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

Proceeding	91214459
Party	Plaintiff Duke University
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Before the Trademark Trial and Appeal Board**

Duke University, Plaintiff-Opposer  vs  John Wayne Enterprises, LLC, Defendant-Applicant	<b>Opposition No. 91214459</b>
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Our Ref.: DUKU9270-b

**RESPONSE TO MOTION TO SUSPEND PROCEEDINGS**

**I. INTRODUCTION**

John Wayne Enterprises, LLC (“Enterprises”)<sup>1</sup> has moved to suspend proceedings herein. The motion is its latest move in a set of longstanding disagreements between the parties. Those disagreements stem from Enterprises’ attempts to establish over-arching rights in itself and to interfere with the ability of Duke University (“Duke”) to protect Duke’s own marks and Duke’s own interests. To date, Enterprises has lost every decision. The present motion, like Enterprises’ prior cases, is not well-founded and should not be granted.

Moreover, as discussed hereafter, it is likely that Enterprises’ motion will in any event become moot in approximately one month. Duke has moved to dismiss the California lawsuit. An order deciding that motion is expected on or before September 15.<sup>2</sup> If the Board delays evaluating Enterprises’ motion until after September 15, which certainly would be a normal time frame for reaching a decision in any event, the lawsuit may already have been dismissed and a decision may well have become unnecessary.

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<sup>1</sup> Enterprises is a commercial entity established by the heirs of John Wayne after some interfamilial wrangling. It is attempting to earn money by licensing what it alleges are trademark rights associated with Mr. Wayne that will “associate the John Wayne brand with quality and timeless products and experiences.” See Ex. 1. Interestingly, although the marketing efforts supposedly are directed to products that will “embody the spirit of John Wayne and give back to the community,” the product that is the focus of Enterprises’ current efforts is liquor.

<sup>2</sup> See Decl. of John A. O’Malley filed herewith as Ex. 2 and incorporated herein by reference.

## II. FACTS

Duke and Enterprises (including Enterprises' predecessor in interest) have been opposing parties before the Trademark Trial and Appeal Board ("TTAB") since at least 2005 in connection with marks each of the parties has sought to register. Judgment has been entered in favor of Duke in each of the prior proceedings. *See Duke v John Wayne Enterprises, LLC*, Opp. Nos. 91167168 (judgment refusing Enterprises' application to register DUKE for restaurant services), 91174273 (judgment refusing Enterprises' application to register DUKE for gaming machines and the like), and Canc. 92053341 (judgment cancelling Enterprises' registration of DUKE for celebrity licensing services); and *John Wayne Enterprises, LLC v Duke University*, Opp. Nos. 91183030 (judgment allowing Duke's opposed application to register DUKE MEDICINE for medical services and licensing services, among other things) and 91193267 (judgment allowing Duke's opposed application to register DUKE for clothing), collectively referred to hereafter as the "Judgments."

Promptly after its latest losses, Enterprises filed an intent-to-use application seeking to register a design mark in which the word DUKE is the most prominent text, for use in connection with "alcoholic beverages except beer, all in connection with indicia denoting the late internationally known movie star, John Wayne, who is also known as Duke." The nature and meaning of the tagline following the identification of goods was not further defined.

Duke, knowing that Enterprises has in the past attempted to use its registration and alleged rights to interfere with Duke's own trademark applications, filed a notice of opposition to that application in December 2013. Since that time, Enterprises has filed its answer to the Notice, the parties have held their discovery conference, and discovery has commenced. As part of the discovery process, Duke has notified Enterprises of its intent to rely on the prior decisions. (Ex. 3)

Almost eight months after Duke's notice of opposition was filed, Enterprises filed a lawsuit in the Central District of California, and a motion to suspend these TTAB proceedings in light of that lawsuit. The lawsuit seeks a declaratory judgment that certain of Enterprises' marks, as used, do not

infringe the rights of Duke University and, as used, do not dilute Duke's rights. The claims are somewhat convoluted but clearly are based on what Enterprises alleges are the existing parameters of its use; and seek a declaration as to Enterprises' rights with respect to what Enterprises presently is doing.<sup>3</sup>

Duke has moved to dismiss the California lawsuit. *See* declaration of John A. O'Malley (attached as Ex. 2). A ruling should be issued promptly—within a month. *Id.* Thus, it is very possible that even before a ruling is entered by the Board on Enterprises' motion to suspend, it will already be moot. A short delay in issuing the Board's ruling may, therefore, render it altogether unnecessary to reach and decide this motion.<sup>4</sup> Perhaps anticipating that result, Enterprises has refused to delay discovery in this or another co-pending proceeding while awaiting the outcome of this Board's decision on the motion to suspend.<sup>5</sup>

Even if the California case were to proceed, however, it addresses fundamentally different issues than this Opposition.<sup>6</sup> As a result, the California case—even if ultimately decided in favor of Enterprises—would not preclude the current proceeding nor assist in its resolution.

Accordingly, Duke opposes Enterprises' motion to suspend proceedings [D5], which is not well-founded and which, if granted, could create unreasonable delay in this proceeding and result in harm to Duke.

The pertinent facts are set out in more detail below, and Duke's argument follows in Section III.

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<sup>3</sup> A copy of the complaint is attached to Enterprises' motion.

<sup>4</sup> Counsel for Enterprises were requested to consent to a motion to extend the deadline to respond to the motion to suspend but did not respond to that request.

<sup>5</sup> *See* Ex. 6.

<sup>6</sup> For example the California lawsuit asks for a Declaratory Judgment that certain marks which Enterprises and its partners are apparently using on liquor bottles do not infringe Duke's rights, while this Opposition is based on an intent-to-use application and all of the ways in which Enterprises would be entitled to use the DUKE mark if it proceeded to registration. The ways in which Enterprises would presumptively be entitled to use its mark, if registered, would of course not be limited to the ways in which it presently uses or contemplates use of the mark.

### III. ARUGMENT

#### A. The Application, the Parties, and This Proceeding

John Wayne never challenged Duke's trademark rights during his lifetime. Subsequent to his death, however, matters changed and unfortunately the present parties to this proceeding have a long history of contested proceedings regarding attempts to register, and registrations of, "Duke." In fact in the first two months of 2013, Enterprises received adverse decisions in four cancellation and opposition proceedings (resulting in denial of one registration it had sought and cancellation of the only registration it owned, as well as judgments allowing Duke University to register marks that Enterprises had challenged), as detailed in the Judgments listed *supra* at 2. This followed judgment against Enterprises in another proceeding that it had initiated against Duke in 2011. *Id.* Enterprises has not appealed any of those judgments, and they act as final bars to further action at least in those cases.

Rather than take time to meditate on its failures to prevail in any opposition or cancellation proceeding involving Duke or engage in constructive discussions, Enterprises waited less than a week to file the an intent-to-use application seeking to register a design mark in which the word DUKE is the most prominent text (Serial No. 85/864,358 hereinafter the "Application") at issue here, for use in connection with alcoholic beverages other than beer.<sup>7</sup> On August 6, 2013, the mark was published for opposition and, as Enterprises surely anticipated, Duke University obtained a 90 day request for extension of time to oppose the mark before timely filing a notice of opposition late last year. [D1]<sup>8</sup>

Duke has long served alcoholic beverages and licenses and sells DUKE-branded products for use with wine and other alcoholic beverages, although it is very careful regarding the nature of its use

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<sup>7</sup> The goods with respect to which the mark would be used are qualified as follows: Alcoholic beverages except beers, all in connection with indicia denoting the late internationally known movie star John Wayne, who is also known as Duke. There is no further explanation as to the intended meaning of the underlined terminology.

<sup>8</sup> Docketed pleadings in the pertinent opposition proceeding are referred to herein as "D" followed by the docket number. Exhibits to such pleadings are referenced following a hyphen.

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