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

Proceeding	91189629
Party	Defendant Multi Media Exposure, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BORGHESE TRADEMARKS, INC.	:	Opposition Proceeding No. 91189629
Plaintiff-Opposer,	:	Mark: PRINCE LORENZO BORGHESE'S LA DOLCE VITA
-- against --	:	
MULTI MEDIA EXPOSURE, INC..	:	Serial No. 77435171
Defendant-Applicant.	:	

APPLICANT'S OPPOSITION TO
MOTION TO STRIKE CERTAIN DEFENSES

Defendant-Applicant Multi Media Exposure, Inc. ("Applicant") submits the following in opposition to the motion of Plaintiff-Opposer Borghese Trademarks, Inc. ("Opposer") to strike paragraphs 20, 30, 31 and 39 of Applicant's Answer to the Notice of Opposition. Applicant concedes to striking paragraph 39 (but not the remainder of the Ninth Affirmative Defense of which that paragraph is a part.)

A. The Opposition Should Not Be Suspended Pending This Motion

As an initial matter, Opposer has requested that the Board suspend this matter pending disposition of this motion. However, Opposer's motion is ***not*** one for summary judgment or otherwise dispositive. Rather, the motion is to strike four out of twenty-four paragraphs contained in nine affirmative defenses. Indeed, striking paragraphs 20 and 39 would not even strike the First and Eighth Affirmative Defenses, in which those paragraphs are respectively included. Thus, as an initial matter, even if Opposer's motion

were granted, the remaining seven defenses would prevent the granting of summary judgment.

Secondly, Opposer requests that "to the extent the motion requires the Board to look beyond the pleadings, the motion may be considered a motion for partial summary judgment ..." However, the motion itself addresses only the pleadings (specifically, the four affirmative allegations at issue), and it would be inequitable for the Board to treat anything "beyond the pleadings" as dispositive when discovery has scarcely commenced, let alone been completed.

Further, Applicant has requested in its written discovery demands that, among other things, Opposer demonstrate whether it has marketed its cosmetics products to pet owners, or has documented any instances of Opposer's products being used on pets. Applicant suspects that such discovery demands are not burdensome in the least because Opposer cannot adequately document any evidence thereof. Further, these directly relate to two issues Opposer seeks to avoid by the present motion: that the goods at issue are sold to different consumers and in different trade channels.

As a result of the foregoing, Applicant respectfully requests that the Board decline to suspend proceedings pending this motion.

B. The Application of the *DuPont* Factors Permit, If Not Require, the Challenged Allegations

To determine likelihood of confusion, the Board and the Federal Circuit Court of Appeals apply the factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (CCPA 1973).[1] See also TMEP § 1207.01 (listing "most important" factors

[1] The DuPont factors that are relevant to this motion include "(2) similarity or dissimilarity and nature of goods or services as described in application or registration or in connection with which prior mark is in use; (3) similarity or dissimilarity of established, likely-to-continue trade channels; .... [and] (9) variety of

from Dupont). Opposer's motion to strike seeks to eliminate, even before discovery, allegations that would help the Board determine, pursuant to the DuPont factors, that the marks at issue are not confusingly similar. As such, the Board should deny the motion. Moreover, the Board should not strike the allegations as Opposer requests because

> Contrary to [Opposer's] contention, the statements set forth by applicant in the paragraphs in question concerning the nature of the respective marks of the parties constitute an affirmative defense which amplifies the denial of likelihood of confusion previously set forth by applicant in its answer. Applicant's allegations, in fact, serve to apprise opposer with greater particularity of the position which applicant is taking in the defense of its right of registration.

Textron v. The Gillette Company, 180 U.S.P.Q. 152, 1973 WL 19689 (TTAB 1973) (cited by Opposer at 2).

1. Paragraph 20 of the Affirmative Defenses Should Not Be Stricken, As it Further Demonstrates that Applicant's Mark Is Relatively "Weak"

Paragraph 20 of the First Affirmative Defense reads as follows:[2]

> 20. Opposer has not opposed registration of third party marks incorporating the family name "Borghese."

This paragraph is one of six allegations indicating that the owner of BORGHESE is not entitled to prevent the registration of Applicant's PRINCE LORENZO BORGHESE'S LA DOLCE VITA because the Opposer's mark is not sufficiently "strong" outside of the goods and services set forth in its registration. Indeed, as Opposer admits, Opposer did not oppose registration of a third party registration that included BORGHESE in connection with food and wine. See Motion at 2, last paragraph; see also CASTELLO DI

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goods on which mark is or is not used, including whether mark is house mark, "family" mark, or product mark; .... DuPont, 476 F. 2d at 1361..

[2] Opposer misquotes Paragraph 20 by adding the words, "As and for a First Affirmative Defense...", which falsely suggests that such paragraph is the only paragraph that supports the First Affirmative Defense.

BORGHESE (Registration Nos. 2660004 and 2505346, Serial No. 76692481). Thus, Opposer has confirmed the accuracy of Paragraph 20: Opposer did not oppose at least one third party registration.

Further, by failing to oppose such third party registration, Opposer's conduct indicates that Opposer is not entitled to prevent registration of marks for goods that are extraneous to those which Opposer sells, to wit, cosmetics. This is highly relevant: Just as "food and wine" were and are substantively different from Opposer's goods and services, Applicant argue in their Answer that Applicant's "pet shampoos and conditioners" are substantively different as well, thus eliminating any likelihood of confusion.

Also, proof of the relative strength or weakness of Opposer's mark, and that it is not part of a "family" of marks, is relevant to a determination that the marks are not confusingly similarity under the DuPont factors. See, e.g., Packard Press, Inc. v. Hewlett-Packard, Inc., 227 F.3d 1352, 1356 (Fed. Cir. 2000), citing In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (CCPA 1973) (9th factor is variety of goods on which mark is or is not used). Thus, paragraph 20 should not be stricken, as it helps to demonstrate the narrow scope of use of Opposer's mark.

2. Paragraphs 30 and 31 of the Affirmative Defenses Should Not Be Stricken, Because the Different Goods Are Clearly Sold to Different Consumers Through Different Trade Channels

In Paragraph 30, Applicant alleges that its mark and Opposer's mark "are not confusingly similar because they are marketed to different consumers." In Paragraph 31, Applicant alleges that "The Opposer's Marks and the PRINCE LORENZO Mark are not

confusingly similar because, upon information and belief, they are sold through different channels of trade."

Opposer bases its motion to strike these paragraphs by alleging that "the marks in its [Opposer's] registration are not limited to any particular end user." However, Opposer's allegation is patently untrue. Opposer's goods are for cosmetics, and as such are limited to end users who wear cosmetics. Applicant's goods are for pets, specifically, pet shampoos and conditioners, and as such are limited to end users who care for pets. Thus, the cases cited by Opposer (none of which were decided within the last two decades), for the proposition that "the identification of goods set forth in the relevant application and/or registrations must be considered" actually support Applicant's argument.

That is, by the very terms of the registrations and the application at issue herein, the goods and services at issue herein are marketed to different consumers, specifically, those who use cosmetics and those who care for pets. See M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1384 (Fed. Cir. 2006) ("The unrelated nature of the parties' goods and their different purchasers and channels of trade are factors that weigh heavily against [registrant] M2 Software"); Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713, 719 (Fed. Cir. 1992) (parties' respective purchasers and potential purchasers are substantially different, and applicant's computer terminals and opposer's data processing services are different; "under a proper analysis of the *DuPont* factors, likelihood of confusion for relevant persons has not been established, even among retail customers.")

Where two products are sold "to different classes of purchasers through different

channels of trade," there is minimal likelihood of confusion. See In re The W.W. Henry Company, L.P., 82 U.S.P.Q.2d 1213, 2007 WL 186661 (T.T.A.B. 2007) (PATCH 'N GO for chemical filler to repair polyolefin sold to plastic manufacturers, not confusingly similar to applicant's PATCH & GO for cement patch for drywall, concrete and the like, sold to do-it-yourselfers and contractors in hardware stores); Central Mfg. Co. v. Casablanca Indus. Inc., 87 Fed. Appx. 156, 159-60, 2003 WL 22977469 (Fed. Cir. 2004) ("no likelihood of confusion between the petitioners' use of the mark on products other than fans, such as bicycles and boats, and Hunter's use of the mark in connection with ceiling fans, because the products were dissimilar and were sold in different channels of trade."). See also Checkpoint Systems, Inc. and Checkpoint Software Technologies, Inc., 269 F.3d 270, 289 (3rd Cir. 2001) (no likelihood of confusion where "products are advertised in different magazines and are promoted in entirely different trade shows" and sold to different consumers).

In the case at hand, the description of goods, alone, targets a particular consumer: those who care for pets. However, if the Board deemed it necessary, Applicant would amend its application to "pet shampoos and conditioners ***sold through retail pet stores, web-sites for pets and pet goods, and direct television featuring pets***." See In re Shoe Works, Inc., 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (no likely confusion was found between PALM BAY for women's shoes and the cited PALM BAY for shorts and pants where applicant amended the description of goods to "women's shoes sold solely through applicant's retail shoe store outlets").

In Applicant's view, such amendment would be superfluous, because the consumer and channels of Applicant's pet goods seem obvious. Cf. Guardian Products

Company, Inc. v. Scott Paper Company, 200 U.S.P.Q. 738, 741, 1978 WL 21568 (TTAB 1978) (cited by Opposer at 5; absent a limitation in the registration, there is a presumption that goods travel in all channels of trade "suitable for ***goods of that type***"; emphasis added). Without any restriction as to classes of purchasers or trade channels, the Board presumes that the goods recited in a registration "are or can be sold through all of the trade channels that can be utilized ***for such goods***." Warnaco Inc. v. Adventure Knits, Inc., 210 U.S.P.Q. 307, 315, 1981 WL 40431 (TTAB 1981) (cited by Opposer at 5; emphasis added).

Opposer baldly asserts that "both parties' goods are in part legally identical and otherwise related and/or complementary." (Motion at 5). Opposer gives no factual or legal basis for such statement. It is simply not credible that shampoos and conditioners for pets and cosmetics for people are interchangeable. Compare Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 U.S.P.Q.2d 1445, 1450, 1986 WL 83319 (TTAB 1986) (cited by Opposer at 4) (because "vitamins" encompasses "vitamin tablets", the goods are "legally identical"). In contrast with the Miles Laboratories case, Opposer's cosmetics and related products do not encompass pet shampoos and conditioners. Indeed, one might assume (and Applicant shall demonstrate, if necessary) that products designed for people are harmful when used on dogs (the primary pet on whom shampoo and conditioners are used), or for other unintended purposes.

Perhaps Opposer asserts that the end users of Opposer's cosmetics products could, theoretically, include consumers who use expensive cosmetics on their pets, merely because Opposer's registration does not limit itself to "consumers of cosmetics for use on human beings". Any such theory should be dismissed out of hand. It seems highly

unlikely – and indeed, would be damaging to Opposer's reputation among consumers of cosmetics – that Opposer would even attempt to sell its goods in pet stores.

Where "there is not more than a theoretical possibility that [Applicant's] goods would be purchased by general consumers at retail, we conclude that [the Board's] ruling [of no likelihood of confusion] is proper." PC Club v. Primex Technologies, Inc., 32 Fed.Appx. 576, 2002 WL 450076 (Fed. Cir. 2002). Electronic Design & Sales, 954 F.2d at 717, citing Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc., 57 C.C.P.A. 804, 807, 418 F.2d 1403, 1405 (CCPA 1969) ("[w]e are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal"). See In re Massey-Ferguson Inc., 222 USPQ 367, 368 (TTAB 1983) ("differences between the goods of the registrant and the services of the applicant are simply too great, even though the marks are almost identical, for confusion to be more than a remote possibility.").

Thus, Opposer apparently suggests that its "unlimited" registration means that its cosmetic products ***might*** be purchased by pet owner consumers for use on their pets. Assuming for the sake of argument, only, that the marks at issue here were not substantially different for a variety of other reasons (as set forth in the other affirmative defenses), such a suggestion is "merely theoretical" and does not justify striking Applicant's allegations.

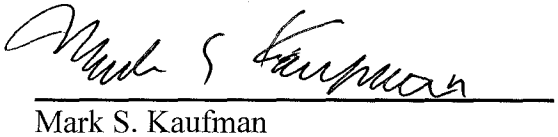
Thus, striking the Fourth and Fifth Affirmative Defenses would be improper and, if paragraphs 30 and 31 were stricken before Opposer even responds to Applicant's discovery requests, would also be patently inequitable.

3. **Paragraph 39 of the Affirmative Defenses May Be Stricken**

Paragraph 39 of the Affirmative defenses reads as follows: "Mr. Borghese is a direct descendant of a noble Italian family and is literally entitled to be called 'Prince'." This allegation helps to indicate that Applicant adopted PRINCE LORENZO BORGHESE'S LA DOLCE VITA in good faith. See M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1385 (Fed. Cir. 2006) ("While a finding of bad intent would alter the likelihood of confusion analysis in M2 Software's favor, substantial evidence supports the board's conclusion that [the applicant's] intent is not a factor favoring [the opposer]."). Nevertheless, to avoid burdening the Board with extraneous evidence regarding the lines of descent in the Borghese family, and without waiving other allegations supporting its ninth affirmative defense, Applicant would concede to strike Paragraph 39.

WHEREFORE, Defendant-Applicant Multi Media Exposure, Inc. respectfully requests that the motion of Plaintiff-Opposer Borghese Trademarks, Inc., be dismissed in their entirety, except that Applicant concedes to strike Paragraph 39 from its Answer.

Dated: New York, New York
July 2, 2009



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

BORGHESE TRADEMARKS, INC. Plaintiff-Opposer, -- against -- MULTI MEDIA EXPOSURE, INC. Defendant-Applicant	x: : : : : : x	Opposition Proceeding No. 91189629 Mark: PRINCE LORENZO BORGHESE'S LA DOLCE VITA Serial No. 77435171

DECLARATION OF SERVICE

Mark S. Kaufman, an attorney duly admitted to practice in the State of New York, declares the following under penalty of perjury:

That on the 2nd day of July, 2009, declarant served the within APPLICANT'S OPPOSITION TO MOTION TO STRIKE CERTAIN DEFENSES upon

Moira J. Selinka, Esq.
Baker and Rannells, P.A.
575 Route 28, Suite 102
Raritan, NJ 08869-1354,

attorneys for BORGHESE TRADEMARKS, INC., plaintiff-opposer in the above-captioned lawsuit, at the addresses designated by said attorneys for such purpose, by causing the same to be served by depositing a true copy of same enclosed in a properly addressed wrapper, in an official depository under the exclusive care and custody of the United States Postal Service within the State of New York.

Dated: New York, New York
July 2, 2009

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