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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 REPLY BRIEF

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I. INTRODUCTION

The undisputed evidence in this case is that Lucky Pup Designs, Inc. (“LPD”) has used the mark “LUCKY PUP” in commerce in connection with dog accessories and clothes since no later than 2003—for at least nine years longer than Applicant’s use of “LUCKY PUPPY” on the same goods. It is further undisputed that in the first year that Applicant began using “LUCKY PUPPY,” there were over 600 instances of actual consumer confusion between Applicant’s use of “LUCKY PUPPY” and Opposer’s use of “LUCKY PUP.”

Flying in the face of that conclusive, undisputed evidence, Applicant now argues that LPD cannot establish that it had priority of use because, “the USPTO has not had a chance to determine if the trademark LUCKY PUP is protectable because it has not been filed for in the USPTO registry.” (Applicant’s Main Brief [AMB], unnumbered fifth page.) Amazingly, the lynchpin of Applicant’s argument is that LPD can never have trademark interests in “LUCKY PUP” because it is unregistered. This argument is simply incorrect. Trademark registration can afford certain presumptions in some circumstances, but is virtually meaningless in a § 2(d) opposition.

Applicant then argues that “LUCKY PUPPY” is not confusingly similar with “LUCKY PUP” because of some third party registrations that it now cites to the Board. These other registrations are irrelevant. In any event, the Board may not consider them because Applicant failed to serve and file a notice of reliance on these registrations and they may not be incorporated into the record by citation in a party’s brief.

Finally, Applicant argues that the classes of goods and services identified in her application are not similar to the goods marked with “LUCKY PUP” by LPD. This

argument exhibits bad faith by Applicant because Applicant admittedly does sell the same goods as LPD, and Applicant brands those goods with “LUCKY PUPPY;” however Applicant filed under 035 retail services class only. The application description of services reads: “retail store services featuring pet food and pet supplies, online retail store services featuring pet pet [sic] food and pet supplies.” Applicant argues that since she only sells pet products “made by others” that the goods and services identified by her application cannot be closely related to LPD’s goods. AMB, unnumbered eighth page.

First, Applicant concedes that it actually sells “pet products” currently. *Id.* This is consonant with the evidence provided in support of this opposition by LPD. (*See* Notice of Reliance, luckypuppyrescueandretail.com website printouts (accessed April 9, 2014).) Although Applicant only indicated an ITU filing basis, and then only for the retail services, the evidence is undisputed that Applicant presently, and for some time, has used the “LUCKY PUPPY” mark to brand dog collars, leads, clothes, and accessories. Accordingly, Applicant’s statement is simply factually untrue. The distinction made by Applicant, that LPD sells the products it produces, while Applicant only sells products others produce, is immaterial because both sell to the same consumer market.

Second, Applicant’s attempt to mislead the Board by relying on the admittedly incorrect statement in its application—that it only uses its mark with services, not goods—cannot form a good faith basis to respond to this opposition. The Applicant’s actual use of the mark is broader than its stated intent to use the mark. The Applicant’s unexcused failure to properly apprise the USPTO of its actual use of the mark, or even that it was actually using the mark, cannot help it sidestep LPD’s opposition here.

This is the undisputed evidence: LPD has used “LUCKY PUP” in commerce on dog collars, leads, clothes, and accessories for over 11 years. Applicant uses “LUCKY PUPPY” on the exact same goods, but only started doing so less than two years ago. There have been over 600 instances of actual confusion in the first 12 months of Applicant’s operations. Both parties operate in the Los Angeles area, and LPD operates across the country. This undisputed evidence forms the classic fact pattern for a § 2(d) opposition. Based on these facts, the opposition must be sustained.

II. LEGAL ARGUMENT

A. Trademark Registration is Not a Prerequisite to Opposition

It is axiomatic that an opposer’s trademark need not be registered before it has standing to oppose a registration.

In an opposition founded on § 2(d), opposer must prove that it has proprietary rights in the term it relies upon to prove likelihood of confusion. The proof could consist of ownership of a registration, prior use of an unregistered mark, prior use in advertising, or as a trade name, or any other type of use which has resulted in establishing a trade identity

Malcolm Nicol & Co. v. Witco Corp., 881 F.2d 1063, 1065 [11 USPQ2d 1638] (Fed. Cir. 1989) (quoting 1 J. McCarthy, Trademarks and Unfair Competition § 20:4 at 1023-26 (1984)).

Here, LPD presented uncontroverted evidence that (1) LPD has been using “LUCKY PUP” since 2003 (Decl. Wynn, ¶ 2); (2) LPD has used “LUCKY PUP” since 2003 to brand dog collars, leads, clothes, and accessories (Decl. Wynn, ¶ 2–3, 5–6); and

(3) “LUCKY PUP” has acquired secondary meaning associated with LPD based on the high volume of actual consumer confusion (Decl. Wynn, ¶ 7). *See, e.g., N.Y. State Elec. & Gas Corp. v. U.S. Gas & Elec., Inc.*, 697 F.Supp.2d 415, 430 (W.D.N.Y. 2010) (“[a]ctual confusion shows at least some amount of secondary meaning”) (quoting *Vision Center Northwest, Inc. v. Vision Value LLC*, No. 07-CV-183, 2007 WL 3256647, at *5 (N.D. Ind. Nov. 1, 2007)) (also citing *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 381 (7th Cir. 1976); *Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc.*, 149 F.3d 722, 728 (7th Cir. 1998) [“Actual confusion logically must be an indication of at least some amount of secondary meaning”] [Wood, J., dissenting]; *Charles Jacquin Et Cie, Inc. v. Destileria Serralles, Inc.*, 921 F.2d 467, 472 n.5 (3d Cir. 1990)). Applicant introduced no evidence whatsoever, let alone evidence that might contradict any of these elements of LPD’s standing. Accordingly, LPD clearly has standing to pursue this opposition, and has produced more than sufficient evidence to prove the foundational elements of its § 2(d) opposition.

B. The Substantial Scale of Actual Confusion Proves Likelihood of Confusion

LPD has presented ample evidence of actual confusion on the part of consumers seeking to purchase dog accessories. In the first year of Applicant’s operations, LPD logged over 600 phone calls placed by consumers in the relevant market. The Declaration of Margaret Wynn, LPD’s president, documents: “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.

No evidence was provided by Applicant, and Applicant refused to respond to discovery that would have shown the levels of actual confusion by consumers seeking LPD’s goods from Applicant. Nonetheless, in its brief, Applicant admitted that it “is a small non-profit, has limited resources and time due to the nature and current state of its business.” AMB unnumbered eighth page. Based on this information, it is not difficult to deduce that over 600 consumer inquiries in the space of a year represents a substantial amount of consumer confusion.

“Evidence of actual confusion is not necessary to prove likelihood of confusion, **but actual confusion is substantial proof of the existence of the likelihood of confusion.**” *Malarkey-Taylor Assocs. v. Cellular Telcoms. Indus. Ass’n*, 929 F.Supp. 473, 477 [40 USPQ2d 1136] (D.D.C. 1996) (emphasis added) (citing *Sears, Roebuck and Co. v. Sears Financial Network*, 576 F. Supp. 857, 861 [221 USPQ 581] (D.D.C. 1983)). See also, e.g., *Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 852–853 [23 USPQ2d 1471] (Fed. Cir. 1992) (“Evidence of actual confusion can constitute strong proof of likelihood of confusion”); *Swatch, S.A. v. Beehive Wholesale, L.L.C.*, 888 F.Supp.2d 738, 755 (E.D. Va. 2012) (“actual confusion is ‘often paramount’ in a court’s analysis”).

LPD has proven actual consumer confusion by a wide margin. Applicant offers no evidence to controvert LPD’s proof. Accordingly, LPD’s opposition on the grounds that Applicant’s mark is likely to cause confusion with LPD’s senior mark should be sustained.

C. Applicant's Citation to Evidence Outside the Record Should Not Be Considered

On the seventh and eighth unnumbered pages of her brief, Applicant cites to a number of third party applications not in the record on this opposition. While the nothing in those citations is probative of any issue in this opposition (the primary application discussed was abandoned when the applicant failed to respond to an office action), none of the third party applications are before the Board because Applicant failed to serve and file any notices of reliance.

The Board may not consider any registrations, other than the Applicant's registration (or a plaintiff's pleaded registration, if applicable), unless they are introduced into evidence. *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009) (“[W]ith the exception of a plaintiff's pleaded registrations, which may be filed along with the petition to cancel or notice of opposition, documents and other exhibits may be made of record only during the testimony period of the offering party in the following two ways: (1) they may be introduced by a witness during the course of a deposition, and (2) they may be submitted pursuant to a notice of reliance filed with the Board”); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) (“In its brief, opposer listed a seventh registration, but it was not pleaded and a copy was not made of record by notice of reliance (NOR) or through testimony, so it has not been considered.”). Applicant never provided any submissions to the record. She cannot ask the Board to consider matters outside the record now.

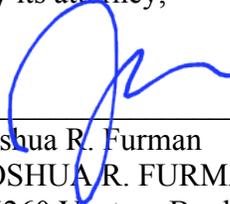
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III. CONCLUSION

In light of the foregoing, LPD respectfully requests the Board sustain this opposition and deny Applicant's trademark registration.

LUCKY PUP DESIGNS, INC.

By its attorney,



Dated: October 6, 2014

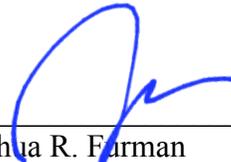
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S REPLY BRIEF was served upon the following Applicant by first class mail on October 6, 2014, by Applicant's counsel of record:

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Dated: October 6, 2014



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