Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1298537**

Filing date: **07/20/2023**

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

Proceeding no.	91285094
Party	Defendant EXP Corp.
Correspondence address	JOHN H. CHOI JOHN H. CHOI & ASSOCIATES LLC 65 CHALLENGER ROAD, SUITE 100 RIDGEFIELD PARK,, NJ 07660 UNITED STATES Primary email: jchoi@jchoilaw.com 201-580-6600
Submission	Motion to Dismiss - Rule 12(b)
Filer's name	Eleni Melekou
Filer's email	Eleni@pnlawyers.com, taso@pnlawyers.com, jdn@pnlawyers.com, greg@pnlawyers.com, jacqueline@pnlawyers.com, nate@pnlawyers.com
Signature	/Eleni Melekou/
Date	07/20/2023
Attachments	Brooklyn Lab - Motion to Dismiss Working Draft_for FILING.pdf(775728 bytes)

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

In the matter of Application Serial No. 90462963
Mark: BROOKLYN LAB

JUDA OHANA

Opposer, Opposition No. 91285094

v.

EXP Corp

Applicant.

APPLICANT'S MOTION TO DISMISS NOTICE OF OPPOSITION

Applicant, EXP Corp ("EXP Corp" or "Applicant"), by its undersigned counsel and pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure, files its Motion to Dismiss the subject Notice of Opposition and, in support, states as follows:

PRELIMINARY STATEMENT

In his Notice of Opposition, Opposer Juda Ohana ("Ohana" or "Opposer") included nothing more than generalities and vague factual fabrications to interfere with EXP Corp's registration of its "Brooklyn Lab" mark with the United States Patent and Trademark Office ("USPTO") (the "Subject Mark"). Ohana, who asserts in his Notice of Opposition that he has been the purported owner of the "Brooklyn Lab" mark since 2015, submitted two (2) failed applications with the USPTO to register his alleged trademark. Remarkably, in his first application, that was ultimately abandoned because of a typographical error, Ohana omitted to disclose the ostensible date of first use of his alleged mark in the United States (U.S.) commerce, while he conveniently failed to submit any specimens. Critically, Ohana's second application, the one referenced in his

kitchen-sink Notice of Opposition, was filed on an intent-to-use basis, namely under an ostensible bona fide intention to be used in the near future. Ohana's applications to register the "Brooklyn Lab" mark show that Ohana does not have any prior superior rights in the "Brooklyn Lab" mark. At bottom, Ohana never used the Subject Mark before EXP Corp. Ohana's applications, and the instant Notice of Opposition were brought in bad faith with an intention to cause harm and pecuniary injury to EXP Corp's successful coffee brand and business. Therefore, for the reasons stated below, the Trademark Trial and Appeal Board (the "Board") should dismiss Ohana's Notice of Opposition and grant EXP Corp's application to register the "Brooklyn Lab" mark in connection with its coffee and coffee-related products.

FACTUAL BACKGROUND

The application involved herein seeks registration of the mark "Brooklyn Lab" for "coffee, coffee beans, tortilla chips and granola." Applicant filed for registration on January 13, 2021 (Serial Number: 90462963). Exp Corp's application inadvertently stated that it made first use of its "Brooklyn Lab" mark in commerce on or around September 1, 2020. However, Exp Corp sold coffee, and coffee products under the "Brooklyn Lab" mark as early as July 30, 2020. (Exhibit 3)

Despite Plaintiff's rights in the "Brooklyn Lab" mark, on October 30, 2020, Defendant Ohana filed an application to register the "brooklyn labr" mark with the USPTO, while he intended to register an infringing "Brooklyn Lab" as his own (Serial Number: 90290520). In his application, Ohana filed no specimens. However, because of a typographical error in his first trademark application, Ohana ultimately abandoned his application. Ohana did not claim a date as the first date that he had allegedly made the first use of the infringing mark in commerce. (Exhibit 1)

While Plaintiff's application to register its "Brooklyn Lab" mark was pending before USPTO, on April 6, 2022, Defendant Ohana filed a second application to register an infringing

"Brooklyn Lab" mark with the USPTO in connection with the same products as Plaintiff, namely coffee, coffee beans, tortilla chips and granola (Serial Number: 97349782). Ohana's second application to register an infringing "Brooklyn Lab" mark was submitted under a Trademark Act Section 1(b) basis, namely as an intent-to-use trademark application. As analyzed below, an intent-to-use basis solely demonstrates Ohana's intention to use the infringing mark in the future, thereby failing to establish Ohana's rights in Plaintiff's mark. (Exhibit 2)

The USPTO examiner suspended Ohana's second application on the grounds that there was likelihood of confusion with Plaintiff's prior-filed mark. (Exhibit 4). On March 21, 2023, USPTO published Plaintiff's trademark application for opposition in the USPTO Trademark Official Gazette. On May 18, 2023, Defendant Ohana filed the subject Notice of Opposition against the registration of Plaintiff's "Brooklyn Lab" mark.

OPPOSER'S ALLEGATIONS

Contrary to his statements in his two prior-filed applications to register the infringing "Brooklyn Lab" mark as his own, Ohana asserted in his Notice of Opposition that he had begun using the "BROOKLYN LAB trademark in connection with coffee and coffee-related products in the United States and had continued to do so since [2015]." *See,* Opposition ("Opp.") ¶ 2. Ohana fails to clarify if he is affiliated with or the owner of a company that purportedly produces or sells the alleged "coffee and related products" for Ohana. Tellingly, Ohana attached no exhibits to his Notice of Opposition regarding his ostensible 2015-founded "Brooklyn Lab" brand.

Moreover, Ohana contends that EXP Corp approached him at an unspecified time in 2020 "about distributing Opposer's coffee and adding it to Applicant's catalog of brands." *See,* Opp. ¶ 3. Similarly, Ohana asserts that in an undisclosed period of time, "Opposer gave Applicant some products for distribution, then learned later on that Applicant was swapping out Opposer's prior

BROOKLYN LAB trademark." *Id.* Opposer does not allege that there was any contract between the parties creating any legal obligation to EXP Corp to exclusively sell Opposer's purported brand – there was not. Conveniently, Ohana does not include any exhibits showing his purported transactions with Applicant.

Further, Opposer alleged that in October 2020, Ohana filed to register the "BROOKLYN LAB" mark in connection with "Coffee, coffee bean; Tortilla; Tortilla Chips; Granola." Opposer's application received serial number 90290520 ("Ohana's First Application"). *See,* Opp. ¶ 4, Exhibit 1. However, "[d]ue to an uncorrectable error in the manner in which Opposer's prior application was filed," Opposer had to abandon his First Application. Ohana sought to register the mark "brooklyn labr" instead of "Brooklyn Lab." *See,* Opp. ¶ 6. After more than a year and a half, in April 2022, Opposer filed a new application. Opposer's newly filed application was assigned serial number 9734978 ("Ohana's Second Application"). *Id.*; Exhibit 2. Ohana's Second Application was suspended because of a likelihood of confusion with Applicant's prior-filed mark. *See.* Opp. ¶ 7; Exhibit 4.

Ohana professes that EXP Corp was aware of "Opposer's prior rights to a BROOKLYN LAB trademark" and that "Applicant's Application is therefore *void ab initio* based on its violation of the application filing oath." *See,* Opp. ¶ 8. Ohana omits to state in his Notice of Opposition that Ohana's First and Second Applications were also *filed under oath,* and Ohana disclosed under oath only his intention to use the "Brooklyn Lab" mark. *See,* Exhibit 2.

Subsequently, Ohana asserts that EXP. Corp's goods "were not in use in U.S. commerce at the time of the application filing on January 13, 2021." *See,* Opp. ¶ 9. However, Ohana's assertion is contradicted by evidentiary document showing EXP Corp's use of the "Brooklyn Lab" mark in July 2020. *See,* Exhibit 3.

Ohana vaguely asserts -without including any exhibits in support of his Notice of Opposition showing his alleged use of the "Brooklyn Lab" mark - that he has superior rights in the mark, he "has invested a substantial amount of time, effort and money in promoting his 'BROOKLYN LAB' mark and products," and his putative mark has become "closely and uniquely identified and associated with Opposer and has come to represent enormous goodwill for Opposer." *See,* Opp. ¶ 10. In sum, Ohana alleges grounds of opposition based on purported consumer confusion given that the marks are purportedly identical, cover the same class of products and the parties target customers and consumers in the same area, namely Brooklyn, New York. *See,* Opp. ¶¶ 11-12.

LEGAL ARGUMENT

Registration decisions fall in the first instance to the USPTO's Examining Attorneys, who possesses the power to grant or deny registration applications in whole or in part. *See, e.g., Moke Am. LLC v. Am. Custom Golf Cars, Inc.*, No. 3:20CV400 (DJN), 2023 WL 3232601, at *2 (E.D. Va. May 3, 2023). Opposition proceedings before the TTAB are "similar to a civil action in a federal district court." TTAB Manual of Procedure § 102.03 (2014) (hereinafter TTAB Manual)[1]. These proceedings, for instance, are largely governed by the Federal Rules of Civil Procedure and Evidence. See 37 C.F.R. §§ 2.116(a), 2.122(a) (2014). It is well established that, in opposition proceedings, the burden of proof rests on the opposer. *See, Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 973 (Fed. Cir. 2018); § 2.116(b). If the opposer cannot meet that burden, – as here- the opposed mark must be registered. *See,* 15 U.S.C. § 1063(b).

To survive a motion to dismiss under Rule 12(b)(6), a notice of opposition need to only allege such facts as would, if proved, establish opposer's standing to maintain the proceeding and

[1] http://www.uspto.gov

a ground or grounds for refusing registration to applicant. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co*., 670 F.2d 1024, 213 USPQ 185 (CCPA1982), and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.,* 228 USPQ 752 (TTAB1985). Here, the Opposer has not pleaded facts which, if proven, would establish grounds for refusing registration to Applicant. Tellingly, the Notice of Opposition fails to state the section or sections of the Trademark Act which Opposer is relying on. At bottom, the Notice of Opposition at issue contains vague recitations of grounds of oppositions and catch-all allegations without any legal or factual basis which would not and can not allow opposer to prevail.

I. <u>Opposer Lacks Standing</u>

It is well-settled that Trademark rights arise from the use of the mark in connection with particular goods or services. *See, B & B Hardware, Inc. v. Hargis Indus., Inc*., 575 U.S. 138, 142, (2015); *United Drug Co. v. Theodore Rectanus Co*., 248 U.S. 90, 97–98 (1918). Accordingly, a party has standing to oppose a trademark registration if that party can demonstrate a real interest in the proceeding. *Universal Oil Products Co. v. Rexall Drug and Chemical Co*., 59 CCPA 1120, 463 F.2d 1122 (C.C.P.A 1972). By way of example, an opposer cannot show injury in fact for purposes of Article III of the United States Constitution standing to appeal Trademark Trial and Appeal Board's decision in an opposition or cancellation proceeding by merely showing the registrant competes with the opposer and receives a benefit from an unlawful trademark. *Brooklyn Brewery Corp v. Brooklyn Brew Shop*, 17 F.4th 129 (Fed. Cir. 2021). *A more particularized showing of harm is required. Id., citing* U.S. Const. art. 3, § 2, cl. 1 (emphasis added).

For the purposes of the instant proceedings, the question of standing is analyzed under the prism of Section 13 of the Lanham Act, which provides, in pertinent part, that "[a]ny person who believes that he would be damaged by the registration of a mark ... may, upon payment of the

prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor." 15 U.S.C. § 1063(a). Similarly to Article III standing requirements, the purpose of the standing requirement under the Lanham Act is "to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler." *Lipton Indus., Inc. v. Ralston Purina Co*., 670 F.2d 1024, 1028–29 (C.C.P.A.1982). It is respectfully submitted that Ohana is an intermeddler lacking any standing to oppose EXP Corp's registration.

In addition to meeting the broad requirements of Section 13, an opposer must satisfy two judicially created standing requirements. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1376–77 (Fed. Cir. 2012) *citing Ritchie v. Simpson,* 170 F.3d 1092, 1094 (Fed.Cir.1999). Specifically, an opposer must show: (1) a "real interest" in the proceeding; and (2) a "reasonable basis" for believing that it would suffer damage if the mark was registered. *Id.* Under the "real interest" requirement, an opposer must have "a legitimate personal interest in the opposition." *Id.* With respect to the second inquiry, the opposer's belief of damage "must have a reasonable basis in fact." *Id*. at 1098 (citation and quotation omitted).

Here, Opposer fails to plead a legitimate personal interest in preventing the registration of the Applicant's mark. Additionally, Ohana improperly fails to specify if he uses the putative mark in his individual capacity or on behalf of an entity. Rather, Ohana does nothing more than merely parroting vague assertions about a hypothetical and unspecified injury. *See, e.g.,* Opp. ¶ 13. Accordingly, Ohana fails to plead standing as a matter of law, given that there is not and cannot be any reasonable basis for his belief that he would suffer any damage whatsoever in light of his mere intention to use the mark in the future. Simply put, Ohana is not owner of the "Brooklyn Lab" mark and cannot establish any prior or superior rights in the mark as a matter of law.

Ownership rights to unregistered trademarks, as the "Brooklyn Lab" mark, flow from two necessary conditions: (1) priority of use of (2) a valid, protectable mark. *See, George & Co. LLC v. Imagination Ent. Ltd.,* 575 F.3d 383, 400 (4th Cir. 2009). Here, the parties do not challenge the protectability and validity of the "Brooklyn Lab" mark. The party asserting priority in a mark must be *the first to use the mark* in connection with the sale of goods or services, or, at a minimum, must demonstrate that it used the mark before the party against which it asserts its putative rights. *Id.* Both Ohana's Applications speak for themselves. Lanham Act requires that the application for a trademark registration must include, *inter alia*, "the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark." *B & B Hardware, Inc., supra* at 142–44 *citing* § 1051(a)(2). Ohana's First Application omits this statutory mandated requirement. Tellingly, Ohana's Second Application was filed under an intent-to-use basis, thereby showing that Ohana had not used the mark prior to the filing of his Second Application in April 2022. It is well-settled that an intent-to-use application does not, by itself, confer any rights enforceable against others. *See, WarnerVision Entm't Inc. v. Empire of Carolina, Inc.,* 101 F.3d 259, 262 (2d Cir.1996) (finding that because an intent-to-use applicant has the right to engage in use so as to complete registration, a court may enjoin a use from a rival who began use ***after*** the intent-to-use filing date). Contrary to his arbitrary assertions, there is no indication that Opposer began using the mark in 2015, nor that he ever used the mark prior to EXP. Corp

Moreover, Opposer fails to specify *how* he allegedly made use of the mark. By way of example, "mere advertising and documentary use apart from the goods do not constitute technical trademark use." *Powermatics, Inc. v. Globe Roofing Products Co*., 341 F.2d 127, 130, (C.C.P.A. 1965); 2 J. McCarthy, Trademarks and Unfair Competition § 16:10 (1984). The use must be

continuous and create an association of the terms with the user's goods. Here, there is no indication that there was any continuous use of the Subject Mark by Ohana given his statements *under oath* in his two Applications. Further, Ohana fails to specify if he or an entity made the alleged use for purposes of assessing Ohana's standing. Plainly, Ohana's pleadings suffer from fatal intentional deficiencies. EXP Corp never had any third-party vendors who used the "Brooklyn Lab" mark. EXP Corp created the "Brooklyn Lab" mark in June 2020, and started selling its coffee products under the "Brooklyn Lab" mark in July 2020 (Exhibit 3). It is respectfully submitted that Ohana's Notice of Opposition includes nothing more than arbitrary assertions in a desperate attempt to establish his flawed causes of action. Importantly, the documentary evidence shows that Ohana never made any prior use of the Subject Mark. Therefore, Ohana lacks any standing to oppose the registration of Exp Corp's mark since he lacks any personal legitimate interest in the mark as a matter of law.

Only "[o]nce standing is established, the opposer is entitled to rely on any of the grounds set forth in section 2 of the Lanham Act which negate applicant's right to its subject registration." *Jewelers Vigilance v. Ullenberg Corp*,823 F.2d 490, 493 (Fed.Cir.1987) (citation omitted). To the extent that the Board decided that Ohana has standing to bring the instant opposition – he does not – then his flawed causes of action must be dismissed as a matter of law under Rule 12(b)(6).

II. <u>Opposer Failed to Plead Deceptiveness</u>

To state a claim of deceptiveness under Section 2(a), an opposer needs only to allege facts from which it may be inferred that opposer has a reasonable belief that it would be damaged by use of applicant's allegedly deceptive mark and facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's goods. It is not a requirement for an opposer asserting such a claim to allege prior use,

or any use at all, of a mark or trade name similar to applicant's mark. *See, MILLER BREWING COMPANY v. ANHEUSER-BUSCH, INCORPORATED,* Opposition No. 88,487, (TTAB June 2, 1993).[2]

In his Notice of Opposition, Ohana vaguely asserts that consumers will be deceived by Applicant's use of the mark. However, this allegation *alone* does nothing more than repeat a variation of the language set forth in Section 2(d) of the Trademark Act, which prohibits registration of marks "likely to cause confusion, or to cause mistake, or to deceive." Section 2(d) prohibits registration of marks *which are likely to deceive a consumer as to the source or origin of goods or services*. *See, Id.* By contrast, Section 2(a) of the Act prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See, e.g., Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc*., 23 USPQ2d 1894 (TTAB1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods). Ohana failed to plead any facts establishing that purchasers would be deceived in a way that would affect materially their decision to purchase Applicant's goods. By way of example, Ohana does not allege that consumer would be deceived about the type, quality, origin, or another characteristic of Applicant's products under the "Brooklyn Lab" mark. Therefore, Ohana utterly fails to plead a claim for deceptiveness. His allegations about deceptiveness are improperly duplicative to his allegation for consumer confusion since he utterly failed to plead how the alleged deception would affect materially consumer's decision to purchase Applicant's goods.

[2] https://www.ipmall.info/content/ttab-trademark-trial-and-appeal-board-1-miller-brewing-company-v-anheuser-busch-incorporated

Furthermore, Opposer has not specifically identified any particular point in time when consumers began to identify his alleged products by the "Brooklyn Lab" mark. The Notice of Opposition is so vague that there is no indication how consumers could be deceived as to the affiliation of Opposer's ostensible products with EXP Corp There is no indication that Ohana sold his ostensible products or that Opposer's products under the purported "Brooklyn Lab" mark acquired secondary meaning within the minds of average consumers. Therefore, Ohana's ground of opposition under deceptiveness must fail for failure to state a claim.

III. <u>Opposer Failed to Plead Consumer Confusion</u>

Section 2(d) of the Lanham Act precludes the registration of a mark that so resembles a registered mark "or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive[.]" 15 U.S.C. § 1052(d) (1994). In an opposition founded on section 2(d), the opposer must establish its own prior proprietary rights in the same or a confusingly similar designation in order to defeat the application. *See generally* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20.04 (3d ed. 1994). In an opposition founded on § 2(d), opposer must prove that it has proprietary rights in the term it relies upon to prove likelihood of confusion.

The proof could consist of ownership of a registration, prior use of an unregistered mark, prior use in advertising, or as a trade name, or any other type of use which has resulted in establishing a trade identity. At common law, "prior ownership of a mark is only established as of the first actual use of a mark in a genuine commercial transaction." *Allard Enters., Inc. v. Adv. Programming Res., Inc.,* 146 F.3d 350, 358 (6th Cir.1998). The 1988 amendments to the Lanham Act codified a standard of "use in commerce," necessary for a valid trademark registration, which

means "the bona fide use of a mark in the ordinary course of trade," including, for a trademark, attaching the trademark to goods. 15 U.S.C. § 1127. In any case, "sporadic or minimal" sales are not sufficient. *Allard Enters., supra*; *see also Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir.1992) ("A few bottles sold over the counter ... and a few more mailed to friends" are not sufficient use.). While a single sale may indicate the first use of a mark, it must be the beginning of "continuous commercial utilization." *Allard, supra.* Obviously, as § 1052(d) requires, such use must also be "in the United States." *See Person's Co. v. Christman*, 900 F.2d 1565, 1568–69 (Fed.Cir.1990) (T-shirt sales in Japan are not "use in United States commerce"). Here, Ohana's First and Second Application demonstrate that Ohana can not establish any prior proprietary rights in the "Brooklyn Lab" mark since his Second Application was filed under an intent-to-use basis.

It is well settled that one may ground one's opposition to an application on the prior use of a term in a manner analogous to service mark or trademark use. *See, e.g., Steer Inn Sys., Inc. v. Laughner's Drive–In, Inc.,* 405 F.2d 1401 (C.C.P.A. 1969) (successful opposition to registration of service mark). Such an "analogous use" opposition can succeed, however, only where the analogous use is of such a nature and extent as to create public identification of the target term with the opposer's product or service. *See, e.g., Malcolm Nicol & Co. v. Witco Corp,*881 F.2d 1063, 1065, 11 USPQ2d 1638, 1640 (Fed.Cir.1989) (affirming Board's determination that "Witco used 'BRITOL' in a way that created in the minds of people the necessary association between 'BRITOL' and the Witco product"). Here, indirect evidence, namely Ohana's two Applications, falls short of supporting the critical inference of identification in the mind of the consuming public of the Subject Mark with the Opposer as the source of a given product or service. Therefore, Ohana's opposition must be rejected given that Ohana has a mere intention to use the "Brooklyn Lab" in commerce, whereas there is no indication that Ohana used the Subject Mark or made any

analogous use of the same that could establish trade identity in Opposer's favor. For example, in *Old Swiss House, Inc. v. Anheuser–Busch, Inc.,* 569 F.2d 1130 (C.C.P.A. 1978), the evidence of analogous use consisted of the following: "12 articles, each published only once, which appeared in various newspapers and trade journals between December 27, 1963, and April 1, 1964, and a single speech, on April 22, 1964, by one of [the user's] vice-presidents at a shareholders' meeting." *Id.* at 1133. Nevertheless, the court rejected the contention that the articles constituted analogous use sufficient to demonstrate prior proprietary rights in the target phrase. According to the court, it is required a type of public exposure of a mark that would be expected to have significant impact on the purchasing public. *See, T.A.B. Sys. v. Pactel Teletrac,* 77 F.3d 1372, 1375 (Fed. Cir. 1996). Here, there is no indication that Ohana made any use of the "Brooklyn Lab" mark that had any impact in the purchasing public or created a trade identity for Ohana and its products.

Therefore, Ohana's ground of opposition under consumer confusion must fail as a matter of law.

IV. <u>Opposer Failed to Plead False Suggestion or Connection</u>

To state a claim of false suggestion of a connection under Section 2(a), an opposer must allege facts from which it may be inferred that the applicant's mark points uniquely to opposer, as an entity—i.e., that applicant's mark is opposer's identity or "persona"—and that purchasers would assume that goods bearing applicant's mark are connected with opposer. *See, The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 (Fed.Cir.1983). Also, a properly pleaded claim of false suggestion of a connection clearly must assert either opposer's prior use of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona," or an association of the same with the plaintiff prior in time to the defendant's use. *See, e.g. In re Nuclear Research Corp*, 16 USPQ2d 1316 (TTAB1990), and *Alabama Board of Trustees*

v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB1986). Here, Opposer's failed to properly plead a claim for relief under false suggestion of a connection.

For a claim of false suggestion of a connection, an opposer must claim, *inter alia*, either that it is a prior user of the mark in question, or that the mark became associated with opposer prior to applicant's use or constructive use. *See, Nuclear, supra, and Alabama Board of Trustees, supra*. Here, Ohana failed to suggest that the mark Applicant seeks to register point "uniquely and unmistakably" to Ohana, neither as an identifier of his persona, nor as an identifier of the source of particular goods. *See McDonnell Douglas Corp v. National Data Corp*, 228 USPQ 45 (TTAB1985). Opposer's claim for relief under false suggestion or connection is improperly duplicative to its claim for relief for consumer confusion. Opposer did not even bother to claim that the "Brooklyn Lab" mark is associated with Ohana's identity or persona, or even when this consumer association started. At bottom, Ohana's claim for relief under false suggestion or connection is flawed and must fail as a matter of law; Ohana had previously filed an application on an intent-to-use basis and fails to plead any "analogous" use of the mark to establish priority over EXP Corp.

V. Opposer Failed to Plead Fraud

Proving fraud "requires a purpose or intent to deceive the [US]PTO in the application for the mark" to be established by clear and convincing evidence. *See Sovereign Military v. Florida Priory of Knights*, 702 F.3d 1279, 1289 (11th Cir. 2012). A party alleging fraud in a trademark application bears a heavy burden of proof; "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference, or surmise and, obviously, any doubt must be resolved against the charging party." *In*

re Bose Corp, supra at 1242, quoting Smith Int'l, Inc. v. Olin Corp, 209 USPQ 1033, 1044 (TTAB 1981); Lanham Act, § 14(3), 15 U.S.C.A. § 1064(3).

Federal Rule of Civil Procedure 9(b), applicable to Board proceedings under 37 C.F.R. § 2.116(a), requires that "[i]n alleging fraud or mistake, a party must state ***with particularity*** the circumstances constituting fraud or mistake." Fed. R. Civ. P. 9(b) (emphasis added). While the rule explains that "[m]alice, intent, knowledge, and other conditions of a person's mind may be averred generally" (*id.*), tellingly, it requires "identification of the specific who, what, when, where, and how of the material misrepresentation or omission committed before the [US]PTO." *Exergen Corp v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1328 (Fed. Cir. 2009) (construing Rule 9 in the context of pleading inequitable conduct in patent cases). Here, Opposer has not and cannot meet this standard.

The regulation governing use-based trademark applications requires that a mark be in use "as of the application filing date." 37 C.F.R. § 2.34(a)(1). Additionally, the 2021 form requires Applicant to certify that: "the mark is in use in commerce and was in use in commerce *as of the application filing date*." *See, e.g., Spliethoff Bevrachtingskantoor B.V. v. United Yacht Transp. LLC*, 2022 WL 17067798, at *2 (S.D. Fla. Nov. 17, 2022), *appeal dismissed,* 2023 WL 4054356 (11th Cir. June 7, 2023). Here, Opposer's allegations that Exp Corp's first use of the "Brooklyn Lab" mark was outside of the U.S. commerce is a mere fabrication. Exp Corp is a New York company, that sold coffee under the "Brooklyn Lab" mark in the United States as early as July 30, 2020.

Similarly, Opposer's allegation that EXP Corp was somehow aware of Ohana's ostensible rights in the "Brooklyn Lab" mark is misleading and directly contradicts Ohana's Second Application that was submitted on an intent-to-use basis. Ohana's assertions lack any factual basis

whatsoever. Therefore, it can be reasonably inferred that Ohana's opposition was brought in bad faith and to unlawfully interfere with Applicant's coffee business.

CONCLUSION

Based on the foregoing, EXP Corp respectfully requests that the Board dismiss the instant Notice of Opposition in its entirety, and grant such other and further relief, favorable to the Applicant, as the Board deems just and proper.

Dated: New York, New York
July 20, 2023

Respectfully submitted,
PARDALIS & NOHAVICKA, LLP

By: /s/_Eleni Melekou_____
Eleni Melekou, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion to Dismiss with Exhibits 1-4 have been served on Opposer's counsel, ROBERTO LEDESMA by forwarding said copy on July 20, 2023, via email to: roberto@ilawco.com.

Signature_/s/ Eleni Melekou____ Date___ July 20, 2023

EXHIBIT “1”

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Jul 19 03:17:23 EDT 2023

Record 1 out of 1

brooklyn labr

Word Mark	**BROOKLYN LABR**
Goods and Services	(ABANDONED) IC 030. US 046. G & S: Coffee; coffee beans; tortilla chips; granola. FIRST USE: 20160000. FIRST USE IN COMMERCE: 20160000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	90290520
Filing Date	October 30, 2020
Current Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Judah Ohnana INDIVIDUAL UNITED STATES 383 kingston ave, suite 58 Brooklyn NEW YORK 11213
Attorney of Record	Roberto Ledesma
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BROOKLYN" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Abandonment Date	November 10, 2022

EXHIBIT “2”

For assistance with TSDR, email **teas@uspto.gov** and include your serial number, the document you are looking for, and a screenshot of any error messages you have received.

STATUS | DOCUMENTS | Back to Search | Print

Generated on:	This page was generated by TSDR on 2023-07-17 11:42:02 EDT
Mark:	BROOKLYN LAB BROOKLYN LAB
US Serial Number:	97349782
Application Filing Date:	Apr. 06, 2022
Register:	Principal
Mark Type:	Trademark
TM5 Common Status Descriptor:	LIVE/APPLICATION/Under Examination The trademark application has been accepted by the Offi minimum filing requirements) and that this application ha examiner.
Status:	Suspension check completed. Application remains suspended.
Status Date:	May 18, 2023

Mark Information

Expand All

Mark Literal Elements:	BROOKLYN LAB
Standard Character Claim:	Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type:	4 - STANDARD CHARACTER MARK

Goods and Services

Note:
The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [..] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For:	Coffee; coffee beans; tortilla chips; granola		
International Class(es):	030 - Primary Class	**U.S Class(es):**	046
Class Status:	ACTIVE		
Basis:	1(b)		

Basis Information (Case Level)

Filed Use:	No	**Currently Use:**	No
Filed ITU:	Yes	**Currently ITU:**	Yes
Filed 44D:	No	**Currently 44E:**	No
Filed 44E:	No	**Currently 66A:**	No
Filed 66A:	No	**Currently No Basis:**	No
Filed No Basis:	No		

Current Owner(s) Information

Owner Name:	Juda Ohana		
Owner Address:	383 Kingston Ave, Suite 58 Brooklyn, NEW YORK UNITED STATES 11213		
Legal Entity Type:	INDIVIDUAL	**Citizenship:**	UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name:	Roberto Ledesma		
Attorney Primary Email Address:	roberto@ilawco.com	**Attorney Email Authorized:**	Yes

Correspondent

Correspondent Name/Address:	Roberto Ledesma LEWIS & LIN, LLC 77 SANDS STREET, 6TH FLOOR BROOKLYN, NEW YORK UNITED STATES 11201		
Correspondent e-mail:	roberto@ilawco.com trademarks@ilawco.com	**Correspondent e-mail Authorized:**	Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 18, 2023	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	88889
Mar. 01, 2023	ASSIGNED TO EXAMINER	92569
Nov. 10, 2022	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	

Nov. 10, 2022	LETTER OF SUSPENSION E-MAILED	
Nov. 10, 2022	SUSPENSION LETTER WRITTEN	92822
Nov. 09, 2022	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 09, 2022	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 09, 2022	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 09, 2022	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 09, 2022	NON-FINAL ACTION E-MAILED	6325
May 09, 2022	NON-FINAL ACTION WRITTEN	92822
May 09, 2022	ASSIGNED TO EXAMINER	92822
Apr. 11, 2022	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED	
Apr. 09, 2022	NEW APPLICATION ENTERED	

TM Staff and Location Information

TM Staff Information

TM Attorney:	O'BRIEN, JENNIFER LYNN	**Law Office Assigned:**	LAW OFFICE 121

File Location

Current Location:	TMO LAW OFFICE 121	**Date in Location:**	May 18, 2023

Assignment Abstract Of Title Information - None recorded

Proceedings - None recorded

EXHIBIT “3”

MORNING

INVOICE

MORNING DISTRIBUTOR
P.O BOX 570039
WHITESTONE , NY 11357
MAIL INFO@EXPCORPUSA.COM
TEL 585-747-2846

ROUTE	INVOICE	ACCOUNT	TERMS	SALES PERSON	SALES PHONE
8	003176	1239		DAVE	[redacted]1141

BILL TO
[redacted]
Ridgewood , NY 11385

SHIP TO
[redacted]
Ridgewood , NY 11385

INVOICE DATE
07-30-2020
SHIP VIA
IN

NO	CASE	ITEM CODE	Description	Pkg Size	Price	Amount
1	1	BL01	BROOKLYN LAB - (Ground) Brazil 6 / 12oz	6 / 12oz	35.00	35.00
2	1	BL03	BROOKLYN LAB - (Ground) Colombia 6 / 12oz	6 / 12oz	35.00	35.00
3	1	BL05	BROOKLYN LAB - (Ground) Brooklyn Blend 6 / 12oz	6 / 12oz	0.00	0.00
4	1	MC01	MUD COFFEE - (GROUND) HUPPIE 6 / 12oz	6 / 12oz	49.00	49.00
5	1	MC03	MUD COFFEE - (GROUND) MOJO 6 / 12oz	6 / 12oz	49.00	49.00
6	1	SC07	STUMPTOWN - CONCENTRATE COLD BREW 6 / 25.4oz	6 / 25.4oz	45.00	45.00
	6					

TOTAL CASE	6	TOTAL ITEMS	6	SUB TOTAL	213.00
COMMENTS	COD 7/30			DISCOUNT	0.00
				CREDIT	0.00
				TOTAL DUE	213.00

EXHIBIT “4”

To: Roberto Ledesma(roberto@ilawco.com)
Subject: U.S. Trademark Application Serial No. 97349782 - BROOKLYN LAB
Sent: November 10, 2022 08:29:07 AM EST
Sent As: tmng.notices@uspto.gov

Attachments

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 97349782

Mark: BROOKLYN LAB

Correspondence Address:
Roberto Ledesma
LEWIS & LIN, LLC
77 SANDS STREET, 6TH FLOOR
BROOKLYN NY 11201 UNITED STATES

Applicant: Juda Ohana

Reference/Docket No. N/A

Correspondence Email Address: roberto@ilawco.com

SUSPENSION NOTICE
No Response Required

Issue date: November 10, 2022

The application is suspended for the reason(s) specified below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq*.

The pending application(s) below has an earlier filing date or effective filing date than applicant's application. If the mark in the application(s) below registers, the USPTO may refuse registration of applicant's mark under Section 2(d) because of a likelihood of confusion with the registered mark(s). 15 U.S.C. §1052(d); *see* 37 C.F.R. §2.83; TMEP §1208.02(c). Action on this application is suspended until the prior-filed application(s) below either registers or abandons. 37 C.F.R. §2.83(c). Information relevant to the application(s) below was sent previously.

- U.S. Application Serial No(s). 90462963

Refusal(s) and/or requirement(s) resolved and maintained and continued.

The following refusal(s) and/or requirement(s) is/are maintained and continued:

- DISCLAIMER REQUIRED

See TMEP §713.02.

These refusal(s) and/or requirement(s) will be made final once this application is removed from suspension, unless a new issue arises. *See* TMEP §716.01.

Suspension process. The USPTO will periodically check this application to determine if it should remain suspended. *See* TMEP §716.04. As needed, the trademark examining attorney will issue a letter to applicant to inquire about the status of the reason for the suspension. TMEP §716.05.

No response required. Applicant may file a response, but is not required to do so.

/Tricia Brown/
Tricia Brown
Trademark Examining Attorney
Law Office 121
(571) 270-7892
tricia.brown@uspto.gov

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on November 10, 2022 for
U.S. Trademark Application Serial No. 97349782

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You may be required to respond to this Office action. Follow the steps below.

(1) Read the Office action. This email is NOT the Office action.

(2) Respond to the Office action, if a response is required. Respond by deadline using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be abandoned. See the Office action itself regarding how to respond.

(3) Direct general questions about using USPTO electronic forms, the USPTO website, the application process, the status of your application, and whether there are outstanding deadlines to the Trademark Assistance Center (TAC).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **Check the status of your application periodically** in the Trademark Status & Document Retrieval (TSDR) database to avoid missing critical deadlines.

- **Update your correspondence email address** to ensure you receive important USPTO notices about your application.

- **Beware of trademark-related scams**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain "@uspto.gov." Verify the correspondence originated from us by using your Serial Number in our database, TSDR, to confirm that it appears under the

"Documents" tab, or contact the Trademark Assistance Center.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.