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

Proceeding	92058315
Party	Defendant M22, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

State of Michigan

Petitioner,

Proceeding No: 92058315

v.

M22, LLC,

Registrant.

RESPONSE TO PETITIONER'S MOTION FOR JUDGMENT ON THE PLEADINGS

I. INTRODUCTION

Registrant hereby responds to Petitioner's Motion for Judgment on the Pleadings and asserts that genuine issues of material fact remain for trial so as to preclude Petitioner's Motion.

II. FACTS

Registrant is M22, LLC ("M22"), a limited liability company organized under the laws of the State of Michigan, which was registered with the State of Michigan on May 19, 2003. M22, LLC is the owner of several registered trademarks¹. At issue in this matter are the following two marks:



Mark: M 22 M22ONLINE.COM

¹ M22 for use in association with wine (Reg. No. 3427900), M22 for use in association with retail store services (Reg Nos. 3992151 and 3992159), M 22 M22ONLINE.COM for use in association with apparel (Reg. No. 3348635), and THE M-22 CHALLENGE for use in association with athletic competitions (Reg No. 3996410).

International Class 025: Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops.

First Use In Commerce: January 1, 2004 (“M22 Apparel Mark”)



Mark: M22

International Class 035: Retail store services featuring clothing, sporting goods, and novelty items.

First Use In Commerce: November 21, 2007 (“M22 Retail Mark”)

(collectively, “M22 Marks”).

M-22 is a Michigan state trunkline highway that originates in the resort community of Traverse City, Michigan and travels the Lake Michigan coastline, including west Grand Traverse Bay and the Sleeping Bear Dunes National Lakeshore, until its termination 3 miles north of Manistee, Michigan. This area of Michigan has long served as a coastal retreat for Chicago and Detroit residents and was recently named “Most Beautiful Place in America” by ABC News. See “Sleeping Bear Dunes Voted ‘Most Beautiful Place in America,’” ABC News (2011), available at http://abcnews.go.com/Travel/best_places_USA/sleeping-bear-dunes-michigan-voted-good-morning-americas/story?id=14319616. Additionally, this area is home to a variety of cultural and recreational activities, including sailing, surfing, fly-fishing, kayaking, skiing, kiteboarding, numerous wineries and microbreweries, Michael Moore’s Traverse City Film Festival, and the National Cherry Festival.

Registrant’s M22 Marks are creatively dissimilar from the M-22 road sign.



Specifically, Registrant’s M22 Marks consist of a modified M-22 road sign, which has been modified by Registrant to increase its aesthetic appeal and suitability for a brand. Registrant rounded the corners of the white diamond located in the middle of the sign, increased the thickness of both the “M” and “22” located in the white diamond, and added a white border around the outside of the mark for emphasis. Thus, Registrant’s M22 Marks are not, in fact, a direct representation of the M-22 sign, but, rather, a derivative work of that sign.

Since as early as 2003, Registrant M22, through its predecessor in interest Broneah, Inc., has sold a variety of goods, including apparel and wine, bearing the M22 Marks. Registrant has become widely known across the United States for its M22 brand, which has achieved wide popularity and notoriety within the kiteboarding industry and with millions of tourists from across the world who have visited northwestern Michigan and consider the area one of scenic beauty and relaxation. In short, M22 is not just a road, it is a way of life².

² As expressed by Registrant’s own website,

From 2003 to 2007, Registrant primarily sold its goods through retailers within the State of Michigan. In November of 2007, however, Registrant opened its first retail store located at 125 E. Front Street in the primary tourist-shopping district of Traverse City, Michigan. Since opening its retail store in 2007, Registrant has expanded the sale of its apparel to over 50 distributors in major Michigan cities, including in college towns such as East Lansing, Michigan, home of Michigan State University. Registrant has become so well known and respected within the State of Michigan that it was recently awarded the coveted “Michigan 50 Companies to Watch” award by Governor Rick Snyder. See “Michigan Celebrates Small Business,” Michigan Small Business and Technology Development Center (2013), available at <http://www.michigancelebrates.biz/past-winners/2013-mcsb-award-winners/>. And, prior to the filing of this Response, Registrant was recognized by the State of Michigan on its “Pure Michigan” website, which is a campaign intended to tout the benefits of doing business in the State of Michigan.

Despite this recognition by the State of Michigan, the Attorney General issued an advisory opinion on May 29, 2012, which stated that no entity could lawfully obtain trademark rights in or to the M-22 sign under trademark law. See Michigan Highway Route Marker Design As Trademark, Mich. Att’y Gen. Op. No. 7265, available at <http://www.ag.state.mi.us/opinion/datafiles/2010s/op10344.htm>. State Representative Frank D. Foster initiated the political process leading to this opinion, which began after Registrant discovered that a company within Mr. Foster’s jurisdiction was producing counterfeit M22

M-22 was created to express a common passion for Northern Michigan. It is marked by the simplicity and appreciation for natural wonders such as bays, beaches, and bonfires, dunes and vineyards, cottages, friends and family everywhere.

See “About Us,” M22.com (2013), available at <http://www.m22.com/about-us>.

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