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

Proceeding	91226679
Party	Plaintiff The Net-a-Porter Group Limited
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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. 86/675,926
Published in the Official Gazette on November 17, 2015
For the mark TREK-A-PORTER TREK A PORTER

THE NET-A-PORTER GROUP LIMITED,

Opposer,

v.

WENLAN CHIA,

Applicant.

Opposition No. 91226679

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer The Net-A-Porter Group Limited (“Opposer”), pursuant to Trademark Rule of Practice 2.127 and Federal Rule of Civil Procedure 56(a), hereby moves for entry of summary judgment in its favor. In support of its motion for summary judgment, Opposer submits this supporting memorandum pursuant to Trademark Rule of Practice 2.127(a), together with the accompanying declaration of John Margiotta and the exhibits thereto.

INTRODUCTION

Since 2002, Opposer has owned numerous federal registrations for the mark NET-A-PORTER for a variety of goods and services, including, among many others, retail store services featuring apparel and accessories. Applicant Wenlan Chia (“Applicant”) seeks to register the highly similar mark TREK-A-PORTER TREK A PORTER (“Applicant’s Mark”) for various apparel and accessories.

As set forth in detail below, Applicant has **admitted** every fact necessary to prove that his registration and use of Applicant’s Mark is likely to cause confusion with the prior-used, federally registered marks of Opposer. Opposer therefore respectfully requests that its motion for summary judgment be granted.

STATEMENT OF FACTS

A. Opposer and the NET-A-PORTER Mark

Opposer, a premier online fashion luxury retailer, owns numerous federal registrations for the mark NET-A-PORTER, which has been used continuously since at least as early as June 2000. Opposer also owns trademark registrations for other A-PORTER suffix marks in connection with its business, including JET-A-PORTER and TV-A-PORTER (together with the NET-A-PORTER mark, the “NET-A-PORTER Marks”). As the United States Patent and Trademark Office status and title records attached to the Notice of Opposition demonstrate—

which are part of the record pursuant to Trademark Rule of Practice 2.122(d)—Opposer’s registrations for the NET-A-PORTER Marks cover a wide variety of goods and services, including, but not limited to, retail store services for clothing, shoes, handbags, accessories, personal care products, and eyewear, among many others. (*See* Notice of Opposition ¶¶ 3-8 & Ex. A, dkt. # 1.) The oldest registration for the NET-A-PORTER Marks issued in 2002. (*Id.*)

B. Applicant and His Application for Applicant’s Mark

As Applicant admits in his Answer, on June 26, 2015, Applicant, an individual, filed Application Serial No. 86/675,926 (the “Application”) to register Applicant’s Mark on an intent-to-use basis for use in connection with “eyewear, namely, sunglasses, eyeglasses, and ophthalmic frames and cases therefor” in International Class 9, “fashion handbags” in International Class 18, and “denims; women’s clothing, namely, shirts, dresses, skirts, blouses” in International Class 25. (*See* Answer ¶¶ 10-11, dkt. # 4.)

As indicated in the Application, which is part of the record pursuant to Trademark Rule of Practice 2.122(b), the Application was published for opposition on November 17, 2015.

C. This Opposition Proceeding

Opposer filed its Notice of Opposition on March 2, 2016, and the Trademark Trial and Appeal Board (the “Board”) instituted the proceeding as Opposition No. 91226679 and issued its scheduling order on the same day. (Declaration of John Margiotta In Support of Motion for Summary Judgment (“Margiotta Decl.”) ¶ 2; Dkt. # 1-2). Opposer has opposed the Application on the grounds that Applicant’s Mark is likely to cause confusion with the NET-A-PORTER Marks in violation of Section 2(d) of the Lanham Act, 15 U.S.C § 1052(d). (*See* Notice of Opposition ¶¶ 15-20, dkt. # 1.)

Applicant, represented by counsel Matthew Swyers of The Trademark Company, PLLC, filed his Answer to the Notice of Opposition on April 11, 2016. (Margiotta Decl. ¶ 3; Dkt. # 4).

D. Applicant Failed to Timely Respond to Opposer’s Discovery Requests

Under the Board’s governing scheduling order, discovery opened on May 11, 2016, and closed on November 7, 2016. (Margiotta Decl. at ¶ 4; Dkt. # 2.) On September 27, 2016, Opposer served on Applicant’s counsel by U.S. mail and email Opposer’s First Set of Requests for Admission (“Opposer’s Requests for Admission”), Opposer’s First Set of Requests for Production of Documents and Things (“Opposer’s Document Requests”), and Opposer’s First Set of Interrogatories (“Opposer’s Interrogatories, and with Opposer’s Requests for Admission and Opposer’s Document Requests, “Opposer’s Discovery Requests”). (Margiotta Decl. ¶ 5 & Ex. A.) Under the applicable rules, Applicant’s responses to Opposer’s Discovery Requests were due on or before November 1, 2016. (*Id.* ¶ 6.)

Applicant did not respond to Opposer’s Discovery Requests, or request an extension of the deadline from Opposer or the Board, on or before the November 1 deadline. (*Id.*) Then, on November 15, 2016, two weeks after the deadline, Applicant served responses to Opposer’s Requests for Admission. (*Id.* ¶ 7 & Ex. B.) Applicant did not provide any justification for serving his responses to Opposer’s Requests for Admission after the November 1 deadline. (*Id.* ¶ 7.)

As of the date of this motion, Applicant has not served responses to Opposer’s Document Requests or Opposer’s Interrogatories, nor has he requested any *post hoc* extension of time to do so. (*Id.* ¶ 8.)

ARGUMENT

A. Standard for Summary Judgment

A motion for summary judgment is an appropriate method for disposing of an *inter partes* proceeding when “there is no genuine issue as to any material fact [such] that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see also* 37 C.F.R. § 2.116(a) (Federal Rules of Civil Procedure generally apply to *inter partes* proceedings). Summary judgment “is regarded as ‘a salutary method of disposition,’ and the Board does not hesitate to dispose of cases on summary judgment when appropriate.” Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 528.01 (citations omitted).

Likelihood of confusion is “a legal conclusion based on underlying facts.” *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1843-44 (Fed. Cir. 2000); *see also Jack Wolfskin Aurustun Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 U.S.P.Q.2d 1129, 1134 (Fed. Cir. 2015). As such, it is an issue that “the [B]oard may unquestionably resolve . . . on summary judgment.” *Sweats Fashions Inc. v. Pannill Knitting Co.*, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987); *see also Hewlett-Packard Dev. Co. v. Vudu, Inc.*, 92 U.S.P.Q.2d 1630, 1632-33 (T.T.A.B. 2009) (granting summary judgment on the issue of likelihood of confusion with respect to certain goods).

B. Opposer’s Requests for Admission are Conclusively Admitted and Established

Federal Rule of Civil Procedure 36(a)(3) provides that requests for admission are deemed admitted *as a matter of law* if the receiving party fails to respond in writing within the required time period. Fed. R. Civ. P. 36(a)(3); *see also Fram Trak Indus., Inc. v. Wiretracks LLC*, 77 U.S.P.Q.2d 2000, 2005 (T.T.A.B. 2006) (“Respondent failed to respond to petitioner’s requests

for admission and failed to file a motion to amend or withdraw those admissions. Accordingly, those requests for admission are deemed admitted and conclusively established.”).

Here, Applicant did not respond to Opposer’s Requests for Admission by the deadline, nor did he request an extension of time to respond from Opposer or the Board. (Margiotta Decl. ¶¶ 6-7.) Therefore, Opposer’s Requests for Admission are deemed admitted as a matter of law. *See* TBMP § 407.03(a) (“If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law It is not necessary to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a).”).

C. Applicant’s Admissions Establish that Applicant’s Mark is Likely To Cause Confusion As a Matter of Law

To establish a likelihood of confusion on a motion for summary judgment, Opposer must establish that there is no genuine dispute of material fact that (1) it has standing to oppose the Application; (2) it has priority; and (3) Applicant’s registration of Applicant’s Mark is likely to cause confusion among consumers as to the sponsorship, affiliation or connection of goods and services offered under the parties’ respective marks. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d 1733, 1735 (T.T.A.B. 2001). As detailed below, based on the undisputed evidence in the record and Applicant’s own admissions, there can be no genuine dispute that Opposer has established each of these elements.

1. There Can Be No Dispute that Opposer Has Standing

Under the Lanham Act, “any person who believes that he is or will be damaged . . . by the registration of a mark” may file an opposition. 15 U.S.C. § 1063(a). This threshold standing requirement is satisfied where the opposer possesses a “real interest” in the proceeding.

Compuclean Mktg. & Design v. Berkshire Prods. Inc., 1 U.S.P.Q.2d 1323, 1324 (T.T.A.B. 1986) (citing cases). As the owner of the NET-A-PORTER Marks and registrations for the same, Opposer has standing to challenge the registration of Applicant's Mark, which is a confusingly similar mark. *See* 15 U.S.C. §§ 1052(d), 1063; TBMP § 309.03(b). Standing is therefore established.

Moreover, Applicant has admitted that Opposer has standing to oppose registration of Applicant's Mark and that it has no evidence to dispute Opposer's standing to bring this opposition. (Margiotta Decl., Ex. A (hereinafter "RFA") nos. 1-2.) Accordingly, there is no dispute that Opposer has standing.

2. There Can Be No Dispute that Opposer Has Priority

Priority is established by Opposer establishing proprietary rights in its NET-A-PORTER Marks arising from "a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); TBMP § 309.03(c)(A). Where the opposer proves that it owns a registration for its pleaded marks, priority is not an issue. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1072 (T.T.A.B. 2011) (stating that priority not at issue as to the marks and goods covered by the pleaded registrations that were of record). Here, Opposer's pleaded registrations for the NET-A-PORTER Marks are of record (Notice of Opposition, Ex. A), and thus priority is established.

Moreover, Applicant has admitted that Opposer had priority. Specifically, Applicant has admitted that Opposer's pleaded registrations for the NET-A-PORTER Marks issued prior to Applicant's filing date and prior to any alleged use of Applicant's Mark in the United States.

(RFA nos. 3-4.) Applicant also has admitted that he has no evidence to dispute Opposer's claim of priority. (RFA no. 5.) Therefore, no dispute exists regarding Opposer's priority of rights.

3. There is No Dispute of Material Fact that Applicant's Mark Is Not Entitled to Registration Under Section 2(d) of the Lanham Act

Section 2(d) of the Lanham Act states in pertinent part that a trademark shall be refused registration if it so resembles a prior-used or registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In determining likelihood of confusion, the Board reviews the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) ("*du Pont*"), to the extent relevant. *See Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1896-97 (Fed. Cir. 2000). Here, the relevant factors are: (i) the similarity of the NET-A-PORTER Marks and Applicant's Mark; (ii) the relatedness of the parties' respective goods and services; (iii) the strength of the NET-A-PORTER Marks; (iv) the overlap of the parties' trade channels and consumers; and (v) Applicant's intent.

In this case, Applicant has **admitted** all the facts necessary to show that the relevant *du Pont* factors overwhelmingly evidence a likelihood of confusion. Accordingly, Opposer is entitled to summary judgment on its Section 2(d) claim.

a. There Can Be No Dispute that the NET-A-PORTER Marks and Applicant's Mark are Highly Similar

The two key factors in a likelihood of confusion analysis are the similarities of the marks and the similarities of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010) ("In any

likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services.”). The similarity of the marks factor focuses on the similarity of the marks in their entireties as to appearance, sound, and commercial impression. *du Pont*, 177 U.S.P.Q. at 567.

By Applicant’s own admission, Applicant’s Mark is confusingly similar to the NET-A-PORTER Marks, Applicant’s Mark is visually similar to the NET-A-PORTER Marks, Applicant’s Mark is aurally similar to the NET-A-PORTER Marks, and Applicant’s Mark is similar to the NET-A-PORTER Marks with respect to overall commercial impression. (RFA nos. 8-11.) In addition, by Applicant’s own admission, consumers are likely to believe that Applicant is affiliated with, authorize by, or related to Opposer because Applicant’s Mark is similar to the NET-A-PORTER Marks. (RFA nos. 17-19.)

Accordingly, this *du Pont* factor weighs conclusively in favor of Opposer.

b. There Can Be No Dispute That Applicant’s Goods are Closely Related to Opposer’s Goods and Services

As stated above, another key *du Pont* factor is the similarity and relatedness of the parties’ goods and services offered under their respective marks. *See Federated Foods*, 192 U.S.P.Q. at 29; *In re Iolo Techs.*, 95 U.S.P.Q.2d at 1499. The goods and services at issue need not be identical for confusion to be likely; there need only be some similarity or relatedness between them. *See Recot, Inc.*, 54 U.S.P.Q.2d. at 1898 (“It is the sense of relatedness that matters in the likelihood of confusion analysis.”); *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (T.T.A.B. 1991).

By Applicant’s own admission, the goods identified in the Application are closely related to the goods and services offered in connection with the NET-A-PORTER Marks. (RFA no. 12.) Applicant also has admitted that he has no evidence that the parties’ goods are not related. (RFA

no. 13.) Finally, by Applicant's own admission, consumers are likely to believe that Applicant is affiliated with, authorize by, or related to Opposer because the parties' marks are similar and because the goods identified in the Application are related to the goods and services offered in connection with the NET-A-PORTER Marks. (RFA nos. 20-22.)

Accordingly, the *du Pont* factor concerning similarity of the parties' respective goods and services weighs conclusively in Opposer's favor.

c. There Can Be No Dispute that Opposer's the NET-A-PORTER Marks are Strong

Another important *du Pont* factor is the strength and fame of the senior mark. *See Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) (a famous mark "casts a long shadow which competitors must avoid"). By Applicant's own admission, the NET-A-PORTER marks are well known and he has no evidence that such marks are weak. (RFA nos. 15-16.)

As such, this *du Pont* factor weighs conclusively in favor of Opposer.

d. There Can Be No Dispute That the Parties' Trade Channels and Consumers Overlap

Another *du Pont* factor is the overlap of the parties' trade channels and consumers. *See du Pont*, 177 U.S.P.Q. at 567. In considering channels of trade and purchasers to determine likelihood of confusion, the Board must look to the application and registrations on the record before it. *See CBS Inc. v. Morrow*, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983).

The Application contains no limitations as to trade channels or purchasers. Therefore, the Board must presume that Applicant's apparel and accessory products will flow through all normal channels of trade and be sold to all normal consumers for such goods. *See In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1639 (T.T.A.B. 2009) (stating that where "there are no

limitations as to channels of trade or classes of purchasers,” it is presumed that the goods “move in all channels of trade normal for those products, and that they are available to all classes of purchasers for the listed goods”). Opposer’s registrations for the NET-A-PORTER Marks likewise are not limited to any particular trade channels or customers.

Given that neither party has limited its trade channels or purchasers, and given that the parties’ goods are closely related by Applicant’s own admission (RFA no. 12), the parties’ respective trade channels and customers are presumed to overlap. *See Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1268 (T.T.A.B. 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to the trade channels and purchasers, [the parties’ goods] could be offered and sold to the same classes of purchasers through the same channels of trade.”). Moreover, by Applicant’s own admission, he has no evidence that consumers for the goods provided or intended to be provided under Applicant’s Mark do not overlap with the consumers of goods and services provided by Opposer under the NET-A-PORTER Marks. (RFA no. 14.)

Accordingly, the *du Pont* factor concerning the overlap of trade channel and customers weighs conclusively in favor of Opposer.

e. Applicant’s Intent

It is clear that Applicant was well-aware of Opposer’s NET-A-PORTER Marks when Applicant adopted and applied to register Applicant’s Mark for closely related goods. By Applicant’s own admission, Applicant was aware of Opposer’s NET-A-PORTER marks prior to adopting Applicant’s Mark and prior to filing the Application. (RFA nos. 6-7.) Applicant has further admitted that the registration and use of Applicant’s Mark could destroy Opposer’s investment and goodwill in the NET-A-PORTER Marks. (RFA nos. 25-26.) As such, this factor

favors a finding of likelihood of confusion.

Moreover, even if there were a dispute concerning Applicant's intent, it is not a material dispute—in fact, it is irrelevant given all of the other factors discussed above. *See, e.g., Daddy's Junky Music Stores, Inc v. Big Daddy's Family Music Ctr.*, 42 U.S.P.Q.2d 1173, 1183 (6th Cir. 1997) (“[T]he *presence* of intent can constitute strong evidence of confusion The converse of this proposition, however, is not true; the *lack* of intent by a defendant is largely irrelevant in determining if consumers likely will be confused as to source.” (emphasis in original)).¹

f. Weighing of the Factors

Weighing the factors, it is clear that there can be no dispute that there is a likelihood of confusion between Applicant's Mark and the NET-A-PORTER Marks, as every relevant factor favors Opposer. Indeed, Applicant has admitted as much—by Applicant's own admission, his use and registration of Applicant's Mark is likely to cause confusion or mistake or deceive the public vis-à-vis the NET-A-PORTER Marks. (RFA nos. 23-24.)

CONCLUSION

For the foregoing reasons, the undisputed facts and admissions establish a likelihood of confusion, mistake, and deception arising from registration of Applicant's Mark and, thus, Opposer is entitled to summary judgment on its Section 2(d) claim.

Accordingly, Opposer respectfully requests that registration be refused to Application Serial No. 86/675,926 and that judgment for Opposer be entered in this proceeding.

¹ Likewise, it is well-established that “it is unnecessary to show actual confusion in establishing a likelihood of confusion,” which is the test for infringement. *Giant Food, Inc v. Nation's Foodservice, Inc.*, 218 U.S.P.Q. 390, 396 (Fed. Cir. 1983).

Accordingly, Opposer respectfully requests that registration be refused to Application Serial No. 86/675,926 and that judgment for Opposer be entered in this proceeding.

Dated: December 9, 2016
New York, NY

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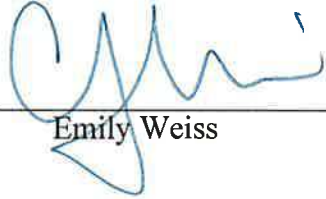
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¹ Likewise, it is well-established that “it is unnecessary to show actual confusion in establishing a likelihood of confusion,” which is the test for infringement. *Giant Food, Inc v. Nation’s Foodservice, Inc.*, 218 U.S.P.Q. 390, 396 (Fed. Cir. 1983).

CERTIFICATE OF SERVICE

I hereby certify that on December 9, 2016, a copy of the foregoing **OPPOSER'S MOTION FOR SUMMARY JUDGMENT** was sent by First Class mail, postage pre-paid, to Applicant's counsel of record at the following address:

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