

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JLE

March 15, 2023

Opposition No. 91269223 (parent)
Opposition No. 91269420

Eva M. Beale

v.

Eddie Parker LLC

By the Trademark Trial and Appeal Board:

In these consolidated proceedings, Opposer Eva M. Beale opposes registration of Applicant Eddie Parker LLC's standard character marks LIL EDIES and LITTLE EDIES for the following goods in International Class 34:

oral vaporizers for smoking purposes; tobacco water pipes for smokers; matches; cigarette paper; cigarette lighters; smokers' rolling trays; tobacco grinders; tobacco jars; tobacco storage boxes made of acrylic; tobacco storage boxes made of glass; tobacco storage boxes made of metal; ashtrays composed of non-precious metal; ashtrays composed of acrylic; glass tips for oral vaporizer pipes, namely, drip tips; cigarette holders¹

Now before the Board is Applicant's fully-briefed motion, filed October 6, 2022, for partial summary judgment as to Opposer's claims of false suggestion of a connection

¹ Application Serial Nos. 90021509 for LIL EDIES and 90021501 for LITTLE EDIES, both filed June 25, 2020 on the basis of a bona fide intent to use the marks in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1052(b).

under Trademark Act Section 2(a), 15 U.S.C. § 1052(a).² For the reasons set forth below, the Board construes the motion as seeking judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c).

For purposes of this order, the Board presumes the parties' familiarity with the arguments and materials submitted in connection with the subject motion. All of the parties' arguments have been carefully considered, although the Board does not find it necessary to discuss all of them in this order. *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at *1 (TTAB 2022) (citing *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015)).

I. Arguments of the Parties

In support of its motion, Applicant contends, inter alia, that the notices of opposition (which appear to be substantively identical) do not allege that Applicant's subject marks are the same as, or are a close approximation of, Opposer's name or identity, or that purchasers of Applicant's goods to be sold under the LIL EDIE and LITTLE EDIE marks would recognize those marks as pointing uniquely and unmistakably to Opposer. In sum, Applicant argues the claims allege that Applicant's marks point not to Opposer, but instead to her relative, Edith Bouvier Beale.³

² 19 TTABVUE. Opposer's claims of likelihood of confusion with its pleaded marks LITTLE EDIE, LITTLE EDIE BEALE, and STAUNCH LITTLE EDIE under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), are not at issue in this motion. See 11 TTABVUE 2-3.

Record citations are to TTABVUE, the Board's publicly available docket history system, in the parent case. See, e.g., *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020).

³ See 19 TTABVUE 7-8.

Applicant argues that only the person identified by the subject mark can assert a Section 2(a) claim.⁴ Accordingly, Applicant argues Opposer's claim is "defective."⁵

In response to the motion, Opposer argues that "Applicant misreads the Notice [of Opposition] in an attempt to narrow the focus of the inquiry and suggest that the two intertwined personas of Eva Beale and Edie Beale are somehow not both impacted by a close association to Applicant's closely-approximate applied-for marks."⁶ Opposer contends there is a "deep public association between Opposer and the LITTLE EDIE marks and business,"⁷ and that "Opposer's identity/persona, as well as the institution of her business, is tied to the LITTLE EDIE brand (and the Grey Gardens brand) and Edie Beale."⁸

II. Legal Standard

Although Applicant's motion is styled as a motion for partial summary judgment, the thrust of Applicant's argument is that the notices of opposition fail to state a claim under Trademark Act Section 2(a) upon which relief can be granted. Because the motion comes after the filing of the answers but prior to trial, and because there is no need to consider matters outside the pleadings to determine the sufficiency of Opposer's claims (indeed, Applicant does not submit any evidence), the Board

⁴ *Id.* at 8 (citing *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1032 (TTAB 2015) and *Heroes Inc. v. Boomer Esiason Hero's Found., Inc.*, 43 USPQ2d 1193 (D.D.C. 1997)).

⁵ *Id.*

⁶ 25 TTABVUE 10.

⁷ *Id.* at 6.

⁸ *Id.* at 12. Applicant's reply is largely directed to Opposer's evidence. *See* 27 TTABVUE.

construes the motion as seeking partial judgment on the pleadings.⁹ *See* Fed. R. Civ. P. 12(c) and 12(h)(2); *DAK Indus. Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995) (motion for failure to state a claim upon which relief can be granted filed after answer construed as motion for judgment on the pleadings); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 528.04 (June 2022).

When a motion for judgment on the pleadings alleges a procedural defect of the sufficiency of the plaintiff's pleading, the Board applies the same standard used for motions to dismiss under Fed. R. Civ. P. 12(b)(6), and likewise grants the appropriate relief or denies the motion as if it had been brought prior to the defendant's answer. *W. Worldwide Enters. Grp. Inc., v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990); *see also* WRIGHT & MILLER, 5C FED. PRAC. & PROC. CIV. § 1367 (3d ed. Apr. 2022 update); 2 JAMES WM. MOORE ET AL., MOORE'S FED. PRAC. – CIV. § 12.38 (Mar. 2023 update) (any distinction between the motions is considered "merely semantic because the same standard applies . . ."); TBMP § 528.04.

Thus, the motion is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board takes judicial notice. *See Media Online Inc. v. El Clasificado, Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *see also* TBMP § 504.02 and cases cited therein. To survive the motion, a notice of opposition need allege only such facts as would, if proven, show that Opposer is

⁹ The construed motion for judgment on the pleadings is timely inasmuch as it was filed after the close of pleadings, but prior to the day of the deadline for pretrial disclosures for the first testimony period. *See Shared, LLC v. SharedSpaceofAtlanta, LLC*, 125 USPQ2d 1143, 1143-44 (TTAB 2017); Fed. R. Civ. P. 12(c).

entitled to bring a statutory cause of action and a statutory ground for opposing registration of the mark exists. *W. Worldwide Enters. Grp. Inc.*, 17 USPQ2d at 1140. For purposes of the motion, all well-pleaded factual allegations of the non-moving party are accepted as true, and those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. *Media Online*, 88 USPQ2d at 1288. Conclusions of law are not taken as admitted, and all reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.*

III. Legal Analysis¹⁰

To sufficiently plead a claim of false suggestion of a connection under Section 2(a), Opposer must allege the following:

1. Applicant's marks (LIL EDIES and LITTLE EDIES) are the same as or a close approximation of Opposer's name or identity;
2. Applicant's marks would be recognized as such, in that they point uniquely and unmistakably to Opposer;
3. Opposer is not connected with the goods sold by Applicant; and,
4. Opposer is of sufficient fame or reputation that when Applicant's marks are used in connection with its goods, a connection with Opposer would be presumed.

See Mystery Ranch, Ltd. v. Terminal Moraine Inc., 2022 USPQ2d 1151, at *19 (TTAB 2022) (citing cases).

¹⁰ The Board notes that Opposer's sufficiently pleaded claim under Section 2(d) is sufficient to plead its entitlement to a statutory cause of action. *See Threshold.TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1036 (TTAB 2010) (a well-pleaded claim of likelihood of confusion also pleaded facts which, if proven, will establish entitlement to a statutory cause of action).

Although the notices of opposition have been reviewed in their entirety, the following allegations are particularly relevant to the Section 2(a) claims:

1. Opposer is an individual and sole proprietor who sells a variety of goods aimed at recreating and honoring the style and taste of Edith Bouvier Beale, a relative by marriage of Opposer and a famous New York socialite in the middle part of the last century known as “Little Edie.” These goods are sold under several registered marks that incorporate or entirely consist of the mark LITTLE EDIE and are marketed and available on Opposer’s online retail business at www.greygardensofficial.com. Opposer has operated this business since at least 2008 and has invested significant resources in developing her business.
2. Opposer has used the marks set forth in the table below (collectively, the “LITTLE EDIE marks”) continuously since at least 2008.
.....
7. By virtue of Opposer’s substantial commercial activities with respect to the LITTLE EDIE marks throughout the United States, the publicity and media attention accorded the marks, and the inherently distinctive nature of the mark, the LITTLE EDIE marks have become well-known marks and distinctive indicators of origin for Opposer’s products.
.....
14. Applicant’s applied-for mark LIL EDIES [LITTLE EDIES] is a close approximation of Opposer’s previously used and registered LITTLE EDIE marks, each of which is a name or identity of substantial reputation that is closely identified with Opposer, so as to be likely, when applied to the goods set forth in Applicant’s application, to point uniquely to Opposer and to falsely suggest a connection with the Opposer within the meaning of 15 U.S.C. § 1052(a).¹¹

These allegations do not sufficiently allege the elements of a Section 2(a) claim.

First, even read liberally, the notices of opposition do not mention the third and fourth elements of the claim (regarding lack of a connection and Opposer’s fame).¹²

¹¹ Opposition Nos. 91269223 and 91269420, 1 TTABVue 5-8, ¶¶ 1, 2, 7, and 14.

¹² Opposer’s allegations that her marks have a “substantial reputation” or are “well-known,” *id.* at 7-8, ¶¶ 7 and 14, do not equal an allegation that Opposer is of sufficient fame or

Next, fundamental to a pleading of false suggestion of a connection under Section 2(a) as to the first element is the “initial and critical requirement” that the identity being appropriated is unmistakably associated with the person or institution identified. *Springs Indus., Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984) (quoting *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir.1983)). Thus, “the rights being asserted by a plaintiff in a claim of false [suggestion of a] connection under Section 2(a) are personal in nature.” *Treadwell’s Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320-21 (TTAB 1990) (citing *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985)).

Opposer does not plead that Applicant’s marks LIL EDIE and LITTLE EDIE are the same as or a close approximation of Opposer’s name or identity. Instead, she pleads that Edith Bouvier Beale was known as “Little Edie.” It is not enough that the marks LIL EDIE or LITTLE EDIES may qualify as, or are a close approximation of, Edith Bouvier Beale’s “name or identity,” and Opposer does not plead that she is the legal successor thereof. *See Mystery Ranch*, 2022 USPQ2d 1151, at *24 (“The crux of the dispute under [the first] prong focuses on whether [LIL EDIE and LITTLE EDIES] qualifies as **Opposer’s** name or identity, and Dana Gleason is not the opposer here”) (emphasis in original); *see also U.S. Olympic Comm. v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164, at *18 (TTAB 2021) (“Thus, to show an

reputation that when Applicant’s marks are used in connection with its goods, a connection with Opposer would be presumed.

invasion of one's 'persona,' it is not sufficient to show merely prior identification with the name adopted by another . . . The mark NOTRE DAME, as used by [Applicant], must point uniquely to [Opposer]"). Nor does Opposer allege that Applicant's subject marks are Opposer's name or identity; instead she claims that each of her LITTLE EDIE marks "is a name or identity" that is "closely identified with Opposer." Thus, the first factor is insufficiently pleaded.

In addition, the notices of opposition do not plead (under the second factor) that Applicant's marks point uniquely and unmistakably to Opposer. Rather, the complaints state that Applicant's subject marks are "likely" to point uniquely to Opposer.

In sum, the facts supporting Opposer's Section 2(a) claims simply echo her likelihood of confusion claims, and therefore are insufficiently pleaded. *See, e.g., Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523-24 (TTAB 2016) (Section 2(a) is not a variation on a likelihood of confusion claim); *Univ. of Notre Dame*, 217 USPQ at 508 (the purpose of the claim is to protect "the name of an individual or institution which [i]s not a technical 'trademark' or 'trade name' upon which an objection could be made under § 2(d).") (citation omitted).

In view thereof, Applicant's construed motion for partial judgment on the pleadings is **granted** as to the Section 2(a) claims, to the extent that Opposer is allowed until **April 5, 2023**, in which to file amended complaints in each proceeding that properly allege claims of false suggestion of a connection; failing which, the claims under Section 2(a) will be **dismissed** with prejudice and these proceedings

will continue only on the claims of likelihood of confusion.¹³ *See, e.g., Int’l Tel. & Tel. v. Int’l Mobile Machs.*, 218 USPQ 1024, 1027 (TTAB 1983) (plaintiff allowed to replead where allegation of standing deemed insufficient on motion for judgment on the pleadings). If Opposer files amended complaints, Applicant is allowed until **April 25, 2023** to file answers thereto.

IV. Guidance for Future Motions and Trial

To assist the parties in future pleadings, motions, and trial, the Board provides the following guidance.

To be considered by the Board at trial on in connection with, or in opposition to, a motion for summary judgment, a plaintiff’s pleaded registrations must be made of record. *See* Trademark Rules 2.122(c) and (d), 37 C.F.R. §§ 2.122(c) and (d); *see also* TBMP §§ 317 and 704.03(b)(1)(A).¹⁴ The Board does not take judicial notice of a party’s registrations. *See UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) (“[I]t is well settled that the Board does not take judicial notice of USPTO records”) (citing *Corp. Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987)); *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007) (Board does not take notice of registrations); *see also* TBMP § 317.

¹³ Whether Opposer can, in good faith, allege facts sufficient to plead claims under Section 2(a) is uncertain given her argument and supporting evidence that the public recognizes the name LITTLE EDIE as pointing to the “intertwined” personas of Edith Bouvier Beale and Opposer, rather than “uniquely and unmistakably” to Opposer. *See, e.g.*, 25 TTABVUE 10.

¹⁴ *See* 11 TTABVUE 2-3, n.4.

A moving party may establish it is entitled to summary judgment in cases where the nonmovant bears the ultimate burden of persuasion by pointing out the lack of admissible evidence to support any essential element of the non-movant's case at trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Monster Energy Co. v. Tom & Martha LLC*, 2021 USPQ2d 1197, at *5 (TTAB 2021) (citing Fed. R. Civ. P. 56(c)(1)). The moving party, however, may not rely on conclusory statements that the record contains no evidence of the elements of a claim; rather, it must satisfy its obligation to demonstrate (e.g., by identifying those portions of the pleadings, depositions, answers to interrogatories, admissions, and affidavits) that there are no factual issues warranting trial before the burden shifts to the nonmovant. *Celotex*, 477 U.S. at 323; *see also Ashe v. Corley*, 992 F.2d 540, 543 (5th Cir. 1993) (“[I]t is not enough for the moving party to merely make a conclusory statement that the other party has no evidence to prove its case.”); *cf. Exigent Tech., Inc. v. Atrana Sols., Inc.*, 442 F.3d 1301, 78 USPQ2d 1321, 1326 & n.9 (Fed. Cir. 2006) (“While the Supreme Court in *Celotex* did not articulate, with precision, the minimum that a movant must do in its motion to discharge its burden . . . [the defendant's] motion went far beyond a conclusory assertion that [the plaintiff] had no evidence to prove its case.”).

V. Proceeding Schedule Reset

Proceedings remain **suspended** and will resume automatically on the schedule set forth below:¹⁵

Discovery Reopens: **April 26, 2023**

Expert Disclosures Due	5/10/2023
Discovery Closes	6/9/2023
Plaintiff's Pretrial Disclosures Due	7/24/2023
Plaintiff's 30-day Trial Period Ends	9/7/2023
Defendant's Pretrial Disclosures Due	9/22/2023
Defendant's 30-day Trial Period Ends	11/6/2023
Plaintiff's Rebuttal Disclosures Due	11/21/2023
Plaintiff's 15-day Rebuttal Period Ends	12/21/2023
Plaintiff's Opening Brief Due	2/19/2024
Defendant's Brief Due	3/20/2024
Plaintiff's Reply Brief Due	4/4/2024
Request for Oral Hearing (optional) Due	4/14/2024

Important Trial and Briefing Instructions

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits,

¹⁵ Following close of the amended pleadings, if any, the parties are reminded that filings should be made in the parent case only.

Opposition Nos. 91269223 (parent) and 91269420

declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). **Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing.** See TBMP § 801.03. Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).