

**THIS DECISION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. BOX. 1451  
Alexandria, Virginia 22313-1451**

Mailed: May 19, 2008

Opposition Nos. 91094961  
91095203

Cancellation Nos. 92029390  
92029476

Valentino Couture, Inc.<sup>1</sup>

v.

Florence Fashions  
(Jersey) Limited

Before Zervas, Kuhlke and Walsh, Administrative Trademark  
Judges.

Kuhlke, Administrative Trademark Judge:

These consolidated cases now come before the Board for  
consideration of opposer/petitioner's (plaintiff) motion for

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<sup>1</sup> There is only one plaintiff in these consolidated cases, Valentino Couture, Inc. Both notices of oppositions and petitions for cancellation name one plaintiff, and fees were submitted for one plaintiff in each proceeding. (In Cancellation No. 92029476, the original petition also named Valentino Globe B.V. as a petitioner; however, petitioner amended the complaint to clarify that only Valentino Couture, Inc. was the petitioner, which was accepted and entered by the Board on January 26, 2001.) We note that approximately a decade after the first notice of opposition was filed, plaintiff, in a December 23, 2004 a motion to extend the scheduling order, included Valentino S.p.A. in the caption of its motion. However, it does not appear from a review of the case files that a motion to join or substitute a party has been filed. Thereafter, routine Board orders issued by the paralegal inadvertently included Valentino S.p.A. in the caption. These were clerical errors; Valentino S.p.A. has not been joined as a party plaintiff. See generally TBMP §512.01 (2d ed. rev. 2004) (motions to join or substitute parties).

summary judgment on the claim of likelihood of confusion under Section 2(d) of the Trademark Act. The motion has been fully briefed.<sup>2</sup>

Plaintiff has brought these proceedings challenging applicant/registrant's (defendant) registration of the marks GIOVANNI VALENTINO and GIANNI VALENTINO in typed form for use in connection with various clothing items, including footwear, scarves, belts, shirts, skirts, and various leather items, including attache cases, handbags, purses, cases for men's toiletries sold empty and garment bags for travel. Plaintiff alleges, inter alia, that it "is and for many years has been solely and exclusively authorized and licensed to market in this country clothing and an extensive line of accessory items bearing the said VALENTINO and VALENTINO GARAVANI trademarks. In addition, [plaintiff] is entitled to and has authorized others in this country to use the trademarks VALENTINO and VALENTINO GARAVANI.... Since long prior to ...the constructive date of first use claimed by [defendant], [plaintiff] has used and continues to use the trademarks VALENTINO and VALENTINO GARAVANI for men's and womens' clothing and accessories, such as dresses,

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<sup>2</sup> The Board has exercised its discretion and has considered plaintiff's reply brief. Trademark Rule 2.127(e). Defendant's motion to file a sur-reply brief is denied and the Board has not considered this filing. Trademark Rule 2.127(e) ("No further papers in support of or in opposition to a motion for summary judgment will be considered by the Board.")

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skirts, blouses, suits, jackets, coats, sweaters, shirts, trousers, vests, shorts, swimwear, footwear, hats, lingerie, ties, belts, scarves, hosiery, gloves, handbags, brief cases, umbrellas and costume jewelry." Notices of Opposition and Petitions to Cancel ¶¶ 1 and 2. Plaintiff further alleges that defendant's marks so resemble plaintiff's names and marks as to be likely, when applied to defendant's goods to cause confusion, to cause mistake or to deceive. ¶ 8.

Plaintiff has pleaded several registrations incorporating the term VALENTINO registered for, inter alia, a variety of clothing items, umbrellas and retail store services. Plaintiff further alleges that the registrations "are valid and subsisting, unrevoked and uncanceled, and [plaintiff] is now exclusively authorized and licensed to use said registered trademarks in the United States." ¶ 6.

In its answers, defendant denies the salient allegations.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's

favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

In support of its motion for summary judgment, plaintiff argues that it has priority based on the pleaded registrations. However, as noted above, the plaintiff in these proceedings is Valentino Couture, Inc. The pleadings do not allege that it is the owner of these registrations but rather that it is the licensee. Further, the copies of the registrations submitted under the declaration of Thomas D. Lyford, counsel for plaintiff, are not status and title copies and the declaration does not attest to their validity or ownership. While the copies have been annotated by someone, indicating that Valentino S.p.A. is the current owner, that is not sufficient to establish their status and title. More importantly, as noted above, Valentino S.p.A. is not a party to this proceeding. As such, plaintiff, a licensee, may not rely on the presumptions accorded under Section 7(b) of the Trademark Act. See *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986). See also TBMP § 704.03(b)(1)(B) (2d. ed. rev. 2004). As to actual use, the record is not clear as to plaintiff's use. One declaration by Carmine Pappagallo attests only to sales occurring since 2003. The copy of a declaration by Graziano De Boni submitted in a civil action attests to use by Valentino USA Inc., Valentino S.p.A. and

Valentino Globe B.V., but not Valentino Couture, Inc. Thus, genuine issues of material fact remain as to priority.

Moreover, upon careful consideration of the arguments and evidence presented by the parties on the likelihood of confusion factors, and drawing all inferences in favor of defendant, we find that plaintiff has not demonstrated the absence of genuine issues of material fact. We find that there are genuine issues of fact, at a minimum, with respect to the similarity of the marks, the strength of plaintiff's marks and the scope of protection to be accorded them.<sup>3</sup> Accordingly, plaintiff's motion for summary judgment is denied.<sup>4</sup>

Discovery is closed and trial dates are reset as indicated below. We note that the scheduling order sets the trial to begin in the fall. We urge the parties to consider and engage in settlement negotiations over the summer. Inasmuch as these proceedings have been pending for between eight and fourteen years, the Board **will not grant any**

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<sup>3</sup> We also note, that it is unclear from the record the extent to which, if at all, the prior agreement affects the parties' respective trademark rights in the United States.

<sup>4</sup> The Board reminds the parties that any evidence submitted in support of or opposition to a summary judgment motion is only considered of record for the purposes of that motion. See TBMP § 528.05(a). If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record and will not be considered at final hearing unless it is properly introduced in evidence, during the appropriate trial period.

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**further extensions or suspensions.** These proceedings will  
either settle over the summer or go to trial in the fall.

DISCOVERY PERIOD TO CLOSE: **closed**

Testimony period for party in position of plaintiff to  
close: **October 31, 2008**

Testimony period for party in position of defendant to  
close: **December 30, 2008**

Rebuttal testimony period to close: **February 13, 2009**

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