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

DA VINCI DENTAL STUDIOS, INC.,

Opposer,

v.

CONTESSA DA VINCI s.r.l.,

Applicant.

Opposition No.: 91163702

Application Serial No. 75/796,383

Mark: ALEXANDRA DA VINCI

Published: July 13, 2004

**ANSWER TO OPPOSITION**

Applicant, Contessa da Vinci s.r.l. ("Applicant"), a limited liability company organized and existing under the laws of Italy, by and through its attorneys Hughes Hubbard & Reed LLP, answers the Notice of Opposition ("Opposition") of Opposer Da Vinci Dental Studios, Inc. ("Dental Studios" or "Opposer") as follows:

1. Applicant denies that Opposer is the owner of all right, title, and interest in and to the mark DA VINCI and states that it lacks knowledge or information sufficient to form a belief as to the truth of the assertion that Opposer has used the DA VINCI mark in connection with various goods and services relating to improvement of personal appearance since at least as early as September 1970.

2. Applicant admits that Registration No. 2,061,195 is for the mark DA VINCI DENTAL STUDIOS ("DDS Mark") and that it lists the owner as Daniel Materdomini; Applicant denies that the Patent and Trademark Office has recognized Opposer's rights in the DDS Mark; and Applicant states that it lacks knowledge or information sufficient to form a belief as to the truth of the assertion that Opposer has used the DDS Mark since the mark was first adopted.



3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the assertion that the DDS Mark has been used, advertised and promoted in interstate commerce prior to the filing date of Applicant's mark; Applicant denies that the application for Applicant's mark is based on intent-to-use; Applicant avers that the application is based upon two Italian registrations with filing dates of June 25, 1999 and July 26, 1999; and Applicant denies that Opposer holds priority to the DA VINCI mark in the United States.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Opposition. To the extent an answer is required, Applicant denies the allegations contained in Paragraph 4 of the Opposition.

5. Applicant denies that Opposer has prior rights in the mark DA VINCI; Applicant admits that it filed an application with the United States Patent & Trademark Office to register the mark ALEXANDRA DA VINCI & Design based on intent-to-use and a foreign application and that the goods covered by the application include those goods in International Class 3 listed in Paragraph 5 of the Opposition.

6. Applicant admits the allegations contained in Paragraph 6 of the Opposition.

7. In response to Paragraph 7 of the Opposition, Applicant repeats and realleges its responses to the preceding paragraphs as if set forth fully herein.

8. Paragraph 8 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 8 of the Opposition.

9. Paragraph 9 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 9 of the Opposition.

10. Paragraph 10 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 10 of the Opposition.

11. Paragraph 11 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 11 of the Opposition.

12. Paragraph 12 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 12 of the Opposition.

13. In response to Paragraph 13 of the Opposition, Applicant repeats and reallages its responses to the preceding paragraphs as if set forth fully herein.

14. Paragraph 14 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 14 of the Opposition.

15. Paragraph 15 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 15 of the Opposition.

16. Paragraph 16 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 16 of the Opposition.

17. Paragraph 17 of the Opposition contains legal conclusions to which no response is required. To the extent a response is required Applicant denies the allegations contained in Paragraph 17 of the Opposition.

AS FOR A SEVENTH DEFENSE

There is no likelihood of confusion between Applicant's mark and the DDS Mark because the goods and channels of trade covered by Applicant's mark are distinguishable from those covered by the DDS Mark.

AS FOR A EIGHTH DEFENSE

Opposer's Mark is not famous or distinctive as those terms are defined by § 43(c) of the Lanham Act, 15 U.S.C.A. § 1125(c).

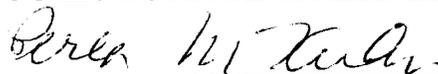
AS FOR A NINTH DEFENSE

Registration of Applicant's mark will not cause dilution of the distinctive quality of Opposer's mark.

WHEREFORE, Applicant respectfully requests that the Board dismiss the Notice of Opposition in its entirety with prejudice and allow Applicant's mark ALEXADRA DA VINCI & Design to subsist on the Principal Register.

Dated: New York, New York  
February 11, 2005

Respectfully submitted,  
HUGHES HUBBARD & REED LLP



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Perla M. Kuhn  
Russell W. Jacobs  
One Battery Park Plaza  
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(212) 837-6000  
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing ANSWER TO  
 OPPOSITION was served, via first-class mail, postage prepaid on Theresa W. Middlebrook,  
 Holland & Knight LLP, 633 West Fifth Street, 21<sup>st</sup> Floor, Los Angeles, CA 90071, this \_\_th day  
 of February, 2005.

Russell W. Jacobs

Russell W. Jacobs

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited  
 with the United States Postal Service as first class mail in  
 an envelope addressed to: Assistant Commissioner for  
 Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

on Feb 11, 2005

HUGHES HUBBARD & REED LLP

Dated: 2/11/05 By: Cecelia Rabena

Name:

Cecelia Rabena



purposes, cosmetic creams, dentifrices, deodorant soap, deodorants for personal use, essential oils for personal use, eyebrow pencils, hair spray, hair lotions, hair colorants, sachets for perfuming linen, lipsticks, lotions for cosmetic purposes, oils for toilet purposes, rouge, scented water, shampoos, shaving soaps, toilet soap, sun tanning preparations, talcum powder, tissues impregnated with cosmetic lotions, nail varnish, nail polish, varnish removing preparations.

Dental Studios asserts that Applicant's Mark is likely to cause confusion with and likely to dilute the mark DA VINCI for "various goods and services relating to improvement of personal appearance." (Notice of Opposition, paras. 1, 12, and 16.)

### **Argument**

In a motion to dismiss an opposition, the Board will assume that the facts alleged in the notice of opposition are true. Young v. AGB Corp., 152 F.3d 1377, 1379 (Fed. Cir. 1998). The party opposing registration must allege facts in the petition which, if proven to be true, would show "(1) that he has standing and (2) a statutory ground which negates the applicant's entitlement to registration." Young, 152 F.3d at 1380. The facts contained in the Opposition do not establish that Dental Studios has standing.

Section 13 of the Lanham Act, which sets forth the basic requirements for standing in opposition proceedings, provides as follows:

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor . . .

15 U.S.C.A. §1063 (2005). Judges have interpreted the § 13 standing requirement to mean that the opposer must show that it has (1) a real interest in the proceedings and (2) a reasonable basis to believe that he will be damaged. Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999).

Dental Studios does not have the "real interest" or "reasonable basis" required to maintain the opposition. One basis for establishing a standing is ownership of a mark which is

similar to the applicant's mark for similar goods. Fed. Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1101, 192 U.S.P.Q. 24 (Fed. Cir. 1976). In the present case, Opposer is not the owner of the mark DA VINCI DENTAL STUDIOS. Opposer asserts in paragraph 2 of the Notice of Opposition that Daniel Materdomini ("Materdomini"), and not Dental Studios, is the owner of Registration No. 2,061,195 for the mark DA VINCI DENTAL STUDIOS. A copy of the registration information, which lists Daniel Materdomini as the owner, is attached hereto as Exhibit A.

The Board has held that a party opposing registration of a mark does not have standing where the opposer asserts that the applied-for mark is similar to a registered mark, but the opposer is not the owner of the registered mark. E.D. Bullard Co. v. Gentex Corp., 168 U.S.P.Q. 602, 603-04 (T.T.A.B. 1970). In Bullard, E.D. Bullard Co. ("Bullard") opposed registration of the mark TURTLE based upon likelihood of confusion with the mark THE TURTLE CLUB. Id., 168 U.S.P.Q. at 602-03. However, the mark THE TURTLE CLUB was registered not to Bullard, but rather to The Turtle Club. Id., 168 U.S.P.Q. at 603-04. Although Bullard's President handled the daily administration of the club, neither Bullard nor its President were members of The Turtle Club. Id., 168 U.S.P.Q. at 603. The Board noted that the facts that Bullard's President ran the club and was perceived as the international sponsor thereof were "totally inadequate to establish that opposer, E.D. Bullard Company, will in any way be damaged by registration of the mark "TURTLE" for applicant's goods." Id.

In the present case, Dental Studios acknowledges that it does not own Reg. No. 2,061,195 for the DDS Mark. (See Notice of Opposition, para. 2.) Dental Studios continues, in the same paragraph, to argue incongruously that it owns rights in the mark DA VINCI based upon the third-party registration for the DDS Mark. It is clear that Dental Studios does not own the DDS

Mark, which raises the presumption that it does not have rights in the mark DA VINCI, despite its conclusory allegations to the contrary. Dental Studios has not rebutted this presumption by alleging facts to establish rights in the mark DA VINCI. Rather, it has alleged that a third-party, Materdomini, owns the registration for the DDS Mark and has failed to set forth the relationship, if any, between Dental Studios and Daniel Materdomini.

Additionally, Dental Studios has not alleged any other basis showing that it has a "real interest" in the proceeding or a "reasonable belief" that it will be damaged. Accordingly, Opposer has not adequately pleaded facts to establish that it has standing to oppose registration of Applicant's Mark and the Opposition should be dismissed.

WHEREFORE, Applicant respectfully requests that the Board dismiss the Notice of Opposition in its entirety with prejudice and allow Applicant's Mark to mature to registration.

Dated: New York, New York  
February 11, 2005

Respectfully submitted,  
HUGHES HUBBARD & REED LLP

*Perla M. Kuhn*

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

on Feb. 11, 2005

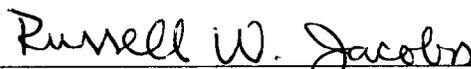
HUGHES HUBBARD & REED LLP

Dated: 2/11/05 By Perla M. Kuhn

Name: PERLA M. KUHN

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S MOTION TO DISMISS OPPOSITION was served, via first-class mail, postage prepaid on Theresa W. Middlebrook, Holland & Knight LLP, 633 West Fifth Street, 21<sup>st</sup> Floor, Los Angeles, CA 90071, this \_\_\_th day of February, 2005.



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Russell W. Jacobs

REC'D

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2005-02-10 15:22:28 ET**

**Serial Number:** 75107384 Assignment Information

**Registration Number:** 2061195 Assignment Information

**Mark (words only):** DA VINCI DENTAL STUDIOS

**Standard Character claim:** No

**Current Status:** Section 8 and 15 affidavits have been accepted and acknowledged.

**Date of Status:** 2005-02-02

**Filing Date:** 1996-05-21

**Transformed into a National Application:** No

**Registration Date:** 1997-05-13

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 109

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 834 -Post Registration

**Date In Location:** 2005-02-02

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. DANIEL MATERDOMINI

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United States

**Legal Entity Type:** Individual

**Country of Citizenship:** United States

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**GOODS AND/OR SERVICES**

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**International Class:** 042

dental laboratory services

**First Use Date:** 1970-09-00

**First Use in Commerce Date:** 1970-09-00

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

**Disclaimer:** "DENTAL STUDIOS"

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**MADRID PROTOCOL INFORMATION**

(NOT AVAILABLE)

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**PROSECUTION HISTORY**

2005-02-02 - Section 8 (6-year) accepted & Section 15 acknowledged

2005-01-11 - FAX RECEIVED

2004-12-17 - Attorney Revoked And/Or Appointed

2004-12-17 - TEAS Revoke/Appoint Attorney Received

2004-11-08 - Response received to Post Registration action - Sections 8 & 15

2004-11-08 - PAPER RECEIVED

2004-07-20 - Post Registration action mailed Section 8 & 15

2004-07-19 - REINSTATED

2003-05-29 - Section 8 (6-year) and Section 15 Filed

2004-02-14 - Canceled Section 8 (6-year)

1997-05-13 - Registered - Principal Register

1997-02-18 - Published for opposition

1997-01-17 - Notice of publication

1996-12-06 - Approved for Pub - Principal Register (Initial exam)

1996-12-05 - Examiner's amendment mailed

1996-12-02 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

**Correspondent**

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