

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

wbc

Mailed: January 25, 2017

Opposition No. 91231108

*Tea Kay Media LLC*

*v.*

*Theresa J Meyer dba PoliceTees.com*

**Wendy Boldt Cohen, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on January 25, 2017. Participating in the conference were Opposer's counsel, Daniel Mazaheri, Applicant's counsel, G. Thomas Williams, and Board interlocutory attorney, Wendy Boldt Cohen.

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at [uspto.gov](http://uspto.gov). If the parties wish to add or modify any provisions to the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

The parties indicated that they have not engaged in settlement negotiations and that there is no other pending litigation, in federal court or before the Board, between the parties.

The parties were informed that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

The Board requires use of ESTTA for the filing of all submissions in Board proceedings.<sup>1</sup> *See* Trademark Rule 2.126; TBMP § 110 (2017-01). In the rare circumstances the rules permit submissions in paper form, the paper submission must be accompanied by a showing that ESTTA is unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. *See id.*

Additionally, service of submissions filed with the Board and any paper served on a party not required to be filed with the Board, must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances. *See* Trademark Rule 2.119(b); TBMP § 113.04.

The Board discussed accelerated case resolution (ACR) and urged the parties to discuss it further at a later date. Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of this proceeding, including:

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<sup>1</sup> The notice of opposition was filed November 1, 2016 on paper, prior to the Board's adoption of this rule. Opposer was reminded to update its correspondence address to include an email address.

abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration. The parties are directed to review the Board's website regarding ACR and TBMP §§ 528.05(a)(2) and 702.04. If the parties later agree to pursue ACR, they should notify the interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure (“TBMP”), online at: [uspto.gov](http://uspto.gov). The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure.

### **Pleadings**

The Board reviewed the pleadings in this case. In the notice of opposition, Opposer has adequately pleaded its standing. *See, e.g., Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b). That is, the statements in the prefatory paragraphs and paragraphs 1-4 of the notice of opposition allege facts which, if

proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. *See Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Opposer enumerates the following grounds for opposition – likelihood of confusion under Section 2(d), merely descriptive and deceptively misdescriptive under Section 2(e).

*Likelihood of Confusion*

Opposer’s claim of priority and likelihood of confusion under Section 2(d) is insufficiently pleaded. In particular, Opposer appears to allege common law rights in the mark BLUE LIVES MATTER but has not specified the particular goods and/or services upon which the alleged common law mark has been used.<sup>2</sup> Further, Opposer has indicated it first advertised its mark BLUE LIVES MATTER on “Facebook [on] December 21, 2014, and its first sale of a t-shirt ... [on] December 24, 2014,” but has not alleged that its use is prior to any rights Applicant may claim in its mark.<sup>3</sup> *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen*,

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<sup>2</sup> Opposer indicates it has sold t-shirts with a logo identified as “Blue Lives Matter,” but has not indicated if that logo was used in a trademark or service mark manner or whether t-shirts are the goods for which it established any purported trademark rights. *See* 1 TTABVue 4.

<sup>3</sup> A mark may be refused registration under Section 2(d) where it:  
[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d).

*Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *see also Giersch*, 90 USPQ2d at 1023; *Kohler C. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007). By so failing, Opposer has not provided fair notice of the basis for its Section 2(d) claim. *See* TBMP § 309.03.

*Merely Descriptive*

A term is considered descriptive within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the product in connection with which it is used. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re Gyulay*, 820 F.2d 1216, 1218, 3 USPQ2d 1009, 1010 (Fed Cir. 1987); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought; the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is

not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the question is whether someone who knows what the goods or services are will immediately understand the mark as directly conveying information about them. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Although Opposer alleges, *inter alia*, that Applicant's mark "is descriptive of a belief held by many civilians" 1 TTABVUE 3; Opposer alludes to but fails to specifically allege how Applicant's mark when applied to Applicant's specific goods would be perceived by the consuming public to convey a descriptive meaning. By failing to do so, Opposer has not provided Applicant with fair notice of its theory of descriptiveness. In view thereof, Opposer's claim of descriptiveness is not properly pleaded.

*Deceptively Misdescriptive*

"A mark may be 'deceptively misdescriptive' under §2(e) if it misrepresents any fact concerning the goods that may materially induce a purchaser's decision to buy." *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) *quoting* 2 McCarthy on Trademarks §11:56. Although Opposer argues that Applicant's mark is deceptive because it leads consumers to believe it is a "police-type organization," Applicant has not indicated

whether this is material fact that would induce a purchaser to buy. In view thereof, this ground for opposition is not properly pleaded.

Opposer is allowed until **February 15, 2017** to file an amended notice of opposition which properly pleads a ground for opposition. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02. If Opposer fails to comply with the foregoing, this proceeding may be dismissed as a nullity. Applicant will be given until **March 15, 2017** to file an answer or otherwise respond to the amended notice of opposition.<sup>4</sup>

Proceedings are resumed and dates are reset as follows:

Discovery Opens	<b>4/14/2017</b>
Initial Disclosures Due	<b>5/14/2017</b>
Expert Disclosures Due	<b>9/11/2017</b>
Discovery Closes	<b>10/11/2017</b>
Plaintiff's Pretrial Disclosures	<b>11/25/2017</b>
Plaintiff's 30-day Trial Period Ends	<b>1/9/2018</b>
Defendant's Pretrial Disclosures	<b>1/24/2018</b>
Defendant's 30-day Trial Period Ends	<b>3/10/2018</b>
Plaintiff's Rebuttal Disclosures	<b>3/25/2018</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>4/24/2018</b>

The Board thanks the parties for their participation.

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<sup>4</sup> The Board notes Applicant filed an answer on December 19, 2016. If Opposer files an amended notice of opposition, Applicant must file a new answer or otherwise respond to the amended notice of opposition.