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

Proceeding	91201666
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CUTLERY AND MORE, LLC,
Opposer,

v.

DESALLA TRADING COMPANY,
Applicant.

Opposition No. 91201666

Serial No. 85/156,141

Mark: CUTLERYANDBEYOND

**OPPOSER CUTLERY AND MORE, LLC'S REPLY MEMORANDUM
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

Cutlery and More, LLC ("Opposer") respectfully submits this memorandum in reply to the response in Opposition to Summary Judgment filed by Desalla Trading Company ("Applicant").

This case is ripe for summary judgment. The Applicant is unable to identify any genuine issue of material fact. Specifically, the Applicant did not challenge – and, in fact, ignored – all but one of the duPont factors and fails to address, let alone refute by affidavit or argument, any of the material facts including that instances of actual confusion have already taken place. Clearly, a reasonable fact finder could only conclude that the CUTLERYANDBEYOND mark is likely to cause, and has already caused, actual consumer confusion with the CUTLERYANDMORE.COM mark in the relevant marketplace.

Undisputed Facts

The undisputed material facts in this proceeding include:

- (1) The Opposer owns U.S. Trademark Registration 3,954,102 for the mark CUTLERYANDMORE.COM.

(2) The Opposer first used the CUTLERYANDMORE.COM mark before the Applicant first used the CUTLERYANDBEYOND mark.

(3) The Opposer has continuously used the CUTLERYANDMORE.COM mark in commerce with “On-line retail store services featuring cutlery, cookware, kitchen items and accessories thereof” since the date set forth in its registration.

(4) The Opposer and the Applicant offer services that overlap and are nearly identical.

(6) The letters “C-U-T-L-E-R-Y-A-N-D” appear in the prefatory position in both marks.

(7) There are no restrictions as to channels of trade in the identification of services in the Opposer’s CUTLERYANDMORE.COM registration or in the Applicant’s CUTLERYANDBEYOND application.

(8) The Applicant’s use of the mark CUTLERYANDBEYOND has already caused actual confusion in the marketplace.

Accordingly, these facts are conceded, which clearly entitles Opposer to summary judgment as a matter of law. See Venture Out Properties LLC v. Wynn Resorts Holdings, LLC, 81 USPQ2d 1887, 1890 (TTAB 2007) (granting motion for summary judgment based in part upon the “absence of any contravening evidence from applicant”).

Similarity of the Marks

The only duPont factor to which the Applicant makes any challenge is the similarity of the marks. Specifically, the Applicant provides third party registrations in which “CUTLERY” appears as a separate term, “MORE” appears as a separate term,

and “BEYOND” appears as a separate term. The Applicant posits that such registrations create a genuine issue of material fact. This is not true. A likelihood of confusion analysis must be based on the entirety of a mark and not a dissection of the letters forming the entire mark.¹

However, even if the marks are analyzed piece-by-piece, the CUTLERYANDMORE.COM mark and the CUTLERYANDBEYOND mark share the letters C-U-T-L-E-R-Y-A-N-D. All the letters appear in the prefatory position of the two marks. It is well known that consumers look to the prefix of a mark to determine whether marks are similar.²

The third party registrations proffered by the Applicant do not support that consumers are accustomed to seeing the dominant portion of the mark – “CUTLERYAND” – in the relevant marketplace. Furthermore, the Applicant fails to provide evidence that the third party marks are actually in use. Third party Federal trademark registrations alone do not establish that consumers are accustomed to seeing the marks or constitute evidence of actual use in the marketplace.³ The

¹ “[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. TMEP § 1207.01; In re Nat’l Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (footnote omitted).

² See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); Mattel Inc. v. Funline Merch. Co., 81 USPQ2d 1372, 1374-75 (TTAB 2006); Presto Prods. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895 (TTAB 1988).

³ See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) (submission of third party registrations is not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them). See AMF Inc. v. Am Leisure Prods. Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (third party registrations are not evidence of what happens in the market place or consumer familiarity); Sports Auth. Mich. Inc. v. PC Auth. Inc., 63 USPQ2d 1782, 1798 (TTAB 2001) (third party registrations are not evidence of use or that consumers have been exposed to them); and Red Carpet Corp. v. Johnstown Am. Enter., Inc., 7 USPQ2d 1404, 1406 (TTAB 1988) (third party registrations are not evidence of use to show public awareness of the marks).

probative value of Federal registrations is limited, particularly in the likelihood of confusion context when there is no evidence of actual use of the third party marks.⁴

The Applicant states the proffered third party registrations that include a separate “CUTLERY” term are used with “similar goods and services with that of the Applicant and Opposer”. However, most of the examples provided by the Applicant are for different goods and services than those offered by the Opposer and the Applicant (e.g., Reg. No. 4,276,434 BRADFORDCUTLERY for goods in class 8 and Reg. No. 1,170,683 CUTLERY WORLD for services in class 42). Only three (3) of the twenty-seven (27) examples provided by the Applicant are in the same class of services – class 35 – as the parties’ marks.⁵

In addition, even if all of the proffered third party marks that include the separate “CUTLERY” term are in use in the relevant marketplace (which they are not), each and every mark cited by the Applicant includes one or more distinctive elements not at all present in the Opposer’s mark with which consumers will distinguish the source of goods or services on which those marks are used. Examples of such distinctive elements include design elements or terms such as “WHETSTONE”, “SCHMID BROTHERS”, “KING”, “LAGUNA”, “GOLDEN EAGLE”, and “PCD”.

⁴ See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (third party registrations may not be given any weight in determining strength of a mark); Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (third party registrations have little evidentiary value in determining scope of protection); Tektronix, Inc. v. Daktronics, Inc., 187 USPQ 588 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (little weight on likelihood of confusion); Conde Nast Publ'n Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975) (little weight on question of likelihood of confusion); and Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151, 153 n.2 (TTAB 1983) (third party registration only establishes what appears on its face, that application was made claiming adoption and use and that registration was granted), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

⁵ Opposer does not dispute that others may be using marks including the term CUTLERY outside the online retail store services industry. However, these uses are immaterial.

The Applicant states the proffered third party registrations that include “MORE” as a separate term or “BEYOND” as a separate term “are coexisting in interstate commerce without consumer confusion”; however, again the Applicant fails to provide any evidence that these marks are actually used in interstate commerce or that any of the registrations are directed to services of the relevant marketplace.⁶ In addition, several of the marks the Applicant compares with one another do not fall within the same class of goods and services (e.g., Reg. No. 3,312,015 KITCHEN & BEYOND for goods in classes 6 and 16 compared with Reg. No. 2,956,427 KITCHEN AND MUCH MORE for services in class 35).

Conclusion

There is no genuine issue of material fact regarding the likelihood of confusion between the marks CUTLERYANDMORE.COM and CUTLERYANDBEYOND. Based on instances of actual confusion, the almost identical marks CUTLERYANDMORE.COM and CUTLERYANDBEYOND, essentially identical services, and identical trade channels, it is undeniable that consumers actually have been, and are likely to continue to be, confused by the Applicant’s use of the CUTLERYANDBEYOND mark in the relevant marketplace.

The Opposer respectfully solicits entry of judgment in favor of Opposer and denying registration of CUTLERYANDBEYOND.

⁶ See footnote 3 and footnote 4.

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