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

Proceeding	91241481
Party	Defendant The Tai Walker Company, LLC and Ty Walker
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SMOKEY ISLAND GRILLE, LLC
Opposer

Opposition No: 91241481
Mark: SMOKEY ISLAND GRILLE JAMAICAN STYLE

V

THE TAI WALKER COMPANY, LLC
Applicant

APPLICANT'S TRIAL BRIEF

COMES NOW, Applicant, and files its Trial Brief, and in support hereof states:

A. MARKS

Likelihood of confusion is a question of law based on underlying findings of fact. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004). A Court assesses a likelihood of confusion based on the factors set forth in *DuPont*. 476 F.2d at 1361. "The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but 'may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.'" *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002) (quoting *Han Beauty, Inc. v. Alberto—Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) (alteration in original)). While evidence of actual confusion may be considered in the *DuPont* analysis, "a showing of actual confusion is not necessary to establish a likelihood of confusion." *Id.* (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d

1565, 1571 (Fed. Cir. 1983)). In the likelihood of confusion analysis "doubts are to be resolved against the newcomer and in favor of the prior user." *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 684 (CCPA 1977).

The first *DuPont* factor requires consideration of "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *DuPont*, 476 F.2d at 1361. "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012).

In this case before us, the Opposer submitted evidence of a mark clearly dissimilar to the Applicants mark; yet it is making an opposition for the likelihood of confusion. However, the Applicants mark is depicted just as it is described in its initial filing application. To date, the Applicant has owned and maintained his original common-law copyright in the drawing he created in 2013 as his logo in doing business as Smokey Island Grille Jamaican Style. The Applicants handcraft signature is a creative drawing within in the mark and is copyrighted material, in which the Opposer cannot argue against and "[c]reative works ... are closer to the core of works protected by the Copyright Act." *Sundeman*, 142 F.3d at 204.

The Opposer cannot establish ownership to a mark in which it first acknowledge having belonged to the Applicant in a written licensing agreement as was evidenced in the Applicants pre-trial disclosures. The Applicant further argues that in order for the Opposer to claim ownership over said mark, it would have had to first survive the common-law copyrights afforded to the Applicants work. Section 106 of the Copyright Act grants "*a bundle of exclusive*

rights to the owner of the copyright," including the rights "to publish, copy, and distribute the author's work." Harper & Row, 471 U.S. at 546-47, 105 S.Ct. 2218. In as much so, the Opposer cannot even claim a fair use of Applicants mark let alone transformative purpose of the "copyrighted work in a different manner or for a different purpose from the original." *Vanderhye, 562 F.3d at 638 (quoting Leval, supra, at 1111).* Therefore, the Applicant should be able to register such mark in which he already owns without opposition.

The likelihood of confusion is not an issue at hand; rather the issue is that the Opposer wants to evade liability of the written licensing agreement established between Opposer and Applicant. Without the Applicants work and its first use of his mark back in 2013, the Opposer would have had no known purpose to use the Applicants mark prior to. Again, the Opposer has not submitted nor evidenced a history of a mark in which does not already belong to the Applicant. Opposer operates under Applicant's licensing agreement and does not entitled them to ownership without compensation for the value in which the mark is worth to date and "*the crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.*" *Harper & Row, 471 U.S. at 562, 105 S.Ct. 2218.*"

B. GOODS AND SERVICES

In a §2(d) determination, the goods and/or services do not have to be identical or even competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). The issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) "[E]ven if the goods in

question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis."); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1403–04, 186 USPQ 476, 480 (C.C.P.A. 1975); *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1270 (TTAB 2007) . It is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services and ONLINE TODAY for an electronic publication likely to cause confusion); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN'S for wheat bran and honey bread, and MARTIN'S for cheese, likely to cause confusion); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347 (TTAB 2014) (holding SHAPES for a variety of beauty salon, day spa, and health spa services likely to cause confusion with SHAPE for magazines where the services are of the type normally featured in the magazines); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) (holding GOTT LIGHT for various water beverages likely to cause confusion with GOTT and JOEL GOTT for wine); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011) (holding composite marks containing the word TOTAL for yogurt and other products likely to cause confusion with the mark TOTAL for ready-to-eat breakfast cereal); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (holding VANTAGE

TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (holding ENYCE for custom automotive accessories, and ENYCE for various urban lifestyle clothing items and accessories, likely to cause confusion); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (holding CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer, and CONFIRMCELLS for diagnostic blood reagents for laboratory use, likely to cause confusion).

Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990)

(finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

When the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness). Therefore, when comparing services such as "restaurant services" with less apparently related goods such as "beer," or "cooking classes" with "kitchen towels," "something more"—beyond the fact that the goods are used in the provision of the services—must be shown to indicate that consumers would understand such services and goods to emanate from the same source. Although the Court in *Coors* found evidence of "a few registrations" covering both the goods and services at issue insufficient, *see In re Coors Brewing Co.*, 343 F.3d at 1346, 68 USPQ2d at 1063, examples of actual use of a mark for both the goods and services at issue and/or evidence of a large number of third-party registrations covering both the goods and services at issue may suffice. When such evidence is not readily available through searches of electronic resources, examining attorneys should consider issuing an information request under 37 C.F.R. §2.61(b), asking whether the applicant provides both the goods and services at issue and inquiring whether the applicant is

aware of others who provide both the goods and services at issue, and if so, requesting additional information about them.

Here, no consumer would confuse Applicant's mark with Opposer's mark because Opposer has not presented any evidence of a mark similar. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015) (noting that the "natural zone of expansion" doctrine normally applies in inter partes cases in the context of the parties' dueling claims of priority); *1st USA Realty Prof'ls*, 84 USPQ2d at 1584.

C. USE

Opposer claims a date of first use in November 2012 when it registered as a limited Liability Company in the state of New York. However, Applicant registered his domain name www.smokeyislandgrille.com on Tuesday, October 29, 2013 5:46:40 AM. Opposer did not object to this domain name. Applicant evidence first use in commerce as of January 2013 and has a continued use to date.

D. CONSUMERS AND CHANNELS OF TRADE

Under the second, third, and fourth *DuPont* factors, a Court must consider "[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use"; the similarity or dissimilarity of the trade channels; and "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 476 F.2d at 1361.

Had Opposer intended to manufacture and sell products similar to Applicant's, it would have registered its mark covering the same goods during its first date of use 2012 and or in 2017. It did not.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy the foregoing is being submitted electronically through the Electronic System for the Trademark Trial and Appeal Board (“ESTTA”) and by email to stephanie@hendricksfirm on this 15th day of April, 2021.

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