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Filing date: **07/08/2016**

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

Proceeding	91226857
Party	Plaintiff Tao Licensing LLC
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Date	07/08/2016
Attachments	2016-07-08 Opposition to 2nd Motion to Amend.pdf(1527312 bytes )

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

In the Matter of Trademark Application:

Serial No. : 86/736,663  
Applicant : POA GROUP LLC  
Filed : August 25, 2015



Mark :  
Published in the *Official Gazette* of January 12, 2016

TAO LICENSING LLC,

*Opposer,*

v.

POA GROUP LLC,

*Applicant.*

Opposition No. 91226857

**OPPOSER'S RESPONSE IN OPPOSITION TO  
APPLICANT'S SECOND MOTION TO AMEND ITS APPLICATION**

**I. INTRODUCTION**

Opposer Tao Licensing LLC (“Opposer” or “Tao Licensing”) submits this memorandum in opposition to Applicant POA Group LLC’s (“Applicant”) *second* motion to amend the identification of goods and services for the above-captioned application (the “Application”), and to amend the Application so that it may retroactively claim a §1(b) (intent-to-use) filing basis as of the date of its Application for its class 35 and 36 services. (*See* D.I. 14) (“Applicant’s *Second* Motion to Amend”). Section 514.01 of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TMBP”) and established Board practice make clear that once an opposition

proceeding has commenced, the application at issue may not be amended except with the consent of the petitioner and approval of the Board, or upon motion granted by the Board. Applicant has now submitted two motions to amend which are presently before the Board.

As stated in Opposer's opposition to Applicant's *first* motion to amend (D.I. 8) ("Applicant's *First* Motion to Amend"), Applicant has neither given a reason for its requested amendments, nor has it stated that it would accept judgment with respect to the deleted goods and services. (See D.I. 12)<sup>1</sup> ("Opposer's Opposition to Applicant's First Motion to Amend"). Applicant has also failed to provide any evidence that the proposed amendments are factually accurate, as it is clear Applicant's allegation of use in commerce in its application for TOA ASIAN FUSION ("Applicant's Mark") is based entirely on a single, standalone restaurant that is far from another state. Applicant has presented no evidence to suggest that it had a *bona fide* intent to use (let alone any actual use of) Applicant's Mark in interstate commerce *as of the date of the application*.

Applicant's second bite of the proverbial apple seeks to remedy the errors of its declaration in support of its proposed amendment; however, Applicant has once again failed to provide *any justification* for its proposed amendments. Accordingly, Opposer does not consent to either amendment, reaffirms its opposition herein, and respectfully requests that the Board deny Applicant's *Second* Motion to Amend.

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<sup>1</sup> Opposer notes to the Board that although the certificate of service for its opposition brief to Applicant's *First* Motion to Amend only provided a physical address, the certificate indicates that its brief had been served "by first class mail, postage prepaid, *and email*." (See D.I. 12). Opposer inadvertently did not send a second, courtesy copy of its brief via email to Applicant's counsel, and apologies for that error.

**II. BACKGROUND**

Opposer is the owner of the widely-successful and world-renowned TAO restaurants and nightclubs, located in Las Vegas and New York (the “TAO Venues”). The TAO Venues are some of the largest, busiest, and most well-known restaurant and entertainment venues in the United States, with the first restaurant opening in 2000 and the venues now frequented by millions of people each year. Tao Licensing has generated hundreds of millions of dollars’ worth of revenue each year at its Tao Venues.

Opposer also owns U.S. Trademark Registration No. 2,472,393, issued July 24, 2001, for TAO in Class 42, in connection with “Restaurant services”, and U.S. Trademark Registration No. 3,770,321, issued April 6, 2010, for TAO in Class 41, in connection with “Night clubs, special events and party planning; and coordinating and providing facilities for entertainment events in the nature of parties and special events featuring music, singing, dancing, lectures, and celebrity or professional entertainment.” Copies of Opposer’s registrations are attached hereto as **Exhibit “A.”**

Applicant filed the Application on August 25, 2015 (the “Application Date”), claiming use in commerce pursuant to Section 1(a) of the Lanham Act, and alleging that Applicant’s Mark was first used in commerce in connection with a litany of restaurant related services in classes 35, 36, and 43 (the “Applied-For Services”) on July 10, 2015. Applicant’s Motion to Amend seeks to delete most of these Services from the Application, and change the basis for the below remaining services to an intent-to-use:

<b>Class</b>	<b>Revised Services</b>	<b>Revised Filing Basis</b>
35	Restaurant franchising, namely, offering business management assistance in the establishment and/or operation of restaurants; Restaurant management for others	1(b)

Class	Revised Services	Revised Filing Basis
36	Franchising services, namely, providing financial information and advice regarding the establishment and/or operation of restaurants	1(b)
43	Bar and restaurant services; catering services; take-out restaurant services	1(a)

(the “Amended Applied-For Services”).

### III. ARGUMENT

Despite Applicant’s oath to the USPTO that it had *actual* use in commerce for the Applied-For Services, as set forth in Opposer’s Notice of Opposition it remains clear that Applicant had no use of Applicant’s Mark in interstate commerce as of the Application Date. To circumvent this blatant deficiency, Applicant, once again, seeks to delete most of these services, and change the basis for the Amended Services to an *intent-to-use* basis. Importantly, however, Applicant has not consented to entry of judgment as to the likelihood of confusion between Opposer’s TAO mark and Applicant’s Mark for the many services it now seeks to delete. *Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1433, 1435 (T.T.A.B. 2007). As pointed out by the Board in *Drive Trademark Holdings LP*,

[i]f [an applicant] wishes to avoid the possibility of a res judicata effect of the entry of judgment, an applicant seeking to amend its identification of goods or recitation of services must set forth adequate reasons for the amendment. . . . That is, [the applicant] must make a prima facie showing that the proposed amendment serves to change the nature and character of the goods and services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the [proceeding] against the application based on the original identification of goods and services.

*Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1433, 1435 (T.T.A.B. 2007); *see also* TBMP §514.03. Similar to Applicant’s *First Motion to Amend*, Applicant’s *Second Motion to*

Amend does not concede judgment with respect to the deleted services, and utterly fails to make any of the required showings. On those grounds alone, Applicant's motion should be denied.

Notwithstanding Applicant's failure to make these required showings, Applicant's Mark is confusingly similar to Petitioner's world famous TAO branded restaurants and nightclubs. Thus, Applicant's request to delete all of the Applied-For Services except for restaurant and bar and franchising services does not narrow the issues before the Board, and does not serve to change the nature and character of the goods and services or to restrict their channels of trade. *Quicksilver, Inc. v. Tiffany & Broadway, Inc.*, Opposition No. 107,511, 2000 TTAB LEXIS 526, at \*15 n.10 (T.T.A.B. July 26, 2000) (given the broadness of Opposer's purported rights in footwear, "applicant's proposed amendment would not serve to avoid a likelihood of confusion since ladies' dress shoes are plainly a type of 'footwear'"); *see also Adams & Brooks, Inc. v. Morris National, Inc.*, Cancellation No. 92052158, 2013 WL 4397065, at \*4 (T.T.A.B. July 23, 2013) ("In this case, neither petitioner's nor respondent's goods recite any restrictions as type or price range; the trade channels in which they are offered; or the consumers to whom they are marketed. Thus, respondent's extensive argument and evidence that the trade channels and conditions of sale are different is misplaced.").

Second, amending the Application's filing basis for its Class 35 and 36 services would constitute a substantive amendment and should only be permitted if Applicant can show some legal or factual justification for the amendment. TBMP §514.01. However, Applicant's *Second Motion to Amend* contains no justification why it is suddenly seeking to amend its filing basis. As set forth in Opposer's Amended Notice of Opposition, Applicant operates a single, standalone restaurant located at 369 Huntington Avenue, Huntington, N.Y. 11743 (a copy of Applicant's website for its "TOA Asian Fusion" restaurant is attached hereto as **Exhibit "B"**).

See D.I. 6, §§ 28-36. On information and belief, the Application was filed solely based on the use of Applicant's Mark in connection with this restaurant. There is no evidence to suggest that Applicant had any actual or *bona fide* intent to use the TOA Asian Fusion Mark in interstate commerce sufficient to support a trademark registration. See *Doctor's Associates Inc. v. Janco, LLC*, Opposition No. 91217243, 2016 WL 247200 (T.T.A.B. January 7, 2016) (a standalone restaurant must show some form of marketing to interstate commerce beyond the presence of a mere website or social media in order to show use in commerce).

### CONCLUSION

Allowing the requested amendment will not eliminate the likelihood of confusion, nor has Applicant accepted judgment with respect to the deleted goods and services. Accordingly, Opposer respectfully requests that for all the reasons set forth above, the Board deny Applicant's Motion to Amend.

If the Board grants Applicant's Motion to Amend, Opposer respectfully requests permission to file a second Amended Notice of Opposition so it may incorporate claims related to Applicant's purported *bona fide* intent to use Applicant's Mark.

Respectfully submitted,

KENYON & KENYON LLP

Dated: July 8, 2016

By: /Howard J. Shire/  
Howard J. Shire  
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*Counsel for Opposer  
Tao Licensing LLC*

# **EXHIBIT A**



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## TAO

**Word Mark** TAO  
**Goods and Services** IC 042. US 100 101. G & S: Restaurant services. FIRST USE: 20001026. FIRST USE IN COMMERCE: 20001026  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 75884286  
**Filing Date** January 3, 2000  
**Current Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** July 25, 2000  
**Registration Number** 2472393  
**Registration Date** July 24, 2001  
**Owner** (REGISTRANT) Asia Five Eight LLC LIMITED LIABILITY COMPANY NEW YORK 42 East 58th Street New York NEW YORK 10022  
 (LAST LISTED OWNER) **TAO LICENSING** LLC LIMITED LIABILITY COMPANY DELAWARE 888 SEVENTH AVENUE, SUITE 3402 NEW YORK NEW YORK 10106  
**Assignment** ASSIGNMENT RECORDED

**Recorded**

**Attorney of Record**

Howard J. Shire, Esq.

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Affidavit Text**

SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110729.

**Renewal**

1ST RENEWAL 20110729

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**Int. Cl.: 42**

**Prior U.S. Cls.: 100 and 101**

**United States Patent and Trademark Office**

**Reg. No. 2,472,393**

**Registered July 24, 2001**

**SERVICE MARK  
PRINCIPAL REGISTER**

**TAO**

ASIA FIVE EIGHT LLC (NEW YORK LIMITED  
LIABILITY COMPANY)  
42 EAST 58TH STREET  
NEW YORK, NY 10022

FIRST USE 10-26-2000; IN COMMERCE 10-26-2000.

SN 75-884,286, FILED 1-3-2000.

FOR: RESTAURANT SERVICES, IN CLASS 42  
(U.S. CLS. 100 AND 101).

ALLISON HALL, EXAMINING ATTORNEY



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# TAO

**Word Mark** TAO

**Translations** The English translation of "TAO" in the mark is the way.

**Goods and Services** IC 041. US 100 101 107. G & S: Night clubs, special events and party planning; and coordinating and providing facilities for entertainment events in the nature of parties and special events featuring music, singing, dancing, lectures, and celebrity or professional entertainment. FIRST USE: 20001026. FIRST USE IN COMMERCE: 20001026

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 77744702

**Filing Date** May 26, 2009

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** January 19, 2010

**Registration Number** 3770321

**Registration Date** April 6, 2010

**Owner** (REGISTRANT) Asia Five Eight LLC LIMITED LIABILITY COMPANY NEW YORK 42 East 58th Street  
New York NEW YORK 10022

(LAST LISTED OWNER) **TAO LICENSING** LLC LIMITED LIABILITY COMPANY DELAWARE 888  
SEVENTH AVENUE, SUITE 3402 NEW YORK NEW YORK 10106

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Howard J. Shire, Esq.

**Prior Registrations** 2472393

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR).

**Live/Dead Indicator** LIVE

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# United States of America

United States Patent and Trademark Office

## TAO

**Reg. No. 3,770,321** ASIA FIVE EIGHT LLC (NEW YORK LIMITED LIABILITY COMPANY)  
Registered Apr. 6, 2010 42 EAST 58TH STREET  
NEW YORK, NY 10022

**Int. Cl.: 41** FOR: NIGHT CLUBS, SPECIAL EVENTS AND PARTY PLANNING; AND COORDINATING AND PROVIDING FACILITIES FOR ENTERTAINMENT EVENTS IN THE NATURE OF PARTIES AND SPECIAL EVENTS FEATURING MUSIC, SINGING, DANCING, LECTURES, AND CELEBRITY OR PROFESSIONAL ENTERTAINMENT, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

**SERVICE MARK**  
**PRINCIPAL REGISTER**

FIRST USE 10-26-2000; IN COMMERCE 10-26-2000.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,472,393.

THE ENGLISH TRANSLATION OF "TAO" IN THE MARK IS THE WAY.

SER. NO. 77-744,702, FILED 5-26-2009.

ALICE BENMAMAN, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

# **EXHIBIT B**





## OUR STORY

Since the 1970s, the creation of fusion cuisine has played an essential role in the development of many contemporary restaurants. ToA, Asian Fusion, is our modern approach in defining Asian fusion. Innovating the best cuisines of the Eastern world is our motto and mission. By combining the essence of Japanese, Chinese, Korean, Thai, Malaysian, Vietnamese cuisine, we transform ordinary ingredients into unexpected and flavorful dishes. Our chefs with years of experience are devoted to creating exquisite culinary delights that will certainly wow your palate.

## MENU

### Dim Sum (4 Pieces Each)

Dim Sum is a style of Cantonese cuisine prepared as small bite-sized portions of food traditionally served in small steamer baskets or on small plates. Dim Sum is also well known for the variety of...



# MENU

## Dim Sum (4 Pieces Each)

*Dim Sum* is a style of Cantonese cuisine prepared as small bite-sized portions of food traditionally served in small steamer baskets or on small plates. *Dim Sum* is also well known for the unique way it is served in some restaurants, whereby fully cooked and ready-to-serve *dim sum* dishes are carted around the restaurant for customers to choose their orders while seated at their tables.

Crystal Seafood Dumpling	\$8	Crystal Pumpkin Dumpling	\$8	Custard Cream Buns	\$6
Crystal Veg Dumpling	\$6	Crystal Dumpling Sampler	\$8	Pan Fried Pork Bun	\$8
Crystal Beef Dumpling	\$8	Lobster/Pork Shumai	\$10/\$8	Steam Chicken Bun (2 Pieces)	\$8

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Huntington, NY 11743

(631) 673 7377



## CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of foregoing **OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S SECOND MOTION TO AMEND ITS APPLICATION** was served by first class mail, postage prepaid, on Applicant's counsel of record on the 8th day of July 2016, at the following address of record:

John G. Tutunjian  
Tutunjian & Bitetto PC  
401 Broadhollow Road, Suite 402  
Melville, NY 11747

By: /Howard J. Shire/  
Howard J. Shire