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

Proceeding	91210514
Party	Plaintiff Lucky Pup Designs, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LUCKY PUP DESIGNS, INC.,

Opposer,

v.

RACHEL ELIZABETH KENNEDY,

Applicant.

Opposition No. 91210514

Serial No. 85/576,906

Mark: LUCKY PUPPY

**OPPOSER'S TRIAL BRIEF**

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## **I. DESCRIPTION OF THE RECORD**

Opposer Lucky Pup Designs, Inc. (LPD) has entered testimony by declaration, pursuant to written agreement of the parties of:

1. Margaret Wynn, President of LPD, including Exhibits A & B thereto.

LPD has entered Notices of Reliance as follows:

1. Excerpts from Applicant Rachel Elizabeth Kennedy's ("Applicant's") website, including five pages of printouts from Applicant's website showing Applicant's use of the word mark that is the subject of this opposition, the "LUCKY PUPPY" mark, Serial No. 85/576,906 (the "Mark").

2. Google search results for the text string "lucky puppy" showing Applicant's use of the Mark.

3. A published article from Examiner.com titled *Grand Opening Lucky Puppy Rescue and Retail Store in Los Angeles*, and bearing a dateline of November 14, 2012.

All of the above-stated evidence was filed and served on Applicant by Applicant's counsel on April 9, 2014.

The record also includes:

1. The application for the challenged Mark, and all materials submitted in support thereof.

2. The Notice of Opposition filed by LPD.

3. The Answer to the Notice of Opposition filed by Applicant.

Applicant has entered no testimony, filed no notices of reliance, failed to provide any evidence during her testimony period, and failed to respond to any discovery.

## **II. STATEMENT OF ISSUES**

1. Whether the Applicant's Mark, "LUCKY PUPPY," when used on connection with dog clothes, equipment, and accessories, is likely to be confused with LPD's unregistered mark "LUCKY PUP."

2. LPD's Notice of Opposition also identified the false matter in the Mark application as a basis for opposition—specifically the fact that Applicant filed a 1(b) application and did not disclose her actual use of the Mark, despite the fact that she is unquestionably in current and persistent use of the Mark since no later than December of 2012—however, LPD does not have evidence that the false matter was inserted in the application, or that the application was not amended, with the requisite intent to deceive the Office (*In re Bose Corp.*, 580 F.3d 1240, 1243, 91 U.S.P.Q.2D 1938 (Fed. Cir. 2009)). Therefore, while the improper filing basis for the application raises additional problems, including failing to put LPD on notice of actual use in commerce that may or may not tend to show a greater likelihood of confusion, LPD is compelled to withdraw this basis for opposition without prejudice.

## **III. SUMMARY STATEMENT**

LPD's use of its unregistered mark "LUCKY PUP" long predates Applicant's use, or even intention to use the Mark "LUCKY PUPPY." Nonetheless, Applicant applied for the Mark and began to use the Mark, in the Los Angeles region and online, for the exact same type of goods branded by LPD's mark. Although Applicant's application only identifies services, the evidence presented in LPD's notices of reliance demonstrates that Applicant is presently marking dog collars, leads, and other dog clothing and accessories with hangtags bearing the Mark. These tags are used in precisely the same manner as

LPD's mark and for precisely the same goods. Further, hundreds of instances of actual confusion have been documented by LPD among consumers of LPD's products.

Given the lack of evidence from Applicant, it is undisputed that 1) Applicant and LPD are using the respective "LUCKY PUP" and "LUCKY PUPPY" marks on the same goods and in the same regions; 2) LPD's use of the mark predates Applicant's use by many years; 3) the marks are inherently confusing on their face; and 4) consumers have been actually confused between the marks in substantial numbers. For these reasons, LPD respectfully requests the Board sustain this opposition.

#### **IV. STATEMENT OF FACTS**

Opposer LPD has used its "LUCKY PUP" word mark ("LPD Mark") in commerce since no later than 2003. (Decl. Wynn, ¶ 2.) LPD designs, manufactures, and sells designer dog collars, leads, tags, and apparel. (*Id.*) LPD presently distributes its products to brick-and-mortar retail locations in Arizona, California, Colorado, Florida, Georgia, Illinois, Maine, Massachusetts, Missouri, Nevada, New York, Ohio, Oregon, Rhode Island, Texas, Virginia, and Washington, as well as sales reach throughout the world via multiple online retail outlets. (Decl. Wynn, ¶ 6.) At all times since 2003, all of LPD's products have featured the LPD Mark and logo. (Decl. Wynn, ¶¶ 2-3, 5; Exs. A & B thereto.) LPD is based in Los Angeles. (Decl. Wynn, signature line bearing Los Angeles location.)

Applicant filed an ITU application for the Mark "LUCKY PUPPY" on March 22, 2012. (Application Serial No. 85/576,906.) Applicant began actual use of the Mark no later than December 8, 2012. (Notice of Reliance, *Grand Opening Lucky Puppy Rescue and Retail Store in Los Angeles*, examiner.com (Nov. 14, 2012).) Applicant presently

brands her retail store under the Mark. (Notice of Reliance, Google search results (accessed April 9, 2014).) Applicant presently sells goods branded with hangtags featuring the Mark. (Notice of Reliance, luckypuppyrescueandretail.com website printouts (accessed April 9, 2014).) The goods sold by Applicant under the Mark include dog collars, leads, tags, and apparel. (*Id.* [photographs on the website depict rows of these products bearing hangtags].) Applicant's store is located in Los Angeles. (Notice of Reliance, luckypuppyrescueandretail.com website printouts (accessed April 9, 2014).)

Almost immediately upon Applicant's actual use of the Mark, evidence of actual consumer confusion with LPD's unregistered mark began to mount. For example, for the twelve-month period from December 2012 to December 2013, LPD received approximately 606 telephone calls from confused consumers who thought that they were calling the store operated under Applicant's purported mark "LUCKY PUPPY." These calls asked for anything from store hours, to what dog apparel products were carried, to whether certain dogs were available for adoption. (Decl. Wynn, ¶ 7.)

## **V. STANDING TO OPPOSE**

Any person who believes that he would be damaged by the registration of a mark may oppose the registration. 15 U.S.C. § 1063(a). For such a person to have standing, they must have a real interest in the outcome of the proceeding, and a reasonable belief that their rights would be damaged as a result of registration. *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 U.S.P.Q.2D 1023 (Fed. Cir. 1999).

Here, LPD has a real interest in the outcome of the present application, or that its rights will be damaged as a result of the registration. LPD is the undisputed user of the LPD Mark "LUCKY PUP" for dog accessories, clothes, and equipment. LPD has more

than nine years of consumer goodwill and identification of “LUCKY PUP” with its products. The Mark “LUCKY PUPPY” is confusingly similar on its face and undisputedly has resulted in actual confusion among consumers seeking to buy dog accessories and products. LPD’s mark is infringed by Applicant’s Mark and diluted by its presence in the marketplace. Accordingly, LPD has standing here.

## **VI. LEGAL ARGUMENT**

### **A. Applicant’s Mark is Likely to Cause Confusion**

The Lanham Act prohibits registration of a mark that would be likely to cause confusion, mistake or deception based on a registered mark previously used in the United States by another and not abandoned. 15 U.S.C. § 1052(d). Both the TTAB and the Court of Appeals for the Federal Circuit have also refused registration based on the likelihood of confusion with an established mark. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 U.S.P.Q.2D 1157 (Fed. Cir. 2014). The rule applies regardless of whether the established mark is registered. 15 U.S.C. § 1052(d) (registration improper where confusion likely with another registered mark or “a mark or trade name previously used in the United States by another and not abandoned”).

The TTAB determines whether there is a likelihood of confusion based on the following factors: (i) the similarity of the marks; (ii) the similarity of the goods designated in the application to the goods with which the prior mark or family is associated; (iii) the respective channels of trade; (iv) the conditions of sale and the intended customers; (v) the strength and scope of the prior mark; (vi) the number and nature of similar marks in use on similar goods; and (vii) any evidence of actual confusion or the absence thereof (the “*Du Pont* factors”). *In re E.I. Du Pont de Nemours*

*& Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). In this case, all applicable *Du Pont* factors weigh towards a likelihood that the Applicant's Mark is confusingly similar to LPD's mark.

First, the marks are essentially identical on their face. "Lucky Puppy" and "Lucky Pup" are identical in meaning and tone. They look the same, they sound the same, they mean the same things, and they evoke the same mental image. The only difference is the two letters on the end of the last word, "py," that Applicant added to her Mark. In the Random House Dictionary, "puppy" is actually included in the first definition of "pup."

Second, the goods identified are identical. While Applicant appears to use the Mark with a wider variety of products (and has a designated ITU class of services), at a minimum, every product that LPD identifies with the LPD Mark (Decl. Wynn, ¶ 2), is also offered by Applicant with a hangtag and the Mark (Notice of Reliance, Applicant's website). Regardless the Applicant's stated intent to use, or her actual use of the Mark, every right that LPD has to identify its goods with the LPD Mark is injured by Applicant's use of the Mark on the same goods, and for similar goods—namely dog equipment, accessories, and clothes of all varieties.

As to the Third and Fourth factors, Applicant's channels of trade are wholly within LPD's channels of trade. As to geography, both are located in Los Angeles, although LPD sells throughout California, and several other states and countries. (Decl. Wynn, ¶ 6; Notices of Reliance, Applicant's website, Google search results.) Both sell consumer products to consumers. (Decl. Wynn, ¶¶ 2, 4, 6, 7; Notices of Reliance,

Applicant's website, examiner.com article.) Both sell dog accessories to dog owners.  
(*Id.*)

Fifth, LPD does not offer a survey or similar direct evidence of the strength of its mark under these circumstances. However, LPD submits that the massive extent of actual consumer confusion (Decl. Wynn, ¶ 7) is circumstantial evidence that LPD's LPD Mark is strong.

Sixth, the only evidence in this proceeding is Applicant's Mark and the LPD Mark. LPD is not presently aware of other users of the words Lucky Pup or Lucky Puppy in the United States for dog collars, leads, clothes, and accessories.

Seventh, the evidence of actual confusion is strong. LPD has documented over 600 cases of actual consumer confusion between Applicant's Mark and the LPD Mark. (Decl. Wynn, ¶ 7.) While some subset of these instances of confusion were not strictly for the products that LPD provides (e.g., some calls related to dog adoption), at a minimum, all of the instances of consumer confusion related to calls from consumers in the consumer pet products market.

Since all *Du Pont* factors weigh in favor of a finding of consumer confusion, and most weigh extremely heavily in favor of consumer confusion, Applicant's Mark has a high likelihood of confusion with the LPD Mark and should not be registered.

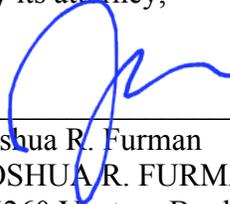
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**VII. CONCLUSION**

In light of the foregoing, Opposer Lucky Pup Designs, Inc. respectfully requests that this opposition be sustained and that Applicant’s application for the mark “LUCKY PUPPY” be refused.

LUCKY PUP DESIGNS, INC.

By its attorney,



Dated: August 22, 2014

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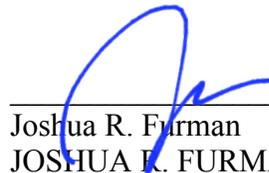
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF RELIANCE was served upon the following Applicant by first class mail on August 22, 2014, by Applicant’s counsel of record:

Pollie Gautsch, Esq.  
G&A Legal, APC  
2033 San Elijo Avenue, Suite 201  
Cardiff, CA 92007-1726

Dated: August 22, 2014



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