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

Proceeding	91195961
Party	Plaintiff ELVH, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ELVH, INC. Opposer, v. KELLY VAN HALEN Applicant.	}	Application Ser. No. 77919644 and Application Ser. No. 77919645 Marks: KELLYVANHALEN Opposition No. 91195961

OPPOSER'S REPLY MEMORANDUM
FOR PARTIAL SUMMARY JUDGMENT

Opposer, ELVH, Inc., submits this memorandum in further support of its motion for partial summary judgment and in reply to Applicant's opposing response. Opposer will timely respond to Applicant's separate cross-motion for partial summary judgment.

Significantly, Applicant makes no argument and presents no evidence to rebut Opposer's assertion that Opposer's and Applicant's marks are confusingly similar. This is true even with respect to Applicant's own motion for summary judgment which is premised solely on the asserted differences in goods and services. Thus, Applicant concedes that the marks are confusingly similar. This concession is appropriate in view of the obvious similarities in the marks and supporting case law (Opp. Mem. pp. 7-10).

Applicant's arguments opposing summary judgment, as to the goods and services, are flawed in two respects. First, Applicant correctly agrees (Mem. p. 7) with the proposition asserted by Opposer that the goods as recited in the registrations and

applications are presumed to move in all normal trade channels; however, contrary to that principle, Applicant also continually argues that Opposer's registered goods are somehow limited to "rock band" merchandise. Applicant has made no counterclaim to narrow the channels of trade asserted in Opposer's registrations and, accordingly, Applicant's "rock band" limitation is without foundation and should be disregarded.

Second, Applicant continually asserts that Opposer has not provided evidence of use of its marks. This assertion is fundamentally flawed since Opposer is entitled to rely upon its existing registrations as a bar under Section 2(d) without showing use of those registered marks. *See Ely & Walker Dry Goods Co. v. Sears, Roebuck & Co.*, 90 F.2d 257, 33 USPQ 549 (CCPA 1937). *See generally* 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20:18 (2011) (Ground of Opposition: Lanham Act § 2(d)—Ownership of Prior Registration).

In view of the foregoing, it is clear that summary judgment is appropriate as to Applicant's Class 25 goods since those goods directly overlap in part with those registered by Opposer and, as noted, the marks are confusingly similar. As to Applicant's Class 24 goods, Applicant acknowledges (Mem. p. 6) that Opposer has submitted evidence linking clothing and blankets. However, Applicant asserts, without evidence or even logic, that "[s]uch evidence itself presents disputed issues of material fact." *Id.* To the contrary, Opposer's evidence stands un-rebutted. At best, Applicant relies on the inappropriate "rock band" limitation to oppose summary judgment as to Class 24, and thus Applicant presents no valid argument in its opposition.

Applicant relies on her own interrogatory response to assert that there is no actual confusion at present and refers to communications with customers (Mem. pp. 7-8). The

latter point must be disregarded since no evidence was submitted. Moreover, there has been little opportunity for evidence of actual confusion to arise and such evidence is not required to hold that there is a likelihood of confusion. *See* Opp. Mem. pp. 10-11.

Finally, Applicant inappropriately relies on an asserted need for discovery. First, Applicant has not, as required, submitted an affidavit or motion in support of her asserted need for discovery. *See* Fed. R. Civ. P. 56(d); 37 CFR § 2.127(e)(1); TBMP 528.06 (3rd Ed. May 2011).[1] Second, Applicant has not pointed to any pending or even proposed discovery that would assist in responding to Opposer's motion and has not pointed out how discovery would so assist Applicant. *See Keebler Co. v. Murray Bakery Products,* 866 F.2d 1386, 1389-90, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989); TBMP 528.06. Third, Applicant cannot argue the merits of her response to summary judgment *and* at the same time also request discovery. *See Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.,* 63 USPQ2d 2009, 2012 n.8 (TTAB 2002); TBMP 528.06.

Accordingly, in view of the foregoing, Applicant has not submitted evidence sufficient to raise a genuine issue of material fact, and Opposer's motion should be granted as to Classes 24 and 25 of Application No. 77919644.

Dated: May 31, 2011

By: _____

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[1] The cited CFR and TBMP refer to an affidavit under Rule 56(f) which was amended, effective December 1, 2010, to 56(d). The Advisory Committee's Notes state, "Subdivision (d) carries forward without substantial change the provisions of former subdivision (f)."

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Certificate of Service

This is to certify that a copy of the foregoing was served this 31st day of May 2011 by first-class mail, postage prepaid, on the following as Applicant's attorney of record:

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