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

Proceeding	92029390
Party	Defendant FLORENCE FASHIONS LIMITED
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VALENTINO COUTURE, INC.,)	
VALENTINO S.P.A.,)	
Petitioners/Opposers,)	
v.)	Opposition No. 91094961
FLORENCE FASHIONS (JERSEY))	Opposition No. 91095203
LIMITED,)	
Applicant/Respondent.)	Cancellation No. 92029390
)	Cancellation No. 92029476

**FLORENCE FASHIONS’ SUR-REPLY TO
OPPOSERS’ MOTION FOR SUMMARY JUDGMENT**

In an effort to eliminate the glaring disputed issue of fact, in their Reply Brief, Petitioners and Opposers Valentino Couture, Inc. and Valentino S.p.A. (together, “Opposer”) simply ignore the evidence submitted by Florence Fashions (Jersey) Limited (“Florence Fashions”). Opposers’ distortion of the record warrants a brief response:

- Genuine issues of material fact clearly exist as to the issue of Florence Fashions’ alleged “bad faith” adoption of the marks at issue. First, Opposer ignores the threshold question that clearly defeats its argument: the marks are not *identical*, and in order to make a claim of bad faith in this context (as even Opposer admits on page 24 of its initial brief), they *must* be identical. Second, Opposer’s own conduct, as discussed in paragraph 21 of Annabella Valentino’s affidavit and supporting Exhibits N-O, compels a finding that Florence Fashions did not adopt the marks in bad faith. Opposer cannot be permitted to now take the directly contrary position that Giovanni Valentino and Florence Fashions are not beneficiaries to the 1979 Agreement simply because it suits its present purposes. The record evidence compels otherwise.
- Opposer’s position that the international proceedings between the parties, the vast majority of which have resulted in favorable rulings for Florence Fashions, are irrelevant to the proceedings here is wrong as a matter of law. Opposer’s Reply Br. at 5. “The absence of actual confusion between the same marks in other countries is relevant to the issue of likelihood of confusion in this country.” CALLMAN, § 21:64. Moreover, Opposer’s assertion (Reply Br. at 5) that Vincenzo and Mario Valentino did not use the VALENTINO marks in the United States is flatly wrong. *See, e.g.*, Annabella Valentino

Aff., ¶6-7; Exhibit D (reflecting that Mario Valentino had a boutique on East 57th Street in New York, New York as early as 1954, in which he sold leather goods under the VALENTINO brand -- usage that predated *Opposer's* U.S.-based use by over a decade).

- Opposer asserts on the first page of its Reply Brief that Florence Fashions has not contested the alleged fame of Opposer's trademark. Florence Fashions sets forth, in the Affidavit of Annabella Valentino, that the Valentino name was made famous not by Valentino Garavani (Opposer) but by Vincenzo and Mario Valentino, Giovanni Valentino's grandfather and father, respectively. The rights to the famous Valentino name passed to Giovanni Valentino and Florence Fashions, as even Opposer has recognized in other judicial forums.
- Despite submitting two briefs in support of its Motion, Opposer has failed to address the issue that the marks are significantly different, phonetically and facially. As explained in the cases cited by Florence Fashions on page 17 of its Opposition, the use of one common word as part of a two word mark, especially where the different words are surnames, weighs strongly against any finding of summary judgment in favor of the Opposer.
- Opposer similarly fails to address the long-term co-existence of its marks with those of Mario Valentino S.p.A., founded and operated by Giovanni Valentino's father. As set forth in Exhibit E to Annabella Valentino's declaration, Opposer recently withdrew its opposition to several VALENTINO marks owned by Mario Valentino S.p.A. and allowed them to proceed to registration.

For the reasons discussed herein, and as stated in Florence Fashions' Opposition Brief, Opposer's Motion for Summary Judgment should be denied based on the existence of disputed issues of material fact.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing FLORENCE FASHIONS' SURREPLY TO OPPOSERS' MOTION FOR SUMMARY JUDGMENT was served with a Certificate of Service by U.S. mail, first class, postage prepaid, on this 10th day of May 2007 on the following:

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