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

Proceeding	91171156
Party	Defendant STRADA SHOE LTDA
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Attachments	Applicant's Response in Opposition to Sozzani's Motion to Compel.pdf (8 pages)(30005 bytes)

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

Carla Sozzani Editore S.r.l.,	)	Opposition No. 91,171,156
	)	Serial No. 78/617,652
Opposer	)	
	)	I hereby certify that this paper is being deposited
v.	)	with the U.S. Patent and Trademark Office
	)	Trademark Trial and Appeal Board at
Strada Shoe Ltda,	)	http://estta.uspto.gov, on this date: 7/16/2008.
	)	/jak/
Applicant.	)	

APPLICANT'S RESPONSE IN
OPPOSITION TO OPPOSER'S MOTION TO COMPEL

Applicant, Strada Shoe Ltda, ("Strada" or "Applicant"), opposes the Motion to Compel filed by Carla Sozzani Editore S.r.l. (hereinafter "Opposer") on the following grounds:

Opposer's Motion to Compel should be denied because the motion and requested relief are overreaching. The interrogatories themselves are overly broad, vague and ambiguous as written; and, the answers sought are not relevant to any claim or defense in this opposition, nor reasonably calculated to lead to the discovery of relevant or admissible evidence in this proceeding. Consequently, Applicant objected to answering Interrogatory Nos. 20 and 21 as written, and requests that Opposer's motion be denied in its entirety and as to each subpart of the Interrogatory Nos. 20 and 21.

ARGUMENT

A. Opposer's Interrogatory No. 20 Is Overbroad And Applicant Should Not Be Compelled To Answer It.

This opposition is based on whether there is a likelihood of confusion between Applicant's mark CORSO COMO for shoes, sandals and boots and Opposer's Registration for 10 CORSO COMO for cosmetic products, and if the Board permits the Notice of Opposition to be amended (which Applicant has opposed), whether Applicant's mark is geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act. Opposer's Interrogatory

No. 20 is overbroad as drafted, seeking information from Applicant that is irrelevant to the analysis, particularly in view of the fact that Opposer's reliance on Section 2(e)(3) of the Trademark Act is misplaced as is addressed in Applicant's opposition to Opposer's motion to amend its notice of opposition, such argument being referenced herein as if fully set forth.

Opposer does not have any basis for seeking wide-ranging interrogatory answers that are only intended to harass and embarrass Applicant and unnecessarily increase the cost of the opposition. Any answers would not relate to the question of whether the marks at issue are similar in overall sound, appearance, and meaning, nor whether the goods are sufficiently related. Moreover, any answers would have nothing to do with whether the public associates Applicant's mark CORSO COMO for shoes as primarily geographic; nothing in the interrogatory addresses a claim for relief under Section 2(e)(3) of the Trademark Act; and, nothing in the interrogatory is would lead to the discovery of relevant or admissible evidence supporting that this alleged manner of deception is material to the public's purchasing decision.

Finally, Opposer relies on Applicant's answer to Interrogatory No. 3 that allegedly contains information that demonstrates Applicant's "actual knowledge" of a street named Corso Como. Opposer inaccurately asserts that Applicant specifically adopted the trademark CORSO COMO because of its geographic significance. Opposer asserts that Applicant is aware of the influence of Italian fashion designers in an attempt to infer that this knowledge should mean that Applicant had bad faith in adopting its CORSO COMO mark for footwear. However, the truly relevant inquiry is whether the purchasing public would associate the CORSO COMO mark foremost with a particular physical location. In Re Societe Generale Des Eaux Minerales De Vittel S.A., 824 F.2d 957, 3 U.S.P.Q.2d 1450 (Fed. Cir. 1987); 1 GILSON ON TRADEMARKS § 3.04[6][a]. The answer here is "no". Therefore, Opposer's motion as to Interrogatory No. 20 and its subparts should be denied.

B. Opposer's Interrogatory No. 21 Is Vague And Ambiguous And Applicant Should Not Be Compelled To Answer It.

Opposer's Interrogatory No. 21 is vague and ambiguous. As such Applicant is unable to answer without further clarification. Interrogatory No. 21 (a) reads, "In response to Interrogatory No. 10, Applicant states that it has a search performed for the mark CORSO COMO by a Brazilian outside company. Did the search include the federal trademark data base in the United States." Applicant's Response to Interrogatory No. 10 reads, "Applicant objects to this Interrogatory on the basis that it seeks information irrelevant to these proceedings and information that is not reasonably calculated to lead to the discovery of admissible evidence." Applicant's Supplemental Response to Interrogatory No. 10 does read, "Applicant had a search performed for the mark CORSO COMO by a Brazilian outside company. The Brazilian company sent Applicant a letter with the search results." However, that was not the reference made in Opposer's Interrogatory No. 21 (a). The Federal Rules of Civil Procedure, of which Rule 33 applies in this case, require Applicant to answer the questions, but do not require that Applicant interpret what Opposer may have meant depending on the way the interrogatory was drafted.

Moreover, Interrogatory No. 21 (a) and (b) make reference to "the federal trademark data base in the United States." Again, this appears to be an issue of drafting and the ambiguity of the question makes it difficult for Applicant to answer without clarification. Applicant does not know which federal trademark data base in the United States is the one to which Opposer refers. There are many companies and agencies that have databases of United States Patent and Trademark Office records, including the United States Patent and Trademark Office and companies including Thomson CompuMark, CCH Corsearch and Name Protect. Interrogatory No. 21 (a) and (b) are written so awkwardly that it is difficult for Applicant to be able to accurately answer without rewriting the question itself, which is not a burden that the Federal

Rules of Civil Procedure require. It follows that Applicant cannot answer Interrogatory No. 21(c) and (d) until (a) and (b) are clarified. For these reasons Opposer's Motion to Compel should be denied as to all subparts of Opposer's Interrogatory No. 21.

Notwithstanding drafting issues and Applicant's inability to determine the specific questions being asked in Interrogatory No. 21, the information sought by Interrogatory No. 21 is irrelevant to the registrability of the mark and not likely to lead to the discovery of admissible evidence. Applicant provided ample and complete information about the adoption of its CORSO COMO mark in its Supplemental Response to Opposer's Interrogatory Nos. 2 and 3 as set forth below.

> INTERROGATORY NO. 2
> a. Identify Applicant's date of first use of Applicant's MARKS in interstate commerce in connection with each of the goods name in answer to Interrogatory No. 1, and the customer which purchased the specific product.
> b. For each matter identified in (a) above, identify the persons having the most knowledge of such use.
> c. If Applicant has not yet used the marks in commerce for Applicant's Goods, state the activities undertaken by Applicant showing that it has an intent to use the marks on each of the goods claimed in the applications.
>
> RESPONSE: Applicant states that it had begun use of the mark CORSO COMO in interstate commerce in connection with footwear at least as early as September, 2005, when it attended at least one shoe trade show. The customer for whom the September, 2005 purchase order was made was located in Miami, Florida; the product shipped in 2006. Applicant objects to identifying its customers without an appropriate Protective Order in place in this proceeding. Applicant states that it has used the CORSO COMO mark for footwear throughout the United States, including Alabama, Arizona, California, Delaware, Florida, Georgia, Idaho, Illinois, Iowa, Kentucky, Louisiana, Maryland, Massachusetts, Michigan, Minnesota, Missouri, New Jersey, New Mexico, New York, Ohio, Oregon, Pennsylvania, South Carolina, Texas, Utah, Virginia, Washington, Washington DC, and Wisconsin. Applicant's CORSO COMO shoes are located in over 700 accounts throughout the United States as of January 21, 2008, and expects to have its CORSO COMO shoes in even more stores as the year continues.
>
> Mr. Carlos Kray is the person with the most knowledge of the matter. He is the founder and president of Applicant, Strada Shoe. Mr. Kray has been in the shoe business for about 20 years. During and after college, he began his career in the shoe industry. In about 1986, he was working in Brazil working for a

company called GVD as a representative to a New York based wholesale shoe company called ES Originals. During his tenure at GVD, his responsibilities included shoe design and sample development. He traveled between Brazil and New York for GVD.

Then in about 1995, he decided to open his own company, called Strada Shoe. Over the years working in the U.S. shoe market, he developed relationships with companies including Mays, Sears, J. Jill, Kinney, and Parade of Shoes. Much of his early business involved the development and design of private label lines of shoes for these companies. Private label means that rather than his own brand or trademark, the shoes he sold to the companies bore the store's mark. In about 2001, Strada Shoe became a global supplier of private label shoes for Gap, Inc. Mr. Kray was developing a name and his company was earning a winning reputation for developing high quality stylish shoes made in Brazil. In about 2004 or 2005, he began working on his own brand of shoes.

The growth of Strada Shoe as a result of introducing the CORSO COMO shoe line is based on the success of the product in the market and on the reputation of Strada Shoe and its founder after many years in the shoe industry. Consumers buy CORSO COMO shoes because of their style, value and fit. Consumers also by CORSO COMO shoes because they associate the high quality and comfort shoes with Strada Shoe itself. Strada Shoe developed shoe technology so that the shoes are comfortable to wear. The shoes have leather soles rather than plastic or rubber. The shoe linings are made of natural material specially treated to help with perspiration and comfort of the foot. The design of the shoe line is inspired with the assistance of a company in the United Kingdom called the London Company and their In Style books. Strada Shoes works together with the London Company to develop the CORSO COMO shoe designs.

Strada Shoe's U.S. independent sales force trains the sales people at stores including and like Nordstrom about the technology that lends itself to the fit and comfort of the CORSO COMO shoes. Strada Shoe's U.S. independent sales force also host events at stores that carry the CORSO COMO shoe line, at times with models wearing the shoes, in order to promote point of purchase sales. The CORSO COMO shoe line is a bridge brand. This means that the shoes are priced less than many luxury designer brands, but not at the low discount rate either.

INTERROGATORY NO. 3

(a) Identify all persons who approved the selection of Applicant's MARKS.
(b) Describe the specific reasons for the selection of Applicant's MARKS.

RESPONSE: Carlos Kray selected the mark CORSO COMO for the Strada Shoe line of shoes. He is knowledgeable about the United States shoe market because of the approximately twenty years he has been in the shoe business. Italian shoe designers are known for high quality leather and fashionable styles. Italian shoe designer names are typically easily understood in the United States. Corso Como is a fashion shopping street in Milan, Italy, which is similar to other Italian streets known for high fashion shopping, including Via Condotti, Via Borgognona and Via Frattina, Via Veneto and Via Del Corso in Rome; Via de' Tournabuoni and

> Via della Vigna Nuova in Florence. Italy is known for fashion designers such as PRADA®, GUCCI®, FENDI®, MANOLO BLAHNIK®, VALENTINO®, and VERSACE®, and BOTTEGA VENETA®. Italian shoe designer names exude the epitome of fashion. These are all one or two word trademarks that are easy to pronounce. So too is CORSO COMO.
>
> Further, it is not uncommon for a business to select the name of a street that becomes a brand in a particular area of products. An example is Via della Spiga, a street in Milan that carries many designer shops. VIA SPIGA® is a brand of shoes named after the street. The street itself in Milan, at one time or another, carried PRADA® at address No. 1, AGNONA® at No. 3, BULGARI® at No. 6, TOD'S® at No. 7, GIORGIO ARMANI® at No. 19, TIFFANY® at No. 19A, DOLCE & GABBANA® at No. 26 and ROBERTO CAVALLI® at No. 42.
>
> With regard to the street in Rome called Via Veneto, the trademark VIA VENETO has been used as trademark for men's neck ties and shirts, many different restaurants from the West Coast to the East Coast of the U.S., salons, flavored ices, and casinos. The name connotes Italy and good style and means simply Veneto Street.
>
> Finally, it is Carlos Kray who decides what the ultimate collection of CORSO COMO shoes will be. Strada Shoe has about 25 people in the design group and about 40 people who work on creating samples in the Brazilian factory where the Strada Shoe CORSO COMO shoes are made.

Suffice it to say that further inquiry into Applicant's adoption of the CORSO COMO mark for shoes made in Brazil by a Brazilian company lead by a Brazilian man who has been in the shoe industry for twenty years, by insinuating bad faith on the part of Applicant is far fetched, tenuous, and not supported by the record.

CONCLUSION

Opposer's Interrogatory Nos. 20 and 21 serve no purpose other than to harass and embarrass Applicant by alluding to bad faith in the adoption of the mark. The questions are written in such an ambiguous manner, that Applicant is unable to interpret them and as such should not be compelled to answer them as is. Finally, any further information derived from these interrogatories is not relevant and not likely to lead to admissible evidence in this proceeding. For all the reasons set forth in this brief, Applicant requests that the Motion to Compel be denied as to each Interrogatory subpart and in its entirety.

STRADA SHOE LTDA

Dated: July 16, 2008

By: /jak/

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL is being served on July 16, 2008, on the following by email:

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