COURT OF APPEALS
STATE OF GEORGIA

Caroline Maki and The Maki Group Real Estate Expert Advisors LLC, Defendants/Appellants, v. Real Estate Expert Advisors, LLC, Plaintiff/Appellee.	Case No. A20A2121

Brief of Appellants Caroline Maki and The Maki Group Real Estate Expert Advisors LLC

Marc B. Hershovitz
MARC B. HERSHOVITZ, P.C.
Georgia Bar No. 349510
One Alliance Center
4th Floor
3500 Lenox Road
Atlanta, Georgia 30326
404-262-1425
404-262-1474 (fax)
marc@hershovitz.com

Attorney for Appellants

Introduction

The adversarial system, with one party's counsel serving as a check on the other, usually works to provide a trial court with the thorough exposition of the applicable law that the court needs to decide a case or conduct a trial. On rare occasions—when counsel for both parties fail in their responsibility to provide the court with the information it needs to properly decide a case and conduct a trial and the trial judge is new to the bench[1]—the adversarial system fails, and the integrity and public reputation of judicial proceedings are put at risk. This is one of those rare cases.

Part One: Statement of Proceedings and Material Facts

Plaintiff Real Estate Expert Advisors, LLC, a real-estate brokerage, began using the mark REAL ESTATE EXPERT ADVISORS in 2014 in conjunction with providing real-estate services featuring people who are very skilled and knowledgeable about real estate providing advice about

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[1] *See* V3-10 (lines 16–19) (Trial Tr. vol. 1, 9:16–19) ("You will notice me reading from my notes a good bit. Just to tell you a little bit about me, I was just elected last May and took the bench in January, and so I'm still getting used to my new role as a judge.").

real estate.[2] The plaintiff never registered its REAL ESTATE EXPERT ADVISORS mark with the United States Patent and Trademark Office or with Georgia's Secretary of State.[3]

At about the same time, Caroline Maki, a licensed real-estate broker practicing real estate as an associate broker, began using the phrase "Real Estate Expert Advisors" to describe the team of real-estate agents she led, who, like the plaintiff's real-estate agents, are people very skilled and knowledgeable about real estate who provide advice about real estate.[4]

Wrongly believing that it had the right to exclude others from using the generic phrase "real estate expert advisors" in conjunction with

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[2] *See* V3-151 (lines 12–23) (Trial Tr. vol. 1, 150:12–23) ("[I]n real estate, teams have names. … So being the expert and being the advisor, we just plugged in 'real estate' at the beginning of it and made a logo and made that our brokerage name and firm. So it was something that we decided that we wanted to continue to be the expert in our area and the advisor but bring in the real estate word into it.").

[3] V3-184 (line 9) – 185 (line 11) (Trial Tr. vol. 1, 183:9–184:11).

[4] *See* V4-16 (Trial Tr. vol. 2, 245:5–19) ("I just put 'real estate' in front of 'expert advisors' and you come up with the name Real Estate Expert Advisors. I only used it as a tag name, The Maki Group Real Estate Expert Advisors. That's all I did. Every time we used that name, it always had 'The Maki Group' in front of it.")

real-estate services, the plaintiff found an attorney to send a letter to Maki demanding that she stop using that phrase to promote her team's real-estate services.[5] After receiving the plaintiff's demand letter, Maki filed articles of organization with Georgia's Secretary of State creating The Maki Group Real Estate Expert Advisors, LLC, under the mistaken belief that doing so would protect her right to use the generic phrase "real estate expert advisors" in connection with her real-estate services, but that LLC never conducted business of any kind whatsoever.[6]

About two months later, after Maki did not stop using the generic phrase "real estate expert advisors" to describe the team of real-estate agents she led, the plaintiff sued both Maki and her newly formed LLC, asserting claims for (1) violations of Georgia's Uniform Deceptive Trade Practices Act, (2) "damages for misappropriation of trade name," (3) attorney's fees under O.C.G.A. § 13-6-11, and (4) punitive damages.[7]

Neither party conducted meaningful discovery. Not even a single

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[5] V5-71–72 (Plaintiff's Trial Ex. 15).

[6] *See* V4-33 (Trial Tr. vol. 2, 262:12–25) (Maki testifying she incorporated The Maki Group Real Estate Expert Advisors, LLC, "as a defense mechanism to [the plaintiff] coming after me").

[7] V2-9–17 (R. 9–17).

deposition was taken by either party. Maki and her LLC's trial counsel did not file any motion for summary judgment, and the case proceeded to be tried before a jury. The trial took place over three days. Only two witnesses testified, Tracy Cousineau, who is the plaintiff's principal, and Maki.

Claims under the Georgia Uniform Deceptive Trade Practices Act are to be decided under the same likelihood-of-confusion analysis used to decide trademark-infringement claims under the federal Lanham Act.[8] To determine whether a likelihood of confusion exists, seven factors must be examined: (1) the strength and distinctiveness of the plaintiff's mark; (2) the similarity of the marks; (3) the similarity of the products the marks represent; (4) the similarity of the parties' retail

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[8] *ITT Corp. v. Xylem Group, LLC*, 963 F. Supp. 2d 1309, 1327 (N.D. Ga. 2013); *compare Ackerman Sec. Sys., Inc. v. Design Sec. Sys.*, Inc., 201 Ga. App. 805, 806 (1991) (setting forth factors to be considered in likelihood-of-confusion analysis under the Georgia Uniform Deceptive Trade Practices Act) *with PlayNation Play Sys., Inc. v. Velex Corp.*, 924 F.3d 1159, 1165 (11th Cir. 2019) (setting forth factors to be considered in likelihood-of-confusion analysis under the Lanham Act); *Hi-Tech Pharm., Inc. v. Wyant*, NO. 1:16-CV-639-AT, 2017 WL 11358731, at *5 (N.D. Ga. Apr. 19, 2017); *see also Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 265 (5th Cir. 1980) (holding "the crux of a complaint based on the Georgia Uniform Deceptive Trade Practices Act is the likelihood of confusion between goods").

outlets and customers; (5) the similarity of advertising media; (6) the defendant's intent; and (7) actual confusion.[9] But the trial court did not give the jury any instructions regarding the likelihood-of-confusion analysis the jury was required to apply.[10]

The only thing the trial court told the jury about the likelihood-of-confusion analysis that the jury was required to apply was that if the jury found that Maki and her company caused a likelihood of confusion, then the jury should find Maki and her company liable for violating the Georgia Uniform Deceptive Trade Practices Act:

> The plaintiff contends that the defendant violated certain laws or ordinances. It is your duty to decide whether such violation took place or not.
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> . . .
>
> A person engages in a deceptive trade practice when, in the course of her business, vocation, or occupation, she

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[9] *Ackerman Sec. Sys.*, 201 Ga. App. at 806; *PlayNation Play Sys., Inc. v. Velex Corp.*, 924 F.3d 1159, 1165 (11th Cir. 2019).

[10] *Compare* V4-163 (lines 16–25) (Trial Tr. vol. 2, 392:16–25) (trial court's instruction to jury regarding likelihood of confusion) *with PlayNation*, 924 F.3d at 1165 (detailing seven factors to be considered in likelihood-of-confusion analyses) *and* 11th Circuit Civil Pattern Jury Instructions § 10.2 (available at V2-213–44 (R. 213–44) (providing detailed instructions on the seven factors to be considered in analyzing whether a mark is likely to cause confusion).

> passes off goods or services as those of another; causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval, or certification of good or services; causes likelihood of confusion or of misunderstanding as to affiliation, connection or association with, or certification by another; or engages in any other conduct which similarly creates a likelihood of confusion or of misunderstanding.[11]

The trial court never instructed the jury how to determine whether Maki's use of the phrase "real estate expert advisors" in connection with her real-estate services was likely to cause confusion with the plaintiff's use of that phrase as its mark.[12]

Without receiving instructions regarding the law that it was required to apply, the jury returned a verdict for the plaintiff against both Maki and her LLC.[13] For the judgment against Maki, the jury awarded the plaintiff actual damages of $10 for violations of the Georgia Uniform Deceptive Trade Practices Act, awarded the plaintiff $20,055.19 in attorney's fees under O.C.G.A. § 13-6-11, and found Maki

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[11] V4-161 (line 24) – 163 (line 25) (Trial Tr. vol. 2, 390:24–392:25).

[12] V4-157–171 (Trial Tr. vol. 2, 386–400).

[13] V2-185–87 (R. 184–87)

liable for punitive damages.[14] For the judgment against Maki's LLC, the jury awarded the plaintiff actual damages of $10 for violations of the Georgia Uniform Deceptive Trade Practices Act and awarded the plaintiff $6,685.06 in attorney's fees under O.C.G.A. § 13-6-11.[15]

Since the jury found Maki liable for punitive damages, further testimony and evidence was presented to the jury, and the jury returned another verdict that awarded the plaintiff $17,000 in punitive damages against Maki.[16]

In total, the jury awarded the plaintiff $20 in actual damages, $26,740 in attorney's fees and expenses under O.C.G.A. § 13-6-11, and $17,000 in punitive damages.

After the jury returned its verdicts, the trial court, at the plaintiff's request, issued a "temporary injunction" against Maki and her LLC that prohibited them from "us[ing] 'real estate expert advisors' in that order"[17] and set a hearing on the plaintiff's motion for a permanent

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[14] V2-184 (R. 184).

[15] V2-185 (R. 185).

[16] V2-187 (R. 187).

[17] V5-59 (line 14) – 60 (line 10) (Trial Tr. vol. 3, 471:14–472:10);
(continued...)

injunction for November 14, 2019.[18]

Between the time the jury returned its verdict in early October and the trial court held its November 14, 2019, hearing, Maki and her LLC replaced its trial counsel,[19] and their new (the undersigned) attorney filed a renewed joint motion for judgment notwithstanding the verdict.[20] Without waiting to receive a response from the plaintiff, the trial court summarily denied Maki and her LLC's motion.[21]

After conducting a hearing on November 14, 2019, to consider a permanent injunction, the trial court entered its "Judgment on Verdict" making the jury's verdict forms the judgment of the court.[22] Maki and her LLC then filed their Notice of Appeal on December 13, 2019, within

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[17](...continued)
see also V2- 5–7 (R. 5–7) (temporary injunction entered Nov. 15, 2019).

[18] V5-56 (Trial Tr. vol. 3, 468).

[19] V2-189–90 (R. 189–90).

[20] V2-191–244 (R. 191–244).

[21] V2-245 (R. 245).

[22] V2-4 (R. 4).

the time required by law.[23] At that time, the trial court had taken no action regarding entering a permanent injunction.

Maki and her LLC's Notice of Appeal preserved for consideration the issue of the trial court's failure to properly instruct the jury (the first enumeration of error set forth in Part Two of this brief) because "[i]t is the duty of the court, *whether requested or not*, to give to the jury appropriate instructions on every substantial and vital issue presented by the evidence, and on every theory of the case."[24] The issue raised by

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[23] V2-1–3 (R. 1–3).

Maki and her LLC's trial counsel asserted counterclaims on their behalf. V2-41–45 (R. 41–45). The jury returned verdicts in favor of the plaintiff on those counterclaims. V2-185–86 (R. 185–86). With the benefit of guidance from new counsel, Maki and her LLC recognize that those counterclaims were without merit and not warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law. Thus, Maki and her LLC did not appeal the jury's verdict regarding those counterclaims. If this Court vacates the trial court's judgment, to the extent this action may be necessary to clear up the record, Maki and her LLC will dismiss the counterclaims asserted by her trial counsel with prejudice.

[24] Richard C. Ruskell, *Davis and Shulman's Georgia Practice and Procedure* § 21:3 (2019-2020 ed.) (emphasis added); *see also Allmond v. Mount Vernon Bank*, 53 Ga. App. 565, 186 S.E. 581, 582 (1936) (holding "[i]t is the duty of the trial judge, whether requested or not, to charge the jury on the substantial and controlling issues raised by the pleadings and the evidence"); *Se. Plumbing Supply Co. v. Lee*, 133 Ga.

(continued...)

the first enumeration of error was also preserved for consideration because it was raised by Maki and her LLC in their Renewed Joint Motion for Judgment Notwithstanding the Verdict.[25]

Maki and her LLC's Notice of Appeal also preserved for consideration enumeration of error 2 through 5 set forth in Part Two of this brief as these issues were raised by Maki and her LLC in their Renewed Joint Motion for Judgment Notwithstanding the Verdict.[26]

Further, a party's trial counsel's failure to object to a court entering a judgment that the law does not allow does not vest the trial court with

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[24](...continued)
App. 470, 472 (1974) (holding "[t]he trial judge is required, without request, to charge upon the material and controlling issues in the case"); *Scott Co. v. Crain*, 55 Ga. App. 514, 190 S.E. 629, 630 (1937) (holding "the law of the case must be given to the jury to the extent of covering the substantial issues made by the evidence, whether requested or not, or whether the attention of the court be called thereto or not; otherwise the verdict will be set aside"); *Mobley v. Merchants' & Planters, Bank*, 157 Ga. 658 (1924) (same);

[25] *See* V2-200–02 (R. 200–02) ("The only instruction that the jury received regarding the plaintiff's claims under the Uniform Deceptive Trade Practices Act was the applicable text of the statute.… The failure of the Court to instruct the jury regarding the likelihood-of-confusion analysis the jurors were required to apply is the equivalent of not instructing the jury at all ….").

[26] *See* V2-191–244 (R. 191–244).

the authority to enter an *ultra vires* judgment.[27] Thus, Maki and her LLC's Notice of Appeal preserved for consideration enumerations of error 3 through 5 set forth in Part Two of this brief.

Part Two: Enumeration of Errors and Statement of Jurisdiction

Enumeration of Errors

1. Claims under the Georgia Uniform Deceptive Trade Practices Act are required to be decided under the same likelihood-of-confusion analysis applied in trademark-infringement claims under the federal Lanham Act, which involves the examination of seven factors. The trial court erred when it failed to tell the jury anything about the likelihood-of-confusion analysis that it was required to apply to reach its verdict.
2. Generic and merely descriptive marks are not entitled to trademark protection. The plaintiff's mark is REAL ESTATE EXPERT ADVISORS, which the plaintiff uses to offer services featuring people who are very skilled and knowledgeable about real estate

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[27] *Cf. Hyde v. State*, 299 Ga. 135, 135 (2016) ("When a court imposes a criminal punishment that the law does not allow, the sentence is not just an error, it is void.").

providing advice about real estate. The plaintiff's mark as applied to the plaintiff's services is generic or merely descriptive. Thus, the trial court erred when it failed to grant the defendants' motion for judgment notwithstanding the verdict.

3. Because the sole remedy available under the Georgia Uniform Deceptive Trade Practices Act is injunctive relief, the trial court erred when it entered a judgment awarding the plaintiff actual damages for violations of the Georgia Uniform Deceptive Trade Practices Act.

4. Because attorney's fees and litigation expenses under O.C.G.A. § 13-6-11 are ancillary and recoverable only where other elements of damage are recoverable on the underlying claims, and because the sole remedy available under the Georgia Uniform Deceptive Trade Practices Act is injunctive relief, the trial court erred when it entered a judgment awarding the plaintiff attorney's fees and litigation expenses under O.C.G.A. § 13-6-11 when the underlying claim was for violations of the Georgia Uniform Deceptive Trade Practices Act.

5. Because punitive damages cannot be awarded in the absence of any

finding of compensatory damages, and because the sole remedy available under the Georgia Uniform Deceptive Trade Practices Act is injunctive relief, the trial court erred when it entered a judgment awarding the plaintiff punitive damages for violations of the Georgia Uniform Deceptive Trade Practices Act.

Statement of Jurisdiction

The Court of Appeals has jurisdiction over this appeal because it does not involve an issue that is within the exclusive jurisdiction of the Supreme Court.

Part Three:
Standard of Review and
Argument & Citation of Authority

Standard of Review

The errors complained of in this appeal all involve questions of law, and "[w]hen a question of law is at issue … [Georgia's appellate courts] owe no deference to the trial court's ruling and apply the plain legal error standard of review."[28]

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[28] *Phoenix Recovery Group, Inc. v. Mehta*, 291 Ga. App. 874, 875 (2008); *Buckler v. DeKalb Cnty. Bd. of Tax Assessors*, 288 Ga. App. 332,
(continued...)

Argument & Citation of Authority

1. This Court should reverse the trial court's judgment because the trial court neglected to instruct the jury about the law applicable to the material and controlling issue in the case.

Trademark claims under the Georgia Uniform Deceptive Trade Practices Act, which were the claims asserted by the plaintiff,[29] are required to be decided under the same likelihood-of-confusion analysis that is applied in trademark-infringement claims under the Lanham Act, the comprehensive federal law that governs trademarks.[30]

To determine whether a likelihood of confusion exists, seven factors

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[28](...continued)
333 (2007).

[29] V2-9–17 (R. 9–17); *see also* O.C.G.A. § 10-1-372(a)(3) (providing "[a] person engages in a deceptive trade practice when, in the course of his business, vocation, or occupation, he … causes likelihood of confusion or of misunderstanding as to affiliation, connection, or association with or certification by another).

[30] *ITT Corp*, 963 F. Supp. 2d at 1327; *compare Ackerman Sec. Sys.*, 201 Ga. App. at 806 (setting forth factors to be considered in likelihood-of-confusion analysis under the Georgia Uniform Deceptive Trade Practices Act) *with PlayNation Play Sys.*, 924 F.3d 1at 1165 (setting forth factors to be considered in likelihood-of-confusion analysis under the Lanham Act); *Hi-Tech Pharm.*, 2017 WL 11358731, at *5; *see also Amstar Corp*, 615 F.2d at 265 (holding "the crux of a complaint based on the Georgia Uniform Deceptive Trade Practices Act is the likelihood of confusion between goods").

must be examined: (1) the strength and distinctiveness of the plaintiff's mark; (2) the similarity of the marks; (3) the similarity of the products the marks represent; (4) the similarity of the parties' retail outlets and customers; (5) the similarity of advertising media; (6) the defendant's intent; and (7) actual confusion.[31] The trial court did not instruct the jury about any of this.[32] The failure of the trial court to instruct the jury regarding the likelihood-of-confusion analysis the jurors were required to apply is the equivalent of not instructing the jury at all, and that is plain error.

"It is the duty of the trial judge, *whether requested or not*, to charge the jury on the substantial and controlling issues raised by the

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[31] *Ackerman Sec. Sys.*, 201 Ga. App. at 806; *PlayNation*, 924 F.3d at 1165.

[32] *See* V4-157 (line 11) – 171 (line 22) (Trial Tr. vol. 2, 386:11–400:22; *compare* V4-163 (lines 16–25) (Trial Tr. vol. 2, 392:16–25) (trial court's instruction to jury regarding likelihood of confusion) *with PlayNation*, 924 F.3d at 1165 (detailing seven factors to be considered in likelihood-of-confusion analyses) *and* 11th Circuit Civil Pattern Jury Instructions § 10.2 (available at V2-213–44 (R. 213–44)) (providing detailed instructions on the seven factors to be considered in analyzing whether a mark is likely to cause confusion).

pleadings and the evidence."[33] Thus, it is immaterial that neither the plaintiff's counsel nor Maki and her LLC's trial counsel requested that the jury be instructed regarding the likelihood-of-confusion analysis the jury was required to apply. The trial court's failure to instruct the jury regarding the law it was required to apply to decide the case is plain error that requires reversal.[34]

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[33] *Allmond v. Mount Vernon Bank*, 53 Ga. App. 565, 186 S.E. 581, 582 (1936) (emphasis added); *Se. Plumbing Supply Co. v. Lee*, 133 Ga. App. 470, 472 (1974) (holding "[t]he trial judge is required, without request, to charge upon the material and controlling issues in the case"); *Scott Co. v. Crain*, 55 Ga. App. 514, 190 S.E. 629, 630 (1937) (holding "the law of the case must be given to the jury to the extent of covering the substantial issues made by the evidence, whether requested or not, or whether the attention of the court be called thereto or not; otherwise the verdict will be set aside"); *Mobley v. Merchants' & Planters, Bank*, 157 Ga. 658 (1924) (same); Richard C. Ruskell, *Davis and Shulman's Georgia Practice and Procedure* § 21:3 (2019-2020 ed.) (duty to instruct in absence of request).

[34] *See Se. Plumbing Supply Co.*, 133 Ga. App. at 472 ("The trial judge is required, without request, to charge upon the material and controlling issues in the case. His failure to do so here requires a reversal." [internal citations omitted]).

2. This Court should reverse the trial court's judgment because the mark REAL ESTATE EXPERT ADVISORS as applied to the plaintiff's services is not entitled to trademark protection as a matter of law, and no reasonably minded jury, properly instructed, could conclude otherwise.

The purpose of a trademark[35] or servicemark[36] is to identify and distinguish the products or services of one party from those of another.[37] To the public, a trademark signifies that all the goods or services

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[35] A trademark is a "[a] word, phrase, logo, or other sensory symbol used by a manufacturer or seller to distinguish its products or services from those of others. BLACK'S LAW DICTIONARY *trademark* (11th ed. 2019).

"Trademark" may sometimes be used as a synonym for "tradename," but more often it means "the name under which a business operates," a "d/b/a" designation. BLACK'S LAW DICTIONARY *tradename* (11th ed. 2019).

[36] A servicemark is "[a] name, phrase, or other device used to identify and distinguish the services of a certain provider." BLACK'S LAW DICTIONARY *servicemark* (11th ed. 2019). "Servicemarks identify and afford protection to intangible things such as services, as distinguished from the protection already provided for marks affixed to tangible things such as goods and products." *Id.* Like a square is a rectangle but a rectangle is not necessarily a square, a servicemark is a trademark but a trademark is not necessarily a servicemark.

[37] J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3: (5th ed. 2017); *e.g.*, *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705 (1st Cir. 2007).

bearing the mark come from the same source.[38]

Trademark claims under the Georgia Uniform Deceptive Trade Practices Act, are required to be decided under the same likelihood-of-confusion analysis that is applied in trademark-infringement claims under the federal Lanham Act.[39] The first step in that analysis is to determine whether the mark the plaintiff seeks to protect is entitled to protection.[40]

All trademarks fall into one of four categories, which are, from weakest to strongest: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.[41] "The stronger the mark, the greater the scope

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[38] J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3:2 (5th ed. 2017).

[39] *ITT Corp*, 963 F. Supp. 2d at 1327; *compare Ackerman Sec. Sys.*, 201 Ga. App. at 806 (setting forth factors to be considered in likelihood-of-confusion analysis under the Georgia Uniform Deceptive Trade Practices Act) *with PlayNation Play Sys.*, 924 F.3d 1at 1165 (setting forth factors to be considered in likelihood-of-confusion analysis under the Lanham Act); *Hi-Tech Pharm.*, 2017 WL 11358731, at *5; *see also Amstar Corp.*, 615 F.2d at 265 (holding "the crux of a complaint based on the Georgia Uniform Deceptive Trade Practices Act is the likelihood of confusion between goods").

[40] *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1356 (11th Cir. 2007).

[41] *PlayNation*, 924 F.3d at 1165.

of protection accorded it, the weaker the mark, the less trademark protection it receives."[42] "Generic marks are the weakest and not entitled to protection—they refer to a class of which an individual service is a member (e.g., 'liquor store' used in connection with the sale of liquor)."[43] "Descriptive marks describe a characteristic or quality of an article or service (e.g., 'vision center' denoting a place where glasses are sold)."[44] A suggestive mark "'suggests, rather than describes,' some characteristic of the goods to which it is applied and requires the consumer to exercise his imagination to reach a conclusion as to the nature of those goods."[45] COPPERTONE is an example of a suggestive mark as it suggests the outcome of using suntan oil. "An arbitrary mark is a word or phrase that bears no relationship to the product."[46] APPLE for smartphones and computers is an example of an arbitrary mark as cell phones and laptops have nothing to do with fruit or cider. And a

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[42] *Frehling Enters., Inc. v. Int'l Select Group, Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999).

[43] *Id.* (parenthetical in original).

[44] *Id.* (parenthetical in original).

[45] *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980).

[46] *Frehling*, 192 F.3d 1330, 1335 (11th Cir. 1999).

fanciful mark is a made-up term invented for the single purpose of functioning as a trademark. XEROX is an example of a fanciful mark.

Suggestive and arbitrary or fanciful marks are considered distinctive and automatically qualify for trademark protection.[47] Generic marks do not receive trademark protection as a matter of law because one cannot deprive competing manufacturers of a product of the right to call an article by its name, nor can one deprive competing service providers of the right to call their service by its name.[48] A mark that is merely descriptive of a product or service is also not entitled to trademark protection unless it has been proven to have acquired distinctiveness as a mark in buyers' minds—in other words, that it has come to be a distinctive source identifier in consumers' minds.[49]

The plaintiff's mark in this case is REAL ESTATE EXPERT ADVISORS, and the plaintiff provides consulting services through a team of experts regarding real-estate transactions. As applied to the

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[47] *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986); *Frehling*, 192 F.3d at 1335.

[48] *A.J. Canfield Co.*, 808 F.2d at 297.

[49] J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3:2 (5th ed. 2017).

plaintiff's services, REAL ESTATE EXPERT ADVISORS is generic. If it is not generic, it is descriptive, but it is so descriptive that it is incapable of acquiring distinctiveness as a trademark. In other words, it is incapable of serving as a source identifier in consumers' minds. And since it is either generic or so merely descriptive that it is incapable of serving as a source identifier for the plaintiff's services, it cannot and does not receive trademark protection as a matter of law.

The Federal Circuit Court of Appeals' decision in *In re Boston Beer Company Limited Partnership*[50] is instructive. In that case, Boston Beer sought to register the mark THE BEST BEER IN AMERICA in conjunction with beer and ale. The Federal Circuit recognized that "a phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark," and, thus, incapable of being a protected trademark.[51] The court then held that "[THE BEST BEER IN AMERICA] is so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods

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[50] 198 F.3d 1370 (Fed. Cir. 1999).

[51] *Id.* at 1373.

and serve as an indication of origin."[52]

As was the case with THE BEST BEER IN AMERICA, REAL ESTATE EXPERT ADVISORS, if not generic, is a common, laudatory advertising phrase that is merely descriptive of the services offered by the plaintiff—consulting services for real-estate transactions provided by a team of experts.[53]

That the plaintiff's claims in this case are unsustainable as a matter of law screams out from the fact that the plaintiff only sought to prevent Maki and The Maki Group from using the words "real estate expert advisors" in that order.[54] If Maki and The Maki Group can offer their real-estate consulting services under the mark THE MAKI GROUP EXPERT REAL ESTATE ADVISORS as the plaintiff

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[52] *Id.* at 1373–74.

[53] *See Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 116 (5th Cir. 1979) (holding "[w]henever a word or phrase naturally directs attention to the qualities, characteristics, effect, or purpose of the product or service, it is descriptive and cannot be claimed as an exclusive trade name").

[54] V2-181 (¶ 4) (R. 181 (¶4)) (requesting permanent injunction "barring each Defendant from using the words 'real estate expert advisors', *in that precise order*" [emphasis added]).

conceded,[55] they must also be able to offer their services under the mark THE MAKI GROUP REAL ESTATE EXPERT ADVISORS. The two marks are aurally similar, semantically identical, and convey similar commercial impressions. And if the plaintiff suddenly now claims that Maki and The Maki Group should be prohibited from offering their services under the mark THE MAKI GROUP EXPERT REAL ESTATE ADVISORS because the plaintiff does business using the mark REAL ESTATE EXPERT ADVISORS for consulting services for real-estate transactions provided by a team of experts, it highlights the fact that the plaintiff is seeking trademark protection for a generic or purely descriptive mark, something the law does not allow.

If the plaintiff in this case were a Chinese restaurant with a similarly generic or merely descriptive name, the plaintiff's name would be something like DELICIOUS CHINESE RESTAURANT. It is stating the obvious that the plaintiff would not have a colorable claim for violations of the Georgia Uniform Deceptive Trade Practices Act against

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[55] *See id.* (requesting permanent injunction "barring each Defendant from using the words 'real estate expert advisors', *in that precise order*" [emphasis added]).

another restaurant doing business using the name WONG KEI DELICIOUS CHINESE RESTAURANT. "Delicious Chinese Restaurant" is a generic or laudatory advertising phrase that is merely descriptive of the services being offered—the preparation and service of good-tasting Chinese food. REAL ESTATE EXPERT ADVISORS is no different than DELICIOUS CHINESE RESTAURANT.

As applied to consulting services for real-estate transactions provided by a team of experts, REAL ESTATE EXPERT ADVISORS is generic or so descriptive as to be incapable of acquiring distinctiveness and serving as a trademark.[56] If properly instructed, no reasonably minded jury could conclude otherwise. And since no reasonably minded, properly instructed jury could have returned a judgment in favor of the plaintiff in this case, the trial court should have granted Maki and The Maki Group's renewed motion for judgment notwithstanding the verdict. Thus, the judgment of the trial court should be reversed.

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[56] *See Vision Ctr.*, 596 F.2d at 116 (holding "[w]henever a word or phrase naturally directs attention to the qualities, characteristics, effect, or purpose of the product or service, it is descriptive and cannot be claimed as an exclusive trade name").

3. The trial court's judgment should be reversed because its award of actual, albeit nominal, damages is unauthorized and improper as a matter of law.

"The [Georgia Uniform Deceptive Trade Practices] does not address past harm."[57] "[T]he sole remedy provided under [the Georgia Uniform Deceptive Trade Practices] Act is injunctive relief."[58] Put another way: "[c]ivil damages are never available under this Act."[59] Thus, the trial court's awarding actual damages to the plaintiff of $10 against Maki and $10 against The Maki Group is unauthorized and improper as a matter of law and should be reversed.

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[57] *Friedlander v. HMS-PEP Prods., Inc.*, 226 Ga. App. 123, 124, 485 S.E.2d 240, 240 (1997)

[58] *Lauria v. Ford Motor Co.*, 169 Ga. App. 203, 206 (1983); *Catrett v. Landmark Dodge, Inc.*, 253 Ga. App. 639, 644 (2002); *Moore-Davis Motors, Inc. v. Joyner*, 252 Ga. App. 617, 619 (2001); *Friedlander*, 226 Ga. App. at 124 (1997); *Magliaro v. Lewis*, 203 Ga. App. 632, 634–35 (1992); *Ezfauxdecor, LLC v. Appliance Art Inc.*, No. 15-9140, 2017 WL 661576, at *4 (D. Kan. Feb. 17, 2017); *Sharpe v. Wells Fargo Home Mortgage*, No. 1:12-CV-04292-CC-GGB, 2013 WL 12109445, at *4 (N.D. Ga. Apr. 4, 2013); *Margineanu v. Wolpoff & Abramson, L.L.P.*, No. 1:08-CV-2198-CAM-RGV, 2009 WL 10712012, at *3 (N.D. Ga. Jan. 16, 2009); *Optimum Techs., Inc. v. Henkel Consumer Adhesives, Inc.*, No. 1:04-CV-1082-TWT, 2006 WL 1663357, at *8 n.2 (N.D. Ga. June 14, 2006).

[59] *Boynton v. State Farm Mut. Auto. Ins. Co.*, 207 Ga. App. 756, 756 n.1 (1993).

4. The trial court's judgment should be reversed because its award of attorney's fees and expenses under O.C.G.A. § 13-6-11 is unauthorized and improper as a matter of law.

Because the trial court's award of actual damages to the plaintiff is unauthorized and improper as a matter of law,[60] the trial court's award of attorney's fees and expenses under O.C.G.A. § 13-6-11 is unauthorized and improper as a matter of law because "attorney fees and expenses of litigation under O.C.G.A. § 13-6-11 … are ancillary and recoverable only where other elements of damage are recoverable on the underlying claim."[61] Thus, the trial court's award of attorney's fees and expenses under O.C.G.A. § 13-6-11 should be reversed.

5. The trial court's judgment should be reversed because its award of punitive damages is unauthorized and improper as a matter of law.

Because the trial court's award of actual damages to the plaintiff is

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[60] *See* § 3, *supra*.

[61] *Davis v. Johnson*, 280 Ga. App. 318, 320 (2006) (ellipses in original); *Sparra v. Deutsche Bank Nat'l Trust Co.*, 336 Ga. App. 418, 422–23 (2016); *Freeman v. Wheeler*, 277 Ga. App. 753, 757 (2006); *Steele v. Russell*, 262 Ga. 651, 651 (1993); *Lincoln Nat'l Life Ins. Co. v. Davenport*, 201 Ga. App. 175, 176 (1991); *Connell v. Houser*, 189 Ga. App. 158, 159 (1988); *Basic Four Corp. v. Parker*, 158 Ga. App. 117, 120 (1981); *Minter v. Powell*, 152 Ga. App. 449, 452 (1979).

unauthorized and improper as a matter of law,[62] its award of punitive damages to the plaintiff is also unauthorized and improper as a matter of law because "punitive damages cannot be awarded in the absence of any finding of compensatory damages."[63]

"The [Georgia Uniform Deceptive Trade Practices] does not address past harm."[64] "[T]he sole remedy provided under [the Georgia Uniform Deceptive Trade Practices] Act is injunctive relief."[65] In a case discussing the injunction remedy provided by the Georgia Uniform Deceptive Trade Practices Act, the Georgia Court of Appeals held that "[b]y definition, an injunction provides relief from *future* wrongful conduct: 'the remedy by injunction is to prevent, prohibit or protect from future wrongs and does not afford a remedy for what is past."[66]

"In accordance with O.C.G.A. § 51-12-5.1, punitive damages can

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[62] *See* § 3, *supra*.

[63] *Martin v. Martin*, 267 Ga. App. 596, 597 (2004); *Hart v. Walker*, 347 Ga. App. 582, 584–85 (2018). *Sparra*, 336 Ga. App. at 422–23; *Nelson v. Glynn-Brunswick Hosp. Auth.*, 257 Ga. App. 571, 579 (2002); *Artis v. Crenshaw*, 256 Ga. 488, 488 (1986).

[64] *Friedlander*, 226 Ga. App. at 124.

[65] *Lauria*, 169 Ga. App. at 206.

[66] *Catrett*, 253 Ga. App. at 644 (emphasis in original).

only be awarded as additional damages."[67] Even if the plaintiff's mark were entitled to protection under the law and the remedy of an injunction was thus available to protect the mark under the Georgia Uniform Deceptive Trade Practices Act, "there can be no recovery of punitive damages where the sole recovery is in equity."[68]

The trial court awarding the plaintiff punitive damages from Maki is unauthorized and improper as a matter of law and should be reversed.

Conclusion

The trial court failed to instruct the jury about the law applicable to the material and controlling issue in the case. That by itself, at a minimum, requires the trial court's judgment to be reversed and a new trial granted. But a new trial is not necessary because the mark REAL ESTATE EXPERT ADVISORS as applied to the plaintiff's services is generic or so descriptive as to be incapable of acquiring distinctiveness and serving as a trademark, and no reasonably minded, properly

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[67] *Martin*, 267 Ga. App. at 597.

[68] *Id.*

instructed jury could conclude otherwise. Thus, the trial court's judgment should be reversed.

Compounding those errors, the trial court entered a judgment against Maki and The Maki Group for actual damages and attorney's fees and expenses under O.C.G.A. § 13-6-11—and against Maki for punitive damages—when the law forbids those awards. If not reversed, the trial court's judgment will seriously affect the integrity and public reputation of judicial proceedings.

This submission does not exceed the word-count limit imposed by Rule 24.

Respectfully submitted, this 5th day of August 2020.

/s/ Marc B. Hershovitz
Marc B. Hershovitz
Georgia Bar No. 349510
MARC B. HERSHOVITZ, P.C.
One Alliance Center
4th Floor
3500 Lenox Road
Atlanta, Georgia 30326
404-262-1425
404-262-1474 (fax)
marc@hershovitz.com

Attorney for Appellants Caroline Maki and The Maki Group Real Estate Expert Advisors LLC

Certificate of Service

I certify that on August 5, 2020, I served by U.S. mail a true and correct copy of this document on Jeffrey M. Barnes, Esq., addressed to him at his law firm, Barnes Firm, LLP, at 3280 Peachtree Road, N.E., 7th Floor, Atlanta, Georgia 30305.

/s/ Marc B. Hershovitz
Marc B. Hershovitz
Georgia Bar No. 349510