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

Proceeding	91219631
Party	Defendant Anaya Gems 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.: 86293737

Filed: May 28, 2014

Date of Publication: October 21, 2014

Mark: "Diamond Essence"

Meeshaa Inc.,)	
Db a Diamond Essence,)	
)	
Opposer,)	
)	Opposition No.: 91219631
v.)	
)	
Anaya Gems Inc.,)	
)	
Applicant.)	

**APPLICANT’S BRIEF IN OPPOSITION AND CROSS MOTION IN
SUMMARY JUDGEMENT**

Applicant, Anaya Gems Inc. (“Anaya Gems”), opposes the motion for summary judgment made by Opposer Meeshaa Inc.’s (“Meeshaa”), and moves, as a cross motion, for Summary Judgment, affirming Anaya Gems’ registration for the DIAMOND ESSENCE mark (the “Mark”), and denying Meeshaa’s opposition to said registration.

**ANAYA GEMS BRIEF IN OPPOSITION TO MEESHAA’S
MOTION FOR SUMMARY JUDGMENT**

I. Anaya Gems opposes Meeshaa’s motion for summary judgment based on the following:

A. MEESHAA’S “FIRST USE” CLAIM IS NOT CREDITABLE

1. Opposer’s claim of October 22, 2009 as their “first use”

date is not supported by the evidence offered, Exs. A-D, or the law, as the evidence does not meet the requirements of establishing “first legal use” of the mark. *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009) (quoting 15 U.S.C. § 1127 (2006)). Anaya Gems asserts that Meeshaa’s evidence is suspect and cannot be relied upon as truthful and accurate, for example:

- a. Jewelry of any sort is not mentioned anywhere in Exhibit B, Meeshaa’s Registration of Alternative Name. Interestingly, the registration refers to “Internet Retail Sales Sites”, but Meeshaa provides no further evidence of any internet sales, nor any evidence of even an internet site.
- b. Meeshaa makes the claim that “Since October 22, 2009, Opposer has continuously sold, without interruption, diamond jewelry containing simulated diamonds as well as other jewelry products under the DIAMOND ESSENCE mark and trade name.” Opposer Motion for Summary Judgment, pg. 4, ¶2. No evidence was offered supporting that claim.
- c. Meeshaa’s only evidence offered to support its claim of a “first use” date of October 22, 2009 is an invoice, Ex. C, sent by Meeshaa, with no evidence of a customer submitted request, which refers to sales of items identified only by non-descript codes, none of which appear in any of Meeshaa’s submitted catalogues, Exs. B1-B6.
- d. The earliest of said catalogues, Ex. B1, has a reference description of “V9, 2010-2011”.

Being that the “First Use” for Meeshaa cannot be properly substantiated by creditable evidence, Anaya Gem’s “first use” should be considered superior. Anaya Gem’s “first use” date is not disputed.

B. MEESHAA’S CLAIM OF ACTUAL CONFUSION IS NOT CREDIBLE

1. Opposer claims that beginning in 2014, it began getting calls from consumers who were confused. The only evidence provided are 3 separate “logs”- each in different format and type, including one that was handwritten, Exhibit J. These Logs, in addition to an edited e-mail alleging confusion, cannot possibly as anything other than hearsay, and would be even harder to justify as excluded or exempted.
2. Furthermore, even if taken on their face, these documents do not support any claim of “many” instances “involving faults or imperfections in Applicant’s goods”, Opposer Motion for Summary Judgement, pg. 16, ¶2. In fact, Applicant is never mentioned once in any of the documents, and no evidence has been proffered to connect the goods in question to Applicant.

C. MEESHAA FAILS TO SHOW THAT THERE EXISTS NO MATERIAL FACTS IN DISPUTE.

1. Meeshaa’s claim of a “first use” date of October 22, 2009 is disputed.
2. Meeshaa’s material evidence supporting their “first use” is disputed.
3. Meeshaa’s material evidence supporting actual confusion is disputed.

MEMORANDUM OF LAW IN SUPPORT OF ANAYA GEM'S BRIEF IN OPPOSITION AND CROSS MOTION IN SUMMARY JUDGEMENT

Anaya Gems opposes Meeshaa's Motion for Summary Judgment and moves, as a cross motion and for Summary Judgment in favor of Anaya Gems, thereby affirming Anaya Gems' registration.

II. INTRODUCTION

Opposer moves for summary judgment based on the unsubstantiated assumption that there is no triable issue of material fact on the issue of likelihood of confusion. Opposer offers no survey or other supporting evidence showing a likelihood of confusion. Opposer's evidence does not support a finding of likelihood of confusion, and on the contrary, the evidence demonstrates there is, in fact, no likelihood of confusion.

Opposer relies on the elements of the test of likelihood of confusion set out in In Re E I DuPont de Nemours, 76 F.2d 1357 (C.C.P.A. 1973): Similarity of goods, similarity of marks, similarity in the channels of trade, and actual confusion. The evidence supplied, however, supports only one element, that both the marks are named DIAMOND ESSENCE. As to similarity of the marks, appearance, overall commercial impression and channels of trade, the marks as used is entirely different. On the element of actual confusion, Opposer has failed to provide any a scintilla of evidence of consumer confusion. The record Opposer has placed before the Board cannot support any finding of actual confusion.

Based on the evidence presented by Opposer and by Applicant in this opposition, Opposer's motion for summary judgment should be denied and summary judgment should be granted in favor of Applicant.

III. STATEMENT OF ACTS

A. Anaya Gems Use of the Diamond Essence Mark

Anaya Gems is an import and wholesale gold, silver, and diamond jewelry manufacturer company operating in New York. One of its product lines is sold under the Diamond Essence mark. Products sold under the Mark are sold directly to Kohl's Corporation, a retail chain with stores across the country. After months and months of discussions, planning, and preliminary art work, Anaya received its first order from Kohl's for Diamond Essence products on October 22, 2011.

B. Moesha Use of the Diamond Essence Mark

Meeshaa is company that claims to sell "The best Simulated Diamond Ever Created...since 1978", Exs.B1-b6, through "mail order catalogs, Opposer's online store, Opposer's retail store, and to retailers," Exs. B1-B6, Opposer's motion for Summary Judgement, pg. 2, ¶2. Yet Meeshaa cannot provide any credible evidence that it has promoted, let alone sold, through any method other than mail order catalogs, of which the earliest provided has no proof of being mailed, no date of printing, and no date of publication beyond "10-11".

Meeshaa's claims of a "first use" date of October 22, 2009 is not substantiated by the evidence presented, and is invalid because it does not qualify, by law, as evidence of "first use." Aycock Eng'g, Inc. v. Airflite, Inc., 560 F.3d 1350, 1357 (Fed. Cir. 2009) (quoting 15 U.S.C. § 1127). Additionally, Meeshaa has failed to provide creditable evidence to support their "first use" claim based on the requirements of the law. Meeshaa failed to offer credible evidence to support a legal "first use" date.

ARGUMENT FOR COCO-JO'S BREIF IN OPPOSITION AND

CROSS MOTION IN SUMMARY JUDGEMENT

Anaya has superior rights to the DIAMOND ESSENCE mark based on its “first legal use in commerce” and its status as first to file.

A. The Summary Judgement Standard

Summary judgment is appropriate where “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56; Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 585-87 (1996). To create a material issue for trial, there must be sufficient evidence in the record to support a verdict in the non-moving party’s favor. Tullo v. City of Mt. Vernon, 237 F.Supp. 2d 493 (S.D.N.Y. 2002). Summary judgment for Meeshaa is not appropriate here because there are genuine issues as to material fact concerning Meeshaa’s rights to the Diamond Essence mark.

The purpose of summary judgment is to avoid unnecessary trial and to save the time and expense of litigation where there is no genuine issue of material fact that exists and where no evidence beyond the evidence submitted with respect to the summary judgment motion could reasonably change the outcome. Pure Gold v. Syntax U.S.A.Inc., 739 F.2d 624, 222 U.S.P.Q 741, 743 (Fed. Cir. 1984); Nature’s Way Prods., Inc. v. Nature’s Herbs, Inc., 9 U.S.P.Q.2d 2077, 2080 (T.T.A.B. 1989).

The pleadings and declarations submitted in this action provide abundant support for Anaya Gems’ Brief In Opposition and Cross Motion in Summary Judgment. Meeshaa has failed to provide creditable evidence to support their claim of a legitimate “first use” of the mark, and Meeshaa has not made any convincing argument that there has been any actual confusion of the marks. This case is then ripe for summary judgment in favor of Anaya Gems.

B. Meeshaa Does Not have Priority Over Anaya Gems’ Mark

The “opposer must prove by preponderance of the evidence that its common-law rights were acquired before any date upon which applicant may rely.” Embarcadero Techs. v. RStudio, Inc., 105 U.S.P.Q.2d 1825, 1834 (T.T.A.B. 2013) (citing Trademark Act Section 2, 15 U.S.C. § 1052; Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 U.S.P.Q.2d 1772, 1773 (Fed. Cir. 1987)). Meeshaa failed to provide credible evidence, of their “first use,” legal or otherwise. “For trademarks, the ‘use in commerce’ requirement is met when the mark is (1) placed on the goods or container, or on documents associated with the goods if the nature of the goods make placement on the good or container impracticable; and (2) that good is then ‘sold or transported in commerce.’” Aycock Eng’g, Inc. v. Airflite, Inc., 560 F.3d 1350, 1357 (Fed. Cir. 2009) (quoting 15 U.S.C. § 1127 (2006)).

Meeshaa has failed to show that (1) the mark was placed on the goods or container, or that it was impracticable to do so, and (2) Meeshaa provided no evidence to support the claim that they were shipped or sold. Meeshaa has failed to fulfill the required conditions for “first use” as established by law. Aycock Eng’g, Inc. v. Airflite, Inc., 560 F.3d 1350, 1357 (Fed. Cir. 2009) (quoting 15 U.S.C. § 1127). Anaya’s “first use” date is not disputed and Meeshaa has failed to provide evidence of a valid earlier “first use” date. Anaya’s mark has priority.

C. There Is No Clear Likelihood Of Confusion

Of the thirteen (13) DuPont factors to be considered by the Court, Opposer has decided that only the four (4) factors it can even claim to prove should be considered. Here, it is respectfully submitted that the Board should consider *all* 13 factors, as none of these factors is more important than the other in the likelihood of confusion determination. In re E.I. DuPont de Nemours & Co., 476 F.2d 1361 (CCPA 1973). Some of the factors Opposer has deceitfully attempted to ignore are discussed below.

1. The dissimilarity of established, likely-to-continue trade

channels. (DuPont Factor No. 3)

First, we must consider a factor Opposer has blatantly misrepresented. Opposer has offered no proof of any sales, or even the potential of sales, through any channels other than mail order catalogues. Anaya, on the other hand, admittedly sells products under the mark only to Kohl's, a retail chain with actual brick & mortar locations.

Even if the Court assume that the goods in that application "would travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods", Opposer has not claimed, because it knows, that mail-order catalogues are not reasonably considered as normal channels for the sale of jewelry. With no retail stores shown to sell Meeshaa's products, the channels of trade are nowhere near as identical as Opposer attempts to claim.

2. The Lack Any Actual Confusion. (DuPont Factor No. 7)

The evidence provided by Opposer that purports to be proof of actual confusion amounts to entirely inadmissible, unsubstantiated examples of issues of pricing. First, the "logs" provided, all during concurrent time periods, are a mix of handwritten comments, spreadsheet entries, and something called a "sticky note". Opposer's Ex. J. These documents are of different format, provide different customer information (Some have phone numbers, some don't, some have email addresses, others don't), and all but one entries are simply about seeking a better price. Furthermore, most are written in a past tense, and refer to actions taken by the Opposer in past: "That is when we purchased an item from Kohl's and were shocked to see Diamond Essence logo and TM in the box." Opposer's Ex. J, Page 11, Entry 2.

This leads to only one conclusion: they were not written concurrently with the placing of complaints, but in retrospect. It is thus quite clear that these "logs" were created not in accordance with any

regular complaint/comment intake process, but rather entirely for the purpose to falsely claim there is confusion. The evidence is entirely inadmissible hearsay, with no applicable exception of exemption.

Yet even if the Court is to consider the evidence, all these logs do is point towards an actual LACK of confusion. A customer calling Opposer asking for a cheaper price than what is available at Kohl's cannot reasonably believe that Opposer would be willing to sell the same product for two different prices. It is also worth noting that Opposer sought discovery documents of any instances of customer confusion reported to either Kohl's or Anaya. Not a single instance was reported. There is literally no admissible evidence of actual confusion.

3. There were at least 3 years of concurrent use without evidence of actual confusion. (DuPont Factor no. 8)

Anaya Gems has proven that it has used the Mark in commerce as early as November 21, 2011. Yet Opposer's earliest alleged evidence of actual confusion is from September 26, 2014. Opposer's Ex. J. For three (3) years, both parties used the Mark, and there was no confusion. In fact, only two (2) entries occurred before October 21, 2014, the date Applicant's registration was published for opposition.

4. The Extent of Potential Confusion, If at All, is De Minimis. (DuPont Factor No. 12)

Opposer has offered no evidence of any confusion that has negatively impacted customer opinion of Meeshaa's goods. In fact, any evidence shows the opposite- if anyone was in fact confused between Opposer and Applicant, they went to Opposer for the cheaper price. The only party here that is affected by potential confusion is Anaya- customers are attempting to seek inferior products for a lower price from Opposer.

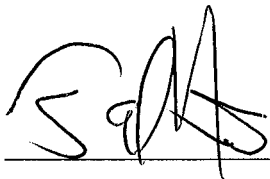
CONCLUSION

Anaya Gems has established in this document that there are genuine issues of material fact regarding the validity of Meeshaa's claim to the DIAMOND ESSENCE mark, that there is no likelihood of confusion, and that there is no actual confusion. Therefore, Opposer's motion should be denied, and summary judgment should be granted in favor of Applicant. Applicant's mark should be permitted to proceed to registration on the Principal Register.

Respectfully Submitted,

Anaya Gems Inc.
Applicant

December 14, 2016

By:  _____

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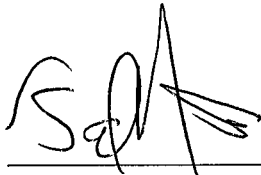
Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby Certify that the foregoing APPLICANT'S BRIEF IN OPPOSITION AND CROSS MOTION IN SUMMARY JUDGEMENT was served on Counsel for Opposer by first class mail at the Address below.

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