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

Proceeding	91268387
Party	Plaintiff Trademark Holdings SRL
Correspondence Address	EVAN BENJAMIN BERGER BECKER & POLIAKOFF PA 1 EAST BROWARD BOULEVARD SUITE 1800 FT. LAUDERDALE, FL 33301 UNITED STATES Primary Email: eberger@beckerlawyers.com Secondary Email(s): jshelton@beckerlawyers.com 954-364-6055
Submission	Reply in Support of Motion
Filer's Name	Evan Benjamin Berger
Filer's email	eberger@beckerlawyers.com
Signature	/s/ Evan Benjamin Berger
Date	09/20/2021
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TRADEMARK HOLDINGS SRL Opposition No. 91268387

Opposer,

v.

AIYARA, LLC

Applicant.

_____/

REPLY TO RESPONSE TO MOTION FOR LEAVE TO FILE SECOND AMENDED NOTICE OF OPPOSITION, OR IN THE ALTERNATIVE, MOTION FOR ENLARGEMENT OF TIME TO RESPOND TO THE MOTION TO DISMISS THE AMENDED NOTICE OF OPPOSITION

Trademark Holdings SRL ("Nayara Trademark Holder") files this Reply to the Response to the Motion for Leave to File Second Amended Notice of Opposition, or in the Alternative, Motion for Enlargement of Time to Respond to the Motion to Dismiss the Amended Notice of Opposition, and states as follows:

1. Although Reply briefs are strongly disfavored by this tribunal, the undersigned is compelled to file this Reply due to a number of inaccuracies included in the Response.

2. The majority of the Brief is a Reply to Applicant's Motion to Dismiss. Applicant both incorrectly states that the Motion was conceded because Opposer filed a motion for enlargement of time instead of a response brief, and then goes on to spend several pages Replying to the Motion it asserts is unopposed. This conclusion ignores 37 CFR § 2.127(a) which states that "[i]If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered." Given that the Motion for Enlargement of Time has not been denied, and in any event the Motion would be conceded if the Court is to accept Applicant's argument, the Reply to the Motion is nothing more than an improper

duplication of the arguments set forth in the Motion to Dismiss.

3. More fundamentally, the Response ignores and misstates several facts. In actuality, the proposed Amended Opposition satisfies the well plead complaint rule and alleges that the Opposer utilizes the mark in commerce. However, even if Opposer does not use the mark in commerce, there remains a basis for the opposition of Applicant's registration pursuant to 15 U.S.C. § 1052(d). Lastly, Opposer has not requested an abusive number of extensions of time. Each of these will be discussed in turn.

The Second Amended Opposition Satisfies the Well Plead Complaint Rule:

4. One of the central arguments in the Motion to Dismiss is that Nayara Trademark Holder does not use the mark Nayara because it is used solely by other entities. The Second Amended Opposition undermines this argument. As alleged in the Second Amended Opposition:

> Nayara Trademark Holder is the owner of internationally registered as well as common law trademark rights and intellectual property for the Nayara Resorts, a high-end boutique resort brand. Nayara Resorts has three luxury resort hotels in Costa Rica; Nayara Springs ("Nayara Springs"), Nayara Tented Camp ("Nayara Tented Camp"), and the Nayara Resort, Spa, & Gardens ("Nayara Resort"). . . . Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, & Gardens, Alto Alcama, Hangaroa, and Nayara Trademark Holder are all owned by separate entities, however, they function as a corporate group along with a number of other related entities. Each of these entities has common ownership through a sophisticated corporate structure and the ultimate owner of each of these six entities is the New Warren Trust which sits at the apex of the corporate group structure. By agreement, Nayara Trademark Holder allows Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, & Gardens, Alto Alcama, Hangaroa, and the Nayara properties which are presently under construction the exclusive use of the Nayara name. At all times Nayara Trademark Holder has direct and indirect control of the use of the Nayara name by Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, & Gardens, Alto Alcama, Hangaroa, and the Nayara properties which are presently under construction. Leo Ghitis, a Florida citizen, serves as the chief executive officer of Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, &

> Gardens, Alto Alcama, Hangaroa, Nayara Trademark Holder, and the New Warren Trust.

See 17 TTABVUE at Proposed Second Amended Opposition ¶¶ 1-5.

5. Given that Nayara Trademark Holder is a related entity with common ownership to Nayara Springs, Nayara Tented Camp, and Nayara Resort, the use by those entities inures to the benefit of Nayara Trademark Holder. *See e.g.*, 15 USC § 1055; TMEP § 1201.03. Therefore, Applicant's position that Nayara Trademark Holder as a holding company does not "use" the term Nayara, and therefore does not have standing to bring this action, is without merit. The Second Amended Opposition simply seeks to clarify the relationship between Opposer and the related entities utilizing the mark. This was done in an effort circumvent the need for a motion to dismiss on this basis and streamline the proceedings.

Nayara Utilizes the Mark in Commerce

6. As alleged in the Second Amended Opposition, Opposer utilizes the trademark Nayara in commerce. As alleged:

> Mr. Ghitis has met with executives from American Express Travel, Virtuoso, Signature Travel Network, and the American Automobile Association ("AAA"), amongst others, to negotiate and execute wholesale travel contracts with Nayara Springs, Nayara Tented Camp, Nayara Resort, Spa, & Gardens, Alto Alcama, and Hangaroa, valued in the millions of dollars. These meetings to promote and sell wholesale travel packages to the various Nayara Resorts occurred in the United States and the wholesale travel contracts were executed in the United States.

See 17 TTABVUE at Proposed Second Amended Opposition ¶ 26.

7. Although Applicant concludes that Opposer does not use the subject mark in commerce, in actuality, contracts valued in the millions of dollars for the wholesale purchase of hotel rooms were negotiated and executed in the United States with companies such as American Express Travel, Virtuoso, Signature Travel Network, and the American Automobile Association. While Applicant attempts to place this activity in the same category as fact patterns involving

the sporadic sale of services in the United States by foreign entities, the activity alleged in the Second Amended Opposition equates to millions of dollars in contracts that were negotiated and executed in the United States.

Nayara Trademark Holder Can Oppose the Application Under 15 U.S.C. § 1052(d) Even if it Does not Utilize the Mark in Commerce:

8. To the extent that there is a finding that Nayara Trademark Holder does not utilize the term Nayara in commerce, and thus, cannot pursue its opposition under 15 U.S.C. § 1125(a), Opposer would still have a basis to oppose the Naiyara mark under a 15 U.S.C. § 1052(d) basis for opposition which simply requires "use" in the United States and not "use in commerce." *See e.g.*, *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Grp., Inc*., 476 F. 3d 867, 870-71 (Fed. Cir. 2007) (permitting a foreign user to oppose a trademark application based solely on use - as opposed to use in commerce - of a trademark in the United States); *see also*, *Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc*., 937 F. 2d 1572, 1578 n. 4 (Fed. Cir. 1991).

Nayara Trademark Holder Has Not Sought an Excessive Number of Extensions

9. Applicant disingenuously raises that Opposer has sought an excessive number of extensions in this matter. Omitted from its Brief is the reason the majority of the extensions were sought, five of which were unopposed. After the filing of the initial Motion to Dismiss, Applicant's counsel reached out to the undersigned in an effort to resolve this matter. While the discussions were ongoing, the parties agreed that the best way to conserve resources would be to discuss resolution rather than expend resources on motion practice. As a result, that parties agreed to four unopposed motions for enlargement of time while exploring the potential for settling this dispute. *See* 5, 6, 8, and 10 TTABVUE.

10. In an effort to determine facts negating the Motion to Dismiss the Amended Opposition, and whether an amendment would streamline the proceedings, Opposer obtained a

7 day enlargement of time. *See* 14 TTABVUE.[1] Given the travel schedule of Opposer's corporate representative and the need to research additional information to include in an amended pleading, Opposer requested an additional short extension of time, the first which was not agreed upon. *See* 15 TTABVUE. However, due to an intervening order, this request was unnecessary. *See* 16 TTABVUE. Based upon this procedural history, the notion that Opposer has abused requesting an extension of time in connection with a deadline is without merit.

Conclusion

WHEREFORE, Trademark Holdings SRL respectfully requests that this Court enter an Order granting it leave to file the Second Amended Notice of Opposition which was attached to the initial Motion as Exhibit "A", or alternatively, an enlargement of time until and including 7 days after the denial of the Motion for Leave to Amend to file a comprehensive response in opposition to Applicant's Motion to Dismiss so that the Motion can be decided on the merits.

Dated: September 20, 2021

Respectfully submitted,

BECKER & POLIAKOFF, P.A.
Attorneys for Trademark Holdings SRL
1 East Broward Boulevard
Suite 1800
Fort Lauderdale, FL 33301
Telephone: (954) 987-7550
Facsimile: (954) 985-4176
eberger@beckerlawyers.com

By: /s/ Evan B. Berger
Evan B. Berger, Esq.
Florida Bar No. 71479

[1] Although the public docket indicates that this Motion was without consent, viewing the Motion makes clear that it was a consent motion.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on counsel for the Applicant by transmitting this document on September 20, 2021 via email to:

Jodi-Ann Tillman
Joseph. W. Bain
SHUTTS & BOWEN LLP
Jodi-Ann Tillman
525 Okeechobee Blvd, Suite 1100
West Palm Beach, Florida 33401
Telephone: 561-835-8500
jbain@shutts.com
jtillman@shutts.com