

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

JK Shields, LLC,

Plaintiff,

v.

Smyth Tavern, LLC, Mercer Street Hospitality
LLC, 142 Mercer Street, LLC, and
John McDonald,

Defendants.

Case No.: 1:25-cv-14182 (JCD)(BWJ)

Judge Jeremy C. Daniel

**ANSWER AND
AFFIRMATIVE DEFENSES**

JURY TRIAL DEMANDED

Defendants Smyth Tavern, LLC ("Smyth Tavern"), Mercer Street Hospitality LLC ("MSH"), 142 Mercer Street, LLC ("142 Mercer"), and John McDonald ("McDonald") ("Defendants"), by their attorneys LOPRESTI, PLLC, answer the Complaint as follows:

AS TO "PARTIES"

1. JK Shields is a limited liability company organized under the laws of Illinois, having an address at 177 N Ada Street, Chicago, IL 60607. JK Shields owns and operates the affiliated restaurants Smyth and The Loyalist, located at 177 N. Ada Street, Chicago, Illinois.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 1, and on that basis deny the allegations.

2. On information and belief, Smyth Tavern, LLC, 142 Mercer Street, LLC and Mercer Street Hospitality LLC are all New York limited liability companies with an address of 142 Mercer Street New York, New York. On information and belief, John McDonald is the owner of each of the three corporate Defendants. Defendants own and operate a series of restaurants, including Lure Fishbar, with locations in Chicago and New York, and Smyth Tavern, a bar and restaurant located at 85 W. Broadway Street, New York, New York.

ANSWER: Defendants deny all allegations in Paragraph 2, except admit that Smyth Tavern, LLC, 142 Mercer Street, LLC and Mercer Street Hospitality LLC are all New York limited liability companies.

AS TO "NATURE OF THE CASE"

3. This is an action for (i) trademark infringement under the Lanham Act; (ii) unfair competition under the Lanham Act; (iii) trademark dilution under the Lanham Act; (iv) trademark dilution under the Illinois Trademark Registration and Protection Act, formerly the Anti-Dilution Act, 765 ILCS 1036/65 (v) common law unfair competition; (vi) violation of the Illinois Consumer Fraud and Deceptive Business Practices Act, 815 ILCS 505; and (vii) violation of Illinois' Uniform Deceptive Trade Practices Act, 815 ILCS 510.

ANSWER: Paragraph "3" states legal conclusions to which no response is necessary. To the extent that any response is necessary or that the allegations are factual, Defendants deny the allegations.

AS TO "JURISDICTION AND VENUE"

4. This Court has subject matter jurisdiction under the Lanham Act pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and 1338(b). This Court also has supplemental jurisdiction over the state law claims included herein pursuant to 28 U.S.C. § 1367, as such claims are so related to the federal claims over which this Court has original jurisdiction that they form part of the same case or controversy. In addition, the Court has subject matter jurisdiction over Plaintiff's unfair competition claim under the common law of Illinois. See 28 U.S.C. § 1338(b).

ANSWER: Paragraph "4" states legal conclusions to which no response is necessary. To the extent that any response is necessary or that the allegations are factual, Defendants deny the allegations.

5. Upon information and belief, Defendants are doing business in the State of Illinois through the ownership and operation of at least one restaurant in Illinois and through advertising their restaurants to Illinois consumers.

ANSWER: Defendants deny the allegations in Paragraph 5.

6. Upon information and belief, this Court has personal jurisdiction over Defendants because Defendants own and operate a restaurant in the state of Illinois, and advertise all of their restaurants to consumers in Illinois, through their website at <https://www.lurefishbar.com> and <https://www.smythtavern.com>. Specifically, Defendants purposely direct their business activities toward Illinois residents, through their websites, social media accounts and actions, as described below, and Defendants derive substantial revenue from their services in Illinois. Further, on information and belief, Defendants have entered into contracts and leases with other Illinois-

based entities that have enabled them to own and operate Lure Fishbar in Chicago. Additionally, Plaintiff's claims for trademark infringement, unfair competition, dilution, and deceptive trade practices arise from acts conducted and harm sustained in the State of Illinois. On information and belief, Defendants conduct continuous and systematic business within the State of Illinois and have played an integral part in the infringement of Plaintiff's trademark rights through advertisement of its restaurants directed at residents in this judicial district. Defendants are committing acts that have wrongfully caused Plaintiff harm in the State of Illinois.

ANSWER: Paragraph "6" states legal conclusions to which no response is necessary. To the extent that any response is necessary or that the allegations are factual, Defendants deny the allegations.

7. Venue is proper in this judicial district under 28 U.S.C. § 1391(b)(2) because a substantial part of the events or omissions which gave rise to Plaintiff's claims occurred in this district. Particularly, Defendants are targeting consumers in Illinois and nationwide—including those consumers located within this district through their advertisement and promotion of the Chicago-based Lure Fishbar, and their associated advertisements of "Smyth Tavern," which is causing actual confusion among consumers within this judicial district.

ANSWER: Paragraph "7" states legal conclusions to which no response is necessary. To the extent that any response is necessary or that the allegations are factual, Defendants deny the allegations.

AS TO "FACTS RELEVANT TO ALL COUNTS"

8. JK Shields owns and operates the affiliated restaurants Smyth and The Loyalist. Smyth is located on the second floor, above a bar/restaurant (also owned by JK Shields) called The Loyalist. [IMAGE]

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 8, and on that basis deny the allegations.

9. The sister restaurants opened within weeks of each other in July and August 2016. Smyth is the fine dining companion restaurant to the casual bar and restaurant, The Loyalist.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 9, and on that basis deny the allegations.

10. JK Shields owns U.S. Trademark Reg. No. 5,070,435 for the mark SMYTH and U.S. Trademark Reg. No. 5,143,480 for the mark SMYTH THE LOYALIST, both for bar and restaurant services in Class 43. JK Shields also owns recently filed U.S. Trademark Appl. No. 99/492,042 for the mark SMYTH (the "SMYTH Application"), for bar and restaurant and related services in Class 43. The registrations for the SMYTH and SMYTH THE LOYALIST trademarks are referred to collectively as the "SMYTH Registrations"; the SMYTH Registrations and the SMYTH Application, along with Plaintiff's common law rights in SMYTH and SMYTH THE LOYALIST, are all collectively referred to herein as the "SMYTH Marks." Copies of the SMYTH Registrations and the SMYTH Application are attached, respectively, as **Exhibits A-C**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 10, and on that basis deny the allegations; except Defendants clarify that the mark SMYTH (U.S. Trademark Reg. No. 5,070,435) was granted registration of the word "SMYTH" only on the *Supplemental Register*, due to the following determination by the USPTO:

"SECTION 2(e)(4) REFUSAL – PRIMARILY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); see TMEP §§1211, 1211.01.

Please see the attached evidence from Whitepages.com, establishing the surname significance of Smyth. This evidence shows the applied-for mark appearing 13,903 times as a surname in a nationwide phone directory of names.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration."

See USPTO Office Action, dated August 24, 2016 (**Exhibit 1**).

11. In 2016, just three months after it opened, Smyth was honored to be awarded one Michelin star, for the upcoming 2017 guide. Just one year later, Smyth was awarded its second Michelin star. See <https://www.dnainfo.com/chicago/2016/11/02/west-loop/roister-oriole-michelin-guide-2017>, attached as **Exhibit D**; see also <https://www.chicagotribune.com/2017/10/20/michelin-awards-two-stars-to-smyth-24-other-chicago-restaurants-honored>, attached as **Exhibit E**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 11, and on that basis deny the allegations.

12. Today, Smyth holds the rare and enviable distinction of being awarded three Michelin stars, one of only fourteen such restaurants in the United States, and the only such restaurant with that distinction in Chicago. See <https://guide.michelin.com/us/en/restaurants/3-stars-michelin>, filtered to show the three-star restaurants in the United States, attached as **Exhibit F**, <https://guide.michelin.com/us/en/article/michelin-guide-ceremony/michelin-stars-in-the-michelin-guide-chicago-2025>, attached as **Exhibit G**, and, <https://www.nytimes.com/2025/11/18/dining/the-2025-michelin-stars-awarded-for-the-northeast-and-chicago.html>, attached as **Exhibit H**. Smyth has held this distinction since November 2023. See <https://guide.michelin.com/ca/en/article/features/smyth-three-michelin-stars-michelin-guide-chicago>, attached as **Exhibit I**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 12, and on that basis deny the allegations.

13. The Michelin Guides are a series of guidebooks published by the French company Michelin for more than a century, and the Michelin Guides can award one, two or three stars to restaurants as an indicator of quality and excellence of the food, ingredients, preparation, service, and other attributes associated with a restaurant experience. The Michelin Guide website outlines the differences in distinctions associated with their awarding restaurants one, two and three stars, respectively:

One MICHELIN Star is awarded to restaurants using top quality ingredients, where dishes with distinct flavours are prepared to a consistently high standard;
Two MICHELIN Stars are awarded when the personality and talent of the chef are evident in their expertly crafted dishes; their food is refined and inspired;
Three MICHELIN Stars is our highest award, given for the superlative cooking of chefs at the peak of their profession; their cooking is elevated to an art form and some of their dishes are destined to become classics.

See <https://guide.michelin.com/en/article/features/what-is-a-michelin-star>, attached as **Exhibit J**.

ANSWER: Defendants admit the allegations in Paragraph 13.

14. As of early 2025, only 217 restaurants in the United States have earned a single Michelin star, and only 33 restaurants in the U.S. have earned two Michelin stars. Plaintiff's restaurant Smyth is one of only 14 restaurants in the U.S. to have earned the exceedingly rare recognition of being awarded three Michelin stars.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 14, and on that basis deny the allegations.

15. In another feat, in a separate publication that recognizes the world's best restaurants, Plaintiff's Smyth was ranked among the top 100 restaurants in the world (*see* <https://www.theworlds50best.com/stories/News/the-worlds-50-best-restaurants-2024-51-100-list.html>, attached as **Exhibit K**) and was more recently ranked number four in North America's 50 Best Restaurants, with numbers two and three both located in Canada. In effect, Smyth was named the runner up as the best restaurant in the United States, second only to Atomix in New York. *See* <https://www.theworlds50best.com/northamerica/en/list/1-50>, attached as **Exhibit L**. In fact, in two separate events this year, Smyth and Atomix collaborated to create a one-night menu, the most recent of which took place at Atomix in New York, on October 3, 2025, which received significant media attention even before it took place, including in Chicago, where the Chicago Star described the event as "Michelin-starred Smyth and Atomix cook up a one-night-only dream team dinner." *See* https://www.chicagostarmedia.com/restaurants/michelin-starred-smyth-and-atomix-cook-up-a-one-night-only-dream-team-dinner/article_603324ff-9645-4a73-8d89-e9ddef8b69db.html, attached as **Exhibit M**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 15, and on that basis deny the allegations.

16. Smyth has been listed as the sixth best restaurant in North America by the Opinionated About Dining (OAD) guide every year dating back to 2019. *See* <https://www.oadguides.com/lists/north-america/top-restaurants/2019>, attached as **Exhibit N**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 16, and on that basis deny the allegations.

17. Smyth has also been listed in eighteenth place on the Robb Report's 100 Greatest American Restaurants of the 21st Century. *See* <https://robbreport.com/food/drink/dining/lists/best-restaurants-america-21st-century-1237256635>, attached as **Exhibit O**.

ANSWER: Defendants lack knowledge or information sufficient to form a belief as the truth of the allegations in Paragraph 17, and on that basis deny the allegations.

18. Unsurprisingly, given these significant honors and accolades, Smyth has been the subject of numerous media articles with significant local, national, and international reach.

ANSWER: Defendants deny the allegations in Paragraph 18.

19. Not only do consumers read about Smyth's many accolades but diners from all over the United States and the world travel to Chicago to dine at Smyth. For example, the day the third Michelin star was announced in 2023, 1,200 new reservations were made, immediately filling the 13-table tasting menu restaurant from November through most of February that following year. See <https://www.wttw.com/playlist/2024/03/06/smyth-three-michelin-stars>, attached as **Exhibit P**.

ANSWER: Defendants deny the allegations in Paragraph 19.

20. The SMYTH Marks represent substantial and valuable goodwill that Plaintiff has earned through years of hard work.

ANSWER: Defendants deny the allegations in Paragraph 20.

21. By virtue of Smyth's commitment to culinary excellence, its hard-earned accolades, and the extensive advertising and promotion it has received on account of the unsolicited awards and media coverage mentioned above and elsewhere, a substantial number and proportion of consumers in and around Chicago, as well as across the United States and the world, have come to associate the SMYTH Marks, and particularly SMYTH, solely and exclusively with JK Shields and its restaurant in Chicago.

ANSWER: Defendants deny the allegations in Paragraph 21.

22. Due to its longstanding and extensive use of the SMYTH Marks and the exceptionally high quality of its cuisine, and news coverage regarding same, JK Shields has achieved a degree of fame in and around at Chicago, across the United States, and the world.

ANSWER: Defendants deny the allegations in Paragraph 22.

23. Upon information and belief, other than Defendants' recent adoption and use, no other entity has used a mark identical to the unique spelling of word "SMYTH" in connection with restaurant or bar services. Certainly, Plaintiff is unaware of any other entity using the term "SMYTH" in connection with restaurant services that have nationwide recognition or a federal trademark registration.

ANSWER: Defendants deny the allegations in Paragraph 23.

24. Upon information and belief, Defendant John McDonald holds himself out as the founder of Defendant Mercer Street Hospitality LLC and through Defendant Mercer Street

Hospitality LLC, or other corporate entities, owns and operates a series of restaurants, including Lure Fishbar and Smyth Tavern. See <https://www.mercerstreethospitality.com/about>, attached hereto as **Exhibit Q**.

ANSWER: Defendants admit the allegations in Paragraph 24.

25. Upon information and belief, Defendant John McDonald is intimately involved in decisions for each of the restaurants in the portfolio of restaurants owned and/or operated by him, or by the corporate Defendants.

ANSWER: Defendants deny the allegations in Paragraph 25.

26. Upon information and belief, Defendants or their affiliates opened a Chicago location of Lure Fishbar in June 2021.

ANSWER: Defendants deny the allegations in Paragraph 26, except admit that pursuant to a Management Agreement with a third party, in about June 2021, the New York limited liability companies Lure Chicago LLC and MSH began management of the restaurant known as Lure Fishbar Chicago.

27. Upon information and belief, Defendants opened Smyth Tavern in New York City in August 2022.

ANSWER: Defendants deny the allegations in Paragraph 27, except admit that in about August 2022 Defendants Smith Tavern, LLC and MSH managed the opening of the hotel restaurant known as "Smyth Tavern" inside the Smyth Tribeca hotel (<https://www.smythtribeca.com>), which had originally opened 13 years earlier in 2009 as the "Smyth" hotel.

28. The Lure Fishbar restaurant and other affiliated restaurants are advertised and promoted on the website located at <http://lurefishbar.com>, which upon information and belief is operated by Defendants or their affiliates. Shown below, and attached hereto as **Exhibit R**, is a true and correct copy of the Lure Fishbar website, with its advertising for Defendants' collection of restaurants, including Smyth Tavern [IMAGE]:

ANSWER: Defendants deny all allegations in Paragraph 28, except admit that Defendant 142 Mercer Street, LLC maintains the Lure Fishbar website at url <https://www.lurefishbar.com>.

29. Lure Fishbar and Smyth Tavern are similarly advertised and promoted as related establishments on the various other websites for Defendants' restaurants, including mercerstreethospitality.com, as shown in Exhibit Q and reproduced below [IMAGE]:

ANSWER: Defendants deny all allegations in Paragraph 29, except admit that Defendant

Mercer Street Hospitality, LLC maintains its website at url

<https://www.mercerstreethospitality.com>.

30. According to the records of the USPTO, Defendants have applied for federal trademark registrations for many of their restaurants. For example, Defendant John McDonald owns U.S. Trademark Reg. No. 6,578,655 for LURE FISHBAR in Class 43 and Defendants 142 Mercer Street, LLC and Mercer Street Hospitality LLC own U.S. Trademark Reg. No. 6,674,745 for [IMAGE: Lure Fishbar Design Mark] in Class 43. Upon information and belief, Defendants have not applied for federal trademark protection for Smyth Tavern.

ANSWER: Defendants admit the allegations in Paragraph 30.

31. Upon information and belief, Defendant John McDonald and the corporate Defendants were aware of Plaintiff's SMYTH Marks and Plaintiff's use of SMYTH in association with a restaurant, at the time Defendants first adopted and began to use "SMYTH" with restaurant services.

ANSWER: Defendants deny all allegations in Paragraph 31.

32. Upon information and belief, Defendant John McDonald intentionally adopted, or directed the corporate Defendants to intentionally adopt, the term "SMYTH" in order to benefit from and ride off the goodwill of the well-known SMYTH Marks and restaurant.

ANSWER: Defendants deny all allegations in Paragraph 32.

33. Upon information and belief, Defendant John McDonald personally oversaw and/or directed Defendants' decision to adopt and use the term "SMYTH" in their Smyth Tavern restaurant.

ANSWER: Defendants deny all allegations in Paragraph 33.

34. Defendants' use of the "Smyth" name and mark creates the false impression that Defendants' Smyth Tavern restaurant and/or their other restaurants (including the Lure Fishbar restaurant in Chicago) are somehow connected or associated with Plaintiff's Smyth restaurant, so as to deceive customers or to cause confusion or mistake as to the origin or affiliation of Defendants' services. For example, consumers who have come to dine at Plaintiff's Smyth restaurant have asked Plaintiff if it is associated or affiliated with the "Smyth Tavern" referenced on the website of the Chicago location of Lure Fishbar.

ANSWER: Defendants deny all allegations in Paragraph 34.

35. Defendants' use is also likely to dilute the distinctive quality of Plaintiff's SMYTH Marks. On information and belief, the association by consumers of Plaintiff's SMYTH Marks with Defendants' restaurant and bar services is likely to blur and/or tarnish the distinctive character of the SMYTH Marks.

ANSWER: Defendants deny all allegations in Paragraph 35, including that the SMYTH Marks are distinctive.

36. Defendants' infringing SMYTH mark is confusingly similar to Plaintiff's SMYTH Marks in appearance, sound, meaning and commercial impression. Defendants use the identical mark, including the unique spelling with the letter "Y," and even uses a nearly identical font and all capital letters, as shown below: [IMAGES]

ANSWER: Defendants deny all allegations in Paragraph 37.

37. Defendants' use of the identical mark "SMYTH" with identical restaurant and bar services is likely to cause confusion or mistake, or falsely suggest that Defendants' restaurant and bar services are related to, sponsored by, or affiliated with Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 37.

38. Defendants' use of "SMYTH" trades off the goodwill and brand reputation of Plaintiff's SMYTH Marks.

ANSWER: Defendants deny all allegations in Paragraph 38.

39. Defendants' conduct in using the identical mark "SMYTH" is likely to cause confusion in the marketplace among consumers and prospective consumers of Plaintiff's restaurant services.

ANSWER: Defendants deny all allegations in Paragraph 39.

40. Upon information and belief, Defendants' use of "SMYTH" and advertisement of same, particularly in Chicago, has caused actual confusion.

ANSWER: Defendants deny all allegations in Paragraph 39, including the fact that Plaintiff has failed to show any actual confusion.

41. Plaintiff has been damaged and is likely to be further damaged by Defendants' wrongful use of the identical "SMYTH" mark in that the relevant purchasing public has been and

is likely to continue to be induced into patronizing Defendants' businesses under the erroneous belief that those services originate or emanate from, or are somehow endorsed, sponsored, or approved by Plaintiff, which they are not.

ANSWER: Defendants deny all allegations in Paragraph 41.

42. Upon first learning of Defendants' use of the "SMYTH" mark in connection with restaurant and bar services, Plaintiff sent a letter to Defendants dated October 13, 2025 demanding that Defendants immediately cease and desist all further use of the infringing "SMYTH" mark. Plaintiff requested a response by October 23, 2025.

ANSWER: Defendants admit the allegations in Paragraph 42, except deny that Defendants acted "Upon first learning of Defendants' use of the "SMYTH" mark in connection with restaurant and bar services".

43. Defendants failed to respond to Plaintiff's letter and have failed to comply with Plaintiff's demand that they cease using the infringing "Smyth" mark. Defendants are thus engaging in unlawful activity and acting in bad faith, with a willful and deliberate intent to deceive and cause confusion among consumers, and to injure Plaintiff, as well as Plaintiff's reputation and goodwill.

ANSWER: Defendants deny all allegations in Paragraph 43.

AS TO "COUNT I - TRADEMARK INFRINGEMENT (15 U.S.C. § 1114)"

44. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

45. On information and belief, Defendant John McDonald and the corporate Defendants were aware of Plaintiff's SMYTH Marks and Plaintiff's use of SMYTH in association with a restaurant, at the time Defendants first adopted and began to use "SMYTH" with restaurant services.

ANSWER: Defendants deny all allegations in Paragraph 45.

46. On information and belief, Defendant John McDonald intentionally adopted, or directed the corporate Defendants to intentionally adopt, the term "SMYTH" in order to benefit from and ride off the goodwill of the well-known SMYTH Marks and restaurant.

ANSWER: Defendants deny all allegations in Paragraph 46.

47. Moreover, on information and belief, regardless of intentionality, Defendant John McDonald personally oversaw and/or directed Defendants' decision to adopt and use the term "SMYTH" in their Smyth Tavern restaurant.

ANSWER: Defendants deny all allegations in Paragraph 47.

48. Defendants' use of an identical and confusingly similar imitation of the SMYTH Marks is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' services originate from or provided by Plaintiff, or are associated or connected with Plaintiff, or have the sponsorship, endorsement, or approval of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 48.

49. Defendants' infringing use of "SMYTH" is identical and confusingly similar to Plaintiff's SMYTH Registrations in violation of 15 U.S.C. § 1114. Defendants' activities are causing and are likely to cause confusion and deceive members of the trade and public, and are injuring and are likely to further injure the goodwill and reputation Plaintiff has developed in its SMYTH Marks. Plaintiff has no adequate remedy at law for these injuries to its goodwill and reputation.

ANSWER: Defendants deny all allegations in Paragraph 49.

50. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with Plaintiff's SMYTH Marks, to Plaintiff's great and irreparable harm.

ANSWER: Defendants deny all allegations in Paragraph 50.

51. Defendants have caused and are likely to continue causing substantial injury to the public and to Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 51.

AS TO "COUNT II - FEDERAL UNFAIR COMPETITION (15 U.S.C. § 1125(a))"

52. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

53. On information and belief, Defendant John McDonald and the corporate Defendants were aware of Plaintiff's SMYTH Marks and Plaintiff's use of SMYTH in association with a restaurant, at the time Defendants first adopted and began to use "SMYTH" with restaurant services.

ANSWER: Defendants deny all allegations in Paragraph 53.

54. On information and belief, Defendant John McDonald intentionally adopted, or directed the corporate Defendants to intentionally adopt, the term "SMYTH" in order to benefit from and ride off the goodwill of the well-known SMYTH Marks and restaurant.

ANSWER: Defendants deny all allegations in Paragraph 54.

55. Moreover, on information and belief, regardless of intentionality, Defendant John McDonald personally oversaw and/or directed Defendants' decision to adopt and use the term "SMYTH" in their Smyth Tavern restaurant.

ANSWER: Defendants deny all allegations in Paragraph 55.

56. Defendants' use of an identical and confusingly similar imitation of Plaintiff's SMYTH Marks have caused and is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' services originate from or are distributed by Plaintiff, or are affiliated, connected, or associated with Plaintiff or have the sponsorship, endorsement, or approval of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 56.

57. Defendants have created a false association and false designation of origin with their services in violation of 15 U.S.C. § 1125(a). Defendants' activities have caused and are likely to continue to cause a likelihood of confusion and deception of members of the trade and public, and injury to Plaintiff's goodwill and reputation as symbolized by Plaintiff's SMYTH Marks for which Plaintiff has no adequate remedy at law.

ANSWER: Defendants deny all allegations in Paragraph 57.

58. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with Plaintiff's SMYTH Marks, to the great and irreparable injury of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 58.

59. Defendants' conduct has caused, and is likely to continue causing, substantial injury to the public and to Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 59.

AS TO "COUNT III - FEDERAL TRADEMARK DILUTION (15 U.S.C. § 1125(c))"

60. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

61. Plaintiff has continuously promoted and exclusively used the SMYTH Marks. The SMYTH Marks are, and have been, well-known and famous symbols of Plaintiff's services since before Defendants began using the infringing mark.

ANSWER: Defendants deny all allegations in Paragraph 61.

62. Defendants' actions are diluting and destroying the distinctiveness of Plaintiff's strong and famous SMYTH Marks by eroding the public's exclusive identification of the SMYTH Marks with Plaintiff, tarnishing and degrading the positive associations and prestigious connotations of the mark, and otherwise blurring and lessening the capacity of the mark to solely and exclusively identify and distinguish Plaintiff's services.

ANSWER: Defendants deny all allegations in Paragraph 62.

63. Defendants' actions are greatly diminishing and blurring the source-identifying capability of the SMYTH Marks through their marketing, advertising, and provision of services under an identical and confusingly similar name.

ANSWER: Defendants deny all allegations in Paragraph 63.

64. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with Plaintiff's SMYTH Marks or to cause dilution of the mark, to the great and irreparable injury of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 64.

65. As a result of Defendants' conduct and actions, Plaintiff's distinctive SMYTH Marks have been diluted, blurred, and diminished.

ANSWER: Defendants deny all allegations in Paragraph 65.

66. Defendants have caused and will continue to cause irreparable injury to Plaintiff's goodwill and business reputations, and dilution of the distinctiveness and value of Plaintiff's famous and distinctive SMYTH Marks in violation of 15 U.S.C. § 1125(c).

ANSWER: Defendants deny all allegations in Paragraph 66.

**AS TO "COUNT IV - TRADEMARK DILUTION UNDER THE ILLINOIS
TRADEMARK REGISTRATION AND PROTECTION ACT,
FORMERLY THE ANTI-DILUTION ACT, 765 ILCS 1036/65"**

67. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

68. This Count arises under the Illinois Trademark Registration and Protection Act, formerly known colloquially as the "Anti-Dilution Act," 765 ILCS 1036/65.

ANSWER: Defendants deny all allegations in Paragraph 68.

69. Through Plaintiff's longstanding use of the SMYTH Marks in commerce in the State of Illinois, the mark has become impressed upon the minds of the relevant trade and consuming public as identifying Plaintiff. The SMYTH Marks have become a well-known and famous symbol of Plaintiff's services in the State of Illinois.

ANSWER: Defendants deny all allegations in Paragraph 69.

70. Defendants' actions are diluting and destroying the distinctiveness of Plaintiff's strong, distinctive, and famous SMYTH Marks by eroding the public's exclusive identification of the SMYTH Marks with Plaintiff, tarnishing and degrading the positive associations and prestigious connotations of the mark, and otherwise blurring and lessening the capacity of the mark to solely and exclusively identify and distinguish Plaintiff's services.

ANSWER: Defendants deny all allegations in Paragraph 70.

71. Defendants' actions are greatly diminishing and blurring the source-identifying capability of the SMYTH Marks through their marketing, advertising, and provision of services under an identical and confusingly similar name.

ANSWER: Defendants deny all allegations in Paragraph 71.

72. Defendants' actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with Plaintiff's SMYTH Marks or to cause dilution of those marks, to the great and irreparable injury of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 72.

73. In addition to being entitled to injunctive relief under 765 ILCS 1036/65 for trademark dilution, Plaintiff is entitled to the remedies listed in 765 ILCS 1036/70, including “judgment for an amount not to exceed 3 times the profits and damages or reasonable attorneys’ fees of the prevailing party, or both,” because Defendants “willfully intended to trade on [Plaintiff’s] reputation or to cause dilution of” the SMYTH Marks.

ANSWER: Defendants deny all allegations in Paragraph 73.

74. As a result of Defendants’ conduct and actions, Plaintiff’s distinctive SMYTH Marks have been diluted, blurred, and diminished. Defendants have caused and will continue to cause irreparable injury to Plaintiff’s goodwill and business reputations, and dilution of the distinctiveness and value of Plaintiff’s famous and distinctive SMYTH Marks in violation of 15 U.S.C. § 1125(c).

ANSWER: Defendants deny all allegations in Paragraph 74.

AS TO "COUNT V - COMMON LAW UNFAIR COMPETITION"

75. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

76. This Count arises under an action for damages and injunctive relief pursuant to acts of unfair competition under the common law of the State of Illinois.

ANSWER: Defendants deny all allegations in Paragraph 76.

77. Through Plaintiff’s longstanding use of the SMYTH Marks in commerce, the mark has become impressed upon the minds of the relevant trade and consuming public as solely and exclusively identifying Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 77.

78. Plaintiff has built a large and valuable business in its use of the SMYTH Marks to become one a small number of restaurants located in the United States that have achieved three Michelin stars and the world renown that accompanies it. The goodwill associated with Plaintiff’s SMYTH Marks is of great value to Plaintiff, and by all rights belongs to Plaintiff alone.

ANSWER: Defendants deny all allegations in Paragraph 78.

79. Defendants have used, and are continuing to use, their infringing name SMYTH Tavern in connection with their own restaurant and bar services.

ANSWER: Defendants deny all allegations in Paragraph 79.

80. Defendants' unauthorized use of the name SMYTH Tavern is likely to cause confusion in the marketplace between Plaintiff and Defendants, and has enabled Defendants to compete unfairly and earn additional revenues off of the name recognition of Plaintiff's SMYTH Marks.

ANSWER: Defendants deny all allegations in Paragraph 80.

81. Defendants' misappropriation is in willful and wanton disregard of Plaintiff's rights in and to SMYTH Marks, and without the consent of Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 81.

**AS TO "COUNT VI - ILLINOIS CONSUMER FRAUD AND DECEPTIVE
BUSINESS PRACTICES ACT UNDER 815 ILCS 505"**

82. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

83. On information and belief, Defendants' above-described acts have been made with the intent of causing a likelihood of confusion, or of a misunderstanding as to the source, ownership and/or association with Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 83.

84. Defendants' acts constitute a violation of Illinois' Consumer Fraud and Deceptive Business Practices Act, 815 ILCS 505 insofar as they:

- (a) cause likelihood of confusion or of misunderstanding as to the source, sponsorship, or approval of services;
- (b) cause likelihood of confusion or of misunderstanding as to affiliation, connection, or association with another; and
- (c) represent that services have approval, characteristics, approval, status, affiliation or connection that they do not have.

ANSWER: Defendants deny all allegations in Paragraph 84.

85. Upon information and belief, Defendants have willfully engaged in the deceptive trade practices complained of herein.

ANSWER: Defendants deny all allegations in Paragraph 85.

86. Defendants' aforesaid acts have caused and, unless such acts are restrained by this Court, will continue to cause great and irreparable injury to Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 86.

87. Defendants' statutory violations and other wrongful acts have injured and threaten to continue to injure Plaintiff, including loss of customers, dilution of goodwill, confusion of existing and potential customers, injury to its reputation, and diminution in the value of its goodwill.

ANSWER: Defendants deny all allegations in Paragraph 87.

88. Defendants have unjustly gained revenue and profits by virtue of their wrongful acts that they otherwise would not have obtained and to which they are not entitled.

ANSWER: Defendants deny all allegations in Paragraph 88.

89. Plaintiff has also been injured and will continue to incur attorneys' fees and costs in bringing the present action.

ANSWER: Defendants deny all allegations in Paragraph 89.

90. Plaintiff has no adequate remedy at law for the wrongful actions of Defendants.

ANSWER: Defendants deny all allegations in Paragraph 90.

**AS TO "COUNT VII - ILLINOIS UNIFORM DECEPTIVE TRADE
PRACTICES ACT UNDER 815 ILCS 510"**

91. Plaintiff realleges and incorporates by reference the allegations set forth in the preceding paragraphs.

ANSWER: Defendants repeat and incorporate their answers contained in the preceding paragraphs as if set forth fully herein.

92. On information and belief, Defendants' above-described acts have been made with the intent of causing a likelihood of confusion, or of a misunderstanding as to the source, ownership and/or association with Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 92.

93. Defendants' acts constitute a violation of Illinois' Uniform Deceptive Trade Practices Act, 815 ILCS 510 insofar as they:

- (a) cause likelihood of confusion or of misunderstanding as to the source, sponsorship, or approval of services;
- (b) cause likelihood of confusion or of misunderstanding as to affiliation, connection, or association with another; and
- (c) represent that services have approval, characteristics, approval, status, affiliation or connection that they do not have.

ANSWER: Defendants deny all allegations in Paragraph 93.

94. On information and belief, Defendants have willfully engaged in the deceptive trade practices complained of herein.

ANSWER: Defendants deny all allegations in Paragraph 94.

95. Defendants' aforesaid acts have caused and, unless such acts are restrained by this Court, will continue to cause great and irreparable injury to Plaintiff.

ANSWER: Defendants deny all allegations in Paragraph 95.

96. Defendants' statutory violations and other wrongful acts have injured and threaten to continue to injure Plaintiff, including through loss of customers, loss of distinctiveness, dilution of goodwill, confusion of existing and potential customers, injury to its reputation, and diminution in the value of their mark.

ANSWER: Defendants deny all allegations in Paragraph 96.

97. Defendants have unjustly gained revenue and profits by virtue of their wrongful acts that it otherwise would not have obtained and to which they are not entitled.

ANSWER: Defendants deny all allegations in Paragraph 97.

98. Plaintiff has no adequate remedy at law for the wrongful actions of Defendants.

ANSWER: Defendants deny all allegations in Paragraph 98.

FIRST AFFIRMATIVE DEFENSE
(Weakness of SMYTH Mark / Primarily Merely a Surname)

Plaintiff's "SMYTH" mark is weak and entitled to, at most, narrow protection, particularly in geographically distinct markets. "Smyth" is a common surname and geographic

name. Plaintiff's mark SMYTH (U.S. Trademark Reg. No. 5,070,435) was granted registration only on the *Supplemental Register*, due to the following determination by the USPTO:

"SECTION 2(e)(4) REFUSAL – PRIMARILY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); see TMEP §§1211, 1211.01.

Please see the attached evidence from Whitepages.com, establishing the surname significance of Smyth. This evidence shows the applied-for mark appearing **13,903 times** as a surname in a nationwide phone directory of names."

See USPTO Office Action, dated August 24, 2016 (**Exhibit 1**) (emphasis added). Because the SMYTH mark is primarily merely a common surname, and commercially weak, it is entitled only to narrow protection in geographically distinct markets where the restaurant operates.

SECOND AFFIRMATIVE DEFENSE
(No Geographic Overlap)

Plaintiff's claims are barred under the *Dawn Donut* doctrine and related caselaw.

Plaintiff's restaurant operates exclusively in Chicago, Illinois. Defendant's restaurant, Smyth Tavern, operates exclusively in the neighborhood of Tribeca, New York City, within the Smyth Tribeca hotel (<https://www.smythtribeca.com>) (which opened as the Smyth hotel in 2009). There is no geographic overlap, no competition in the same market, and no allegations or evidence of Plaintiff's imminent expansion into Defendant's market or vice versa. The Defendants do not advertise or market "Smyth Tavern" outside of the New York metropolitan area. The mere existence of the words "Smyth Tavern" on a Lure Fishbar website footer (now removed) does not constitute targeted marketing in Chicago or nationwide expansion. Plaintiff cannot obtain injunctive relief.

THIRD AFFIRMATIVE DEFENSE
(Defendants Maintain Senior Priority Rights)

Plaintiff's claims are barred, in whole or in part, by Defendants' prior and senior rights. Smyth Tavern operates within the Smyth Tribeca hotel, which opened as the Smyth hotel in 2009, and which used the SMYTH brand and mark for hotel accommodation services, including food and beverage services - seven years prior to Plaintiff's claimed first use in 2016. In addition, on August 26, 2025, the USPTO issued U.S. Registration No. 7,914,013 for "SMYTH TRIBECA" for hotel accommodation services, which include food and beverage services. Defendants' use of "Smyth Tavern" is pursuant to and derivative of these senior rights and predates Plaintiff's most recent USPTO application filed November 12, 2025. Plaintiff's claims are barred by Defendants' senior priority.

FOURTH AFFIRMATIVE DEFENSE
(Dilution Fails as a Matter of Law)

To the extent Plaintiff alleges dilution: (i) "Smyth" is not a famous mark within the meaning of 15 U.S.C. § 1125(c); (ii) it is a common surname used by numerous third parties; (iii) it lacks the nationwide household recognition required for dilution protection. Michelin recognition does not equate to statutory fame.

FIFTH AFFIRMATIVE DEFENSE
(No Likelihood of Confusion)

Plaintiff cannot establish likelihood of confusion, *See, e.g., Ty, Inc. v. Jones Group, Inc.*, 237 F.3d 891 (7th Cir. 2001). Factors include: (i) the marks differ in sound, appearance, meaning, and commercial impression; (ii) the services, cuisine and concepts offered by each restaurant differ in marketplace reality (*e.g.*, "3 Michelin stars" fine dining versus local neighborhood hotel tavern eatery) ("Today, Smyth holds the rare and enviable distinction of

being awarded three Michelin stars, one of only fourteen such restaurants in the United States, and the only such restaurant with that distinction in Chicago." *See* Plaintiff's Complaint, ¶ 12; 13-15); (iii) the parties operate restaurants in distinct geographic markets, almost a thousand miles and a time zone apart; (iv) the Smyth Tavern operates pursuant to and derivative of the senior rights of the Smyth hotel that predate Plaintiff's use; (v) customers of these restaurants exercise significant care; (vi) Plaintiff's SMYTH mark is a commercially weak surname and geographic location, with only Supplemental Register protection; (vii) there is no actual confusion; and (viii) Defendants acted at all times in good faith.

SIXTH AFFIRMATIVE DEFENSE
(Lack of Actual Confusion)

Plaintiff's claims are barred because there is no evidence of actual confusion. Since Smyth Tavern opened in the Smyth hotel in 2022, there have been years of concurrent operation without a single instance of documented consumer confusion. The parties coexisted without confusion or conflict for over three years before Plaintiff filed this action.

SEVENTH AFFIRMATIVE DEFENSE
(Good Faith)

The name "Smyth Tavern" was adopted in good faith based on longstanding "Smyth" hotel branding, without any intent to trade on Plaintiff's goodwill. Defendants had independent, legitimate reasons for adoption of the mark. There is no evidence of bad faith. Plaintiff is not entitled to enhanced damages, profits, or attorneys' fees.

EIGHTH AFFIRMATIVE DEFENSE
(Laches, Estoppel, and Acquiescence)

Plaintiff's claims are barred, in whole or in part, by the doctrines of laches, estoppel, and/or acquiescence. Some or all of the claims asserted in the Plaintiff's Complaint are barred by

the applicable statute of limitations.

NINTH AFFIRMATIVE DEFENSE
(Failure to State a Claim)

Some or all of the claims asserted in Plaintiff's Complaint fail to state a claim upon which relief may be granted.

TENTH AFFIRMATIVE DEFENSE
(Statute of Limitations)

Some or all of the claims asserted in the Plaintiff's Complaint are barred by the applicable statute of limitations.

Defendants reserve the right to assert additional defenses as they become known through discovery or further investigation.

WHEREFORE, Defendants Smyth Tavern, LLC, Mercer Street Hospitality LLC, 142 Mercer Street, LLC, and John McDonald pray for judgment dismissing the Complaint, awarding Defendants costs, disbursements and reasonable attorneys' fees of this action, and for such other and further relief as this Court deems just and proper.

Dated: February 25, 2026

Respectfully submitted,

LOPRESTI, PLLC

By: /s/ Anthony A. LoPresti
Anthony A. LoPresti
alopresti@lopresti.one

55 Broadway, 3rd Fl.
New York, New York 10006
(646) 490-0065

*Attorneys for Defendants
Smyth Tavern, LLC
Mercer Street Hospitality LLC,
142 Mercer Street, LLC and John McDonald*

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was electronically filed and served to all counsel of record via the Court's CM/ECF system.

Dated: February 25, 2026

LOPRESTI, PLLC

/s/ Anthony A. LoPresti

Anthony A. LoPresti

alopresti@lopresti.one

55 Broadway, 3rd Fl.
New York, New York 10006
(646) 490-0065

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

JK Shields, LLC,

Plaintiff,

v.

Smyth Tavern, LLC, Mercer Street Hospitality
LLC, 142 Mercer Street, LLC, and
John McDonald,

Defendants.

Case No.: 1:25-cv-14182 (JCD)(BWJ)

Judge Jeremy C. Daniel

Exhibit 1

[USPTO Office Action, dated August 24, 2016]

To: JK Shields, LLC (ipdocket@muchshelist.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87029213 - SMYTH - 0013310.0005
Sent: 8/24/2016 5:41:25 PM
Sent As: ECOM101@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 87029213

MARK: SMYTH

87029213

CORRESPONDENT ADDRESS:

ADAM K SACHAROFF
MUCH SHELIST, PC
191 N WACKER DRIVE, SUITE 1800
CHICAGO, IL 60606

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: JK Shields, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

0013310.0005

CORRESPONDENT E-MAIL ADDRESS:

ipdocket@muchshelist.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 8/24/2016

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring

this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

SECTION 2(e)(4) REFUSAL – PRIMARILY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009) *see* TMEP §§1211, 1211.01.

Please see the attached evidence from *Whitepages.com*, establishing the surname significance of Smyth. This evidence shows the applied-for mark appearing 13,903 times as a surname in a nationwide phone directory of names.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

SUPPLEMENTAL REGISTER

A mark in an application under Trademark Act Section 1(b) is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use under 37 C.F.R. §2.76 has been filed. 37 C.F.R. §§2.47(d), 2.75(b); TMEP §§815.02, 1102.03. When a Section 1(b) application is successfully amended to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(c) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03.

Although an amendment to the Supplemental Register would normally be an appropriate response to this refusal, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(c) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03. In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements.

See 15 U.S.C. §§1052(d), 1091, 1094; TMEP §815.

Ira Goodsaid
/Ira Goodsaid/
Law Office 101
571-272-9166
ira.goodsaid@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.



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- New Jersey (633)
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A Smyth

Lives in: Lebanon, VA
 Prior: Haymarket, VA, Bealeton, VA
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Whitepages Premium Contact Info & Public Records

A Smyth

Lives in: Sutton, WV
 Prior: No known previous cities
 Find: Phone, Address, Email & Public Records

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John W Smyth

Age: 30-34
 Current: Spring Valley NY
 Prior: No known previous cities
 Knows: Joann C Smyth, John W Smyth I, John...

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Brian J Smyth Sr.

Age: 65+
 Current: Lakeland TN
 Prior: No known previous cities
 Knows: Brian J Smyth Sr., J R Smyth, Kathleen...

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Sue E Smyth

Age: 65+
 Current: Milford OH
 Prior: No known previous cities
 Knows: James T Smyth

[View Full Profile](#)

T Smyth

Age: 65-69
 Current: Commack NY
 Prior: No known previous cities
 Knows: Madeline Feaster, Thomas J Smyth Jr,...

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Siri M Smyth

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- Sid M Smyth**  
Age: 60-64
Current: Victoria VA
Prior: Kenbridge VA
Knows: No known associations
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- Paul Smyth**  
Age: Unknown
Current: Metcalfe ON
Prior: No known previous cities
Knows: No known associations
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- Margaret Smyth**  
Age: Unknown
Current: Riviera Beach FL
Prior: Riviera Beach FL
Knows: Otto A Clark, Saul R Robbins, Gabriela...
[View Full Profile](#)

- Ada D Smyth**  
Age: Unknown
Current: Noblesville IN
Prior: No known previous cities
Knows: Donald W Linville, Sandra J Linville, Erin...
[View Full Profile](#)

- John A Smyth**  
Age: 60-64
Current: Wallis TX
Prior: Friendswood TX, Houston TX, Richmond TX
Knows: Joshua Smyth
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- Matthew E Smyth**  
Age: 30-34
Current: Schenectady NY
Prior: Glenville NY, Schenectady NY
Knows: David A Berg, Robert P Berg, Sarah R B...
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- Genevieve M Smyth**  
Age: 30-34
Current: Oakland CA
Prior: Philadelphia PA
Knows: Lisa Henderson, Derek Smyth
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- Eileen M Smyth**  
Age: 60-64
Current: University Heights OH
Prior: University Heights OH
Knows: No known associations
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Celeste Smyth  

Age: 50-54
 Current: Morgantown WV
 Prior: No known previous cities
 Knows: Celeste A Wilmore, Betty Mullins, Celest... [View Full Profile](#)

Sunshine R Smyth  

Age: 55-59
 Current: Medford MA
 Prior: Medford MA, Midland TX, Auburndale MA,...
 Knows: Sarah Smyth [View Full Profile](#)

Caleb Smyth  

Age: Unknown
 Current: Kalispell MT
 Prior: No known previous cities
 Knows: Crystal Smyth, Russell R Dunten, Desire... [View Full Profile](#)

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Find contact information for Smyth

Name	Location	Contact Info
A Smyth	Lebanon, VA	Phone Address View Full Report
A Smyth	Sutton, WV	Phone Address View Full Report
A Smyth	Cincinnati, OH	Phone Address View Full Report
View More Results	Phone Address	View More Details

Email Records found for Smyth

Name	Age	Location	Records Found
A Smyth		Lebanon, VA	 View All Details
A Smyth		Sutton, WV	 View All Details
A Smyth		Cincinnati, OH	 View All Details
A Smyth		South Bend, IN	 View All Details

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Background Records found for Smyth

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Smyth	Court Records	Get Records
Smyth	Driving Records	Get Records
Smyth	Bankruptcy Records	Get Records

Birth, Marriage, & Death Records for Smyth

Sponsored by Ancestry.com

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Smyth	6116 Death Records	See Details
Smyth	3759 Marriage Records	See Details
Smyth	547 Divorce Records	See Details

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 We'll match all the cash back you've earned at the end of your first year.* No annual fee



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*See Terms. Only for new cardmembers.

To: JK Shields, LLC (ipdocket@muchshelist.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87029213 - SMYTH - 0013310.0005
Sent: 8/24/2016 5:41:27 PM
Sent As: ECOM101@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **8/24/2016** FOR U.S. APPLICATION SERIAL NO. 87029213

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **8/24/2016** (or sooner if specified in the Office action). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

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