

This Opinion Is Not a  
Precedent of the TTAB

Hearing: July 14, 2021

Mailed: July 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Smokey Island Grille LLC*  
*v.*  
*The Tai Walker Company, LLC and Ty Walker*

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Opposition No. 91241481  
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Stephanie Hendricks of Hendricks Law Firm PLLC for Smokey Island Grille LLC.

The Tai Walker Company, LLC and Ty Walker, pro se.

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Before Bergsman, Heasley and Lebow, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The parties in this case purportedly had a business relationship and perhaps a personal relationship. Now the only thing they have in common is that each believes it owns the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE and design used in connection with restaurant services.

The Tai Walker Company, LLC and Ty Walker (Applicants) seek registration on the Principal Register of the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE and design, reproduced below, for the services listed below:

On-line ordering services in the field of restaurant take-out and delivery, in International Class 35; and

Restaurant, bar and catering services, in International Class 43.<sup>1</sup>



The description of the mark in the application reads as follows:

The mark consists of the words “Smokey island Grille.” It also features a design of a full 360° circle filled with a burgundy color, outlined by an orange color trim, that include the words “Smokey Island Grille Jamaican Style” within the circumference of the circle. Specifically “JAMAICAN STYLE” is written in green and is located at the near bottom of the design, while the name “Smokey Island Grille”, is written in orange. The letter “S” in the name “Smokey” is the personal hand drawn signature of the original owner of the design mark. The design also features a green palm leaf which hovers to the right just above the remaining 5 letters “mokey” of “Smokey”; and sits on a[n] orange color bark/stem with an almost full oval shape base that symbolizes an island. The black Background represents transparency and is not part of the mark.

The color(s) BURGUNDY, ORANGE AND GREEN is/are claimed as a feature of the mark.

Applicants disclaim the exclusive right to use the term “Grille Jamaican Style.”

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<sup>1</sup> Serial No. 87472640 was filed June 2, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicants’ claim of first use of its mark anywhere as of January 29, 2013, and first use in commerce as of June 6, 2013.

Smokey Island Grille LLC (Opposer) opposes registration of Applicants' mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer alleges that it has used the mark SMOKEY ISLAND GRILLE in connection with restaurant, bar, catering and on-line ordering services in the field of take-out and delivery since 2012, and that Applicants' mark so resembles Opposer's mark as to be likely to cause confusion. In addition, Opposer alleges that Applicants' logo is identical to Opposer's logo.<sup>2</sup>

Applicants, in their Answer, denied the salient allegations in the Notice of Opposition. As "affirmative defenses," Applicants allege the following:

- "Applicant is the legitimate owner of the mark."<sup>3</sup>
- "Opposer has unclean hands in that it wrongfully ousted Applicant[s] from [their] business."<sup>4</sup>
- "Opposer breached its contract with Applicant[s] concerning Applicant[s'] use of the mark."<sup>5</sup>

Although Opposer brought this proceeding on the ground of likelihood of confusion, the actual issue in this case is ownership of the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE and design for restaurant services. Based on Applicants' affirmative defenses, it is clear that Opposer had fair notice that

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<sup>2</sup> The Board dismissed with prejudice Opposer's dilution claim in its August 3, 2018 order (8 TTABVUE).

<sup>3</sup> Applicants' Affirmative Defenses ¶1 (9 TTABVUE 2).

<sup>4</sup> Applicants' Affirmative Defenses ¶3 (9 TTABVUE 2).

<sup>5</sup> Applicants' Affirmative Defenses ¶5 (9 TTABVUE 3).

Applicants intended to focus on the issue of ownership. In this regard, Opposer titled a section of its brief “History of Relationship between Applicant and Opposer.”<sup>6</sup>

Where, as here, the parties claim rights in the same mark for the same services, likelihood of confusion is inevitable. In addition, because both parties are relying on activities the two purportedly conducted in concert with one another — each now attempting to establish prior rights in the mark — the dispute centers on ownership of the mark. *See Lyons v. Am. Coll. of Veterinary Sports Med. and Rehab*, 859 F.3d 1023, 123 USPQ2d 1024, 1028 (Fed. Cir. 2017) (although plaintiff initiated proceeding based on likelihood of confusion, *inter alia*, the dispute centers on ownership of the mark); *Uveritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1245 (TTAB 2015) (citing *Nahshin v. Product Source Int’l LLC*, 107 USPQ2d 1257, 1258 (TTAB 2013) (“Although the proceeding was brought on the ground of priority/likelihood of confusion, the actual issue in this matter is ownership of the mark....”).

We, therefore, focus our discussion on who owns the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE and design. It is Opposer’s burden as plaintiff in the proceeding to establish prior ownership by a preponderance of the evidence. *See, e.g., Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997).

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<sup>6</sup> Opposer’s Brief, pp. 4-6 (39 TTABVUE 5-7).

**I. The record**

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicants' application file. The parties introduced the testimony listed below:

**A. Opposer's testimony**

1. Testimony affidavit of Doreen Cranston, Opposer's sole member;<sup>7</sup>
2. Testimony affidavit of Conrad Hunter, Opposer's chef and kitchen manager;<sup>8</sup>
3. Rebuttal testimony affidavit of Conrad Hunter;<sup>9</sup> and
4. Rebuttal testimony affidavit of Doreen Cranston.<sup>10</sup>

**B. Applicant's testimony**

1. Testimony affidavit of Tai Walker, aka, Ty Walker, co-Applicant;<sup>11</sup>
2. Testimony affidavit of Ella Carter Aernan, who assisted Applicants in creating a name for Applicants' restaurant;<sup>12</sup>
3. Testimony affidavit of Aubrey Beckwith, who participated in a focus group regarding the "Smokey Island Grille" and design trademark;<sup>13</sup>
4. Testimony affidavit of Michele Hepburn, who participated in a focus group regarding the "Smokey Island Grille" and design trademark;<sup>14</sup> and

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<sup>7</sup> 30 TTABVUE 11-32.

<sup>8</sup> 30 TTABVUE 2-10. Conrad Hunter is Doreen Cranston's brother.

<sup>9</sup> 38 TTABVUE 2-5.

<sup>10</sup> 38 TTABVUE 6-9.

<sup>11</sup> 33 TTABVUE 2-7.

<sup>12</sup> 33 TTABVUE 8-11.

<sup>13</sup> 33 TTABVUE 12-15.

<sup>14</sup> 33 TTABVUE 16-19.

5. Testimony affidavit of Kristopher Rodriguez, a graphic artist, who purportedly created the “Smokey Island Grille” logo at issue in this proceeding.<sup>15</sup>

## **II. Entitlement to a statutory cause of action<sup>16</sup>**

Opposer’s entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020) , *cert. denied*, \_\_\_ S. Ct. \_\_\_ (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *reh’g en banc denied* 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *petition for cert. filed*; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at \*4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

In order to satisfy entitlement to a statutory cause of action, “a plaintiff need only show that it has a real interest, that is, a personal stake in the outcome of the

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<sup>15</sup> 33 TTABVUE 20-35.

<sup>16</sup> Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 remain applicable.

proceeding.” *Ritchie v. Simpson*, 50 USPQ2d at 1026. Opposer has demonstrated a real commercial interest in the mark SMOKEY ISLAND GRILLE through the testimony of Doreen Cranston and Conrad Hunter, who dispute Applicant’s ownership of the mark.<sup>17</sup> *Uveritech, Inc. v. Amax Lighting*, 115 USPQ2d at 1245 (“The dispute over ownership of the mark also establishes standing.”).

Opposer has a reasonable basis in its belief that registration of Applicants’ mark will damage Opposer because Opposer is rendering restaurant services bearing a mark that is similar to Applicants’ mark used for restaurant services. *See Australian Therapeutic Supplies*, 2020 USPQ2d 10837, \*4 (“A petitioner may also demonstrate a real interest and reasonable belief of damage by producing and selling *merchandise* bearing the registered mark.”) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (citing *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984))); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit.”); *Executive Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1179 (TTAB 2017) (same).

By demonstrating that it has a real commercial interest in the mark SMOKEY ISLAND GRILLE and that it has a reasonable basis in its belief that it will be damaged

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<sup>17</sup> Cranston Testimony Aff. ¶9 (30 TTABVUE 12); Hunter Testimony Aff. ¶¶1, 3, 7, and 8 (30 TTABVUE 2-3).

by the registration of Applicants' mark, Opposer has proven its entitlement to a statutory cause of action.

**III. Whether Opposer is Applicants' licensee and estopped from challenging Applicants' application.**

On January 23, 2013, Tai Walker, licensor, and Doreen Cranston, dba, Smokey Island Grille LLC, licensee, executed a trademark license agreement effective November 1, 2012, through which Walker licensed Cranston to use the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE.<sup>18</sup> Specifically, the license provides;

- Walker is the owner of the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE;
- Walker grants Cranston a non-exclusive license to use the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE in New York City;
- Walker retains ownership of the mark;
- Walker controls the nature and quality of the services rendered under the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE;
- Opposer “acknowledges and agrees that [Walker] owns all rights, title, and interest in and to [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE], and [Opposer] will not challenge in any court of law or in any other manner the validity of [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE] or [Walker’s] exclusive ownership of [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE].”;

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<sup>18</sup> Walker Testimony Aff. ¶13 and Exhibit 8 (33 TTABVUE 4 and 35 TTABVUE 20-22).



- “Except as expressly authorized by [Walker] in writing, [Opposer] shall not use [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE] or any similar [mark] as, or as part of, a trademark, service mark, trade name, fictitious name, company or corporate name, or Internet domain name anywhere in the world.”;

- In connection with its use of [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE], [Opposer] will not in any manner represent that it has any ownership right in [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE], and [Opposer] acknowledges that all use of [the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE] by [Opposer] shall inure to the benefit of [Walker].”; and

- The license terminates on November 1, 2032.<sup>19</sup>

In rebuttal, Doreen Cranston testified “Neither I, nor [Opposer] entered into any agreement with Tai Walker to pay him any kind of licensing fees.”<sup>20</sup>

To the extent that Applicant alleges any contract with Opposer in this proceeding, whether directly with Opposer or through Ty Walker, the Board should note that no such contract was alleged in the proceeding in Kings County Supreme Court, and Opposer argued in that proceeding that there was not such contract. Thus to the extent that such a contract now magically exists, it [is] a fraud.<sup>21</sup>

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Neither Cranston, nor [Opposer] entered into any agreement with Ty Walker to pay him any kind of licensing fees.<sup>22</sup>

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<sup>19</sup> Walker Testimony Aff. Exhibit 8 (35 TTABVUE 20-21).

<sup>20</sup> Cranston Rebuttal Aff. ¶9 (38 TTABVUE 7).

<sup>21</sup> Opposer’s Brief, p. 5 (39 TTABVUE 6).

<sup>22</sup> *Id.*, p. 6 (39 TTABVUE 7).

Because Opposer did not introduce any of the relevant pleadings, motions or other documents from the proceeding in Kings County Supreme Court, in spite of the Board's Order allowing it time to do so,<sup>23</sup> there is no evidence to assess Opposer's argument disavowing any contract between Applicants and Opposer. "Attorney argument is no substitute for evidence." *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005). *See also Martahus v. Video Duplication Servs. Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) ("mere attorney arguments unsubstantiated by record evidence are suspect at best").

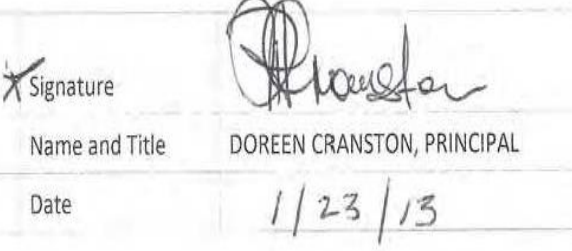
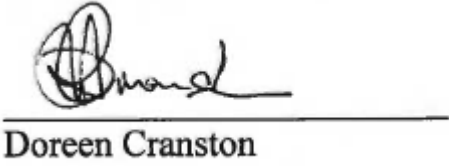
Contrary to Opposer's argument, Applicants introduced a copy of the above-noted written trademark license between Walker and Cranston. While the Board does not purport to be an expert in hand writing analysis, expert testimony is not required to establish the genuineness of a signature. Fed. R. Evid. 901(b)(3) ("*Comparison by an Expert Witness or the Trier of Fact: A comparison with an authenticated specimen by an expert witness or the trier of fact.*"). *See also* Weinstein's Federal Evidence, 1 WEINSTEIN'S FEDERAL EVIDENCE § 801 (2021) ("Expert testimony is not necessary, however, to authenticate handwriting by the method of comparing the handwriting on a proffered exhibit with the handwriting on an admittedly authentic exemplar.

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<sup>23</sup> Board's November 4, 2019 order (20 TTABVUE.2) ("The parties are allowed until **thirty days from the date of this order** in which to submit 1) a copy of the operative pleadings, as well as any final order or mandate issued in the civil action, and 2) a statement or brief setting forth, at a minimum, the current status of the civil action" so the Board can determine whether "the outcome of the civil action will directly affect the outcome in this opposition because the issues therein are about ownership of a business named Smokey Island Grille that is owned by [Opposer].").

The Board resumed proceedings in its March 12, 2020 order because Opposer did not respond. 26 TTABVUE.

The trier of fact may also perform that task.”). Doreen Cranston’s signature on the license agreement and her signature on her declaration are similar.<sup>24</sup> We reproduce below Ms. Cranston’s signatures.

Signature on license <sup>25</sup>	Signature on declaration <sup>26</sup>
 <p>X Signature</p> <p>Name and Title     DOREEN CRANSTON, PRINCIPAL</p> <p>Date                     1/23/13</p>	 <p>_____</p> <p>Doreen Cranston</p>

While Cranston testified she did not enter into any agreement to pay Walker a licensing fee, her disavowal is marked by notable omissions. Notably, she did not testify unequivocally that:

- She never saw the trademark license agreement before Opposer introduced it in Walker’s testimony affidavit; and
- That is not her signature on the trademark license agreement attached to Walker’s testimony affidavit.

Finally, Opposer did not avail itself of the opportunity to cross-examine Tai Walker regarding the authenticity of the trademark license agreement, the purportedly false material representations regarding the trademark license

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<sup>24</sup> We cannot conclude that Tai Walker is an expert in manipulating .pdf software and somehow placed Ms. Cranston’s signature on the license as Opposer suggested during the oral hearing.

<sup>25</sup> 35 TTABVUE 22.

<sup>26</sup> 30 TTABVUE 13.

agreement, and Walker's purported intent to deceive the USPTO by introducing the purportedly fraudulent trademark license agreement.<sup>27</sup>

We find that Applicants have proven by a preponderance of the evidence that there is trademark license between Walker and Cranston regarding the use of the mark SMOKEY ISLAND GRILLE JAMAICAN STYLE. Because there is a trademark license between Walker and Cranston, dba Smokey Island Grille, LLC, Opposer may not challenge the validity of Applicants' mark. *See Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700, 1703 (TTAB 2002) (attacking the validity of the marks petitioner was licensed to use "is the type of conduct which the doctrine of licensee estoppel is intended to prevent"); *Leatherwood Scopes Int'l, Inc. v. Leatherwood*, 63 USPQ2d 1699, 1703 (TTAB 2022) (amended notice of opposition fails to state a claim upon which relief can be granted "because opposer, as the alleged licensee, is estopped to challenge applicant's ownership of the mark, under the doctrine of licensee estoppel."); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 (TTAB 1991) (licensee estopped from challenging validity of agreement on the basis of lack of quality control based on facts that occurred during the time frame of the license); *Garri Publ'n Assocs., Inc. v. Dabora Inc.*, 10 USPQ2d 1694, 1697 (TTAB 1988) ("[A] licensee is

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<sup>27</sup> As noted above, Opposer argued, in its brief, that the trademark license is a "fraud." Opposer's Brief, p. 5 (39 TTABVUE 6).

Neither party availed itself to the right to cross-examine the witnesses. *See Trademark Rule 2.123(e)(1)*, 37 C.F.R. § 2.123(e)(1) ("When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States.").

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estopped to challenge the licensor's rights in the licensed mark during the time that the license is in force.”).

**Decision:** We dismiss the opposition because Opposer may not challenge Applicants’ application under the doctrine of licensee estoppel.