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

Proceeding	91207312
Party	Plaintiff Sterling Jewelers Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF: Application Serial No. 85/526,229
PUBLISHED IN THE OFFICIAL GAZETTE OF June 19, 2012

Sterling Jewelers Inc.,	:	
	:	
Opposer,	:	
	:	Opposition No.: 91207312
v.	:	
	:	Serial No. 85/526,229
	:	
Romance & Co., Inc.,	:	
	:	
Applicant.	:	
	:	

OPPOSITION TO APPLICANT’S MOTION FOR JUDGMENT

Opposer, Sterling Jewelers Inc., respectfully requests that the Board deny Applicant Romance & Co., Inc.’s Motion for Judgment as Applicant has not shown good cause for its motion.

Applicant filed the Motion for Judgment on September 27, 2013 and served Opposer’s counsel by first class mail. Accordingly, Opposer’s reply is timely under 37 CFR § 2.119(c) as being filed within 20 days of service.

Applicant Romance & Co., Inc. requests dismissal for an alleged failure to take evidence or submit a copy of its registration into evidence. Both of these rationales for dismissal are without basis. Applicant maintains that the copy of Registration No. 3,313,172, provided as Exhibit 1 to the Notice of Opposition does not meet the requirements of 37 CFR § 2.122(d)(1) to place the trademark registration on the record in the Opposition proceeding. Applicant, however, previously admitted, “that Opposer is

listed as the owner of record for U.S. Registration No. 3313172 for the mark ‘Hearts Desire.’” (Answer to Notice of Opposition, Paragraph 3.) Therefore, Opposer’s ownership of the registration is not in question. If Applicant wished to contest this point, its Answer to Notice of Opposition should not have admitted Opposer’s ownership. Neither should Opposer be penalized for Applicant’s vacillation on this point.

In support of its position, Applicant cites Hewlett-Packard Co. v. Olympus Corp., 18 USPQ2d 1710 (Fed. Cir. 1991), Hartwell Co. v. Shane, 17 USPQ2d 1569, at fn 4 (TTAB 1990) and Hester Industries, Inc. v. Tyson Foods, Inc., 2 USPQ2d 1646 (TTAB 1987). None of these cases support dismissal here. In Hewlett-Packard Co., for example, “Olympus challenged the current status and title of Hewlett’s registration and Hewlett took no action.” (18 USPQ2d at 1713.) In the present case, Applicant has admitted Opposer’s ownership from its first filing in the Opposition.

Similarly, Hartwell Co. v. Shane states:

[s]tanding at the pleading stage is reviewed by determining whether petitioner has alleged facts, which if later proven, would establish that petitioner has a real interest in the proceeding. The facts so pled must be sufficient to show a personal interest in the outcome of the case beyond that of the general public.” (17 USPQ2d at 1570 (*internal citations omitted*).

Again, Applicant’s admission of Opposer’s ownership establishes Opposer’s “interest in the outcome of the case beyond that of the general public.”

Likewise, Hester Industries, Inc. v. Tyson Foods, Inc., is distinguishable. In Hester Industries, Inc., “Opposer did not submit, with the notice of opposition, status and title copies (or, for that matter, any copies at all) of the registrations of the asserted marks of opposer mentioned in its pleadings.” In this case, Opposer did file a copy of

the registration, showing Opposer's ownership of the registration for HEARTS DESIRE, and Applicant has admitted that Opposer is the owner of record.

Applicant also asserts that dismissal is warranted for Opposer's failure to take testimony. In support of this argument, Applicant again cites cases that are distinguishable from this Opposition. For example, Hyde Park Footwear v. Hampshire-Designers, Inc. (197 USPQ 639 (TTAB 1997)) is cited. The portion of the opinion in Hyde Park Footwear quoted by Applicant, however, conflates two separate statements made by the Board in that case and eliminates a significant distinction made by the Board, apparently represented by the ellipsis in the quotation provided.

The first portion of the quotation provided by Applicant is

The registrations alone are incompetent to establish any facts with regard to the nature or extent of Opposer's use and advertising of its trademarks or any reputation they enjoy or what purchasers reactions to them may be... (197 USPQ at 641.)

Applicant conflates this statement with another that is two entire paragraphs later in the opinion,

However, when there is a difference between the marks or between the goods, or both, it is incumbent upon the plaintiff to persuade us that there is a reasonable likelihood of confusion. (*Id.*)

In quoting from the opinion, however, Applicant fails to recite an intervening statement also made by the Board that is applicable to the present case. "When it is apparent from the face of opposer's application that the marks are so similar and the goods are so related that a likelihood of confusion exists, opposer may rest upon the prima facie case made by its registration..." (*Id.*)

Applicant's citation of Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 USPQ2d 1879, 1880 (TTAB 1990), is inapposite. In Syntex, the Board stated, "In this case, the parties' marks are not identical and the relationship, if any, between the parties' goods is not apparent from the face of opposer's registration." (*Id.*) In the present case, in contrast, the goods at issue are identical (jewelry/fine jewelry) and the marks HEARTS DESIRE and WHAT YOUR HEART DESIRES are highly similar in appearance and virtually identical in meaning. While Applicant is correct in pointing out the difference between the singular and plural forms of HEART(S) and DESIRE(S), this difference is trivial for purposes of a likelihood of confusion analysis, as is the addition of "WHAT YOUR" to the beginning of Applicant's proposed mark.

Applicant also cited the nonprecedential opinion Ston Cor Group, Inc. v. Cupa Materiales, S.A., Opposition No. 91190420 (TTAB 2012) as being "on point" but without any indication of the similarities between that decision and the present Opposition. Far from being on point, however, the decision in Ston Cor Group, Inc. rested on the finding:

The only arguable similarity between applicant's mark and any of opposer's marks is the STONE and STON- elements of the marks which may or may not be perceived by consumers as describing or suggesting a 'stone' feature or purpose of the goods themselves." (Opposition No. 91190420 at page 6.)

Furthermore, the Board in Ston Cor Group, Inc., addressed a different fact set than in the present case, namely, dissimilarity of the goods in question. "Where 'the goods recited in the subject application and in opposer's registration are obviously different, the registration, *per se*, is manifestly insufficient to establish a *prima facie* case and to shift the burden of going forward to applicant.'" In contrast, the goods in question here

are recited as “Fine jewelry” and “Jewelry.” Applicant’s citation of cases involving dissimilar goods is not instructive here.

Applicant has not been prejudiced by Opposer’s lack of discovery. In fact, during the Discovery Conference of December 13, 2013, Opposer’s attorney proposed that the case proceed under the Accelerated Case Resolution (ACR) insofar as there were few if any factual issues that would be determinative. While Applicant declined to proceed under ACR, as was its right, it nevertheless was informed that discovery by Opposer would be limited. Nor has the Opposer completely failed to engage in discovery, as initial disclosures have been exchanged, as acknowledged by Applicant.

In the Motion for Judgment, Applicant maintains that Opposer has shown no right to relief. (Motion for Judgment, page 3, line 8.) Applicant, however, had previously indicated, “[o]pposer attempts to make legal argument in the Notice of Opposition which is more appropriate for a brief.” (Answer, paragraph 10.) Both statements by Applicant cannot be simultaneously true. Opposer maintains that Applicant has, in effect, acknowledged in its Answer, that the Opposer has set forth sufficient facts to show it has a right to relief.

Accordingly, Opposer requests that the Board deny Applicant’s Motion for Judgment. In the alternative, Opposer requests that the Board decline to render judgment until all of the evidence is in the record and decide the case on the merits, particularly in the event that the Board finds that Applicant has not admitted Opposer’s ownership of Registration No. 3,313,172 and that further evidence of Opposer’s ownership is required. In that event, Opposer further requests that the Board give Opposer leave to file further evidence of the current status and title of the registration.

Respectfully submitted,

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Dated: October 17, 2013

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing OPPOSITION TO APPLICANT'S MOTION FOR JUDGMENT was served by first class postage prepaid mail, this 17th day of October 2013, addressed to:

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