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

Proceeding	91226056
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JUNG, Sun-Hee Plaintiff/Opposer, v. Magic Snow, LLC Defendant/Applicant.	Opposition No. 91226056 Mark: SUL BING Application Serial No. 86/357,240 Application filed August 5, 2014

For online submission via ESTTA

OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS THE SECOND AMENDED NOTICE OF OPPOSITION

Opposer, Sun-Hee Jung (hereinafter "Jung" or "Opposer"), timely opposes Applicant Magic Snow, LLC's (hereinafter "Magic Snow" or "Applicant") Motion to Dismiss Opposer's Second Amended Notice of Opposition under Federal Rule of Civil Procedure 12(b)(6). For reasons set forth below, Jung's Second Amended Notice of Opposition sufficiently sets forth grounds for opposition of Applicant's Application Serial No. 86/357,240 (hereinafter "Applicant's Application") for mark SUL BING, and therefore Applicant's Motion to Dismiss should be denied in its entirety.

I. DESCRIPTION OF THE RECORD AND INTRODUCTION

Opposer filed a Notice of Opposition on January 27, 2016 alleging, inter alia, likelihood of confusion and prior use of her SULBING mark. [Dkt. No. 1.] In lieu of an Answer, Applicant filed a Motion to Dismiss Opposer's Notice of Opposition. [Dkt. No. 4.] In response, Opposer

timely filed a Motion To Amend Notice of Opposition, along with an Amended Notice of Opposition adding new claims of unfair competition and invalid application based on nonuse in commerce. [Dkt. Nos. 6, 7.] Applicant opposed Opposer's Motion to Amend Notice of Opposition and also filed a Motion to Dismiss only with respect to Count I (Likelihood of Confusion) and Count II (Unfair Competition) of Opposer's Amended Notice of Opposition. [Dkt. Nos. 9, 10.] Regarding Count III (Invalid Application), Applicant did not seek to dismiss it in its Motion to Dismiss and in fact admitted that allegations of nonuse in commerce "could possibly be construed to sustain the Opposition." [Dkt. No. 10 at 2.] After the parties filed their respective opposition and reply with respect to Applicant's Motion to Dismiss the Amended Notice of Opposition [Dkt. Nos. 12, 13], the Board issued an Order on August 29, 2016 granting in part, and denying in part Applicant's Motion to Dismiss. [Dkt. No. 14.] Specifically, the Board found that Opposer "adequately pleaded the likelihood of confusion portion of its Section 2(d) claim," but granted Applicant's motion with respect to the priority portion of Opposer's Section 2(d) claim and unfair competition claim. The Board, however, sustained Opposer's nonuse in commerce claim. [*Id.* at 8.] In the Order the Board also explicitly gave Opposer permission to file a second amended notice of opposition to "correct[] the defects noted in her Section 2(d) claim." [*Id.* at 7-8.]

On September 19, 2016, Opposer timely and in accordance with the Board's August 29, 2016, Order, filed a Second Amended Notice of Opposition (hereinafter "Second Amended Opp.") claiming likelihood of confusion (and priority) based on a completely new legal ground different than Section 2(d), namely the United States-Korea Free Trade Agreement. It also included the previous claim of invalidity based on nonuse in commerce. [Dkt. No. 16.]

Specifically, in her Count of likelihood of confusion, Opposer asserts that her SULBING marks had obtained their fame in Korea before the filing date of Applicant's intent-to-use Application. Opposer' Second Amended Opp. contains numerous factual allegations with exhibits attesting to the fame of Opposer's SULBING marks in Korea. [Dkt. No. 16, at ¶¶ 1-19 and Exhibits 1-17.][1] As a result of 19 USCA §3805, the United States-Korea Free Trade Agreement provides that well-known marks in Korea are treated as famous marks in the United States. Because that fame and the KORUS FTA have been newly alleged in Opposer's Second Amended Opp., it is an issue not addressed in the Board's decision of August 29, 2016. [Dkt. No. 14.]

Further, contrary to Applicant's assertions in its Motion to Dismiss, Opposer has in fact sufficiently pled in her Second Amended Opp. claims upon which relief can be granted. As a matter of law, Applicant's Motion to Dismiss lacks merit and should be denied.

The United States-Korea Free Trade Agreement

The United States-Korea Free Trade Agreement (hereinafter "KORUS FTA") was signed between the United States and South Korea in June 2007 and entered into force on March 15, 2012 in an effort to strengthen and develop economic relations between the United States and South Korea for their mutual benefit and to facilitate the freer flow of products, services, and ideas. (*See* Exhibit 1, U.S.-Korea Free Trade Agreement Article from the website of the Office of the United States Trade Representative; *see also* Dkt. No. 16, Exhibit 17 at 1.) The KORUS FTA contains over 20 Chapters of provisions agreed upon between the U.S. and Korea. Chapter 18 of the KORUS FTA sets forth provisions concerning intellectual property rights. And Article 18.2, ¶ 8 states in relevant part:

[1] The factual allegations are incorporated herein by reference.

> Each Party[2] shall provide for appropriate measures to refuse or cancel the registration and prohibit the use of a trademark . . . that is identical or similar to a well-known trademark, for related goods or services, if the use of that trademark . . . is likely to cause confusion, or to cause mistake, or to deceive or risk associating the trademark or geographical indication with the owner of the well-known trademark, or constitutes unfair exploitation of the reputation of the well-known trademark.

(Dkt. No. 16, Exhibit 17 at 10-11.)

As clearly stated in the language and explained in the legislative history of the KORUS FTA, Article 18.2, ¶ 8 provides for owners of well-known marks (in Korea) to prohibit or cancel trademark registrations (in the U.S.) of marks that are identical or similar to the well-known mark (in Korea). (*See* Exhibit 2, Report of the Industry Trade Advisory Committee on Intellectual Property Rights, at 8.) "This protection in the KORUS FTA extends not only to registration of conflicting marks but also to the *use* of the conflicting mark . . . . This FTA provides the greatest protection for well-known marks to date[] and should be applauded." (*Id.*)

Moreover, as a result of the implementing legislation, priority is conferred by Article 18.2, ¶ 8 such that if a party owns a well-known trademark in Korea then that party has priority as of its date of fame in Korea over another party who later tries to register or starts using a similar or same mark in the U.S. after the mark first became famous and well-known in Korea.

According to the legislative history of the KORUS FTA, "the trademarks section includes major provisions that should assist trademark owners in protecting trademarks." (Exhibit 2 at 7.) "This agreement makes some significant advances toward the broader goal of setting high standards and good precedents for the future and for other FTAs. But again . . . the proof will lie in the implementation of these new standards on the ground in the country, by police,

[2] Party is defined as The Government of the United States and the Government of the Republic of Korea. [*See* Dkt. No. 16, Exhibit 17 at 1.]

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