

**This Opinion is Not a
Precedent of the TTAB**

Mailed: December 4, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Emerald Cities Collaborative, Inc.

v.

Sheri Jean Roese
—————

Opposition No. 91197060
—————

Joshua W. Newman of Reed Smith LLP
for Emerald Cities Collaborative, Inc.

Sheri Jean Roese, *pro se*.

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Before Mermelstein, Wellington, and Hightower,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Sheri Jean Roese (“Applicant”) seeks to register the mark **EMERALD CITIES**,
in standard character format, for the following services:

Providing business consulting services and information relating to environmentally friendly and sustainable products and services, including solar reflective cool pavement, cool roofing and other cool re-surfacing materials relating to reduction of urban heat island and carbon emissions to reduce global warming and increase energy savings in Class 35; and

Providing financial consulting services and information relating to environmentally friendly and sustainable products and services; carbon offset financing services; green project financing services; carbon offset

brokerage services; providing financial consulting and information relating to the reduction of emissions to reduce global warming and increase energy savings; providing financial consulting services and financial information relating to green project development design and financing; providing financial consulting and information relating to carbon offset brokerage; providing financial consulting and information services in the fields of architecture, infrastructure and urban planning design in Class 36.¹

Emerald Cities Collaborative, Inc. (“Opposer”) filed a notice of opposition to registration of Applicant’s proposed mark based on a likelihood of confusion² with its registered mark **THE EMERALD CITY** (Registration No. 3814868)³ for the following services:

Business development and formation consulting services for the renewable energy industry in Class 35.

In particular, Opposer pleaded that “[g]iven the nearly identical nature of [Applicant’s mark], and the identical nature of the services and channels of trade, registration of [Applicant’s proposed mark] will create a serious conflict with [Opposer’s] use and registration of its trademark” and that “[t]his conflict is likely to cause confusion, mistake, or deception as to affiliation, connection, or association

¹ Application Serial No. 77819939, filed September 3, 2009, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Opposer also alleged that Applicant’s use of the applied-for mark would “dilute the distinctive character of Opposer ECC’s valuable and famous [registered mark] and its established goodwill.” Not. of Opposition ¶ 5. However, Opposer did not pursue a dilution claim at trial or argue such a claim in its brief. Accordingly, any dilution claim has been waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

³ Registration No. 3814868 issued on July 6, 2010, based on an application filed on November 28, 2008. The registration number is abbreviated herein to ‘868.

of Applicant Roese with [Opposer], or as to the origin, sponsorship, or approval of Applicant Roese's services or activities by [Opposer]." Not. of Opposition ¶ 4.

Applicant filed an answer denying the salient allegations of Opposer's likelihood of confusion claim. Applicant also alleged several "affirmative defenses," and set forth a counterclaim to cancel Reg. '868, Opposer's pleaded registration. With respect to the counterclaim, Applicant alleges that the registration is void and should be cancelled on the following alternative grounds: that the specimen did not show the mark in the underlying application used in commerce in connection with any of the services recited in the application; that Opposer committed fraud in the procurement of the registration; that an assignment of the registration violated 15 U.S.C. § 1060(a)(1); and that the mark "was not in use in commerce by Opposer or a related company or licensee as of the filing the statement of use" or as of the issuance of the registration.

In its answer to the counterclaim, Opposer made certain admissions with respect to the assignment of Reg. '868 and certain submissions made in connection with the registration's underlying application, but denied other salient allegations including the bases asserted by Applicant for cancellation of its registration.

The opposition, including the counterclaim, has been briefed by the parties.⁴

⁴ In the Board order issued on June 9, 2015 (134 TTABVUE), it was decided that Applicant's "reply brief" (131 TTABVUE) was filed one day late, noting a difference in time zones and the USPTO electronic filing system using Eastern Daylight Time. The Board noted that a decision whether to consider the reply brief was being deferred until final

I. Record

The record in this case consists of the pleadings and, by rule, the file of the involved application, as well as Reg. '868 since it is subject of the counterclaim for cancellation.⁵ Trademark Rule 2.122.

Opposer submitted the testimony, with exhibits, of Joel Rogers, a Board member for Opposer and one of the founders of Opposer corporation, and Denise Fairchild, Opposer's Executive Director/ CEO since 2010.

For her part, Applicant submitted the following materials under several notices of reliance during her trial period:⁶

- Copy of a "Screen Shot From [Opposer's] website" and copies of USPTO Office Actions for applications Serial Nos. 85320519 and 85319249;⁷
- A printout from what appears to be a single page from the Rogers deposition transcript;⁸
- Internet printouts from websites www.mugshots.com, www.intellius.com, and Westlaw involving legal matters for Mr. Perry Orlando, the filer of the underlying application for Opposer's pleaded registration;⁹

decision in this proceeding. Opposer, on June 17, 2015, moved to strike Applicant's reply brief. A decision whether to consider Applicant's brief in this matter is moot because we would reach the same decision regardless. To be clear, we have not considered Applicant's reply brief, filed on May 30, 2015, in making our final decision herein.

⁵ We note that Reg. '868 was also properly made of record, in any event, by way of Opposer's submission of a printout from the USPTO electronic database ("TARR") showing the current status and title of the registration with its notice of opposition. 1 TTABVUE.

⁶ 25 TTABVUE.

⁷ Applicant's "First Notice of Reliance," 28 TTABVUE.

⁸ Applicant's "Second Notice of Reliance," 28 TTABVUE.

⁹ *Id.*

- Printouts from the USPTO's TESS electronic database listing applications and registrations containing the terms EMERALD CITY;¹⁰
- Internet printouts for websites involving "Emerald Cities Cool Pavement";¹¹
- Copies of: a letter from Mr. Perry Orlando to the USPTO, an article involving a "Writing Contest for Prisons!," an Order from the U.S. District Court for the Southern District of Georgia involving Mr. Orlando as Petitioner, a printout from "Justia.com" concerning a proceeding involving Mr. Orlando, a USPTO Notice of Publication for application Serial No. 76694594, a printout from the website www.sunbiz.com involving "The Emerald City Industries, Inc.," and a printout from the Google+ website involving "A Plus Computer Services, Inc.";¹²
- A copy of the underlying application (Serial No. 76694594) for Opposer's pleaded registration;¹³
- An internet printout from the website www.stophedrugwar.com involving a writing contest for prisons;¹⁴
- Excerpts from an "Admission & Orientation Inmate Handbook" and "Legal Resource Guide to the Federal Bureau of Prisons 2008";¹⁵
- Copies of: a letter from the Warden's Office of a Federal Correctional Complex (U.S. Department of Justice Federal Bureau of Prisons), a copy of a Statement of Use for the underlying application for Opposer's pleaded Reg. '868, and copies of IRS forms 990 for the years 2009-2010;¹⁶ and
- Internet printouts involving a Criminal Docket involving a person named "Perry Orlando" and internet printouts from a "Trinity Title of Pasco, Inc." website involving real estate title insurance.¹⁷

¹⁰ Applicant's "Third Notice of Reliance," 35 TTABVUE.

¹¹ *Id.*

¹² Applicant's "Fourth Notice of Reliance," 36 TTABVUE.

¹³ Applicant's "Fifth Notice of Reliance," 59 TTABVUE.

¹⁴ *Id.*

¹⁵ Applicant's "Sixth Notice of Reliance," 60 TTABVUE.

¹⁶ Applicant's "Seventh Notice of Reliance," 75 TTABVUE.

¹⁷ Applicant's "Eighth Notice of Reliance," 103 TTABVUE.

II. Standing

The testimony of Opposer's Executive Director/ CEO, Ms. Fairchild, demonstrates that Opposer renders "the same range of services" as Applicant.¹⁸ As previously mentioned, Opposer is also owner of the pleaded registration, Reg. '868, which is of record. This is sufficient to establish that Opposer is more than a mere intermeddler and has standing in this matter. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Likewise, Applicant, as counterclaim plaintiff seeking to cancel Opposer's pleaded registration, has standing by virtue of her position as defendant in the opposition and Opposer's reliance on the pleaded registration. *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840 (TTAB 1979) ("it is clear from the counterclaimant's position as defendant in the opposition that he has a personal stake in the controversy").

III. Applicant's Counterclaim to Cancel Opposer's Pledaded Registration

We address Applicant's counterclaim to cancel Opposer's pleaded '868 registration because, without the registration, Opposer cannot prevail in the Opposition. That is, Opposer relies exclusively on the pleaded registration for purposes of establishing its rights in the mark THE EMERALD CITY.

¹⁸ Fairchild Dep. 8:22, 32 TTABVUE 9.

At the heart of Applicant's counterclaim is the propriety or effect of dealings between Opposer and Mr. Perry Orlando, the individual who filed the underlying application that matured into the '868 registration. To better understand Applicant's counterclaim, we offer the following background.

A. Background

On November 29, 2008, Mr. Perry Orlando filed an intent-to-use application ("Orlando application") that matured into the pleaded registration, Reg. '868. The application was based upon Mr. Orlando's allegation that he had a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

On November 24, 2009, the USPTO issued a "notice of allowance" in connection with the Orlando application, notifying Mr. Orlando that he had six months to file a Statement of Use (SOU) or a request for an extension of time to do file an SOU.

By way of a document dated December 30, 2009 and captioned, "TRADEMARK ASSIGNMENT AND LICENSE" (hereinafter, "the Agreement"), Mr. Orlando entered into an agreement with Opposer concerning the Orlando application.¹⁹ The following are certain key provisions that Mr. Orlando and Opposer agreed to:

Mr. Orlando owns certain rights in the Mark, The Emerald City, U.S. Trademark Application Serial No. 76/684,594 (the "Mark") ...

Mr. Orlando agrees to convey and assign unto [Opposer], all right, title and interest in and to the Mark and any and all derivatives thereof, together

¹⁹ Rogers Dep. Exhibit 2, 31 TTABVUE 27-31.

with any and all goodwill associated therewith, ... at such time as the Mark is registered at the [USPTO] ...

Concurrently with the execution of this Agreement Mr. Orlando is executing the form of assignment as Exhibit A hereto to be used by [Opposer] to effect the assignment contemplated by [a previous section of the agreement] ...

Between the Effective Date and the Registration Date, Mr. Orlando may continue to use the Mark.

In exchange for the agreements contained herein, [Opposer] shall promptly pay to Mr. Orlando a one-time non-refundable cash payment of \$ 25,000. Upon payment of such amount, Mr. Orlando appoints Joel Rogers as his Power of Attorney (with the full power of substitution and resubstitution) for the limited purpose of allowing [Opposer] to take over continued prosecution of the application for the Mark. The Power of Attorney wanted herein is a Durable Power of Attorney and is irrevocable ...

Upon [Opposer's] request Mr. Orlando agrees to execute any additional documents as may be reasonably required to effect and/or record this new Power of Attorney and to use reasonable effort to assist [Opposer] and its attorneys with the prosecution of the application, satisfying the USPTO's requirement for use of the mark in commerce, and ensure registration of the Mark in a timely manner. Mr. Orlando agrees to use the Mark in connection with business development, formation and consulting services for the renewable energy industry by January 31, 2010 and provide evidence of such use in the form of a specimen and date of first use to [Opposer] to assist [Opposer] in its registration of the Mark. ...

Upon final registration of the Mark by the USPTO and completion of the Mark to [Opposer], [Opposer] agrees to pay Mr. Orlando a final installment payment of \$ 40,000. ...

Upon registration of the Mark by the USPTO and completion of the transfer of the Mark to [Opposer], [Opposer] agrees to license certain rights in the Mark to Mr. Orlando ...

Either [Opposer] or Mr. Orlando may terminate this agreement if the other breaches any of his or its material obligations under this Agreement and does not remedy within 30 days thereafter. ... Upon termination of this Agreement by [Opposer] pursuant to the preceding sentence, Mr. Orlando shall promptly cease use of the Mark. ...

The products and services sold by Mr. Orlando and his associated entities under the Mark shall at all times be of a high quality, as determined by [Opposer] acting reasonably. ...

Mr. Orlando shall not challenge [Opposer's] use of the mark or support challenges by third parties, whether before or after the Registration Date. Only [Opposer] shall have the exclusive right to file oppositions or claims against the users of confusingly similar trademarks. ...

[Opposer] shall be responsible for all payments in connection with the continued prosecution of the mark in the United States or possessions.

On April 19, 2010, an SOU was filed, containing an appointment of counsel to Angela Washelesky (and others) of Reed Smith, LLP, the law firm acting as counsel for Opposer in this proceeding. The SOU contains a statement that the mark was first used in commerce at least as early as January 15, 2010, and a "page from Applicant's web site" was attached as a specimen of use. The SOU's declaration was signed by Ms. Washelesky.

On July 6, 2010, Reg. '868 issued to Mr. Orlando.

On July 27, 2010, an assignment was recorded with the USPTO²⁰, wherein Mr. Orlando agreed to assign his entire interest to Opposer. A copy of the "Trademark Assignment" submitted with the USPTO contains an "effective date of July 6th 2010."

B. Applicant's Claims

²⁰ Assignment recorded at reel/frame 4248/0486.

In a section of her brief (“Statement of Facts”), Applicant elaborates on her counterclaim to cancel Opposer’s pleaded ‘868 registration and sets forth various theories and arguments why the registration should be canceled. They are:

1. *Fraud, “Token Use” and “Inequitable Conduct”*

Applicant contends that Mr. Orlando was incarcerated in a Federal prison for most, if not all, of the prosecution timeline for the Orlando application and, as a result, “knew that he had no intent-to-use” the mark in commerce. Applicant asserts that the registration thus was fraudulently acquired by Mr. Orlando through the filing of “fraudulent declarations,” a “token specimen,” and the “assignment agreement ... skillfully engineered by Joel Rogers [Opposer’s founder] to give the appearance of legitimacy, but which in fact deceived the USPTO into issuing [the pleaded registration].” Brief, p. 9. In support, Applicant does not rely on any testimony, but instead relies heavily on “Admissions of Applicant Perry Orlando,” that she lists in her brief and says were ascertained through “a very significant phone call.” *Id.* at p. 11. Applicant also relies on various materials, including statements within these materials, that she submitted under notices of reliance.

Many of the key facts necessary for Applicant to establish any of the aforementioned claims have not been proven. Particularly, Applicant’s assertion that Mr. Orlando was incarcerated at any point in time has not been demonstrated. Applicant has not introduced any testimony and the statements in the materials she submitted under the notices of reliance constitute inadmissible hearsay. *See*

Fed. Rules of Evidence Rule 802 (The Rule Against Hearsay). The hearsay statements cannot be relied upon to the extent that Applicant seeks to prove the truth of these statements. For example, the statement in a letter from a Federal Bureau of Prisons official to Applicant that “Inmate Orlando was housed at FSL Jessup from December 2, 2005, until April 15, 2010,”²¹ is not a fact that has been established, either through this letter or other documents. Moreover, it has not been argued, nor demonstrated, that this letter and all the statements contained therein fall within any of the hearsay exceptions.

Accordingly, without any evidence establishing key factual assertions, Applicant’s fraud counterclaim has not been established and is hereby dismissed. Furthermore, Applicant’s “inequitable conduct” claim is not a separate, identifiable ground for cancellation from fraud.

With respect to Applicant’s assertion that the specimen submitted in connection with the pleaded ‘868 registration was merely “token use” or otherwise an unacceptable specimen of use, this, too, is not a separate or appropriate ground for cancellation. As the Board observed in a similar context, “fairness dictates that the *ex parte* question of the sufficiency of the specimen not be the basis for sustaining an opposition.” *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989). *See also, Granny’s Submarine Sandwiches, Inc. v. Granny’s Kitchen, Inc.*, 199 USPQ 564, 567-68 (TTAB 1978).

²¹ Submitted under notice of reliance at 75 TTABVUE.

2. Abandonment

For the first time in her main trial brief (on pp. 13-14), Applicant raises the claim that Opposer has abandoned the pleaded registered mark. Opposer correctly points out that an abandonment claim was “never before raised” and it is not “listed as a basis for cancellation in Applicant’s counterclaim.”²²

In view of the fact that Applicant did not plead an abandonment claim, and we do not find that the issue has been tried by implicit consent, it is not before us and has been given no further consideration.

3. Improper Assignment in Violation of Section 10 (15 U.S.C. § 1061(a))

Applicant clearly asserted in her counterclaim that Opposer’s registration was acquired by way of an assignment that violated Section 10 of the Lanham Act. We address this claim in the following section.

C. Analysis of Applicant’s Section 10 Claim

Section 10 of the Lanham Act prohibits the assignment of an application filed under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), before the applicant files an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. § 1051(c) or a statement of use under 15 U.S.C. § 1051(d)), except to a successor to the applicant’s business, or portion of the business to which the mark pertains, if that

²² Opposer’s reply brief p. 19, 127 TTABVUE 24.

business is ongoing and existing.²³ Section 10 of the Trademark Act, 15 U.S.C. § 1060; *see also* 37 C.F.R. § 3.16. If found in violation of this section, the result is that the application, as well as any resulting registration, are void. *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ 1134 (TTAB 2013); *see also Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

There is no dispute that the Agreement was executed, with an effective date, prior to the SOU being filed. The crux of the matter is whether the Agreement constituted an impermissible assignment, as contemplated by Section 10 of the Lanham Act. Opposer argues that the Agreement was merely an “agreement to assign in the future [and] doesn’t violate the letter of Section 10, because the assignment only takes place once the prohibition no longer applies,” citing, in part, 3 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 18:13 (4th ed. 2010) (“*McCarthy on Trademarks*”). 127 TTABVUE 23 (Reply Brief p. 18, at footnote 13).

Professor McCarthy has offered his views on agreements to assign in the future:

Agreements to Assign in the Future: Author’s Opinion. Similarly valid, in the author’s opinion, is an agreement by a[n] ITU applicant to assign the mark and its registration in the future once the applicant has commenced actual use and filed an SOU. Such an agreement is not a present assignment, which is all that the statute prohibits.¹⁰ It is only an agreement by a party to execute an assignment in the future, once the prohibition of Lanham Act § 10 has expired. Because no present

²³ Opposer makes no argument, and there is no evidence to support a showing, that Opposer is the successor-in-interest to Mr. Orlando’s business, or any portion thereof. Accordingly, this exception is not applicable.

assignment takes place until after the statutory prohibition on assignment has evaporated, I do not think that it is a violation of either the letter or the spirit of the statutory prohibition.

3 *McCarthy on Trademarks* § 18:13 (4th ed., updated December 2015).

In footnote 10 of the passage referenced above, Professor McCarthy elaborates and provides his thoughts on a second scenario in which a transfer of ownership of an application agreement is made and the actual assignment is automatically triggered by the filing of an SOU:

An assignment with a condition such that the assignment automatically becomes effective once the SOU has been filed is in the middle, between the situation of a present assignment and an agreement to assign in the future. Such a conditional assignment comes closer to a present assignment and some practitioners view it as presenting some risk of being found to violate the prohibition of Lanham Act § 10. In my view, it does not violate § 10. If § 10 is viewed as a technical prohibition with only the slightest impact on consumer protection, then even such a conditional assignment should be found valid.

Id.

The Agreement before us is somewhat similar to the scenarios posited by Professor McCarthy inasmuch as it calls for an assignment to be filed after a use statement has been filed (“at such time as the Mark is registered at the [USPTO]”); however, it is significantly different in various aspects. In particular, by way of the Agreement, Opposer acquired immediate control of the application as well as the manner of use of the mark. The Agreement states that Opposer shall “take over continued prosecution of the application for the Mark” and Mr. Orlando would act “to assist [Opposer] in its registration of the Mark.” Opposer was further given the “exclusive right to file opposition or claims against users of confusingly similar

trademarks.” Simply put, Applicant relinquished any control he had over the application to Opposer.²⁴

In addition, although the Agreement contemplated a “grant of license” (from Opposer to Mr. Orlando) to begin “upon registration,” Opposer immediately acquired the right to exert control over Mr. Orlando’s use of the mark prior to filing of the SOU. All “products and services sold by Mr. Orlando and his associated entities under the Mark shall at all times be of a high quality, *as reasonably determined by [Opposer] acting reasonably.*” (emphasis added). Indeed, Opposer’s founder and witness, Joel Rogers, described Mr. Orlando’s use of the mark, prior to filing the SOU and registration of the mark, as being pursuant to a license from Opposer:

Q. Mr. Rogers, do you recognize this as a web page from the Licensee in this case, Mr. Orlando?

A. I do.

Q. Do you view this use by Mr. Orlando of the mark, The Emerald City, consistent with the license granted to him?

A. I do.

Q. And would you please look at the bottom and read the date into the record that this was printed?

²⁴ We further note the Agreement provides that it “shall continue in perpetuity,” but that either party “may terminate this Agreement if the other breaches any of his or its material obligations under this Agreement and does not remedy such breach after being requested to do so in writing within 30 days thereafter.” 31 TTABVue 29. Moreover, “[u]pon termination of this Agreement by [Opposer] pursuant to the preceding sentence, Mr. Orlando shall promptly cease use of the Mark.” *Id.*

A. April 6, 2010.

31 TTABVUE 16 (Rogers Dep. 15:7-17, referencing Exhibit 5).²⁵

This testimony, combined with the fact that the SOU was not filed until April 19, 2010, demonstrates that Opposer's own witness considered a license from Opposer to Mr. Orlando to use the mark THE EMERALD CITY as being in effect prior to the filing of the SOU. In order for Opposer to be the licensor and Mr. Orlando the licensee, an assignment of interest must have occurred between the two entities. Without an assignment of interest, Opposer would have no rights in the Mark or application to license use by Mr. Orlando which presumably was inuring to Opposer's benefit.

Aside from the pre-SOU licensing aspect, Mr. Rogers' testimony also reflects an understanding that a transfer of ownership had occurred by way of the Agreement:

Q. Look at the document and tell me if you recognize it.

²⁵ In describing an exhibit consisting of "marketing material" created by Mr. Orlando and dated well after the mark had registered, Mr. Rogers characterized this use by Orlando in the same manner.

Q. I'll ask if you recognize that as a piece of marketing material from Mr. Orlando?

A. I do.

Q. Would you please read the date in from the bottom of the page here?

A. December 14, 2010.

Q. And do you view this as consistent with the license granted to Mr. Orlando for the trademark The Emerald City?

A. I do.

31 TTABVUE 17 (Rogers Dep. 16:3-12, referencing Exhibit 6).

A. I do.

Q. It is titled "Trademark Assignment and License." Is this the document that gave Emerald Cities Collaborative [Opposer] ultimate ownership of the mark we just looked at, The Emerald City?

A. Yes.

Q. If you could turn to the first page ..., it says an effective date as of 12/30/2009; is that correct?

A. On the first page? Oh, I'm sorry. Yes, of course. Yes. Yes.

31 TTABVUE 9-10, Rogers Dep. 8:16-9:6 (referencing Exhibit 2, the Agreement).

D. Conclusion

Based on the record before us, with a particular emphasis on the Agreement itself and the testimony of Opposer's witness, the ramifications of the Agreement were such that Mr. Orlando relinquished, and Opposer acquired, control of the application and use of the involved mark, in manner tantamount to an assignment of ownership of the application. Applicant's subsequent filing of an assignment with the USPTO, after the SOU was filed and registration issued, was merely a formality or confirmation of a *fait accompli* resulting from the Agreement. The Agreement therefore constituted an impermissible assignment of ownership of the application, in violation of Section 10. Accordingly, Applicant's counterclaim to cancel Opposer's pleaded Reg. '868 is granted and the registration will be cancelled.

IV. Opposer's Likelihood of Confusion Claim

Inasmuch as Opposer's likelihood of confusion claim rests entirely on its asserted rights in the pleaded Reg. '868 for the mark THE EMERALD CITY, and this registration is to be cancelled pursuant to the counterclaim in this proceeding,

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Opposer cannot prevail in the opposition. We note that Opposer did not claim, let alone prove, any prior common law rights in the mark THE EMERALD CITY.

Decision: Applicant's counterclaim to cancel Registration No. 3814868 is granted and this registration will be cancelled in due course.

The opposition is dismissed.