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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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Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/20/2016
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**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

MOTION TO AMEND NOTICE OF OPPOSITION ON CONSENT

Pursuant to 37 U.S.C. § 2.107, T.B.M.P. § 315, and Fed. R. Civ. P. 15(a), Opposer, Tao Licensing LLC (hereinafter, “Opposer”), respectfully moves on consent of Applicant POA Group LLC (hereinafter, “Applicant:”) for leave to file the attached proposed Amended Notice of Opposition.

“[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.” T.B.M.P. § 315. Opposer submits that the Amended Notice of Opposition does not violate settled law, and there has been no delay to

this proceeding as Applicant has not yet filed its Answer. Lastly, counsel for Applicant provided consent on April 20, 2016 to the undersigned counsel for filing of the foregoing amended Notice Opposition. *See* Fed. R. Civ. P. 15(a); *see also* T.B.M.P. § 315.

Accordingly, Opposer requests that its motion be granted.

Respectfully submitted,

KENYON & KENYON LLP

Date: April 20, 2016

By: /Jeremy S. Boczko/
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

AMENDED NOTICE OF OPPOSITION

Opposer, Tao Licensing LLC (“Tao” or “Opposer”), a corporation existing under the laws of the state of Delaware and having an address of 888 Seventh Avenue, Suite 3402, New York, N.Y. 10106, believing it will be damaged by registration of the below identified design mark whose literal elements are “TOA Asian Fusion” (the “TOA Asian Fusion Mark” or “Applicant’s Mark”), as shown in Application Serial No. 86/736,663 (the “Application”), hereby opposes same.



As grounds for opposition, Tao alleges as follows:

Applicant's Use and Application for the mark "TOA Asian Fusion"

1. Applicant seeks registration of the Toa Asian Fusion Mark as a service mark in International Class 035 for "Advice in the running of establishments as franchises; Assistance in business management and product commercialization, within the framework of a franchise contract; Assistance in franchised commercial business management; Association services, namely, promoting diversity in the restaurant and hotel industries on behalf of employees, vendors, management, and owners; Business management advisory services relating to franchising; Franchise services, namely, offering business management assistance in the establishment and operation of restaurant; Franchising, namely, consultation and assistance in business management, organization and promotion; Franchising, namely, offering business management assistance in the establishment and/or operation of restaurant; Marketing advisory services in the field of restaurant; Marketing services in the field of restaurant; Offering business management assistance in the establishment and/or operation of restaurants; On-line business directories featuring restaurant; On-line ordering services in the field of restaurant take-out and delivery; Promotional services, namely, promoting the goods of others by means of providing online restaurant menus; Providing a website featuring the ratings, reviews and recommendations posted by consumers on restaurants, food and wine for commercial purposes; Providing on-line consumer information concerning the location of mobile

restaurants; Restaurant franchising, namely, offering business management assistance in the establishment and/or operation of restaurants; Restaurant management for others” (the “Class 35 Services”), in International Class 036 for “Franchising services, namely, providing financial information and advice regarding the establishment and/or operation of restaurants” (the “Class 36 Services”), and in International Class 043 for “Bar and restaurant services; Cafeteria and restaurant services; Café and restaurant services; Café-restaurants; Consulting in the field of restaurant menu development; Delicatessen services; Doughnut shops in the nature of a restaurant; Fast-food restaurant services; Fast-food restaurants; Fast-food restaurants and snackbars; Frozen yogurt shop services in the nature of a restaurant; Hotel and restaurant services; Hotel, bar and restaurant services; Hotel, motel, restaurant, bar and catering services; Hotel, restaurant and bar services; Hotel, restaurant and catering services; Ice cream shop services in the nature of a restaurant; Making reservations and bookings for restaurants and meals; Mobile restaurant services; Providing progressive dinner events where participants sample meals and drinks at a series of restaurants; Providing reviews of restaurants; Providing reviews of restaurants and bars; Provision of food and drink in restaurants; Reservation of restaurants; Restaurant; Restaurant and bar information services; Restaurant and bar services; Restaurant and bar services, including restaurant carryout services; Restaurant and café services; Restaurant and catering services; Restaurant and hotel services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services featuring sandwiches; Restaurant services featuring Asian fusion fare; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption

on and off the premises; Restaurant, bar and catering services; Restaurants; Restaurants featuring home delivery; Salad bars; Self service restaurants; Take-out restaurant services” (the Class 43 Services”) (collectively, the “Applied-for Services”).

2. In the Application, Applicant has disclaimed any rights to the “Asian Fusion” portion of Applicant’s Mark apart from the mark as shown.
3. 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 the Applied-for Services on July 10, 2015. The Application was published for opposition on January 12, 2016.
4. Tao timely filed a request for extension of the time to oppose the subject application, and is now filing this Notice of Opposition, all within the prescribed statutory periods.

Opposer’s TAO® Trademark and TAO® Venues

5. Tao owns and operates food and entertainment venues under the mark “TAO” (the “TAO® Mark”) in New York City and Las Vegas (the “TAO® Venues”). The TAO® Venues are some of the largest, busiest, and most well-known food and entertainment venues in the United States, frequented by millions of people each year.
6. The first of the TAO® Venues, opened in New York City in October 2000 and has been operating under the TAO® Mark ever since. It is the largest and busiest Asian restaurant in New York City, and has been visited by millions of people since it opened. Tao has since opened other TAO restaurants in New York City and Las Vegas, and has plans to expand in several other locales in the United States.

7. The TAO® Venues are some of the largest, busiest, and most well-known restaurant and entertainment venues in the United States. Additionally, the TAO® Venues are frequently visited by celebrities and consequently are routinely mentioned in various national publications and media outlets around the country. Millions of dollars are spent each year in advertising and promoting the TAO® Venues.
8. As a result of the long-term, continuous, exclusive and widespread use of the TAO® Mark, and all the advertising and promotional efforts in connection therewith, the TAO® Mark has attained a very high level of recognition among consumers in the United States, and became famous well before Applicant's alleged date of first use.
9. In addition to its common law rights, Tao is the owner of U.S. Trademark Registration No. 2,472,393, issued July 24, 2001, for the TAO® Mark in Class 42 in connection with "Restaurant services", and U.S. Trademark Registration No. 3,770,321, issued April 6, 2010, for the TAO® Mark 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" (the "TAO® Registrations").
10. The TAO® Mark is in full force and effect, and the TAO® Registrations have become incontestable pursuant to Section 15 of the Trademark Act 15 U.S.C. § 1065.
11. Applicant's alleged first use date for Applicant's Mark is July 10, 2015.
12. Applicant claims no rights to Applicant's Mark prior to July 10, 2015.
13. Tao's rights to its TAO mark clearly predate any rights Applicant may have in or to Applicant's Mark. There is no question of priority of rights, and such priority clearly belonging to Tao.

Likelihood of Confusion

14. Opposer re-alleges and incorporates by reference, as though fully set forth herein, each and every allegation contained in the above paragraphs.
15. Applicant's Mark is confusingly similar to Tao's TAO® Mark.
16. Applicant has disclaimed the words "Asian Fusion" from Applicant's Mark, since they are obviously the generic term for a particular type of food sold at Applicant's restaurant.
17. Consequently, consumers only recognize "TOA" as identifying a source of origin for the Applied-for Services
18. The "TOA" element of Applicant's Mark appears in substantially larger font and stylization than the words "Asian Fusion". Thus, "TOA" is the most prominent element of Applicant's Mark
19. "TOA" is nearly identical (both visually and phonetically) to Opposer's TAO Mark.
20. The Applied-for Services are identical or closely related to the services that Tao offers under its famous TAO® Mark.
21. Accordingly, consumers and members of the general public are likely to be confused into mistakenly believing that many of the services offered under Applicant's Mark are endorsed, manufactured, or sponsored by Tao.
22. Furthermore, any objection or fault found with the Applied-for Services would necessarily reflect upon and seriously injure the excellent reputation which Tao has established in connection with Tao's services sold under its TAO® Mark.
23. Any such confusion or mistake on the part of consumers is likely to cause injury to Tao.
24. Because of this likelihood of confusion, the Application should be denied. 15 U.S.C. §§ 1052(d), 1063(a).

Dilution

25. Opposer re-alleges and incorporates by reference, as though fully set forth herein, each and every allegation contained in the above paragraphs.
26. Consumers and members of the general public are likely to associate the services offered under the Applicant's Mark with Tao's TAO® Mark. Applicant's mark is therefore likely to dilute the distinctive nature of the famous TAO Mark by blurring and tarnishment.
27. Because the Applicant's Mark is likely to dilute the TAO® Mark, the Application should be denied. 15 U.S.C. §§ 1063(a), 1125(c).

Lack of Use of the TAO Asian Fusion Mark

28. Opposer re-alleges and incorporates by reference, as though fully set forth herein, each and every allegation contained in the above paragraphs.
29. Applicant operates a single, standalone restaurant located at 369 Huntington Avenue, New York, N.Y. 11743. A copy of Applicant's website for its "TOA Asian Fusion" restaurant is attached hereto as Exhibit A ("Applicant's Website").
30. According to Applicant's Website, Applicant's restaurant is a sit-down eatery that provides various dishes of Japanese, Chinese, Korean, Thai, Malaysian, and Vietnamese origin.
31. On information and belief, the Application was filed solely based on the use of Applicant's Mark in connection with this restaurant.
32. On information and belief, and as shown by Applicant's Website, Applicant did not have actual use in commerce of the TOA Asian Fusion Mark in connection with any of the Class 35 Services and Class 36 Services, and many of the Class 43 Services as of July 10,

2015, the alleged date of first use identified in the Application (“Applicant’s First Use Date”), or as of the date the Application was filed.

33. The Applied-for Services seek registration of the alleged TOA Asian Fusion Mark for services well-beyond the ownership of a single, standalone restaurant.
34. In particular, the Application seeks registration of the TOA Asian Fusion Mark in connection with a host of services tenuously related to the restaurant industry, but unrelated to Applicant’s restaurant, including without limitation: “Consulting in the field of restaurant menu development,” “Frozen yogurt shop services in the nature of a restaurant, “Hotel, bar and restaurant services; Hotel, motel, restaurant, bar and catering services; Hotel, restaurant and bar services; Hotel, restaurant and catering services; Ice cream shop services in the nature of a restaurant,” “Mobile restaurant services,” “Providing reviews of restaurants,” as well as many other services.
35. As shown by Applicant’s Website, Applicant did not have actual use in commerce of Applicant’s Mark for many of Applicant’s Applied-for Services as of Applicant’s alleged date of first use or as of the date the Application was filed.
36. Because the Applicant did not have actual use in commerce of Applicant’s Mark for virtually all of the Applied-for Services, the Application should be denied. 15 U.S.C. §§ 1051(a), 1125(c).

WHEREFORE, Opposer Tao Licensing LLC prays that Application Serial No. 86/736,663 be rejected; that no registration be issued to Applicant; and that this opposition be sustained in favor of Tao.

Please address all future communications regarding this opposition to:

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If any fees associated with this proceeding are required and were not paid during the course of the electronic filing process, please charge such fees to Deposit Account 11-0600 (Our Ref. 15369/0164).

Respectfully submitted,

KENYON & KENYON LLP

Date: April 20, 2016

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EXHIBIT A





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 unique way



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

[VIEW FULL MENU \(PDF\)](#)





15% OFF YOUR ORDER!

RESERVATIONS

RESERVATIONS

Sunday - Thursday : 11:30am - 10:00pm

Friday - Saturday: 11:30am - 11:00pm

MAKE A RESERVATION

GALLERY





CONTACT

369 New York Ave.
Huntington, NY 11743

(631) 673 7377



CERTIFICATE OF SERVICE

I hereby certified that the required number of copies of the foregoing *Motion to Amend Notice of Opposition on Consent and Amended Notice of Opposition* was served as shown below:

By U.S. Mail (Postage Prepaid)

Attorney/Correspondence Information

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