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

Proceeding	92052525
Party	Plaintiff Kohl's Department Stores, Inc.
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Date	08/04/2010
Attachments	Response to Motion to Suspend Petition for Cancellation .PDF ( 9 pages ) (409688 bytes )

1 **IN THE UNITED STATES**  
2 **PATENT AND TRADEMARK OFFICE**  
3 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**  
4

5 In the matter of:

6 KOHL'S DEPARTMENT  
7 STORES, INC., petitioner,  
8 v.  
9 PEACE & LOVE JEWELRY BY  
10 NANCY DAVIS LLC,  
11 registrant/respondent.  
12

**Cancellation No. 92052525**

Registration No.: 3,779,506

Date of Issue: April 20, 2010

Registration No.: 3,779,507

Date of Issue: April 20, 2010

13  
14 **RESPONSE TO MOTION TO SUSPEND PETITION FOR CANCELLATION**  
15 **AND MEMORANDUM IN SUPPORT OF RESPONSE**  
16

17 **RESPONSE TO MOTION TO SUSPEND PETITION FOR CANCELLATION**

18 Pursuant to 37 C.F.R. §§ 2.119(c) and 2.127(a), Kohl's Department Stores,  
19 Inc. ("Kohl's") hereby submits its response to the Motion to Suspend Petition for  
20 Cancellation filed by Peace & Love Jewelry by Nancy Davis, LLC ("Nancy Davis").  
21 This response opposes Nancy Davis' request to suspend these Cancellation proceedings  
22 ("Cancellation") on the grounds that the civil action identified in Nancy Davis' moving  
23 papers is not dispositive on this Cancellation and should not be deemed to have a  
24 bearing on this Cancellation. The reasons supporting this response are more fully set  
25 forth in the attached Memorandum in Support of Response to Motion to Suspend  
26 Petition for Cancellation.

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1 **MEMORANDUM IN SUPPORT OF**  
2 **RESPONSE TO MOTION TO SUSPEND PETITION FOR CANCELLATION**  
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4 **I. Introduction**

5 Nancy Davis' Motion to Suspend Petition for Cancellation ("Motion") should  
6 be denied because the registered trademarks that are at issue in the case *Peace & Love*  
7 *Jewelry by Nancy Davis, LLC v. Kohl's Department Stores, Inc.*, United States Central  
8 District of California Case No. CV10-0417 GW (VBKx) ("Federal Court Case"), are  
9 not dispositive of, and should not be deemed to have a bearing on, United States  
10 Trademark Registration Nos. 3,779,506 ("506 Mark") and 3,779,507 ("507 Mark")  
11 which are the subject of these Cancellation proceedings. In particular, the trademarks at  
12 issue in the Federal Court Case solely apply to Class 14 goods (jewelry and watches),  
13 whereas the '506 Mark applies to goods from Class 18 (handbags), and the '507 Mark  
14 applies to goods from Classes 18 (handbags) and 25 (clothing).<sup>1</sup> Accordingly, Nancy  
15 Davis' Motion to suspend these Cancellation proceedings should be denied.

16  
17 **II. Facts**

18 Registration for the '506 Mark was granted on April 20, 2010. The '506 Mark  
19 consists of the words "Peace & Love" and design of a heart with a superimposed peace  
20 symbol. The '506 Mark was registered on the Principal Register, in international class  
21 18 for handbags, tote bags, purses, and shoulder bags.

22 Registration for the '507 Mark was granted on April 20, 2010. The '507 Mark  
23 consists of a heart with a superimposed peace symbol. The '507 Mark was registered  
24 on the Principal Register, in international class 18 for handbags, tote bags, purses, and  
25 shoulder bags; and international class 25 for clothing, namely, t-shirts, shirts,  
26

27 <sup>1</sup> The trademark application identified in Nancy Davis' moving papers (trademark  
28 application No. 77813776) is likewise not at issue in the Federal Court Case. (*See*  
*Motion, Ex. 2 at ¶ 9.*)

1 sweatpants, jeans, pants, dresses, shorts, tops, bottoms, headwear, headwear accessories,  
2 namely, scarves, head bands, berets, hats; footwear, and belts.

3 Nancy Davis filed the Federal Court Case on January 20, 2010. (*See* Motion,  
4 Ex. 2.) The only marks at issue in the Federal Court Case are United States Trademark  
5 Registration Nos. 2,989,992, 3,193,106, and 3,193,107. (*See* Motion, Ex. 2 at ¶ 9.)  
6 Each of these marks is registered solely for jewelry and watches in Class 14 goods.  
7 (*See* Motion, Ex. 1.)

8 The time for Nancy Davis to amend the Complaint in the Federal Court Case  
9 expired on May 21, 2010. Nevertheless, Nancy Davis has filed a motion to supplement  
10 its Complaint (“Motion to Supplement Complaint”) in the Federal Court Case to add the  
11 ‘506 and’507 Marks to that action. (*See* Motion, Ex. 4.) Kohl’s has opposed the  
12 Motion to Supplement Complaint, which hearing is scheduled for August 5, 2010.

13  
14 **III. Argument**

15 If Nancy Davis is successful in supplementing its Complaint to add the ‘506  
16 and ‘507 Marks, then Kohl’s does not dispute that the Federal Court Case at that point  
17 would have a bearing on these Cancellation proceedings. For this reason, Kohl’s  
18 respectfully requests that the Board await the decision by the Federal Court on the  
19 Motion to Supplement Complaint before issuing its ruling on this pending Motion.  
20 However, as it stands now, the ‘506 and ‘507 Marks are not part of the Federal Court  
21 Case. Accordingly, unless Nancy Davis succeeds on its Motion to Supplement  
22 Complaint, then (for the reasons articulated below) this Cancellation should not be  
23 stayed.

24 At its core, Nancy Davis’ Motion argues that these Cancellation proceedings  
25 should be stayed because the ‘506 and ‘507 Marks use a similar peace/love design as  
26 the marks at issue in the Federal Court Case. However, the marks at issue in the  
27 Federal Court Case are for an entirely different category of goods (Class 14 goods:  
28 jewelry and watches) as compared to the goods associated with the ‘506 and ‘507

1 Marks (Class 18 goods: accessories, and Class 25 goods: clothing). Thus, even if the  
2 marks do have a similar design, their use on their respective goods will vary  
3 significantly, and must be determined on a class-by-class basis. *See, e.g., American*  
4 *Hygienic Laboratories Inc. v. Tiffany & Co.*, 12 U.S.P.Q.2d 1979, 1989 WL 274397  
5 (T.T.A.B. 1989) (prior use of TIFFANY on jewelry, silver and china does not have  
6 rights superior to a later, intervening user, of TIFFANY “E” on cosmetics); *Clark &*  
7 *Freeman Corp. v. Heartland Co. Ltd.*, 811 F. Supp. 137 (S.D.N.Y. 1993) (a senior user  
8 of HEARTLAND on women’s boots and shoes could not, by launching a line of  
9 clothing, prevent an intervening user’s good faith use of the HEARTLAND mark on  
10 shirts); *American Steel Foundries v. Robertson*, 269 U.S. 372, 382, 46 S. Ct. 160 (1926)  
11 (probability of confusion when goods are different is “more remote than when the  
12 articles are of like kind”); *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361,  
13 177 U.S.P.Q. 563 (C.C.P.A. 1973) (identifying thirteen-point test used in Federal  
14 Circuit to determine likelihood of confusion, including “[t]he similarity or dissimilarity  
15 and nature of the goods or services as described in an application or registration”);  
16 *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348, 204 U.S.P.Q. 808 (9th Cir. 1979)  
17 (identifying eight-factor test used in Ninth Circuit to determine likelihood of confusion,  
18 including “proximity of the goods”). Indeed, the cases cited above illustrate that  
19 trademark rights for one category of goods is not dispositive to trademark rights in a  
20 different category of goods.

21 Furthermore, the dissimilar nature of goods between the ‘506 and ‘507 Marks  
22 and the marks in the Federal Court Case means that any ruling that the federal court  
23 might make as to Nancy Davis’ peace/love design for Class 14 goods (watches and  
24 jewelry) will have no bearing on a determination as to Nancy Davis’ alleged rights to  
25 use a peace/love design on goods from Classes 18 (handbags) and 25 (clothing). *See* 37  
26 C.F.R. § 2.117(a) (allowing discretionary suspension of TTAB proceedings only where  
27 “the parties to a pending case are engaged in a civil action or another Board proceeding  
28 which may have a bearing on the case”) (emphasis added); *see also* T.B.M.P. 510.02(a)

1 (similar). In other words, even if the Federal Court Case determines that Nancy Davis  
2 has valid marks for Class 14 goods, this has no bearing on whether Nancy Davis has  
3 valid marks for Class 18 or 25 goods. Similarly, even if the Federal Court Case  
4 determines that Nancy Davis' use of the peace/love design on jewelry is distinctive, this  
5 does not mean that Nancy Davis' use of the peace/love design on clothing or  
6 accessories is distinctive.

7           Simply put, the '506 and'507 Marks are not at issue currently in the Federal  
8 Court Case. There are no allegations in either the Federal Court Case or these  
9 Cancellation proceedings that Kohl's has infringed the '506 or '507 Marks. There is  
10 also no current claim for declaratory judgment with respect to the '506 or '507 Marks.  
11 The Marks are simply not currently involved in the Federal Court Action. The only  
12 allegations involving the '506 and '507 Marks are those by Kohl's in these proceedings  
13 that these marks should be cancelled. Thus, there are no grounds for concern over any  
14 inconsistent rulings should these Cancellation proceedings be allowed to proceed.

15           Finally, it should be noted that federal courts have repeatedly recognized the  
16 expertise and specialized knowledge of the TTAB in trademark disputes such as this.  
17 *See, e.g., Citicasters Co. v. Country Club Communications*, 44 U.S.P.Q.2d 1223, 1997  
18 WL 715034 (C.D. Cal. 1997) (stay of federal action granted because of "the efficiencies  
19 generated by the TTAC first addressing the issues involved in this matter," and because  
20 "the court is confident that the TTAB will exercise its specialized knowledge in  
21 effecting a determination that will prove valuable to this court"); *see also Driving*  
22 *Force, Inc. v. Manpower, Inc.*, 498 F. Supp. 21, 211 U.S.P.Q. 60 (E.D. Pa. 1980)  
23 (Trademark Board is "better equipped than are the courts" to determine trademark  
24 matters). Nancy Davis' Motion should accordingly be denied.

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1        **IV.    Conclusion**

2                    For the foregoing reasons, Kohl’s respectfully requests that Nancy Davis’  
3 Motion to Suspend Petition for Cancellation be denied and that the Cancellation  
4 proceedings be allowed to proceed.

5  
6 Dated: August 4, 2010

By:           /Vonn R. Christenson/            
      Vonn R. Christenson

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1 **CERTIFICATE OF SERVICE**  
2 (United States District Court)

3 I am employed in the County of Orange, State of California. I am over the age of  
4 18 and not a party to the within action; my business address is 610 Newport Center  
5 Drive, Suite 700, Newport Beach, CA 92660.

6 On August 4, 2010, I have served the foregoing document described as  
7 **RESPONSE TO MOTION TO SUSPEND PETITION FOR CANCELLATION**  
8 **AND MEMORANDUM IN SUPPORT OF RESPONSE** on the following person(s)  
9 in the manner(s) indicated below:

10 **SEE ATTACHED SERVICE LIST**

11  (BY ELECTRONIC SERVICE) I am causing the document(s) to be served on  
12 the Filing User(s) through the Court's Electronic Filing System.

13  (BY MAIL) I am familiar with the practice of Call & Jensen for collection and  
14 processing of correspondence for mailing with the United States Postal Service.  
15 Correspondence so collected and processed is deposited with the United States Postal  
16 Service that same day in the ordinary course of business. On this date, a copy of said  
document was placed in a sealed envelope, with postage fully prepaid, addressed as set  
forth herein, and such envelope was placed for collection and mailing at Call & Jensen,  
Newport Beach, California, following ordinary business practices.

17  (BY OVERNIGHT SERVICE) I am familiar with the practice of Call & Jensen  
18 for collection and processing of correspondence for delivery by overnight courier.  
19 Correspondence so collected and processed is deposited in a box or other facility  
20 regularly maintained by the overnight service provider the same day in the ordinary  
21 course of business. On this date, a copy of said document was placed in a sealed  
22 envelope designated by the overnight service provider with delivery fees paid or  
provided for, addressed as set forth herein, and such envelope was placed for delivery  
by the overnight service provider at Call & Jensen, Newport Beach, California,  
following ordinary business practices.

23  (BY FACSIMILE TRANSMISSION) On this date, at the time indicated on the  
24 transmittal sheet, I transmitted from a facsimile transmission machine, which telephone  
25 number is (949) 717-3100, the document described above and a copy of this declaration  
26 to the person, and at the facsimile transmission telephone numbers, set forth herein.  
The above-described transmission was reported as complete and without error by a  
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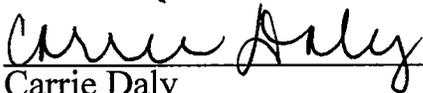
27  (BY E-MAIL) I transmitted the foregoing document(s) by e-mail to the  
28 addressee(s) at the e-mail address(s) indicated.

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(FEDERAL) I declare that I am a member of the Bar and a registered Filing User for this District of the United States District Court.

(FEDERAL) I declare that I am employed in the offices of a member of this Court at whose direction the service was made.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Certificate is executed on August 4, 2010, at Newport Beach, California.

  
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Carrie Daly

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