



4. The rulings in the Federal Court Action, and by the United States Court of Appeals for the Second Circuit in the appeal from the verdict in that Action (the "Appeal"), dispose of the entirety of the claims in this proceeding and mandate dismissal.

***The Petitioner Asserted the Same Claims in the Federal Court Action and Appeal as in This Proceeding***

5. In the Federal Court Action, HLI as plaintiff sought damages for violations of 15 U.S.C. § 1125 with respect to its registered trademark "Hamptons Locations," which is the same mark at issue in this proceeding.

6. In her petition in this proceeding, Petitioner asserts as "the grounds to cancel" are that HLI's service mark "Hamptons Locations" is either "generic" or "descriptive" and lacks secondary meaning. For example, the petition claims as a basis to cancel that:

Because the service mark Hamptons Locations is so highly descriptive and generic it cannot be a source indicator nor can it be distinctive or could it of gained secondary meaning at time of registration. [sic]

Petition, paragraph 9.

7. These are precisely the same defenses asserted in the Federal Court Action and the Appeal. In the Federal Court Action, the pre-trial order identifies as defenses that:

2. . . . The mark in suit is generic and is the common name for the service in connection with which it is used, A generic term is not capable of serving the essential trademark function of distinguishing the products or services of a business from the products or services of other businesses, and therefore cannot be afforded any legal protection . . . .

3. . . . The mark in suit is descriptive and lacks secondary meaning; it is therefore not distinctive or famous, and cannot be afforded protection under the Lanham Act . . . .

Federal Court Action Joint Pre-Trial Order at 3 (dated September 12, 2006). The Joint Pre-Trial Order was submitted as Exhibit D to the affidavit of Nancy Grigor sworn to November 25, 2006 in this proceeding, and is located in Docket Item 4 at page 58.

8. The Federal Court Action was tried to a jury in January 2007. At the conclusion of the trial, Judge Dennis Hurley charged the jury to determine, among other things, whether the “Hamptons Locations” mark had acquired secondary meaning and is protectible.

9. The jury returned its verdict on January 29, 2007. On the special verdict sheet, the jury answered “yes” to the question “Did plaintiffs Hamptons Locations, Inc. and Nancy Grigor prove that the service mark ‘Hamptons Locations’ had acquired ‘secondary meaning’ prior to July 8, 1999?”. The jury proceeded to find that HLI and Ms. Grigor had proved the other elements of a violation of Section 1125(d) against one of the defendants in the Federal Court Action, and awarded damages. The jury's verdict sheet, dated January 29, 2007, is annexed hereto as Exhibit A.

### ***Petitioner's Appeal***

10. While the claims against Petitioner had been dismissed at the time of trial, the Petitioner filed a notice of appeal in the Federal Court Action June 23, 2009, seeking review of the dismissal of her counterclaims and certain other relief. The Petitioner's husband and son also filed notices of appeal from various aspects of the Federal Court Action.

11. Petitioner and the other appellants to the Appeal filed a single brief asserting various grounds for reversal. In Petitioner's brief on Appeal, Petitioner and the other appellants included in their summary of argument that:

71. The District Court erred when it held that Grigor's [HLI's] mark was not generic. Both the geographical name Hamptons and the word locations are generic and when put together it becomes a generic term which describes the very genus of services being offered. Even if the generic term had become identified with a first user, it cannot be afforded protection since it would grant the owner of the mark a monopoly, since a competitor could not describe his goods or services as he should.

72. The Jury verdict that Grigor's [HLI's] mark Hamptons Locations had acquired secondary meaning as of July 8, 1999, that Darrell had violated § 1125(d) of the Lanham Act and awarded Grigor [HLI] statutory damages had to be based on a complete failure of the jury to understand the complexity of trademark law and the Court's limited jury charge which did not explain the 'heavy burden of proof' necessary for Grigor [HLI] to prove that her mark was distinctive and had acquired secondary meaning and therefore, could have only been based on sheer conjecture and surmise.

Brief for Defendants-Appellants at 19-20. Petitioner's brief is annexed hereto as Exhibit B.

12. The United States Court of Appeals for the Second Circuit affirmed the District Court's rulings in the Federal Court Action in its summary order dated February 5, 2010. Relevant here, the Second Circuit upheld the jury's verdict against the

Petitioner's son with respect to the claim advanced at trial and on appeal that HLI's trademark "Hamptons Locations" "should have been held generic as a matter of law. The district court did not err in rejecting this argument." *Hamptons Locations, Inc. v. Rubens*, 364 Fed. Appx. 685, 686 (2d Cir. Feb. 5, 2010).

13. The Second Circuit similarly rejected Petitioner's appeal in the Federal Court Action, holding that the "district court did not err when it dismissed the Rubens' counterclaims, as those claims were baseless as a matter of law." *Id.*

#### ***Petitioner Has Had Her Day In Court***

14. Having participated fully in the Appeal from the Federal Court Action, including advancing as co-defendant-appellant the very same claims as are asserted in this Proceeding that HLI's mark should be held to be "generic" or "descriptive" and lacking secondary meaning, Petitioner should not be permitted to re-litigate those claims all over again in this forum. *See Ball v. A.O. Smith Corp.*, 451 F.3d 66, 69 (2d Cir. 2006).

15. Indeed, the attempt to re-litigate these issues by Petitioner will exacerbate the expense, delay and harm already suffered by HLI. HLI expressly reserves all of its rights to recover attorneys fees and other expenses occasioned by this Proceeding.

#### ***Conclusion***

16. For the foregoing reasons, and those set forth in Respondent's previous submissions in this proceeding, Respondent respectfully requests that the TTAB either dismiss this Proceeding in its entirety, or to continue to hold this matter in suspension pending an agreed-upon schedule to brief a motion for summary judgment based on the

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