

ESTTA Tracking number: **ESTTA1251069**

Filing date: **11/30/2022**

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

Proceeding no.	91271796
Party	Defendant Tishman Speyer Properties, L.P.
Correspondence address	SUSAN L. HELLER GREENBERG TRAUIG, LLP 18565 JAMBOREE ROAD, SUITE 500, GREENBER IRVINE, CA 92612 UNITED STATES Primary email: gtipmail@gtlaw.com Secondary email(s): octm@gtlaw.com 949-732-6810
Submission	Answer
Filer's name	Susan L. Heller
Filer's email	gtipmail@gtlaw.com, octm@gtlaw.com, hellers@gtlaw.com, nyleng@gtlaw.com, jennice.lee@gtlaw.com
Signature	/Susan L. Heller/
Date	11/30/2022
Attachments	ANSWER-91271796.pdf(173820 bytes)

Application”). Applicant denies that it applied to register Applicant’s Mark with the U.S. Patent and Trademark Office (“USPTO”) in Class 5. Applicant further denies that US Serial No. 90/274,932 covers Classes 9, 14, 16, 18, 20, 26, 30, 35, 41, and 43.

2. Answering Paragraph 2 of the Opposition, Applicant admits that it filed Applicant’s Application on October 23, 2020, pursuant to Section 1(b) of the Trademark Act (15 USC Section 1051(b)), claiming a bona fide intent to use Applicant’s Mark in connection with the Subject Goods. Applicant denies that it filed Applicant’s Application on October 20, 2020.

3. Answering Paragraph 3 of the Opposition, Applicant admits that Applicant’s Application was published on March 23, 2021 and that Opposer obtained an extension of time necessary to oppose Applicant’s Application, with the deadline to oppose being September 19, 2021. Applicant denies that Applicant’s Application was published on April 20, 2021 or September 14, 2021.

4. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 4 of the Opposition and therefore denies the same.

5. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 5 of the Opposition and therefore denies the same.

6. The allegations in Paragraph 6 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 6 of the Opposition.

7. Answering Paragraph 7 of the Opposition, Applicant admits that the marks listed in the chart appearing in Paragraph 7 appear to be registered with the United States Patent and Trademark Office, with the registration numbers listed in the chart, and that the statements of services described in the chart match the statements for the corresponding registrations listed with

the United States Patent and Trademark Office. With respect to the remaining allegations of Paragraph 7, Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 7 of the Opposition and therefore denies the same.

8. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 8 of the Opposition and therefore denies the same.

9. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 9 of the Opposition and therefore denies the same.

10. The allegations in Paragraph 10 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant admits the allegations in Paragraph 10.

11. The allegations in Paragraph 11 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant admits that it has acknowledged MEC's ownership of the ROCKEFELLER CENTER® in certain contexts. Applicant denies the remaining allegations in Paragraph 11 of the Opposition.

12. The allegations in Paragraph 12 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant admits the allegations in Paragraph 12 of the Opposition.

13. The first and last clauses of allegations in Paragraph 13 of the Opposition - "Unbeknownst to MEC" and "which is confusingly similar to MEC's ROCKEFELLER CENTER® Logo"- call for legal conclusions and therefore do not require responses. To the extent responses are required, Applicant denies the foregoing first and last clauses of the Opposition. Applicant admits the remainder of Paragraph 13 of the Opposition.

14. The allegations in Paragraph 14 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 14 of the Opposition.

15. The allegations in Paragraph 15 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 15 of the Opposition.

16. Answering Paragraph 16 of the Opposition, Applicant admits it will offer the Subject Goods and Services under Applicant's Mark to a variety of customers. Except as expressly admitted, Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 16 of the Opposition and therefore denies the same.

17. Answering Paragraph 17 of the Opposition, Applicant admits it intends to use Applicant's logo in connection with its TOP OF THE ROCK mark, which Opposer allowed Applicant to file and which Applicant now owns, at the "TOP OF THE ROCK" venue located at 30 Rockefeller Plaza, New York, N.Y. The remaining allegations in Paragraph 17 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies the remaining allegations in Paragraph 17 of the Opposition.

18. Answering Paragraph 18 of the Opposition, Applicant admits that US Reg. Nos. 3194827, 3268693 and 4691866 for TOP OF THE ROCK are owned by RCPI LANDMARK PROPERTIES, L.L.C. With respect to the remaining allegations of Paragraph 18 of the Opposition, Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 18 of the Opposition and therefore denies the same.

19. Answering Paragraph 19 of the Opposition, Applicant admits that it is an affiliate, but not the parent corporation, of RCPI LANDMARK PROPERTIES, L.L.C.

20. Answering Paragraph 20 of the Opposition, Applicant admits that Applicant's Mark is in use for certain goods and services, including on the website depicted in Exhibit "C" to the Opposition. The remaining allegations in Paragraph 20 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies the remaining allegations of Paragraph 20 of the Opposition.

21. The allegations in Paragraph 21 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 21 of the Opposition.

22. The allegations in Paragraph 22 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 22 of the Opposition.

23. The allegations in Paragraph 23 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 23 of the Opposition.

LIKELIHOOD OF CONFUSION

24. The allegations in Paragraph 24 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 24 of the Opposition.

25. The allegations in Paragraph 25 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 25 of the Opposition.

26. The allegations in Paragraph 26 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 26 of the Opposition.

27. The allegations in Paragraph 27 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 27 of the Opposition.

28. The allegations in Paragraph 28 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 28 of the Opposition.

COPYRIGHT INFRINGEMENT

29. The allegations in Paragraph 29 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 29 of the Opposition.

30. The allegations in Paragraph 30 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 30 of the Opposition.

31. The allegations in Paragraph 31 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 31 of the Opposition.

BREACH OF THE LICENSE AGREEMENT

32. The allegations in Paragraph 32 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 32 of the Opposition.

33. Answering Paragraph 33 of the Opposition, Applicant admits that the License Agreement is dated 7/17/96. The remaining allegations in Paragraph 33 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies the remaining allegations in Paragraph 33 of the Opposition.

34. Applicant denies the allegations in Paragraph 34 of the Opposition.

35. The allegations in Paragraph 35 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 35 of the Opposition.

36. The allegations in Paragraph 36 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 36 of the Opposition.

37. The allegations in Paragraph 37 of the Opposition call for a legal conclusion and therefore do not require a response. To the extent a response is required, Applicant denies each and every allegation in Paragraph 37 of the Opposition.

38. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 38 of the Opposition and therefore denies same.

39. Applicant is without sufficient knowledge or information to form a belief as to the allegations contained in Paragraph 39 of the Opposition and therefore denies same.

AFFIRMATIVE DEFENSES

40. Opposer's Opposition is barred because Opposer fails to state a claim upon which relief may be granted.

41. Opposer's Opposition is barred because Opposer's mark is sufficiently dissimilar to Applicant's Mark.

42. Opposer's Opposition is barred because Applicant's Mark is not substantially similar to, and a derivative work based upon, the artistic design of Opposer's mark.

43. Applicant further affirmatively alleges that there is no likelihood of confusion because the parties' respective goods/services are unrelated, are marketed in different channels of trade to different classes of purchasers and convey different commercial impressions.

44. Opposer's Opposition is barred to the extent they allege copyright infringement because the federal courts have exclusive jurisdiction over such claims.

45. Applicant is not a party to the License Agreement and, therefore, any purported breach of the License Agreement cannot serve as the basis for refusing registration of Applicant's Mark. In addition, to the extent the License Agreement is binding in any way on Applicant, the License Agreement provides in Article 13 that the parties should first attempt to resolve their disputes prior to filing any claims against each other, and after that period such claims are to be arbitrated, neither of which occurred here.

PRAYER FOR RELIEF

WHEREFORE, Applicant contends that the Opposition is without grounds and requests judgment denying the Opposition and this proceeding in its entirety with prejudice, and for such other and further reliefs as the Board deems just and proper.

Dated: November 30, 2022

Respectfully submitted,

By: Susan L. Heller

Susan L. Heller
GREENBERG TRAURIG, LLP
18565 Jamboree Road, Suite 500
Irvine, CA 92612-4410
Telephone No.: (949) 732-6500
Facsimile No.: (949) 732-6501
E-Mail: hellers@gtlaw.com

Counsel for Applicant

By: Gregory A. Nylén

Gregory A. Nylén
GREENBERG TRAURIG, LLP
18565 Jamboree Road, Suite 500
Irvine, CA 92612-4410
Telephone No.: (949) 732-6500
Facsimile No.: (949) 732-6501
E-Mail: nyleng@gtlaw.com

Counsel for Applicant

CERTIFICATE OF ELECTRONIC TRANSMISSION

The undersigned hereby certifies that the foregoing Answer to Notice of Opposition is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent and Trademark Office on the date indicated below, through the ESSTA electronic filing system at the website <http://esta.uspto.gov/>.

DATE: November 30, 2022

/Gregory A. Nylen/

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing Answer to Notice of Opposition is being served, via electronic mail and by First Class Mail, postage prepaid, on November 30, 2022, on the following:

Jonathan D. Reichman
Jeremy S. Boczko
HUNTON ANDREWS KURTH LLP
200 Park Avenue
New York, NY 10166
Tel.: (212) 309-1000
Fax: (212) 309-1100
Email: tmdocketny@HuntonAK.com
jreichman@HuntonAK.com
jboczko@HuntonAK.com

DATE: November 30, 2022

/Gregory A. Nylen/