rabbit” on Facebook, Twitter, Instagram, YouTube, Magnify, Spotify and iTunes, Kickstarter, Magnifi.FM as both Google searches and Bing searches for “Wild Rabbit” redirect the searcher to Applicant’s “Rabbit Wilde” web site and music on iTunes, Spotify and other music performance and music streaming and music selling web sites and services. The Opposer and Applicant use the same channels of trade and advertising to market recorded music and perform live musical performances. Applicant and Opposer have played the same venues and sold their music on the same platforms. Applicant’s HTML code for its Rabbit Wilde website includes 5 Meta tags for “WildRabbitMusic”, 12 Meta tags for “Wild Rabbit”, 71 Meta tags for “Wild” 77 Meta tags for “Rabbit” and 7 Meta tags for “Bre’r Rabbit”. Applicant is selling CDs and music online using the mark Wild Rabbit. WildRabbitMusic, Wild Rabbit, LLC, Wild Rabbit are all confusingly similar to the Opposer’s marks. Applicant uses a similar trade dress as Opposer’s trade dress, for example, combining the mark Rabbit Wilde surrounding an image of a rabbit’s head on the bass drum during live musical performances. Thus, this enhanced similarity contributes to the likelihood of confusion. The contextual evidence of Applicant’s retention of the rabbit head along with the Rabbit Wilde mark use of Wild Rabbit Meta tags and Applicant’s continued use of all three marks (Bre’r Rabbit, Wild Rabbit and Rabbit Wilde) on the same products constitutes evidence that the Applicant intended to cause confusion.

12. Applicant is still using wildrabbitmusic.com and has named its company Wild Rabbit, LLC, which was hastily formed after abandoned its original name, “Bre’r Rabbit” it had been using for two years. Applicant had been using the mark Wild Rabbit for about 1 month when Opposer sent a demand letter to cease and desist using the name “Wild

Rabbit”, which was followed by the federal law suit for trademark infringement and cancellation of the Applicant’s application for the mark “Wild Rabbit”.

13. Opposer sued Applicant in Federal Court for Trademark infringement for using the mark Wild Rabbit. The Applicant had applied for a trademark for “Wild Rabbit” in classes 9 and 41 as described above, now abandoned. Opposer dismissed the suit without prejudice to pursue the issue of likelihood of confusion and seniority on the applied for mark in the Trademark Trial and Appeal board. Opposer advised the Applicant that Opposer had dismissed the law suit and would instead pursue the issue of likelihood of confusion and seniority in the Trademark Trial and Appeal board. The Applicant then summarily cancelled Applicant’s trademark application serial number 86564331 for the Wild Rabbit mark. The Applicant also filed a trademark application for the mark now opposed, Rabbit Wilde. Opposer had previously told the Applicant that reversing the order of the elements of the mark from Wild Rabbit to Rabbit Wilde had little or no bearing or significance in avoiding a likelihood of confusion with the Opposer’s marks.

14. Upon information and belief, Applicant’s cancellation of its trademark application for the mark “Wild Rabbit” and adaptation of the mark “Rabbit Wilde” with knowledge that the Applicant’s application for the mark “Wild Rabbit” would be opposed constitutes prejudice and an admission against interest by the Applicant that the Applicant’s applied for mark for “Wild Rabbit” is confusingly similar to the registered mark “Wild Rabbit Salad”. Likewise, the applied for mark of the elements reversed, “Rabbit Wilde” is confusingly similar with the mark registered Wild Rabbit Salad as well as Opposer’s other registered, applied for and common law rights in the Opposer’s marks. Reversal of the elements of a mark of the mark does little or nothing to obviate a

likelihood of confusion. Opposer communicated with the Applicant and cited case law regarding the negligible effect of reversing the elements of the mark to avoid confusion and requested that Applicant not choose the name Rabbit Wild. Moreover, adding the letter “e” to the reversed mark to form “Rabbit Wilde” has negligible effect on avoiding confusion between the marks as Rabbit Wild and Rabbit Wilde are phonetically identical. Moreover, Applicant has admitted that Wild Rabbit is confusingly similar to Rabbit Wilde in threatening litigation for use of the Mark Wild Rabbit as confusingly similar to Rabbit Wilde. Moreover, upon information and belief, the Applicant has committed acts that diminish the good will in the Opposer’s marks. Applicant has made disparaging remarks about the quality of goods and services provided by Opposer.

15. Upon information and belief, there is a likelihood of confusion, mistake or deception as to the source or origin of Applicant’s goods by creating the erroneous impression that Applicant’s goods originate with, are sponsored, approved, endorsed or licensed by, are affiliated or associate with, or are in some way connected to Opposer.

16. Upon information and belief, the granting of a trademark registration for the Rabbit Wilde mark to Applicant would be contrary to 15 USC § 1052(d) and would diminish the prior and superior rights of the Opposer the Opposer’s Marks and in Opposer’s “Wild Rabbit Salad” and “Wild Rabbit” and Logo trademarks. Upon information and belief there is likelihood of confusion, mistake or deception as to the source or origin of Applicant’s goods by creating the erroneous impression that Applicant’s goods originate with, are sponsored, approved, endorsed or licensed by, are affiliated or associate with, or are in some way connected to Opposer.

17. Upon information and belief, there is overlap between the goods and services listed in the Opposer's registrations and common law rights the Opposer's marks including but not limited to the Opposer's rights in the "Wild Rabbit Salad" and "Wild Rabbit" and Logo trademarks and Applicant's application. Thus, there is a basis for a likelihood of confusion the Opposer's registration and Applicant's application and the Opposition should be dismissed.

WHEREFORE, Applicant asks the opposition no. 91226018 to Application Serial Number 8609919 be granted and that the Applicant's proposed registration be refused in favor of Opposer.

Respectfully submitted,

Date: December 30, 2016

/G. Michael Roebuck/
G. Michael Roebuck
Reg. No. 35,662
Frost Bank Building, Suite 920
6750 West Loop South
Bellaire, Texas 77401
Telephone: 713-400-1100
Facsimile: 713-349-8755
OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer's Notice of Opposition has been served on opposing counsel by mailing said copy on December 30, 2016, via first class mailed, postage prepaid to:

Derek Quick
Strasburger & Price, LLP
720 Brazos Street, Suite 700
Austin, TX 78701

/G. Michael Roebuck/

G. Michael Roebuck

December 30, 2016