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

Proceeding no.	91272420
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Date	07/05/2022
Attachments	Opp. No. 91272420 Applicant's Response to Opposers Motion to Suspend and Exhibit (002).pdf(635441 bytes)

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

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

In the matter of trademark application Serial No. 90/050,159
For the design mark THE NEW MISS BRAND
Published in the Official Gazette on June 22, 2021

THE UNIVERSITY OF MISSISSIPPI,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91272420
)	
SUZI ALTMAN,)	
)	
Applicant)	

**APPLICANT’S BRIEF IN RESPONSE TO OPPOSER’S MOTION
TO SUSPEND PROCEEDING UNDER C.F.R. § 2.117(a)**

Applicant Suzi Altman (“Applicant”) submits this brief in response to the University of Mississippi’s (“Opposer”) Motion and Brief in Support of Motion to Suspend Proceeding Under 37 C.F.R. § 2.117(a), dated June 14, 2022 (“Motion to Suspend”), per 37 C.F.R. §2.127(a).

I. INTRODUCTION AND BACKGROUND

Suspension of this opposition proceeding would unnecessarily delay proper determination of the issues before the Trademark Trial and Appeals Board (the “Board”) and force the parties to litigate tangential issues while the Applicant’s mark awaits registration. The motion should be denied, because the issues in the state court proceeding are not nearly as overlapping with the issues in this opposition as Opposer’s motion suggests. Applicant respectfully requests that the Board exercise its discretion and deny Opposer’s Motion to Suspend.

Applicant Suzi Altman began using the phrase “New Miss” with her friend, James Meredith, as early as October 2018. On July 13, 2020, following development of THE NEW MISS BRAND and the accompanying mark (the “New Miss mark”), Applicant filed for federal trademark registration. The New Miss mark was published in the Trademark Official Gazette on June 22, 2021.

Opposer filed for, and the Board initiated, the above captioned opposition proceeding on October 20, 2021. Since then, Applicant and Opposer have been participating in this opposition, including a consented-to extension of the discovery period.

On June 10, 2022, Opposer filed a complaint in Mississippi state court in Lafayette County (attached as Exhibit A), claiming the Applicant violated the Mississippi Anti-Dilution Law and engaged in common law trademark infringement as recognized in Mississippi. Ex. A at 3-4. The complaint applies legal theories particular to Mississippi state law and raises no federal claims, but Opposer now seeks suspension of this opposition that determines solely federal trademark registration. As detailed below, the Board should exercise its discretion and deny Opposer’s Motion to Suspend.

II. ARGUMENT

A. The TTAB Proceedings Will Have Bearing on the Mississippi State Court Proceeding, Not the Other Way Around.

The Board should exercise its discretion and deny Opposer’s Motion to Suspend because not only will the Mississippi state court action *not* have bearing on the issues before the Board, but the decision of the Board may have bearing on the issues before the Mississippi state court. The Mississippi Anti-Dilution Statute expressly considers the federal registration of marks when determining fame for state law dilution purposes. MISS CODE ANN. § 75-25-25(b). And the Mississippi common law trademark infringement action considers likelihood of confusion as a factor in determining whether a trademark right was infringed. *See W&W Holdings, Inc. v. Village at Henderson Point Owners Ass’n, Inc.*, 503 So.2d 286, 288 (Miss. 1987) (citing *Cockrell v. Davis*, 23 So.2d 256, 262 (Miss. 1945)). Each of these considerations are only a piece of the analysis in the Mississippi state court action, but federal registration

and likelihood of confusion are precisely the issues already before the Board. The Board's decision will thus likely have bearing on the Mississippi state court action, not the reverse.

B. The Mississippi State Court Proceeding Will Not Have Bearing on the Issues Before the Board.

The Board has the discretion to suspend proceedings “if the final determination of the other proceeding may have bearing on the issues before the Board.” TBMP § 510.02(a) (2022); *see* 37 C.F.R. § 2.117(a). Here, the issues posed by the state court action are not identical to the issues to be determined by the Board, nor is any issue in the Mississippi state court action dispositive or preclusive of any issue in the opposition.

To warrant suspension based on a state court action, the proceedings in state court must “have bearing on the issues before the Board,” which according to Federal Circuit Court precedent, aligns with the concept of issue preclusion. TBMP § 510.02(a) (2022); *see* 37 C.F.R. § 2.117(a); *Mother's Restaurant, Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1567-568 (Fed. Cir. 1983). *Mother's Restaurant, Inc. v. Mama's Pizza, Inc.* involved a cancellation proceeding, a Texas state court action, and a federal district court action. *See* 723 F.2d at 1567-568. The federal court dismissed the action because “the Texas state court action would dispose of the issues as a matter of collateral estoppel.” *Id.* at 1569. Following suspension of the cancellation proceeding and decision of the state court, the Board gave preclusive effect to the Texas court's findings. *Id.* at 1573. The Federal Circuit affirmed the Board's use of the Texas state court decision under the doctrine of issue preclusion. *Id.* at 1569-573. Unlike the Texas state action in *Mother's Restaurant*, however, the Mississippi state court action does not require the consideration of identical issues, and the determination of any identical issue is not necessary to the judgment of the state court—two necessary elements of issue preclusion.

Under Mississippi common law trademark infringement, Opposer must show that the New Miss mark is so similar to the Ole Miss mark that “its use is reasonably calculated to deceive and result in injury, or it must be used fraudulently so as to have this effect.” *Staple Cotton Co-op. Ass'n v. Federal*

Staple Cotton Co-op Ass'n, 162 So.2d 867, 869 (Miss. 1964). To determine whether the trademark right under Mississippi common law has been infringed, “the court must determine whether:

- (1) The subsequent use was in good faith;
- (2) The subsequent use resulted in confusion or the likelihood of confusion;
- (3) The subsequent use was done with the intent to appropriate business or good will;
- (4) The subsequent use provokes unfair competition; or
- (5) The subsequent use, without competition, is a capitalization upon another’s goodwill.”

W&W Holdings, Inc. v. Village at Henderson Point Owners Ass'n, Inc., 503 So.2d 286, 288 (Miss. 1987) (citing *Cockrell v. Davis*, 23 So.2d 256, 262 (Miss. 1945)). Although the Mississippi common law trademark infringement analysis involves the consideration of the likelihood of confusion, likelihood of confusion is only one factor in determining state common law infringement.

To avoid the necessary comparison of the issues before the Board and the issues included in the complaint in the Mississippi state court, Opposer cites to *Professional Economics Inc. v. Professional Economic Services, Inc.*, 205 U.S.P.Q. 368 (T.T.A.B. 1979) to demonstrate that the “decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion.” Motion to Suspend at 4. But *Professional Economics* involved a **Massachusetts** state court decision; the state courts in Massachusetts have recognized that “the gravamen of a claim of trademark infringement under Massachusetts common law **is the same as under the Lanham Act**: likelihood of confusion.” *Jenzabar, Inc. v. Long Bow Group, Inc.*, 977 N.E.2d 75, 82 n.11 (Mass. App. Ct. 2012) (emphasis added). The Mississippi state courts have framed common law trademark infringement differently; likelihood of confusion is only one element of an infringement claim, not the central tenet.

Opposer cites *Git-R-Done Productions, Inc. v. Giterdone C Store, LLC* to support the premise that “the standard for common law trademark infringement in Mississippi are the same as for federal law: likelihood of confusion.” Motion to Suspend at 4; *see* 226 F. Supp. 3d 684, 691 (S.D. Miss. 2016). The federal district court’s holding is not properly supported by the Mississippi state precedent cited in *Git-R-Done*. First, the two cases cited by the federal district court predate *W&W Holdings, Inc.*, the 1987

Supreme Court of Mississippi case outlining the factored test for Mississippi common law trademark infringement. Second, in both *Richardson v. Thomas* and *Dollar Dep't Stores of Miss. v. Laub*, the Supreme Court of Mississippi did not solely consider likelihood of confusion; it determined “if the use of similar names results in confusion or unfair competition,” which then determines whether “the use [of a mark] is constructively fraudulent even though the act may be done innocently.” *Richardson v. Thomas*, 257 So.2d 877, 880 (Miss. 1972); *Dollar Dep't Stores of Miss. v. Laub*, 120 So.2d 139, 143 (Miss. 1960). Neither *Richardson* nor *Dollar Dep't Stores* stands for the premise that Mississippi common law trademark infringement is only determined by likelihood of confusion. As outlined by the Mississippi state precedent above, likelihood of confusion is merely a factor considered by a Mississippi state court when determining common law trademark infringement.

Nor does the determination that the Mississippi state court must make under the Mississippi Anti-Dilution statute bear on the issues before the Board. Although the Mississippi Anti-Dilution statute and the Lanham Act define dilution by blurring and dilution by tarnishment identically, the analyses of the issues diverge from there. MISS CODE ANN. § 75-25-1(l), (m); 15 U.S.C. §1125(c)(2)(B), (C). The Mississippi Anti-Dilution statute considers the fame of the mark only within the state of Mississippi, and the Mississippi state court will consider registration of the mark in determining whether the mark is famous. MISS CODE ANN. § 75-25-25(b). These differences that distinguish the state claim from the federal claim of dilution ensure that the Mississippi state court’s decision on the claim of dilution should not bear on the issues before the Board.

Opposer additionally writes that “the suspension of this proceeding will assist in avoiding premature and unnecessary discovery regarding currently unresolved issues about the Subject Mark that may be resolved in the State Court Action.” Motion for Suspension at 3. This argument makes no sense: the discovery will have to be done one way or the other, either in this opposition (where it is already ongoing) or in Mississippi state court (if this proceeding were suspended). Considering the applicable law in both actions and the shared desire for efficiency, the Board should deny the Opposer’s Motion to

Suspend and continue the opposition proceeding so any decision by the Board and the Mississippi state court is fully informed and properly concludes all claims between Opposer and Applicant.

III. CONCLUSION

For the reasons set forth above, Applicant Suzi Altman respectfully requests the Board exercise its discretion and deny Opposer's Motion to Suspend this proceeding pursuant to 37 C.F.R. § 2.117(a).

Respectfully submitted,

Date: 07/05/2022

By: /Louis W. Tompros/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Response to Opposer's Motion to Suspend Proceeding Under C.F.R. § 2.117(a) of Opposition No. 90/050,159 has been served on Adelee Traylor, Butler Snow LLP, by forwarding said copy on July 5, 2022, via email to: Adelee Traylor at adelee.traylor@butlersnow.com; johnny.healy@butlersnow.com; john.dollarhide@butlersnow.com; whitcomb@olemiss.edu; ldbrown1@olemiss.edu; and trademark.docket@butlersnow.com.

Date: 7/5/2022

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EXHIBIT A

IN THE CIRCUIT COURT FOR LAFAYETTE COUNTY, MISSISSIPPI

THE UNIVERSITY OF MISSISSIPPI

PLAINTIFF

v.

FILED

CIVIL ACTION NO.:

22-201

SUZI ALTMAN

JUN 03 2022

DEFENDANT

BY:

JEFF SUSBY
CIRCUIT CLERK

D.C.

COMPLAINT

Plaintiff University of Mississippi (“University”), by and through its undersigned counsel, brings this complaint against Defendant Suzi Altman (“Ms. Altman”), and alleges as follows:

PARTIES

1. The University is a state-chartered public institution of higher learning physically located primarily in Lafayette County, Mississippi.
2. Suzi Altman is an adult resident of the State of Mississippi. She can be served with process at her residence at 103 Riverbend Dr., Brandon, MS 39047.

JURISDICTION AND VENUE

3. This Court has jurisdiction over the subject matter of this action under Mississippi Code § 9-7-81.
4. This Court has jurisdiction over the person of the Defendant because she is a resident of the state.
5. Venue is proper in this Court under Mississippi Code § 11-11-3(1)(a)(i) because substantial acts causing injury, including instances of actual confusion, occurred on and around the campus of the University, located within Lafayette County.

FACTS

6. The University's byname is "Ole Miss." The phrase "Ole Miss" has been associated with the University since the late 1890s, and has been used in connection with the University's academics and athletics goods and services since that time. As a result of this use, consumers in Mississippi have come to associate "Ole Miss," as used in connection with these goods and services, with the University. The University therefore is the owner of common law rights in the "Ole Miss" mark in connection with the sale and licensing of apparel and accessories, and education, sports, and entertainment services. The University also is the owner of all rights, title, and interest in U.S. Registration No. 1,405,895 for OLE MISS (stylized) (the "Registration"). Attached as Exhibit A is a true and correct printout from the United States Patent and Trademark Office ("USPTO") database reflecting the Registration. The Registration and the University's common law rights in the "Ole Miss" name and trademark are hereinafter referred to as the "Ole Miss mark."

7. The University has invested considerable time and resources in the development and protection of the Ole Miss mark, reputation, and goodwill.

8. During the time in which the University has used the Ole Miss mark, it has promoted its goods and services throughout the State of Mississippi under the Ole Miss mark. Those goods and services now possess a recognizable and favorable brand recognition. By virtue of the University's many efforts and expenditures of considerable sums for advertising and promotional activities, and by virtue of the excellence of the services associated with the Ole Miss mark, the Ole Miss mark has an extremely valuable reputation.

9. The Ole Miss mark is distinctive to both the consuming public and the University's trade.

10. As a result of its distinctiveness and widespread use and promotion throughout the State of Mississippi, the Ole Miss mark is a famous and distinctive mark under Mississippi Code § 75-25-25. The Ole Miss mark is famous and distinctive throughout the State of Mississippi in that it is widely, if not universally, recognized by the general consuming public of the state as a designation that the University is the source of goods and services bearing the Ole Miss mark.

11. A specimen of common use of the Ole Miss mark is shown here:



12. Ms. Altman, since July of 2020, has been using the mark “New Miss” in the sale of apparel and accessories, all of which are the same types of goods the University sells or licenses. A specimen of use of the “New Miss” mark, taken from Ms. Altman’s website, www.thenewmiss.com, is shown here:



13. As is plain from the specimen above and from other published uses, Ms. Altman uses the New Miss mark in nearly identical fonts, colors, and overall style to have a similar commercial impression as the Ole Miss mark.

14. The New Miss mark is confusingly similar to the Ole Miss mark, trades on the University’s goodwill and reputation, and causes dilution of the Ole Miss mark.

15. The Ole Miss mark became famous in the State of Mississippi prior to Ms. Altman's July 9, 2020, date of first use.

16. Given the similarities between the two marks' words and typefaces, and Ms. Altman's use of the school's red, navy blue, and powder blue colorways, which have attained secondary meaning, Ms. Altman has willfully intended to cause dilution of the Ole Miss mark.

17. Ms. Altman's conduct has damaged and will continue to damage the University through the loss of revenue and inability to protect its brand and the goodwill of that brand.

FIRST CAUSE OF ACTION – VIOLATION OF MISSISSIPPI ANTI-DILUTION LAW

18. The University incorporates by reference and realleges the allegations of the preceding paragraphs as if fully set forth herein.

19. Ms. Altman's conduct dilutes the famous Ole Miss mark. Ms. Altman's use of the New Miss mark has caused and will continue to cause the diminution of the value of the goodwill represented by the Ole Miss mark as well as the distinctiveness of the Ole Miss mark.

20. And so, under Mississippi Code § 75-25-25(c), the University is entitled to an injunction prohibiting Ms. Altman from any and all uses of the New Miss mark in the State of Mississippi.

21. Additionally, as a result of Ms. Altman's willful intent to cause dilution, the University is entitled to the remedies set forth in title 75, chapter 25 of the Mississippi Code, as well as the University's attorneys' fees.

SECOND CAUSE OF ACTION – COMMON LAW TRADEMARK INFRINGEMENT

22. The University incorporates by reference and realleges the allegations of the preceding paragraphs as if fully set forth herein.

23. Ms. Altman's use of the New Miss mark in connection with the sale, offering for sale, distribution, and advertising of the goods and services is reasonably calculated to deceive and result in injury to the University's rights in the Ole Miss mark.

24. And so Ms. Altman's conduct constitutes common law trademark infringement, with harm to the University as stated herein.

PRAYER FOR RELIEF

WHEREFORE, the University prays for the following relief against Ms. Altman:

- a) That the Court issue an injunction prohibiting Ms. Altman forever from using the New Miss mark in any manner in the State of Mississippi;
- b) That Ms. Altman be ordered to produce for destruction all goods in her possession, custody, or control that contain the New Miss mark;
- c) That the Court award the University its attorneys' fees and costs under Mississippi Code § 75-25-25; and
- d) That the Court award to the University and against Ms. Altman any other relief the Court deems just under the facts and applicable.

DATED: this the 3rd day of June, 2022.



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