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

Proceeding	91192750
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re* Application No. 77/783,089  
Filed: July 16, 2009  
Published: October 20, 2009 in the Official Gazette  
For: **WEST END**

WILLIAMS-SONOMA, INC.,

Opposer,

vs.

E & E CO., LTD. (d/b/a JLA HOME),

Applicant.

Opposition No. 91192750

**OPPOSER'S MOTION**  
**FOR SUMMARY JUDGMENT**

**TABLE OF CONTENTS**

	<b><u>Page</u></b>
<b>I. INTRODUCTION</b> .....	1
<b>II. FACTS</b> .....	2
A. Williams-Sonoma’s Mark.....	2
B. Applicant’s WEST END Mark.....	4
C. Applicant Does Not Deny Likely Confusion In Response To Discovery .....	4
<b>III. RELEVANT LAW</b> .....	5
A. Summary Judgment .....	5
B. Deemed Admissions .....	6
<b>IV. ARGUMENT</b> .....	7
A. Summary Judgment is Warranted in This Case.....	7
B. Applicant’s WEST END Mark is Likely to Cause Confusion with Williams-Sonoma’s WEST ELM Mark.....	8
1. Williams-Sonoma’s and Applicant’s Marks are Extremely Similar.....	9
2. Applicant’s Goods are Identical to Goods in Williams-Sonoma’s Registration No. 2,738,123 .....	10
3. Williams-Sonoma and Applicant Offer Goods in the Same Channels of Trade .....	11
4. Williams-Sonoma’s WEST END Mark is Strong .....	11
5. There are No Similar Marks for Similar Goods or Services.....	13
6. Williams-Sonoma Uses its WEST ELM Mark With a Variety of Goods and Services .....	13

7.	There is No Evidence of Market Interface Between Applicant and an Owner of a Prior Mark.....	13
8.	Applicant Is Deemed To Have Admitted That Actual Confusion Exists .	14
9.	The Extent of Potential Confusion Is Substantial.....	14
10.	Applicant’s Adoption of a Confusingly Similar Mark was Knowing and Willful.....	14
<b>V.</b>	<b>REQUEST FOR SUSPENSION OF PROCEEDINGS.....</b>	<b>16</b>
<b>VI.</b>	<b>CONCLUSION .....</b>	<b>16</b>

**TABLE OF AUTHORITIES**

	<b><u>Page</u></b>
<b>CASES</b>	
<i>Banff, Ltd. v. Federated Dep't. Stores, Inc.</i> , 6 U.S.P.Q.2d 1187 (2d Cir. 1988).....	10
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986).....	6
<i>Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.</i> , 42 U.S.P.Q.2d 1173 (6th Cir. 1997) .....	11
<i>DC Comics v. Pan American Grain Mfg. Co.</i> , 77 U.S.P.Q.2d 1220 (T.T.A.B. 2005) .....	14
<i>Exxon Corp. v. National Food Line Corp.</i> , 198 U.S.P.Q. 407 (C.C.P.A. 1978) .....	5
<i>Exxon Corp. v. Texas Motor Exch. of Houston, Inc.</i> , 628 F.2d 500, 208 U.S.P.Q. 384 (5th Cir. 1980) .....	10
<i>Gillette Canada Inc. v. Ranir Corp.</i> , 23 U.S.P.Q.2d 1768 (T.T.A.B. 1992) .....	14
<i>In re E.I. Du Pont de Nemours &amp; Co.</i> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A 1973).....	8
<i>In re Lamson Oil Co.</i> , 6 U.S.P.Q.2d 1041 (T.T.A.B. 1987) .....	9
<i>In re Swan, Ltd.</i> , 8 U.S.P.Q.2d 1534 (T.T.A.B. 1988) .....	9
<i>International Paper Co. v. Valley Paper Co.</i> , 175 U.S.P.Q. 704 (C.C.P.A 1972) .....	11
<i>Kenner Parker Toys Inc. v. Rose Art Indust., Inc.</i> , 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992), <i>cert. denied</i> , 506 U.S. 862 (1992).....	12, 13
<i>Lloyd's Food Products, Inc. v. Eli's, Inc.</i> , 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993) .....	6

<i>McGregor-Doniger Inc. v. Drizzle Inc.</i> , 599 F.2d 1126, 202 U.S.P.Q. 81 (2d Cir. 1979) .....	11
<i>Packard Press, Inc. v. Hewlett-Packard Co.</i> , 227 F.3d 1352, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000) .....	7
<i>Pure Gold, Inc. v. Syntex (U.S.A.), Inc.</i> , 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984) .....	5, 6
<i>Recot, Inc. v. Becton</i> , 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) .....	11
<i>Sleekcraft</i> , 204 U.S.P.Q. at 818 .....	11
<i>Sleekcraft</i> , 204 U.S.P.Q. at 819 .....	16
<i>Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.</i> , 833 F.2d 1560, 4 U.S.P.Q. 2d 1793 (Fed. Cir. 1987) .....	6, 7
<b>STATUTES</b>	
37 C.F.R. § 2.116(a).....	5
37 C.F.R. § 2.127 .....	1
15 U.S.C. § 1052(d) .....	8
15 U.S.C. § 1115(a) .....	13
15 U.S.C. § 1125(c)(1).....	1
<b>RULES</b>	
Fed. R. Civ. P. 36(a)(3).....	6
Fed. R. Civ. P. 36(b) .....	6, 7
Fed. R. Civ. P. 56(a) .....	5
Fed. R. Civ. P. 56(c) .....	5
Fed. R. Civ. P. 56(e) .....	6
<b>OTHER AUTHORITIES</b>	
T.M.E.P. § 1207.01(b)(ii) .....	9

## **NOTICE OF MOTION**

Please take notice that Opposer, Williams-Sonoma, Inc. (“Opposer” or “Williams-Sonoma”), by this document and pursuant to Federal Rule of Civil Procedure 56 and 37 C.F.R. § 2.127, moves the Trademark Trial and Appeal Board to grant summary judgment on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act<sup>1</sup> for the reasons set forth in the accompanying Memorandum of Points and Authorities.

### **MEMORANDUM OF POINTS AND AUTHORITIES**

#### **I. INTRODUCTION**

This is a straightforward case of an applicant who intentionally adopted a mark confusingly similar to Williams-Sonoma’s WEST ELM® mark in order to benefit from the goodwill in Williams-Sonoma’s mark. Applicant’s attempt to usurp Williams-Sonoma’s rights by selecting the WEST END mark unfairly targets Williams-Sonoma’s customers for Applicant’s identical products. As demonstrated below, the undisputed facts of this case support a finding of a likelihood of confusion with the WEST ELM mark. The Board should readily determine that summary judgment for Williams-Sonoma on its Section 2(d) grounds for opposition must be entered.

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<sup>1</sup> Opposer’s Notice of Opposition also contains a claim for relief for trademark dilution under 15 U.S.C. § 1125(c)(1), which is not the subject of the present motion. If the Board grants summary judgment on the present motion, registration of Applicant’s mark will be denied, thus rendering Williams-Sonoma’s dilution claim moot and making the Board’s decision dispositive of this Opposition.

## II. FACTS

### A. Williams-Sonoma's Mark

Williams-Sonoma's exclusive ownership of the WEST ELM mark is evidenced by a number of valid and subsisting U.S. trademark registrations. These include the following (see Declaration of Marie C. Seibel ("Seibel Decl."), ¶ 2, Ex. A):

1. **U.S. Trademark Registration No. 2,725,772** for **WEST ELM** for "mail order catalog services featuring housewares, beverage glassware, tableware, flatware, indoor and outdoor furniture, pillows, slip covers, table linens, bed and bath linens, accessories for bed and bath, candles, candle holders, picture frames, furniture mirrors, vases, baskets for household and garden use, rugs, lamps, electric lighting fixtures, curtains, curtain rods, window shades, wall coverings, interior wall paint and furniture paint" in International Class 35. The application for Registration No. 2,725,772 was filed on June 1, 2001 and matured to registration on June 10, 2003, and the registration is now incontestable.

2. **U.S. Trademark Registration No. 2,845,444** for **WEST ELM** for "retail store services, and computerized online retail store services featuring housewares, beverage glassware, tableware, flatware, indoor and outdoor furniture, pillows slip covers, table linens, bed and bath linens, accessories for bed and bath, candles, candle holders, picture frames, furniture mirrors, vases, baskets for household use, rugs, lamps, electric lighting fixtures, curtains, curtain rods, window shades" in International Class 35. The application for Registration No. 3,089,360 was filed on June 1, 2001 and matured to registration on May 25, 2004, and the registration is now incontestable.

3. **U.S. Trademark Registration No. 2,738,123** for **WEST ELM** for "linen, duvet covers, coverlets, bed blankets, comforters, quilts, pillow cases, pillow shams, bedskirts,

unfitted fabric furniture covers, table linen, bath towels, hand towels, washcloths, fabric bath mats, shower curtains, window curtains, draperies, and window panels” in International Class 24. The application for Registration No. 2,738,123 was filed on June 1, 2001 and matured to registration on July 15, 2003, and the registration is now incontestable.

4. **U.S. Trademark Registration No. 2,860,667** for **WEST ELM** for “dishes, bowls, cups and serving platters” in International Class 21. The application for Registration No. 2,860,667 was filed on June 1, 2001 and matured to registration on July 6, 2004.

5. **U.S. Trademark Registration No. 2,854,307** for **WEST ELM** for “pictorial prints, posters, photograph albums, scrapbook albums, desk baskets for desk accessories, desk top stationery cabinets, file boxes for storage of business and personal records, blackboards, bulletin boards, book-ends, and mail order catalogs in the fields of furniture, decorative home furnishings, dining and kitchen goods, textiles, linens, housewares, bed and bath products, gardening products, and gifts” in International Class 16. The application for Registration No. 2,854,307 was filed on June 1, 2001 and matured to registration on June 15, 2004.

6. **U.S. Trademark Registration No. 3,539,865** for **WEST ELM & design** for “candles” in International Class 4, “diffusers for dispensing air fresheners” in International Class 11, “picture and photograph frames” in International Class 20, and “serving spoons; serving forks” in International Class 21. The application for Registration No. 3,539,865 was filed on March 24, 2008 and matured to registration on December 2, 2008.

**B. Applicant's WEST END Mark**

Applicant filed **U.S. Trademark Application Serial No. 77/783,089** (the "Application"), which is the subject of this Opposition, on July 16, 2009, based on its purported use of the mark **WEST END** in connection with "Bed and table linen; Bed blankets; Bed canopies; Bed covers; Bed linen; Bed linen and table linen; Bed pads; Bed sheets; Bed sheets of paper; Bed skirts; Bed spreads; Bed throws; Bedsheets; Comforters; Contour sheets; Contoured mattress covers; Covers for cushions; Cushion covers; Duvet covers; Duvets; Fabric window coverings and treatments, namely, curtains, draperies, sheers, swags and valances; Fabrics used in home decorative items with inspirational messages imprinted or woven into the fabrics; Feather beds; Interior decoration fabrics; Mattress covers; Pillow cases; Pillow covers; Pillow shams; Table and bed linen; Table linen" in International Class 24.

Applicant's goods, as described in the Application, are identical to the goods identified in Williams-Sonoma's Registration No. 2,738,123 for the WEST ELM mark. Williams-Sonoma began use of its WEST ELM mark in connection with its goods and services at least as early as April 2002, which is well prior to Applicant's alleged April 24, 2009 first use date and July 16, 2009 filing date. The filing dates of Williams-Sonoma's Registrations Nos. 2,725,772, 2,845,444, 2,738,123, 2,860,667, 2,854,307 and 3,539,865 all similarly pre-date both the Application's July 16, 2009 filing date as well as the alleged first use date of April 24, 2009.

**C. Applicant Does Not Deny Likely Confusion In Response To Discovery**

On October 6, 2010, Williams-Sonoma timely and properly served Requests for Admission upon Applicant. The requests included admissions related to the likely confusion that would arise from adoption of Applicant's mark. Applicant's deadline to respond to the Requests

for Admission was November 10, 2010, 35 days from the date of service. Applicant failed to deny any of Williams-Sonoma's Requests for Admission. Seibel Decl. ¶3 and Ex. B.

### **III. RELEVANT LAW**

#### **A. Summary Judgment**

The Federal Rules of Civil Procedure generally apply to proceedings before the Trademark Trial and Appeal Board. *See* 37 C.F.R. § 2.116(a). Therefore, on a motion for summary judgment, the Board may render judgment for the moving party if there is no genuine issue as to any material fact. *See* Fed. R. Civ. P. 56(c). Further, a party may move for summary judgment in its favor regarding all asserted claims, or any part thereof. *See* Fed. R. Civ. P. 56(a). In *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984), the Federal Circuit affirmed the Board's grant of summary judgment in an opposition proceeding. The court explained that the "basic purpose of summary judgment is one of judicial economy." *Id.* at 743 (*citing Exxon Corp. v. National Food Line Corp.*, 198 U.S.P.Q. 407, 408 (C.C.P.A. 1978)). It is against public interest to conduct unnecessary trials, and where the time and expense of a full trial can be avoided by the summary judgment procedure, such action is favored. *See Pure Gold*, 222 U.S.P.Q. at 743. The court encouraged the disposition of matters before the Trademark Trial and Appeal Board by summary judgment:

The practice of the U.S. Claims Court and of the former U.S. Court of Claims in routinely disposing of numerous cases on the basis of cross-motions for summary judgment has much to commend it. The adoption of a similar practice is to be encouraged in inter partes cases before the Trademark Trial and Appeal Board, which seem particularly suitable to this type of disposition. Too often we see voluminous records which would be appropriate to an infringement or unfair competition suit but are wholly unnecessary to resolution of the issue of registrability of a mark.

739 F.2d at 627 n.2. *See also Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560 1562, 4 U.S.P.Q. 2d 1793, 1795 (Fed. Cir. 1987) (lauding the use of summary judgment to resolve Board proceedings).

The burden of a party moving for summary judgment is met by showing “that there is an absence of evidence to support the nonmoving party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). When the moving party shows that there is no genuine issue of material fact, the nonmoving party “may not rest upon the mere allegations or denials of [its] pleadings.” Fed. R. Civ. P. 56(e). It must respond, setting “forth specific facts showing that there is a genuine factual issue for trial.” *Id.* A factual dispute is genuine only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *See Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d 2027, 2029 (Fed. Cir. 1993).

#### **B. Deemed Admissions**

Fed. R. Civ. P. 36(a)(3) provides that “[a] matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney.” Further, under Fed. R. Civ. P. 36(b), a matter admitted under Rule 36 “is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended.” Here, for example, Applicant is deemed to have admitted the ultimate fact that disposes of any ground to sustain its application:

Applicant admits the following as to this overarching legal question:

#### ***REQUEST NO. 16:***

*Admit that there is a potential for confusion between Your Mark and Opposer’s Mark.*

***[Deemed admitted.]***

#### **IV. ARGUMENT**

##### **A. Summary Judgment is Warranted in This Case**

Based on the uncontested record in this case, Williams-Sonoma's rights in the WEST ELM mark are senior to Applicant's rights in the WEST END mark. Applicant's WEST END mark is strikingly similar to Williams-Sonoma's WEST ELM mark. As a result of the extreme similarity between the parties' marks and the identical nature of the goods associated with each mark, it is beyond dispute that Applicant's WEST END mark is likely to cause confusion, mistake or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties' respective goods and services. By failing to answer Williams-Sonoma's Requests for Admissions (timely and properly served on October 6, 2010) within 35 days of service, Applicant is deemed to have admitted the foregoing and other facts which demonstrate a likelihood of confusion between WEST END and Williams-Sonoma's WEST ELM mark. Seibel Decl. ¶3 and Ex. B, and Fed. R. Civ. P. 36(a) and (b).

Given Williams-Sonoma's senior rights in the WEST ELM mark and the conclusively established facts from Applicant's own admissions, there are no remaining issues of material fact. "Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000); *Sweats Fashions*, 4 U.S.P.Q.2d at 1797 ("The uniform precedent of this court is that the issue of a likelihood of confusion is one of law."). Thus, the determination of whether there is a likelihood of confusion between the WEST ELM and WEST END marks is a question of law and wholly appropriate for disposition on summary judgment.

**B. Applicant's WEST END Mark is Likely to Cause Confusion with Williams-Sonoma's WEST ELM Mark**

Section 2(d) of the Lanham Act provides that registration of a trademark should be refused if the mark “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, to cause mistake, or to deceive...” 15 U.S.C. § 1052(d). The registration of Applicant's WEST END mark, and any use of WEST END mark by Applicant, admittedly is likely to cause confusion, to cause mistake, or to deceive, particularly as to the source or origin of the goods and services with which Applicant uses its mark. Further, registration or use of the WEST END mark may induce purchasers to believe that Applicant's goods and services are Williams-Sonoma's, or are endorsed by, or in some way affiliated or associated with Williams-Sonoma.

The court in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A 1973), listed a number of factors which may be considered when testing for a likelihood of confusion under Section 2(d). These factors include:

- Similarity of the marks;
- Similarity of the goods;
- Similarity of the trade channels;
- Conditions under which consumers purchase the goods;
- Strength of the prior mark;
- Number and nature of similar marks used on similar goods;
- Nature and extent of actual confusion;
- Length of time and conditions under which concurrent use has not produced actual confusion;
- Variety of goods on which a mark is used (e.g., “family” mark);
- Market interface between applicant and owner of a prior mark;
- Extent of potential confusion; and
- Any other fact probative of effect of use.

*Id.* at 567.

Each of the relevant *DuPont* factors reveals that a likelihood of confusion exists in this case and that registration of the WEST END mark should be denied.

**1. Williams-Sonoma's and Applicant's Marks are Extremely Similar**

Identity of marks is not required to support a finding of a likelihood of confusion.

“Marks may be confusingly similar in appearance despite the addition, deletion or substitution of letters or words.” T.M.E.P. § 1207.01(b)(ii). The standard for determining the similarity of marks involves evaluating the similarities in sight, sound and meaning. Similarities in any one of these three components may suffice for the marks to be deemed confusingly similar. *In re Swan, Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (T.T.A.B. 1988); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1987).

Williams-Sonoma's WEST ELM mark and Applicant's WEST END mark are sufficiently similar in sight and sound to mandate rejection of the WEST END application based on a finding that a likelihood of confusion exists under Section 2(d), particularly since, as Applicant admits, the shared term “WEST” is the dominant portion of the mark:

***REQUEST NO. 15:***

*Admit that the dominant portion of Your Mark is the word WEST.*

***[Deemed admitted.]***

Applicant has simply copied the dominant “WEST” component of the mark and replaced the three-letter word “ELM” with another three-letter word that starts with an “E.” This has resulted in a mark that is nearly indistinguishable, visually and aurally, from Williams-Sonoma's WEST ELM mark.

**2. Applicant's Goods are Identical to Goods in Williams-Sonoma's Registration No. 2,738,123**

The more similar or closely related the goods, the greater the likelihood of confusion. *Exxon Corp. v. Texas Motor Exch. of Houston, Inc.*, 628 F.2d 500, 505, 208 U.S.P.Q. 384, 388 (5th Cir. 1980). Further, the more closely related the goods or services, the lesser of a showing is needed under the remaining likelihood of confusion factors. *Banff, Ltd. v. Federated Dep't. Stores, Inc.*, 6 U.S.P.Q.2d 1187, 1192 (2d Cir. 1988).

Applicant admits the following relevant to this factor:

**REQUEST NO. 17:**

*Admit that You promote and sell home textiles under Your Mark.*

**[Deemed admitted.]**

**REQUEST NO. 21:**

*Admit that You and Opposer are competitors.*

**[Deemed admitted.]**

**REQUEST NO. 53:**

*Admit that the goods You provide under Your Mark are identical to Opposer's WEST ELM goods.*

**[Deemed admitted.]**

**REQUEST NO. 57:**

*Admit that the goods identified in Your Application are identical to Opposer's WEST ELM home textile goods.*

**[Deemed admitted.]**

The WEST END products and services are admittedly identical to competitive products offered by Williams-Sonoma under the WEST ELM mark. The likelihood of confusion between these identical products and services is undisputed. This factor, accordingly, clearly supports the conclusion that a likelihood of confusion exists.

**3. Williams-Sonoma and Applicant Offer Goods in the Same Channels of Trade**

Overlapping or complementary marketing channels increase the likelihood of confusion.

*Sleekcraft*, 204 U.S.P.Q. at 818. Applicant admits the following as to this factor:

***REQUEST NO. 48:***

*Admit that You and Opposer advertise, market, offer to sell, and/or sell their respective goods in the same channels of trade.*

***[Deemed admitted.]***

As noted, the parties' trademark filings cover identical goods. Further, Applicant has not limited its marketing channels in its application. Thus, if Applicant receives a registration, Applicant's goods may be sold and advertised in any and all marketing channels used for such goods. As a matter of law, therefore, the Board must assume that allowing Applicant's WEST END mark to register would result in Applicant's goods and Williams-Sonoma's goods being sold in the same marketing channels, thus tending to increase the likelihood of confusion.

*International Paper Co. v. Valley Paper Co.*, 175 U.S.P.Q. 704, 705 (C.C.P.A 1972).

Because the channels of trade for the parties' respective products are the same, consideration of this factor favors a finding of a likelihood of confusion.

**4. Williams-Sonoma's WEST END Mark is Strong**

"[T]he strength of a mark depends ultimately on its distinctiveness, or its 'origin-indicating' quality, in the eyes of the purchasing public." *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 U.S.P.Q. 81, 87 (2d Cir. 1979). The more distinctive the mark, the more likely confusion will result from its infringement. *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 42 U.S.P.Q.2d 1173, 1177 (6th Cir. 1997). The fame of a mark is a dominant factor in the likelihood of confusion analysis, "independent of the consideration of the relatedness of the goods." *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1898 (Fed.

Cir. 2000). Thus, the effectively acknowledged fame of Williams-Sonoma's WEST END mark is an important factor and one that weighs strongly in Williams-Sonoma's favor. Applicant admits the following as to this factor:

**REQUEST NO. 58:**

*Admit that Opposer's WEST ELM mark is famous in the U.S.*

**[Deemed admitted.]**

**REQUEST NO. 59:**

*Admit that Opposer's WEST ELM mark was famous in the U.S. on April 24, 2009.<sup>2</sup>*

**[Deemed admitted.]**

**REQUEST NO. 60:**

*Admit that Opposer's WEST ELM mark was famous in the U.S. when you adopted Your Mark.*

**[Deemed admitted.]**

Williams-Sonoma's WEST ELM mark is extremely strong. First, the term "WEST ELM" is an inherently distinctive and arbitrary term. Second, by virtue of its registration, including incontestable Registration Nos. 2,725,772, 2,845,444 and 2,738,123, the WEST ELM mark is entitled to a presumption of validity and exclusivity that prohibits the use of a confusingly similar mark. Third, and most importantly, over the past eight years, Williams-Sonoma's WEST ELM mark has achieved such recognition and distinction amongst the consuming public due to Williams-Sonoma's popularity, and massive promotion that it has become a famous mark entitled to broad protection. "Famous or strong marks enjoy a wide latitude of legal protection." *Kenner Parker Toys Inc. v. Rose Art Indust., Inc.*, 963 F.2d 350, 22

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<sup>2</sup> The filing date of the opposed application.

U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992). As a strong mark, WEST ELM “casts a long shadow which competitors must avoid.” *Id.*

Hence, this factor favors a finding that Applicant’s adoption and use of the WEST END mark will create a likelihood of confusion.

**5. There are No Similar Marks for Similar Goods or Services**

There is no evidence of record that other parties use or have used WEST ELM for home textiles or the various other goods set forth in Williams-Sonoma’s above-referenced trademark registrations. Further, the statutory presumption of exclusivity afforded Williams-Sonoma pursuant to 15 U.S.C. § 1115(a) has not and cannot be rebutted.

This factor favors a finding of a likelihood of confusion.

**6. Williams-Sonoma Uses its WEST ELM Mark With a Variety of Goods and Services**

Williams-Sonoma uses its WEST ELM mark not only for home textiles, but also on a variety of housewares, home furnishings and decorative items which are the subjects of Williams-Sonoma’s prior-pending WEST ELM registrations. Thus, the scope of Williams-Sonoma’s rights in the WEST ELM mark is broad, and exclusive, for a wide range of goods and services. Applicant’s use of WEST END will infringe these broad rights, and thus this factor favors a likelihood of confusion.

**7. There is No Evidence of Market Interface Between Applicant and an Owner of a Prior Mark**

The record is devoid of evidence regarding Applicant’s market interface with any owner of a prior mark that may impact, enhance, or limit Applicant’s use of WEST END. Hence, this factor neither favors nor disfavors a finding of likelihood of confusion.

**8. Applicant Is Deemed To Have Admitted That Actual Confusion Exists**

Applicant admits the following:

**REQUEST NO. 44:** *Admit that there are instances of actual confusion between Your Mark and Opposer's Mark.*

**[Deemed admitted.]**

Again, this factor dictates a finding of a likelihood of confusion.

**9. The Extent of Potential Confusion Is Substantial**

As the discussion of the previous factors shows, the potential for confusion between Williams-Sonoma's WEST ELM mark and Applicant's WEST END mark is substantial.

Applicant admits the following as to this factor:

**REQUEST NO. 16:**

*Admit that there is a potential for confusion between Your Mark and Opposer's Mark.*

**[Deemed admitted.]**

It stands to reason that the adoption of a confusingly similar mark by Applicant for use on goods identical to Williams-Sonoma's WEST END goods presents the potential for substantial confusion. Thus this factor favors denial of registration of the WEST END mark.

**10. Applicant's Adoption of a Confusingly Similar Mark was Knowing and Willful**

A significant factor that courts consider in determining the likelihood of confusion is the intent of the actor in adopting and using the mark. "[A] party which knowingly adopts a mark similar to one used by another for the same or closely related goods or services does so at its peril and any doubt on the question of likelihood of confusion must be resolved against the junior user." *Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (T.T.A.B. 1992). *See also DC Comics v. Pan American Grain Mfg. Co.*, 77 U.S.P.Q.2d 1220 (T.T.A.B. 2005) ("Evidence of applicant's bad faith adoption is pertinent to our likelihood of confusion analysis under the thirteenth *du Pont* factor.").

Applicant admits the following as to this factor:

**REQUEST NO. 2:**

*Admit that You were aware, prior to filing Your Application, that Opposer was promoting and selling home textiles in the U.S. under its WEST ELM mark.*

***[Deemed admitted.]***

**REQUEST NO. 3:**

*Admit that You were aware, prior to Your first use of Your Mark, that Opposer was promoting and selling home textiles in the U.S. under its WEST ELM mark.*

***[Deemed admitted.]***

**REQUEST NO. 11:**

*Admit that You were aware of Opposer's WEST ELM mark when You decided to adopt Your Mark.*

***[Deemed admitted.]***

**REQUEST NO. 12:**

*Admit that Your awareness of Opposer's WEST ELM mark influenced Your decision to adopt Your Mark.*

***[Deemed admitted.]***

**REQUEST NO. 13:**

*Admit that Your awareness of Opposer's WEST ELM mark influenced Your decision to include the term "WEST" within Your Mark.*

***[Deemed admitted.]***

**REQUEST NO. 14:**

*Admit that Opposer's WEST ELM mark was discussed, mentioned, considered, or referenced in connection with Your decision to adopt Your Mark.*

***[Deemed admitted.]***

**REQUEST NO. 46:**

*Admit that You did not conduct a trademark search or seek the advice of counsel prior to filing Your Application.*

***[Deemed admitted.]***

**REQUEST NO. 47:**

*Admit that You did not conduct a trademark search or seek the advice of counsel prior to adopting Your Mark.*

**[Deemed admitted.]**

Applicant was admittedly aware of Williams-Sonoma's WEST ELM mark when it adopted and applied for the opposed WEST END mark and admittedly did not conduct a full trademark search, as a good faith adopter of a new mark would be expected to do. *See Seibel Decl.*, ¶ 3 and Ex. B. "When the alleged infringer knowingly adopts a mark similar to another's, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived." *Sleekcraft*, 204 U.S.P.Q. at 819. As such, this factor weighs in favor of a finding of a likelihood of confusion.

**V. REQUEST FOR SUSPENSION OF PROCEEDINGS**

Williams-Sonoma hereby requests that this opposition proceeding be suspended with respect to all matters not germane to this motion pending resolution of this motion.

**VI. CONCLUSION**

The uncontroverted and uncontrovertible facts require a holding that Williams-Sonoma is entitled to summary judgment. There are no genuine issues of material fact to be tried, and this matter should be decided as a matter of law in Williams-Sonoma's favor.

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For all of these reasons, Williams-Sonoma respectfully requests the Board to grant this motion.

Dated: November 19, 2010

Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

By: /s/ Marie C. Seibel

Gregory S. Gilchrist

Marie C. Seibel

*Attorneys for Williams-Sonoma*

Townsend and Townsend and Crew LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111-3834  
Telephone: (415) 576-0200  
Facsimile: (415) 575-0300

62999967 v1

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

*In re* Application No. 77/783,089  
Filed: July 16, 2009  
Published: October 20, 2009 in the Official Gazette  
For: **WEST END**

WILLIAMS-SONOMA, INC.,

Opposer,

vs.

E & E CO., LTD. (d/b/a JLA HOME),

Applicant.

Opposition No. 91192750

**DECLARATION OF MARIE C. SEIBEL  
IN SUPPORT OF OPPOSER'S MOTION  
FOR SUMMARY JUDGMENT**

1. I, Marie C. Seibel, am an attorney at Townsend and Townsend and Crew LLP, attorneys for Williams-Sonoma, Inc. I submit this declaration in support of Williams-Sonoma's Motion for Summary Judgment.

2. Attached hereto as Exhibit A are true and correct copies of the Certificates of Registration Nos. 2,725,772, 2,845,444, 2,738,123, 2,860,667, 2,854,307 and 3,539,865 for the WEST ELM mark.

3. Attached hereto as Exhibit B is a true and correct copy of Opposer's Requests for Admission, which I caused to be properly served on October 6, 2010. Applicant's deadline to respond to the Requests for Admission was November 10, 2010, 35 days from the date of service. To date, Applicant still has not responded to the Requests for Admission.

Having been warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 10001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Dated: November 19, 2010

/s/ Marie C. Seibel

Marie C. Seibel

63000712 v1

**EXHIBIT A**

**Int. Cl.: 35**

**Prior U.S. Cls.: 100, 101, and 102**

**Reg. No. 2,725,772**

**United States Patent and Trademark Office**

**Registered June 10, 2003**

**SERVICE MARK  
PRINCIPAL REGISTER**

**WEST ELM**

WILLIAMS-SONOMA, INC. (CALIFORNIA CORPORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FOR: MAIL ORDER CATALOG SERVICES FEATURING HOUSEWARES, BEVERAGE GLASSWARE, TABLEWARE, FLATWARE, INDOOR AND OUTDOOR FURNITURE, PILLOWS, SLIP COVERS, TABLE LINENS, BED AND BATH LINENS, ACCESSORIES FOR BED AND BATH, CANDLES, CANDLE HOLDERS, PICTURE FRAMES, FURNITURE MIRRORS, VASES, BASKETS FOR HOUSEHOLD AND

GARDEN USE, RUGS, LAMPS, ELECTRIC LIGHTING FIXTURES, CURTAINS, CURTAIN RODS, WINDOW SHADES, WALL COVERINGS, INTERIOR WALL PAINT AND FURNITURE PAINT, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 4-23-2002; IN COMMERCE 4-23-2002.

SN 76-975,281, FILED 6-1-2001.

KATHERINE STOIDES, EXAMINING ATTORNEY

**Int. Cl.: 35**

**Prior U.S. Cls.: 100, 101, and 102**

**Reg. No. 2,845,444**

**United States Patent and Trademark Office**

**Registered May 25, 2004**

**SERVICE MARK  
PRINCIPAL REGISTER**

**WEST ELM**

WILLIAMS-SONOMA, INC. (CALIFORNIA CORPORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FOR: RETAIL STORE SERVICES, AND COMPUTERIZED ONLINE RETAIL STORE SERVICES FEATURING HOUSEWARES, BEVERAGE GLASSWARE, TABLEWARE, FLATWARE, INDOOR AND OUTDOOR FURNITURE, PILLOWS SLIP COVERS, TABLE LINENS, BED AND BATH LINENS, ACCESSORIES FOR BED AND BATH, CANDLES, CANDLE HOLDERS, PICTURE

FRAMES, FURNITURE MIRRORS, VASES, BASKETS FOR HOUSEHOLD AND GARDEN USE, RUGS, LAMPS, ELECTRIC LIGHTING FIXTURES, CURTAINS, CURTAIN RODS, WINDOW SHADES, WALL COVERINGS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-15-2003; IN COMMERCE 10-15-2003.

SN 76-267,307, FILED 6-1-2001.

KATHERINE STOIDES, EXAMINING ATTORNEY

Int. Cl.: 24

Prior U.S. Cls.: 42 and 50

Reg. No. 2,738,123

United States Patent and Trademark Office

Registered July 15, 2003

Corrected

OG Date Oct. 21, 2003

**TRADEMARK  
PRINCIPAL REGISTER**

**WEST ELM**

WILLIAMS-SONOMA, INC. (CALIFORNIA CORPORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FOR: BED LINEN, DUVET COVERS, COVERLETS, BED BLANKETS, COMFORTERS, QUILTS, [ MATTRESS PADS, ] PILLOW CASES, PILLOW SHAMS, BED-SKIRTS, UNFITTED FABRIC FURNI-

TURE COVERS, TABLE LINEN, BATH TOWELS, HAND TOWELS, WASH-CLOTHS, FABRIC BATH MATS, SHOWER CURTAINS, WINDOW CURTAINS, DRAPERIES, AND WINDOW PANELS, IN CLASS 24 (U.S. CLS. 42 AND 50).

FIRST USE 9-17-2002; IN COMMERCE 9-17-2002.

SER. NO. 76-267,305, FILED 6-1-2001.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on Oct. 21, 2003.*

**DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE**

**Int. Cl.: 21**

**Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40, and 50**

**Reg. No. 2,860,667**

**United States Patent and Trademark Office**

**Registered July 6, 2004**

**TRADEMARK  
PRINCIPAL REGISTER**

**WEST ELM**

WILLIAMS-SONOMA, INC. (CALIFORNIA COR-  
PORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FIRST USE 9-17-2002; IN COMMERCE 9-17-2002.

SN 76-267,304, FILED 6-1-2001.

FOR: DISHES, BOWLS, CUPS AND SERVING  
PLATTERS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30,  
33, 40 AND 50).

BRIDGETT SMITH, EXAMINING ATTORNEY

**Int. Cl.: 16**

**Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50**

**Reg. No. 2,854,307**

**United States Patent and Trademark Office**

**Registered June 15, 2004**

**TRADEMARK  
PRINCIPAL REGISTER**

**WEST ELM**

WILLIAMS-SONOMA, INC. (CALIFORNIA CORPORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FOR: PICTORIAL PRINTS, POSTERS, PHOTOGRAPH ALBUMS, SCRAPBOOK ALBUMS, DESK BASKETS FOR DESK ACCESSORIES, DESK TOP STATIONERY CABINETS, FILE BOXES FOR STORAGE OF BUSINESS AND PERSONAL RECORDS, BLACKBOARDS, BULLETIN BOARDS, BOOK-ENDS, AND MAIL ORDER CATALOGS IN THE FIELDS OF FURNITURE, DECORATIVE HOME

FURNISHINGS, DINING AND KITCHEN GOODS, TEXTILES, LINENS, HOUSEWARES, BED AND BATH PRODUCTS, GARDENING PRODUCTS, AND GIFTS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 4-23-2002; IN COMMERCE 4-23-2002.

SN 76-267,312, FILED 6-1-2001.

BRIDGETT SMITH, EXAMINING ATTORNEY

Int. Cls.: 4, 11, 20 and 21

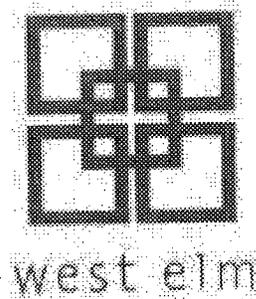
Prior U.S. Cls.: 1, 2, 6, 13, 15, 21, 22, 23, 25, 29, 30, 31,  
32, 33, 34, 40 and 50

Reg. No. 3,539,865

Registered Dec. 2, 2008

**United States Patent and Trademark Office**

**TRADEMARK  
PRINCIPAL REGISTER**



WILLIAMS-SONOMA, INC. (CALIFORNIA COR-  
PORATION)  
3250 VAN NESS AVENUE  
SAN FRANCISCO, CA 94109

FOR: CANDLES, IN CLASS 4 (U.S. CLS. 1, 6 AND  
15).

FIRST USE 12-26-2007; IN COMMERCE 12-26-2007.

FOR: DIFFUSERS FOR DISPENSING AIR FRESH-  
ENERS, IN CLASS 11 (U.S. CLS. 13, 21, 23, 31 AND 34).

FIRST USE 12-26-2007; IN COMMERCE 12-26-2007.

FOR: PICTURE AND PHOTOGRAPH FRAMES,  
IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 10-2-2007; IN COMMERCE 10-2-2007.

FOR: SERVING SPOONS; SERVING FORKS, IN  
CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 10-2-2007; IN COMMERCE 10-2-2007.

OWNER OF U.S. REG. NOS. 2,725,772, 2,854,307  
AND OTHERS.

SER. NO. 77-430,082, FILED 3-24-2008.

JAMES MACFARLANE, EXAMINING ATTORNEY

**EXHIBIT B**

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

*In re* Application No. 77/783,089  
Filed: July 16, 2009  
Published: October 20, 2009 in the Official Gazette  
For: WEST END

WILLIAMS-SONOMA, INC.,

Opposer,

vs.

E & E CO., LTD. (d/b/a JLA HOME),

Applicant.

Opposition No. 91192750

**OPPOSER'S FIRST SET OF REQUESTS  
FOR ADMISSION  
TO APPLICANT**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer Williams-Sonoma, Inc. ("Opposer"), by its attorneys, requests that Applicant E & E Co., Ltd. ("Applicant") admit or deny the following requests for admission under oath within thirty (30) days from the date hereof.

**DEFINITIONS**

1. "Opposer" refers to Williams-Sonoma, Inc., its officers, directors, employees, agents, predecessors-in-interest, or any other Person acting on its behalf or with its authority.
2. "Applicant," "You," or "Your" refers to E & E Co., Ltd., or any other Person acting on its behalf or with its authority.

3. "Opposer's Mark" means the mark WEST ELM, which is the subject of, *inter alia*, U.S. Trademark Registration Nos. 3,539,865, 2,854,307, 2,860,667, 2,738,123, 2,845,444 and 2,725,772.

4. "Your Mark" means Applicant's WEST END Mark, which is the subject of this proceeding, whether used as a trademark, service mark, trade name, or corporate name, either alone or in association with other words or designs, or any term incorporating "WEST END." To the extent that this definition includes more than one word, phrase, name, term, trademark or service mark, responses should be made separately for each.

5. "Your Application" means Application Serial No. 77/783,089 that is the subject of this proceeding.

#### **REQUESTS FOR ADMISSION**

##### **REQUEST NO. 1:**

Admit that You are aware that Opposer promotes and sells home textiles in the U.S. under its WEST ELM mark.

##### **REQUEST NO. 2:**

Admit that You were aware, prior to filing Your Application, that Opposer was promoting and selling home textiles in the U.S. under its WEST ELM mark.

##### **REQUEST NO. 3:**

Admit that You were aware, prior to Your first use of Your Mark, that Opposer was promoting and selling home textiles in the U.S. under its WEST ELM mark.

##### **REQUEST NO. 4:**

Admit that You are aware that Opposer promotes and sells home accessories and furniture in the U.S. under its WEST ELM mark.

**REQUEST NO. 5:**

Admit that You were aware, prior to filing Your Application, that Opposer was promoting and selling home accessories and furniture in the U.S. under its WEST ELM mark.

**REQUEST NO. 6:**

Admit that You were aware, prior to Your first use of Your Mark, that Opposer was promoting and selling home accessories and furniture in the U.S. under its WEST ELM mark.

**REQUEST NO. 7:**

Admit that You are aware that Opposer promotes and sells glassware and dinnerware in the U.S. under its WEST ELM mark.

**REQUEST NO. 8:**

Admit that You were aware, prior to filing Your Application, that Opposer was promoting and selling glassware and dinnerware in the U.S. under its WEST ELM mark.

**REQUEST NO. 9:**

Admit that You were aware, prior to Your first use of Your Mark, that Opposer was promoting and selling glassware and dinnerware in the U.S. under its WEST ELM mark.

**REQUEST NO. 10:**

Admit that You did not use Your Mark prior to April 24, 2009.

**REQUEST NO. 11:**

Admit that You were aware of Opposer's WEST ELM mark when You decided to adopt Your Mark.

**REQUEST NO. 12:**

Admit that Your awareness of Opposer's WEST ELM mark influenced Your decision to adopt Your Mark.

**REQUEST NO. 13:**

Admit that Your awareness of Opposer's WEST ELM mark influenced Your decision to include the term "WEST" within Your Mark.

**REQUEST NO. 14:**

Admit that Opposer's WEST ELM mark was discussed, mentioned, considered, or referenced in connection with Your decision to adopt Your Mark.

**REQUEST NO. 15:**

Admit that the dominant portion of Your Mark is the word WEST.

**REQUEST NO. 16:**

Admit that there is a potential for confusion between Your Mark and Opposer's Mark.

**REQUEST NO. 17:**

Admit that You promote and sell home textiles under Your Mark.

**REQUEST NO. 18:**

Admit that You promote and sell home accessories under Your Mark.

**REQUEST NO. 19:**

Admit that You promote and sell furniture under Your Mark.

**REQUEST NO. 20:**

Admit that You promote and sell glassware and dinnerware under Your Mark.

**REQUEST NO. 21:**

Admit that You and Opposer are competitors.

**REQUEST NO. 22:**

Admit that Target is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 23:**

Admit that Target is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 24:**

Admit that JCPenney is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 25:**

Admit that JCPenney is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 26:**

Admit that Mervyns is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 27:**

Admit that Mervyns is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 28:**

Admit that Kohl's is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 29:**

Admit that Kohl's is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 30:**

Admit that Saks Fifth Avenue is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 31:**

Admit that Saks Fifth Avenue is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 32:**

Admit that Macy's is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 33:**

Admit that Macy's is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 34:**

Admit that Dillard's is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 35:**

Admit that Dillard's is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 36:**

Admit that Bed Bath & Beyond is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 37:**

Admit that Bed Bath & Beyond is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 38:**

Admit that Zellers is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 39:**

Admit that Zellers is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 40:**

Admit that Home Outfitters is a customer for the goods and/or services You provide under Your Mark.

**REQUEST NO. 41:**

Admit that Home Outfitters is a reseller for the goods and/or services You provide under Your Mark.

**REQUEST NO. 42:**

Admit that Your goods identified in Your Application are offered to, among others, consumers who purchase or use Opposer's goods offered under Opposer's WEST END mark.

**REQUEST NO. 43:**

Admit that Your goods identified in Your Application are intended to be purchased by,

among others, consumers who purchase or use Opposer's goods offered under Opposer's WEST  
END mark.

**REQUEST NO. 44:**

Admit that there are instances of actual confusion between Your Mark and Opposer's  
Mark.

**REQUEST NO. 45:**

Admit that you are aware of an instance, occasion and/or Documents in which You or a  
third party referenced Your Mark and/or the goods and/or services sold by You under Your  
Mark, on the one hand, and Opposer's Mark and/or goods or services sold or provided by  
Opposer under Opposer's Mark, on the other hand.

**REQUEST NO. 46:**

Admit that You did not conduct a trademark search or seek the advice of counsel prior to  
filing Your Application.

**REQUEST NO. 47:**

Admit that You did not conduct a trademark search or seek the advice of counsel prior to  
adopting Your Mark.

**REQUEST NO. 48:**

Admit that You and Opposer advertise, market, offer to sell, and/or sell their respective  
goods in the same channels of trade.

**REQUEST NO. 49:**

Admit that You advertise, market, provide, offer to sell, and/or sell the goods provided by  
You under Your Mark via the Internet.

**REQUEST NO. 50:**

Admit that You advertise, market, provide, offer to sell, and/or sell the goods provided by You under Your Mark through retail stores.

**REQUEST NO. 51:**

Admit that You advertise, market, provide, offer to sell, and/or sell the goods provided by You under Your Mark through catalogs.

**REQUEST NO. 52:**

Admit that the goods You provide under Your Mark are highly related to Opposer's WEST ELM goods.

**REQUEST NO. 53:**

Admit that the goods You provide under Your Mark are identical to Opposer's WEST ELM goods.

**REQUEST NO. 54:**

Admit that the goods You provide under Your Mark are highly related to Opposer's WEST ELM home textile goods.

**REQUEST NO. 55:**

Admit that the goods You provide under Your Mark are identical to Opposer's WEST ELM home textile goods.

**REQUEST NO. 56:**

Admit that the goods identified in Your Application are highly related to Opposer's WEST ELM home textile goods.

**REQUEST NO. 57:**

Admit that the goods identified in Your Application are identical to Opposer's WEST ELM home textile goods.

**REQUEST NO. 58:**

Admit that Opposer's WEST ELM mark is famous in the U.S.

**REQUEST NO. 59:**

Admit that Opposer's WEST ELM mark was famous in the U.S. on April 24, 2009.

**REQUEST NO. 60:**

Admit that Opposer's WEST ELM mark was famous in the U.S. when you adopted Your Mark.

**REQUEST NO. 61:**

Admit that use of Your Mark in connection with the goods listed in Your Application will dilute the goodwill associated with Opposer's Mark in the U.S.

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**REQUEST NO. 62:**

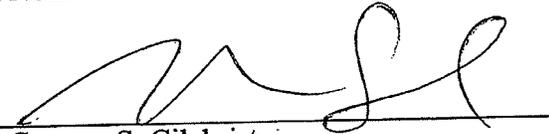
Admit the authenticity of all documents You produced in response to Opposer's First Set of Requests for Production of Documents to Applicant.

Date: October 6, 2010

Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

By:



Gregory S. Gilchrist  
Marie C. Seibel

*Attorneys for Opposer*  
WILLIAMS-SONOMA, INC.

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