

ESTTA Tracking number: **ESTTA213305**

Filing date: **05/23/2008**

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

Proceeding	91175950
Party	Plaintiff Dooney & Bourke, Inc.
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Attachments	00157418.pdf (14 pages)(437925 bytes)

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

In The Matter of Trademark Application:

Serial No.: 76/584,390
Applicant: La Vani, Inc.
Mark: DD (Stylized)
Filing Date: 4/1/2004
Publication Date: 11/7/2006

Dooney & Bourke, Inc.,	:	Opp. No. 91175950
Plaintiff-Opposer	:	
	:	
v.	:	
	:	
La Vani, Inc.,	:	
Defendant-Applicant	:	May 23, 2008

MAIN BRIEF OF PLAINTIFF-OPPOSER
DOONEY & BOURKE, INC. IN SUPPORT OF ITS OPPOSITION

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TABLE OF CONTENTS

	<u>Page</u>
Index of Authorities.....	2
Description of the Record.....	3
Statement of the Issues.....	5
Recitation of the Facts.....	5
Argument.....	7
THE OPPOSITION SHOULD BE SUSTAINED BECAUSE THERE IS A LIKELIHOOD OF CONFUSION.....	7
A. The Marks Are Confusingly Similar	8
B. The Goods Are Identical	9
C. Additional Factors Further Support a Likelihood of Confusion.....	10
Summary.....	13

INDEX OF AUTHORITIES

<u>Cases</u>	<u>Page(s)</u>
<i>In re Dixie Restaurants, Inc.</i> , 105 F.3d 1405, 41 USPQ2d 253 (Fed. Cir. 1997).....	10
<i>In re E.I. DuPont de Nemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)	7, 10
<i>In re Electrolyte Laboratories, Inc.</i> , 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990).....	8
<i>Federated Foods, Inc. v. Fort Howard Paper Co.</i> , 544 F.2d 1098, 192 USPQ 24 (C.C.P.A. 1976).....	7
<i>In re Hyper Shoppes (Ohio), Inc.</i> , 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).....	7
<i>James Burrough, Ltd. v. Sign of Beefeater, Inc.</i> , 540 F.2d 266, 192 USPQ 555 (7 th Cir. 1976)	10
<i>Kenner Parker Toys Inc. v. Rose Art Industries Inc.</i> , 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).....	9
<i>Lone Star Mfg. Co. v. Bill Beasley, Inc.</i> , 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).....	7
<i>Maternally Yours, Inc. v. Your Maternity Shop, Inc.</i> , 234 F.2d 538, 110 USPQ 462 (2d Cir. 1956).....	9
<i>In re Pneumatiques Caoutchouc Mfg. et Plastiques Kleber-Colombes</i> , 487 F.2d 918 (C.C.P.A. 1973)	7
<i>In re Smith and Mehaffey</i> , 31 USPQ2d 1531 (T.T.A.B. 1994).....	9
<i>Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.</i> , 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)	9
<i>Weiss Associates, Inc. v. HRL Associates, Inc.</i> 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).....	8
 <u>Statutes & Rules</u>	
15 U.S.C. § 1052(d).....	5, 7
 <u>Miscellaneous</u>	
3 <i>McCarthy on Trademarks and Unfair Competition</i> § 23:115	11

DESCRIPTION OF THE RECORD

The evidence of record consists of Plaintiff's Notice of Reliance filed December 17, 2007, containing the following evidence in support of its opposition:

- Exhibit 1:** Certification of Status and Title, dated July 3, 2007, for U.S. Reg. No. 2,771,012.
- Exhibit 2:** Certification of Status and Title, dated May 30, 2007, for U.S. Reg. No. 3,000,026.
- Exhibit 3:** Copies of official records of the U.S.P.T.O. contained within file history for Reg. No. 2,771,012 establishing distinctiveness and widespread use and public recognition of Dooney & Bourke's interlocking logo mark, including an Affidavit of Carolyn Donohue, sworn to March 18, 2003, with exhibits.
- Exhibit 4:** Sample advertisements showing prominent use and recognition of Dooney & Bourke's interlocking logo, including advertisements by major retailers such as Bloomingdales, Lord & Taylor and Macy's, offering Dooney & Bourke's products:

<u>Publication</u>	<u>Date</u>	<u>Pages</u>
<i>Teen Vogue</i>	Aug/Sept. 2003	32 and 65
<i>New York Times</i>	Nov. 30, 2001	A7
<i>New York Times</i>	Dec. 23, 2001	A9
<i>New York Times</i>	April 11, 2003	A3
<i>New York Times</i>	April 13, 2003	A13
<i>New York Times</i>	May 8, 2003	A5
<i>New York Times</i>	May 9, 2003	A3
<i>New York Times</i>	Nov. 11, 2003	A3
<i>New York Times</i>	Dec. 11, 2003	A17
<i>New York Times</i>	Dec. 18, 2003	A13
<i>New York Times</i>	Feb. 5, 2004	A3
<i>New York Times</i>	Feb. 8, 2004	N13
<i>New York Times</i>	Dec. 16, 2005	A13
<i>New York Times</i>	May 9, 2006	A5
<i>New York Times</i>	Nov. 26, 2006	N3
<i>New York Times</i>	Dec. 16, 2007	N18

Exhibit 5: Copies of foreign certificates of trademark registration owned by Dooney & Bourke for its interlocking DB mark as further evidence of widespread use and recognition of that mark:

<u>Country</u>	<u>Reg. No.</u>	<u>Filing Date</u>	<u>Reg. Date</u>
Japan	4813678	04/5/2004	10/29/2004
China	4046190	04/30/2004	04/30/2004
European Community	003408556	10/16/2003	10/07/2006

(References herein to “Exhibits” are to these exhibits annexed to the Plaintiff’s Notice of Reliance.)

The Applicant did not object to any of these materials and has not filed any evidence in this proceeding in support of its Application.

STATEMENT OF THE ISSUES

The issue to be decided in this proceeding is whether the application should be rejected and the Opposition sustained because the proposed mark, comprising an interlocking design of the letters DD, so resembles a registered mark of Dooney & Bourke, namely its “signature” interlocking DB logo, that the proposed mark when used in connection with Applicant’s goods is likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

RECITATION OF THE FACTS

The Applicant’s logo mark comprises an interlocking design of the letters DD as shown in application Serial No. 76/584,390 (the “Application”). Dooney & Bourke’s interlocking design of the letters DB has been in use since January 2001 and registered since October 2003. (*See* Exhibit 1.) The two marks are shown here:



Dooney & Bourke’s mark is registered in International Class 18 for the same goods as listed on the Applicant’s Application. (*See id.*) The Application claimed use of the mark in commerce since August 2003 and was accompanied by two specimens showing the interlocking design logo on a handbag in a repeating, criss-cross pattern with alternating upside-down and rightside-up versions. Since 2001, Dooney & Bourke has continuously deployed its interlocking DB logo on identical products in the same fashion. (*See* Exhibit 4.)

Dooney & Bourke's interlocking DB logo mark is distinctive and there is widespread use and public recognition of this mark. Major retailers such as Bloomingdales, Lord & Taylor and Macy's advertise Dooney & Bourke's products bearing the DB mark in prominent publications such as *The New York Times*, *Vogue*, *Vanity Fair* and *Elle*. (See Exhibit 4 and Exhibit 3 at Ex. G therein.) In addition to its own retail stores in several states, Dooney & Bourke has sold its products bearing the DB mark through multiple major retailers nationwide comprising at least 1,000 retail outlets. (See Exhibit 3 at Donahue Aff't, ¶ 16 and Exs. B and E therein.)

Within the first two years after introducing its "signature" line with the repeating DB mark, Dooney & Bourke sold over 600,000 units of products worldwide in that line, generating over \$40,000,000 in wholesale sales. (See Exhibit 3 at Donahue Aff't, ¶¶ 14 and 15 therein.) In that time, Dooney & Bourke spent at least \$2,000,000 devoted specifically to promoting products bearing the DB mark. (See Exhibit 3 at Donahue Aff't, ¶ 11 therein.) Dooney & Bourke has advertised the DB mark prominently in its catalogs and on its website, with annual catalog distribution in excess of 2,000,000 copies, plus over 2,000,000 annual website visits in the first full year of use of the DB mark. (See Exhibit 3 at Donahue Aff't, ¶ 13 therein.)

The prestige and fame of Dooney & Bourke's marks, including the DB mark, is confirmed by the fact that, despite vigorous anti-counterfeiting efforts, many counterfeit Dooney & Bourke products have appeared in the marketplace over the last several years. Dooney & Bourke is aware of many instances in which United States Customs and law enforcement personnel have seized products bearing counterfeit Dooney & Bourke trademarks. (See Exhibit 3 at Donahue Aff't, ¶ 17 therein.) The DB mark is also registered in Japan, China and the European Community. (See Exhibit 5.)

ARGUMENT

THE OPPOSITION SHOULD BE SUSTAINED BECAUSE THERE IS A LIKELIHOOD OF CONFUSION

Dooney & Bourke began using its interlocking DB logo mark in interstate commerce on January 10, 2001, and the mark became registered on October 7, 2003. (*See* Exhibit 1.) These dates are earlier than Applicant's filing and first-use dates. Dooney & Bourke's mark is registered in International Class 18 for the same goods as listed on the Applicant's application. (*See id.*) Applicant's interlocking logo mark is strikingly similar and likely to cause confusion if used on the claimed products. Thus, Dooney & Bourke's standing and priority are clear.

Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), prohibits registration of a mark that gives rise to a likelihood of confusion with a federally registered mark. The Court in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563 (C.C.P.A. 1973), listed the principle factors for determining likelihood of confusion. Primary among the factors are similarity of the marks and similarity of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (C.C.P.A. 1976). Any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 909, 182 USPQ 368 (C.C.P.A. 1974); *In re Pneumatiques Caoutchouc Mfg. et Plastiques Kleber-Colombes*, 487 F.2d 918, 919, 179 USPQ 729 (C.C.P.A. 1973). The similarity of the marks and goods in this case make clear that confusion is likely.

A. The Marks Are Confusingly Similar.

The marks, shown below, are strikingly similar.



In analyzing composite letter marks, it is important to consider the visual elements of the marks.

In re Electrolyte Laboratories, Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

Here, the visual similarity of the marks is strong and the overall commercial impression is similar. The first letter in each linked letter-pair logo is D. The letters in each linked letter-pair logo are in the same size and proportion to each other, capitalized in virtually identical typeface, and arranged in similar interlocking form. Both letters share a similar shape and the curved shapes blend together in this presentation further increasing the visual similarity. The fact that the second, subsidiary letter in Applicant's interlocking logo is a D rather than a B does not avoid the obvious likelihood of confusion. *See Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 1548, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990) (TMM confusingly similar with TMS for identical goods.)

The strong similarity of the marks is exacerbated when one considers the overall appearance of the parties' products. The Applicant's specimens show use of its interlocking DD mark on a handbag in a repeating criss-cross pattern, with alternating right-side-up and upside-down renditions of the interlocking logos¹. This is exactly the way Dooney & Bourke deploys its interlocking letter-pair logo on identical products. (*See Exhibit 4.*) This deployment is hardly

¹ Opposer has no actual knowledge whether Applicant in fact has sold any products with the DD logo in commerce. No discovery or evidence on that issue is in the record.

a coincidence given the prominence of Dooney & Bourke's products and mark in the marketplace. The alternating upside-down presentation further increases the already high likelihood of confusing the letter pairs. Similarity in appearance of marks in the context of the overall appearance of the relevant products can be a significant factor in determining the likelihood of confusion. *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992) (“[t]he multitude of similarities in the trade dress of PLAY-DOH and FUN-DOUGH products cries out for recognition . . . The trade dress of the marks enhances their similar commercial impression”). Where the defendant's mark is used in the same lettering style or format as the plaintiff's mark, then the likelihood of confusion is increased. *See, e.g., Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538, 542-3, 110 USPQ 462 (2d Cir. 1956).

B. The Goods Are Identical.

The Application claims the following goods:

Leather and imitations of leather articles, namely, trunks and traveling bags, brief cases, back packs, hand bags, shopping bags, wallets, purses, key case and key chains.

Dooney & Bourke's Reg. No. 2,771,012 for its interlocking DB logo covers the following goods:

Wallets, purses, coin purses, clutches, handbags, shoulder bags, shoulder straps, tote bags, backpacks, luggage, suitcases, trunks, empty cosmetics cases, leather key cases, leather key fobs [and] fanny packs.

(*See Exhibit 1.*) The two lists of goods are substantially the same. Further, because there are no restrictions as to the channels of trade for the goods or their classes of purchasers, the goods must be deemed to be sold in the same channels of trade and directed to the same purchasers. *See In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (T.T.A.B. 1994). Where, as here, the goods are

virtually identical, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1408 41 USPQ2d 2531 (Fed. Cir. 1997).

The marks and the goods in this case are both highly similar. This is enough to create a likelihood of confusion and to sustain Dooney & Bourke’s opposition.

C. Additional Factors Further Support a Likelihood of Confusion.

In addition to the likelihood of confusion based on the close similarity of the marks and goods, the strength of Dooney & Bourke’s mark and Applicant’s apparent intent to cause confusion favor opposer Dooney & Bourke.

Strong marks are afforded broad protection. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276, 192 USPQ 555 (7th Cir. 1976). Sales, advertising and length of use, as well as the distinctiveness of the mark, are considered to evaluate the strength of a mark. *See In re E.I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Dooney & Bourke’s interlocking logo, long advertised as the company’s “signature logo,” deserves strong protection. Many millions of dollars have been spent advertising goods with the DB mark, and goods bearing the DB mark have generated many more millions of dollars in sales. (*See Exhibit 3 at Donahue Aff’t at ¶¶ 11, 14, 15 therein.*) Some of the supporting facts include the following:

- Within the first two years after introducing its "Signature" line with the repeating DB mark, Dooney & Bourke sold over 600,000 units of products worldwide in that line. (*See Exhibit 3 at Donahue Aff’t, ¶ 14 therein.*)
- In that time, Dooney & Bourke products bearing the DB mark generated over \$40,000,000 in wholesale sales. (*See Exhibit 3 at Donahue Aff’t, ¶ 15 therein.*)
- In that time, Dooney & Bourke spent at least \$2,000,000 devoted specifically to promoting products bearing the DB mark. (*See Exhibit 3 at Donahue Aff’t, ¶ 11 therein.*)
- Dooney & Bourke has advertised the DB mark prominently in its catalogs and on its website, with annual catalog distribution in excess of 2,000,000 copies, plus over 2,000,000 annual website visits in the first full year of use of the DB mark. (*See Exhibit 3 at Donahue Aff’t, ¶ 13 therein.*)

- Dooney & Bourke and outside retailers have advertised Dooney & Bourke's products, including but not limited to the "Signature" line bearing the repeating DB mark, in prominent publications, including *The New York Times*, *Vogue*, *Gourmet*, *Vanity Fair*, *Harper's Bazaar*, *InStyle*, *Elle* and *Martha Stewart*. (See Exhibit 4 and Exhibit 3 at Ex. G therein.)
- In addition to its own retail stores in several states, Dooney & Bourke has sold its products bearing the DB mark through multiple major retailers nationwide comprising at least 1,000 retail outlets. These retailers include many well-known stores and catalogs, such as Macy's, Dillards, Nordstrom, Burdines, Filene's, Barnett's, Spiegel, Herrington and Lord & Taylor, many of which also directly advertise the "Signature" line with the repeating DB mark as a product of Dooney & Bourke. (See Exhibit 3 at Donahue Aff't, ¶ 16 and Exs. B and E therein.)
- The prestige and fame of Dooney & Bourke's marks, including the DB mark, is confirmed by the fact that, despite vigorous anti-counterfeiting efforts, many counterfeit Dooney & Bourke products have appeared in the marketplace over the last several years. Dooney & Bourke is aware of many instances in which United States Customs and law enforcement personnel have seized products bearing counterfeit Dooney & Bourke trademarks. (See Exhibit 3 at Donahue Aff't, ¶ 17 therein.)
- The DB mark is also registered in Japan, China and the European Community. (See Exhibit 5.)

Finally, there is no plausible explanation for Applicant's adoption of its DD interlocking logo for leather goods – especially in the repeating pattern displayed on the specimens it submitted with its Application – other than intent to cause confusion and to capitalize on the goodwill and recognition of Dooney & Bourke's nearly identical interlocking logo. The letters "DD" have nothing to do with Applicant's name or goods. Applicant's logo shares nearly identical letters, typeface, proportions, interlocking format, and deployment on identical products, with Dooney & Bourke's registered DB logo. Such striking similarity to a well-known mark – with no plausible explanation or justification – further supports a finding of likely confusion. *See generally, 3 McCarthy on Trademarks and Unfair Competition* § 23:115 and cases cited therein.

Accordingly, every factor that can be considered based on the evidence weighs strongly in favor of finding a likelihood of confusion and sustaining the Opposition.

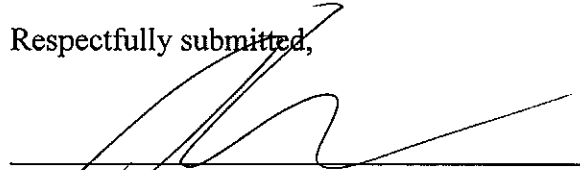
SUMMARY

As demonstrated above, the Applicant's logo mark comprising an interlocking design of the letters DD is an obvious and close imitation of Dooney & Bourke's "signature" interlocking DB logo mark which has been in use since January 2001 and registered since October 2003. The goods claimed in the Application are identical to Dooney & Bourke's goods, and the marks are deployed on these goods in an identical manner. Further, because of the prominent and widespread use of Dooney & Bourke's DB mark, the only plausible explanation for Applicant's adoption of its DD interlocking logo for leather goods is an intent to cause confusion and capitalize on the goodwill and recognition of Dooney & Bourke's DB mark. For the foregoing reasons, Dooney & Bourke believes that it will be damaged by the registration of the interlocking DD logo mark shown in the Application, and that there is a likelihood of confusion between the marks. Accordingly, Dooney & Bourke requests that such registration not be allowed and the opposition herein be sustained.

Date: May 23, 2008

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 23, 2008, the foregoing Main Brief of Plaintiff-Opposer Dooney & Bourke, Inc. in Support of its Opposition was served upon counsel for the Applicant via First Class mail, postage prepaid:

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