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

Proceeding	91189629
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BORGHESE TRADEMARKS, INC.
Opposer,

v.

MULTI MEDIA EXPOSURE, INC.
Applicant.

Opposition No. 91189629

Mark: PRINCE LORENZO BORGHESE'S LA DOLCE VITA

Serial No. 77/435,171

REPLY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT & OPPOSER'S MOTION TO STRIKE EXHIBITS C&D OF 2nd APICELLA DECLARATION

Opposer, Borghese Trademarks, Inc. ("Opposer"), respectfully moves the Board for leave to file a reply brief in support of its motion for summary judgment pursuant to Fed. R. Civ. P. 56.

Applicant's Material Mistatements of Fact

In this reply, Opposer feels it must first address issues in the "Preliminary Statement" and "Counter Statement of Undisputed Material Facts" portions of Applicant's response to set the record straight regarding the egregious statements made by Applicant in those portions. Opposer will address these flagrantly misleading statements in the order in which they were presented.

Preliminary Statement *First:* Applicant claims it created a private label for PetSmart called LA DOLCE VITA with the PRINCE LORENZO BORGHESE element set apart from the "focal, La Dolce Vita portion." This claim is irrelevant, as 1) manner of use on labels is not relevant; and 2) if it is being used in the manner claimed by Applicant, then the mark is not being used in the manner in which it was filed. Further, in Fn 1 to Applicant's Response to Opposer's Cross Motion for Summary Judgment, Applicant advises that it will collectively refer throughout its brief to LA DOLCE VITA BY PRINCE LORENZO BORGHESE and PRINCE LORENZO BORGHESE'S LA DOLCE VITA in shortened form LA DOLCE VITA. Only the mark sought to be registered is in issue. Opposer objects to Applicant's referring to the marks as LA DOLCE VITA as a ploy to take away attention from the BORGHESE

portion of the mark and objects to use of the shortened form to interject a mark not in issue throughout the brief.

Preliminary Statement *Second*: Applicant claims that the "evidence of record" establishes "beyond dispute" that Lorenzo Borghese is well known. Opposer wishes to point out that the only evidence of record for purposes of the summary judgment motion are a few self-serving internet articles attached to Applicant's vice president's declaration.

Preliminary Statement *Third*: Applicant claims—falsely—that Opposer stated in its discovery responses that it has no intention of offering goods or services for pets. What Opposer actually said was simply that "it has not commenced planning for sale of its goods to pets."

Preliminary Statement *Fourth*: There are no limitations in the Application as to exclusive channels of trade. Applicant's channels of trade use or intended use is, therefore, irrelevant.

Preliminary Statement *Finally*: Regarding the "many other brands" claimed by Applicant 1) there are only two trademark registrations owned by the same entity for unrelated goods; and 2) the Internet references to "Borghese" are for unrelated goods without any evidence as to ownership or source. Furthermore, Applicant claims Opposer has "conjured up a false motive" but does not identify what that false motive is. Blatantly disparaging remarks such as that have no place before the Board.

Counter Statement #1: Opposer never claimed that pet products are included under the wide range of personal care products currently sold by Opposer. Opposer has, however, clearly stated that pet shampoos and conditioners and body sprays are substantially similar goods that the consuming public would likely misunderstand as coming from Opposer. (Not. of Opp. ¶11, 13, 14 and Opp. Resp. & Cross Mot.p.12, 13)

Counter Statement #2: Use by Applicant of a different version of the mark in issue is irrelevant. If Applicant is not using the mark as filed, the same constitutes independent grounds for denying its application as Applicant will never be able to prove use vis-a-vis this material alteration of the mark. Finally, there are no limitations as to exclusive channels of trade for the mark in issue. Accordingly, Applicant's counter statement is irrelevant.

Counter Statement #3: Once again, Applicant falsely claims that Opposer stated it "does not intend to" sell pet products. Opposer never made any such statement. (2nd Apicella Decl.,Ex.A,Resp. Nos. 4, 5,11). In addition, whether Opposer intends to sell pet products in the future or not, does not have any bearing on the fact that the marks are confusingly similar and the public is conditioned to expect, based on, inter alia, the numerous companies already offering both pet and human products, that Opposer is doing the same.

Counter Statement #4: Applicant's vice president admitted that leading beauty, hair, body and clothing companies in the United States offer both pet and human products under the same marks. (Opp.Resp.&Cross Mot.,Ex.A, Borghese Dep. pgs.103-105, 108-110, 112, 115, 116, 118) .These are not fly-by-night or mom and pop operations. These are major, well-recognized companies. If that does not make the practice appear common to consumers, Opposer is at a loss to say what does. In addition, Applicant once again misleadingly claims that Opposer has no intention of offering pet products.

Counter Statement #5: Opposer reiterates its argument that whether Opposer currently sells pet products or not is not the issue. The issue is whether customers will believe they are doing so or that the products are somehow licensed by, approved by, or otherwise associated with Opposer. And, Applicant's argument that font and styling of the parties' respective products are different is irrelevant as both marks are word marks without limitation as to how they may be used.

Counter Statement #6: Here, Applicant is trying to put the cat back in the bag. Having admitted that companies and stores sell both pet and human products (Opp.Resp.&Cross Mot.,Ex.A, Borghese Dep. pgs.103-105, 108-110, 112, 115, 116, 118), Applicant attempts to backpeddle and offer specific searches that yield the differing results Applicant wants. The fact of the matter is, whether a customer wanders down the shampoo aisle in a drug store and then heads over to the pet section, or clicks on the haircare tab on a website and then clicks on the pet tab of the same website, that customer is going to believe that substantially similar and related products offered by PRINCESS MARCELLA BORGHESE and PRINCE LORENZO BORGHESE come from the same source.

Counter Statement #7: That poor cat is getting stuffed in the bag again. Applicant's vice president did not "attest to the accuracy of...a naked comparison of his full mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA to the mark LA DOLCE VITA alone." (Opp.Resp.&Cross Mot.,Ex.D, Friedman Decl., ¶4 and Ex. 3 thereto). He attested to the conclusion that "PRINCE LORENZO BORGHESE'S" was the dominant portion of Applicant's mark. Applicant's admission that the mark is actually "La Dolce Vita by Prince Lorenzo Borghese & Design" is 1) new information to Opposer; 2) shows that Applicant materially changed their mark; and 3) does not match with their sworn discovery responses.

Counter Statement #8: If Applicant wanted to keep such a clear distinction between its products and those for humans, its vice president should not have made representations in promoting and marketing its products that its pet shampoo may be used by, and is used by, humans. (Opp.Resp.&Cross Mot.,Ex.E, Rannells Decl., ¶4) That only blurs the line between the products and confuses the customer.

Counter Statement #9: Opposer has not made any factual misrepresentations about Lorenzo Borghese's Royal Treatment or Italian Pet Spa products. Applicant's website, www.multimediaexposure.com is material and relevant to this proceeding as it describes and promotes the association of Prince Lorenzo Borghese with Princess Marcella Borghese, the founder of Opposer's beauty care line and the person for whom the mark PRINCESS MARCELLA BORGHESE was named. Furthermore, Applicant's website is the very site where consumers would go to learn more about the company that owns the mark at issue and where they would be confused by the connection and association with Princess Marcella Borghese. And finally, at issue are not Applicant's First Amendment rights but rather Applicant's deliberate association with Opposer in an attempt to trade off the good will and good reputation which Opposer has spent over fifty years building.

Counter Statement #10: Applicant again claims "factual misrepresentation" of its products but fails to identify or explain what factual misrepresentations were allegedly made.

Counter Statement #11: Applicant must think if they say it enough, i.e. "Opposer does not intend to use its marks on pet products," that the Board may begin to believe that Opposer actually made this

statement. Opposer did not. As for Applicant's contention that third party marks are immaterial, Opposer would agree that third party marks for unrelated goods or services are immaterial to this proceeding. Applicant fails to distinguish, however, case law which provides that third party marks for related goods and services are relevant.

Counter Statement #12: The number of persons with the name "Borghese" in the United States is quite relevant to these proceedings. As a surname, it is extremely rare (Opp.Resp.&Cross Mot.,Ex.E, Rannells Decl., ¶'s6,7,8,9) and, therefore, more likely to be recognized as a trademark and more likely to be recognized as and associated with the well-known Princess Marcella Borghese. Whether or not Prince Lorenzo Borghese has achieved name recognition, he intentionally associates himself with Opposer's founder.

Counter Statement #13: As evidenced by all the third party companies and their products for both humans and pets (Opp.Resp.&Cross Mot.,Ex.D, Friedman Decl., ¶4 and Ex. 4-12 thereto), Applicant is not "using [the mark] commercially in a distinct and different field from Opposer."

Counter Statements #14 & #15: Both websites are relevant to this proceeding as Applicant's vice president deliberately associates himself on both with Opposer's founder, Princess Marcella Borghese. (Opp.Resp. &Cross Mot.,Ex.D, Friedman Decl., ¶4 and Ex. 1-2 thereto) thus reinforcing and conditioning consumers to make the association. Again, Applicant's First Amendment rights are not at issue, but rather Applicant's deliberate association with Opposer in an attempt to trade off Opposer's good will and good reputation.

Counter Statement #16: PetSmart does not make mention of Princess Marcella Borghese because 1) No evidence can be found that any of Applicant's products are sold at PetSmart stores or on their website; 2) the mark in issue is PRINCE LORENZO BORGHESE'S LA DOLCE VITA.

Counter Statement #17: Applicant's claim of sales since November 2008 is unsubstantiated by any competent evidence and the mark is not LA DOLCE VITA.

Counter Statement #18: There are only two registered third party marks cited by Applicant, both owned by the same entity for unrelated goods (i.e. wine), and all the alleged common law examples of third party "use" are for unrelated goods or services and there is no evidence concerning ownership.

Counter Statement #19: The third party examples cited by Applicant are for very "distinct" goods and services (i.e. tennis equipment and speakers) and are, therefore, irrelevant.

I. The relevant duPont factors all favor Opposer.

A. Opposer's Marks and Applicant's Mark are similar.

Applicant claims its product label is visually and contextually different from Opposer's. (Appl. Resp. pg. 9, 10) Current use of a mark on labels is irrelevant and Applicant cites no case law to the contrary. Applicant's entire argument is based on a comparison of labels, not a comparison of the marks in issue. The marks at issue are word marks and may not be compared based on label presentation.

Applicant claims that on its labels the words 'Prince Lorenzo Borghese' are plainly not dominant." (Appl. Resp. pg. 9). Applicant's use on its labels is irrelevant and does not present the mark in issue in this proceeding. Further, and as discussed in Opposer's main brief, in a response to Suspension Inquiry, to which Lorenzo Borghese's sworn declaration was attached Applicant stated "... the dominant part of the mark is "Prince Lorenzo Borghese;" and "The first word (or in this case three words) is often the predominant visual cue to the consumer;" and "Thus the 'Prince Lorenzo Borghese' portion of the mark is even more predominant and eliminates any likelihood of confusion" [i.e. with the cited mark "La Dolce Vita"]; and "Finally, the term 'La Dolce Vita' alone is apparently not the predominant portion of the entire trademark, when considered as a whole." (Opp.Resp.&Cross Mot.,Ex.D, Friedman Decl., ¶4 and Ex. 3 thereto).

Finally, Opposer notes that contrary to the cases cited by Applicant, in the eyes of the average consumer, the titles of nobility used in conjunction with the Borghese name, namely PRINCE and PRINCESS, do go together and confusingly indicate products coming from the same source. (Opp. Resp.&Cross Mot.,Ex.D, Friedman Decl., ¶6 and Ex. 14 thereto).

B. Opposer's Goods and Applicant's Goods are Similar and Related.

Applicant claims that because Opposer has not commenced offering shampoo, conditioner and body spray goods for pets, consumers will not be confused as to the source of its shampoo, conditioner and body spray products. The fact is that if these similar products are coming from "Princess Marcella Borghese" and "Prince Lorenzo Borghese," consumers are going to believe they emanate from the same source. Applicant also claims that Opposer made "material concessions" regarding the parties' products catering to different customers, but fails to identify what those alleged material concessions are. (Appl. Resp. p. 13).

Applicant claims judicial notice "can be taken of the fact that humans and animals have different and specific needs" and that its goods were formulated based on "extensive research." (Appl.Resp. p.14). Such claims are clearly not the type of statements the Board may take judicial notice of. At issue is the fact that, because consumers and their pets both use shampoo, conditioner and body sprays, consumers are going to naturally associate shampoos, conditioners and body sprays manufactured by PRINCESS MARCELLA BORGHESE with shampoos, conditioners and body sprays manufactured by PRINCE LORENZO BORGHESE.

Further, Opposer did not argue "that its customers would buy LA DOLCE VITA pet products as a substitute for BORGHESE personal care items" (Appl.Resp. p.14) as Applicant claims. How products are used once they are purchased is not at issue. The fact is that, because Applicant's and Opposer's goods are substantially similar and related, consumers will believe they emanate from the same source.

Applicant claims that only two of the cosmetic companies cited by Opposer also sell pet products. The fact is Opposer has submitted uncontroverted evidence that at least four cosmetic/personal care product companies sell pet products. (Opp. Resp.&Cross Mot.,Ex.D, Friedman Decl., ¶4 and Ex. 4-7 thereto).

In attempting to show that its shampoo, conditioner and body spray products are different from Opposer's shampoo, conditioner and body spray products, Applicant claims that other goods and services of third parties such as wine, handbags, hotels and law firms exist under the name "Borghese" without

any consumer confusion. (Appl.Resp. p.15 and 2d Apicella Decl. Ex. C&D). To the extent that Applicant is attempting to submit the documents identified as Exhibits C & D to the 2d Apicella Declaration, Opposer, pursuant to 37 CFR 2.122, Fed.R.Civ.P. 56 and TBMP 528.05(b) and (e), hereby moves to strike Exhibits C and D attached to the 2d Apicella Declaration submitted in support of Applicant's Opposition to Opposer's Cross Motion for Summary Judgment. Exhibits C and D are not admissible evidence and should be excluded from consideration as they are hearsay being submitted for the truth of the matters contained therein, are not based on personal knowledge and have not been properly authenticated. *See, Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369-1370 (TTAB 1998).

C. **Channels of trade for Opposer's Goods and Applicant's Goods are the same.**

Applicant claims that its products are only available at PetSmart retail stores and, in the future, will be available on PetSmart's website. (Appl.Resp. p.15). The fact is that there is no limitation in Applicant's application as to exclusive channels of trade. By law it is well settled that there is a presumption that the goods in a registration encompass all goods of the type described, and that they move in all normal channels of trade for such goods. *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) Applicant could tomorrow begin to sell its products in department stores, drug stores, pharmacies and over the Internet—all the same places where Opposer sells its goods and all places that sell both pet and human products. Indeed, Applicant has indicated it will sell its goods on PetSmart's website in the future. (3d Borghese Decl. ¶5).

Applicant's argument that customers searching for a product that includes the name Borghese in its trademark would "either use the brand name of the product such as LA DOLCE VITA or quickly discern the presence of such a brand name" (Appl.Resp. p.17) is unsupported by any examples of how customers might search for a product. The channels of trade are not limited for Opposer's Marks or Applicant's Mark and customers encountering either on substantially identical and related products would think they both emanate from the same source.

D. Applicant's contentions with regard to the remaining DuPont factors are spurious arguments.

Applicant claims as to buying conditions that customers take care when selecting products for pets or when selecting beauty and bath products are without merit. (Appl.Resp. p.18) The fact is shampoo, conditioner and body spray are considered impulse buys and do not fall under the category of expensive goods to which careful consideration is given.

Applicant obviously considers the name PRINCESS MARCELLA BORGHESE to be well known, otherwise it would not deliberately associate itself with the name.

With regard to Applicant's argument concerning similar marks, as explained earlier, there are only two registered third party marks cited by Applicant, both owned by the same entity for unrelated goods, and the alleged examples of third party "use" are for unrelated goods or services and there is no evidence concerning ownership. Opposer has moved to strike this evidence on the basis that it is not based on personal knowledge, has not been authenticated and is hearsay submitted for the truth of the matters contained therein.

Applicant also claims that Opposer cannot advance any evidence of actual confusion and the absence of same creates an inference of no likelihood of confusion. (Appl.Resp. p. 19). However, there is no competent evidence of any use of the mark in issue. In fact, Applicant states in Fn 1 it has used another mark since 2008, not the mark in issue and "products will also be sold by PetSmart under...the applied-for PRINCE LORENZO BORGHESE'S LA DOLCE VITA mark..." In fact, visits to PetSmart stores found no evidence of the product being sold under the mark in issue. There can be no actual confusion if both parties' products have not coexisted in the marketplace.

Applicant's claim that Opposer's Marks are not part of a "family of marks" (Appl.Resp. p.19) is irrelevant because Opposer has not made this contention.

Applicant claims that its vice president has "established personal renown as an expert" in the pet care industry and, therefore, can exclude others from using its brand (Appl.Resp. p.19) is untrue. A few self-serving articles from the Internet and Applicant's own website are hardly valid proof that Applicant's vice president is a pet care expert. Lorenzo Borghese admitted in deposition testimony that he does not have

any special training with regard to animals, does not have a veterinary degree, and has an MBA in an unrelated field. (Opp.Resp.&Cross Mot.,Ex.A, Borghese Dep. Pg. 11-12). Furthermore, being an expert in an industry has no bearing on whether one is able to protect one's brand.

Applicant's argument that any confusion between the parties' marks would only be *de minimus* is without merit as the goods under Opposer's Marks have been well known for over fifty years.

II. Applicant's intentional association with Opposer's founder will lead to confusion on the part of consumers.

The First Amendment rights of Applicant's vice president are not at issue in this proceeding. By his own admission, Applicant's Vice President, Lorenzo Borghese, has been using the name of Opposer's cosmetics line founder, Princess Marcella Borghese, on his pet care products website (Opp. Resp.&Cross Mot., Ex. A, Borghese dep., pg. 86-87 and Ex.D,Friedman Decl., ¶4 and Ex. 2 thereto), in association with company management on Applicant's website, and in the context of advertising for his own pet care products. In so doing, Applicant has purposely created an association in the minds of consumers between Applicant's products and Opposer.

CONCLUSION

Based on the foregoing, Opposer respectfully requests that its Cross Motion for Summary Judgment be granted, that its Motion to Strike on pg. 8 be granted, and U.S. Appl. Serial No. 77/435,171 for the mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA not be allowed to register.

Dated: March 26, 2010

BAKER AND RANNELLS, PA

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer's Reply in Support of Its Cross Motion for Summary Judgment and Opposer's Motion to Strike in re Opposition No. 91189629 was forwarded by First Class postage pre-paid mail by depositing the same with the U.S. Postal Service on this 26th day of March, 2010 to the attorneys for the Applicant at the following address:

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