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Filing date: **09/29/2017**

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

Proceeding	91234701
Party	Plaintiff TVI, Inc.
Correspondence Address	CHRISTOPHER W PIRNKE INSLEE BEST DOEZIE & RYDER PS 10900 NE 4TH ST STE 1500 BELLEVUE, WA 98004 UNITED STATES Email: ddascenzo@insleebest.com, jkovalenko@insleebest.com, cpirnke@insleebest.com, mleen@insleebest.com
Submission	Other Motions/Papers
Filer's Name	Mark S. Leen
Filer's email	mleen@insleebest.com, cpirnke@insleebest.com, ddascenzo@insleebest.com, jkovalenko@insleebest.com
Signature	/Mark S. Leen/
Date	09/29/2017
Attachments	Opposers Motion for Board to Amend and Suspend.pdf(120960 bytes) Declaration of Mark Leen in Support of Opposers Motion.pdf(289965 bytes)

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

In the matter of trademark application Serial No. 87149184	Opposition No. 91234701
TVI, INC, a Washington corporation, Opposer, v. CASSIDY M. ELLIS, Applicant.	OPPOSER’S MOTION FOR THE BOARD TO USE ITS INHERENT POWER TO (1) AMEND APPLICANT’S DESCRIPTION OF SERVICES AND DISMISS OPPOSITION WITHOUT PREJUDICE AND (2) SUSPEND THE PROCEEDING

MOTION

The Opposer, TVI, Inc., by and through its attorneys of record, Mark S. Leen, Christopher W. Pirnke, and the law firm of Inslee, Best, Doezie & Ryder, P.S., hereby makes the following Motion for the Board to use its inherent power to (1) amend Applicant’s description of services and dismiss this opposition proceeding without prejudice and (2) suspend this proceeding with respect to all matters not germane to the motion (“Motion”).

I. RELIEF REQUESTED.

TVI respectfully requests the Board, as provided for under its inherent authority and pursuant to the agreement of the Applicant to resolve these proceedings via amendment of its description of services and dismissal of the opposition proceeding without prejudice, amend the description of services to say “On-line retail store services featuring new and used luxury goods; On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring authenticated new and used handbags” and dismiss the opposition proceeding without

prejudice. TVI further requests that the proceedings be suspended with respect to all matters not germane to the Motion.

II. STATEMENT OF FACTS.

On July 31, 2017, Applicant confirmed that it would settle this opposition proceeding on the following terms:

1. [Applicant] changes their ID of services to IC 035: “On-line retail store services featuring new and used luxury goods; On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring authenticated new and used handbags”
2. The parties agree to dismiss the pending proceeding (i.e., withdrawal of the opposition) without prejudice, each side to bear their own fees and costs incurred in relation to the proceeding.
3. The parties otherwise reserve all of their rights.

On August 31, TVI responded “We have a deal. Please prepare the appropriate document regarding the withdrawal and narrowing of the scope of services.” Applicant responded the same day with “OK, sounds good.” Despite the clear agreement to resolve the case as indicated above, Applicant now refuses to amend its description of services and dismiss the pending proceeding without prejudice. (Leen Decl. and Exh. A)

III. STATEMENT OF ISSUES

Whether the Board should use its inherent authority, grant the Motion, amend the description of services, and dismiss the opposition proceeding without prejudice.

Whether the Board should suspend this proceeding with respect to all matters not germane to the Motion.

IV. EVIDENCE RELIED UPON

This Motion is based upon the Declaration of Mark Leen and the Exhibit attached thereto as well as the pleadings and files herein.

V. AUTHORITY

The TTAB has the inherent authority to sanction. *See* TBMP at §527.03. For example, “[w]hen a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor.” *Id.* Applicant agreed to amend its description of services and have this proceeding dismissed without prejudice. The TTAB should, therefore, amend the description of services and dismiss this proceeding without prejudice.¹ Additionally, the TTAB should suspend the proceeding with respect to all matters not germane to the Motion. *See* TBMP § 510.03(a); *See also* 37 CFR § 2.127(d).

VI. CONCLUSION

Based on the foregoing, the TTAB should exercise its inherent authority to amend the description of services and dismiss this proceeding without prejudice. Further, the proceedings should be suspended with respect to all matters not germane to the Motion.

RESPECTFULLY SUBMITTED this 29th day of September, 2017.

INSLEE, BEST, DOEZIE & RYDER, P.S.

By *s/Mark S. Leen*

Mark S. Leen, W.S.B.A. #35934
Chris W. Pirnke, W.S.B.A. #44378
Attorneys for Opposer TVI, Inc.

¹ *See also* TBMP §514.02 & .03 regarding the ability of the Board to amend applications.

CERTIFICATE OF DEPOSIT

Date of Deposit: September 29, 2017

I hereby certify that on September 29, 2017, Counsel for Opposer filed the foregoing *Opposer's Motion for the Board to Use Its Inherent Power to (1) Amend Applicant's Description of Services and Dismiss Opposition Without Prejudice and (2) Suspend the Proceeding* electronically using the Electronic System for Trademark Trials and Appeals.

s/Mark S. Leen

Mark S. Leen, W.S.B.A. #35934
Chris W. Pirnke, W.S.B.A. #44378
Attorneys for Opposer TVI, Inc.

CERTIFICATE OF SERVICE

Date of Service: September 29, 2017

I hereby certify that on September 29, 2017, Counsel for Opposer served a true and complete copy of the foregoing *Opposer's Motion for the Board to Use Its Inherent Power to (1) Amend Applicant's Description of Services and Dismiss Opposition Without Prejudice and (2) Suspend the Proceeding* on the attorney for the Applicant by forwarding said copy on September 29, 2017, via e-mail to:

Joshua Schoonover
Coastal Patent Law Group PC
PO Box 131299
Carlsbad, CA 92013
United States
Email: LawGroup@CoastalPatent.com
Attorney for Applicant Cassidy M. Ellis

s/Mark S. Leen

Mark S. Leen, W.S.B.A. #35934
Chris W. Pirnke, W.S.B.A. #44378
Attorneys for Opposer TVI, Inc.

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

In the matter of trademark application Serial No. 87149184	Opposition No. 91234701
TVI, INC, a Washington corporation, Opposer, v. CASSIDY M. ELLIS, Applicant.	DECLARATION OF MARK LEEN IN SUPPORT OF OPPOSER’S MOTION FOR THE BOARD TO USE ITS INHERENT POWER TO (1) AMEND APPLICANT’S DESCRIPTION OF SERVICES AND DISMISS OPPOSITION WITHOUT PREJUDICE AND (2) SUSPEND THE PROCEEDING

Mark Leen, under penalty of perjury under the laws of the United States, declares as follows:

1. I am an attorney at Inslee, Best, Doezie & Ryder, P.S., attorneys for the Opposer, TVI, Inc. I am over 21 years old, am competent to testify as to the matters set forth herein, and testify based upon my personal knowledge.
2. Attached hereto as **Exhibit A** and incorporated herein is an email exchange between me and the attorney of record for Applicant regarding Applicant’s agreement to settle this opposition proceeding. The language quoted in the Motion appears in the first two pages of the email string.
3. Applicant now refuses to comply with its agreement.

Signed this 29th day of September, 2017, at Bellevue, Washington.

/s/ Mark S. Leen
Mark S. Leen, WSBA #35934
Attorney for Opposer TVI, Inc.
10900 NE 4th St., Suite 1500
Bellevue, WA 98009-9016
(425) 455-1234
mleen@insleebest.com

CERTIFICATE OF DEPOSIT

Date of Deposit: September 29, 2017

I hereby certify that on September 29, 2017, Counsel for Opposer filed the foregoing *Declaration of Mark Leen in Support of Opposer’s Motion for the Board to Use Its Inherent Power to (1) Amend Applicant’s Description of Services and Dismiss Opposition Without Prejudice and (2) Suspend the Proceeding* electronically using the Electronic System for Trademark Trials and Appeals.

s/Mark S. Leen
Mark S. Leen, W.S.B.A. #35934
Chris W. Pirnke, W.S.B.A. #44378
Attorneys for Opposer TVI, Inc.

CERTIFICATE OF SERVICE

Date of Service: September 29, 2017

I hereby certify that on September 29, 2017, Counsel for Opposer served a true and complete copy of the foregoing *Declaration of Mark Leen in Support of Opposer’s Motion for the Board to Use Its Inherent Power to (1) Amend Applicant’s Description of Services and Dismiss Opposition Without Prejudice and (2) Suspend the Proceeding* on the attorney for the Applicant by forwarding said copy on September 29, 2017, via e-mail to:

Joshua Schoonover
Coastal Patent Law Group PC
PO Box 131299
Carlsbad, CA 92013
United States
Email: LawGroup@CoastalPatent.com
Attorney for Applicant Cassidy M. Ellis

s/Mark S. Leen
Mark S. Leen, W.S.B.A. #35934
Chris W. Pirnke, W.S.B.A. #44378
Attorneys for Opposer TVI, Inc.

EXHIBIT A

Jerilyn K. Kovalenko

From: Joshua S. Schoonover, Esq. <jschoonover@coastalpatent.com>
Sent: Tuesday, August 01, 2017 1:34 PM
To: Mark S. Leen
Cc: Jerilyn K. Kovalenko; 'Shannon Whitmore'
Subject: RE: Follow-Up - FRE 408

OK, sounds good.

Thanks,

Josh

From: Mark S. Leen [<mailto:mleen@insleebest.com>]
Sent: Tuesday, August 1, 2017 1:33 PM
To: 'Joshua S. Schoonover, Esq.'
Cc: Jerilyn K. Kovalenko; 'Shannon Whitmore'
Subject: RE: Follow-Up - FRE 408

Josh,

We have a deal. Please prepare the appropriate document regarding the withdrawal and narrowing of the scope of services.

Sincerely,

Mark

From: Joshua S. Schoonover, Esq. [<mailto:jschoonover@coastalpatent.com>]
Sent: Monday, July 31, 2017 2:02 PM
To: Mark S. Leen <mleen@insleebest.com>
Cc: Jerilyn K. Kovalenko <jkovalenko@insleebest.com>; 'Shannon Whitmore' <swhitemore@savers.com>
Subject: RE: Follow-Up - FRE 408

Hi Mark,

Yes, i confirm this is correct.

Josh

On Jul 31, 2017 2:01 PM, "Mark S. Leen" <mleen@insleebest.com> wrote:

Josh,

So to be clear, your client's offer is:

1. Your client changes their ID of services to IC 035: “On-line retail store services featuring new and used luxury goods; On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring authenticated new and used handbags”

2. The parties agree to dismiss the pending proceeding (i.e., withdrawal of the opposition) without prejudice, each side to bear their own fees and costs incurred in relation to the proceeding.

3. The parties otherwise reserve all of their rights.

Please confirm, and I will take this to my client.

Mark

From: Joshua S. Schoonover, Esq. [<mailto:jschoonover@coastalpatent.com>]
Sent: Monday, July 31, 2017 1:16 PM
To: Mark S. Leen <mleen@insleebest.com>
Cc: 'Shannon Whitemore' <swhitemore@savers.com>; Jerilyn K. Kovalenko <Jkovalenko@insleebest.com>
Subject: RE: Follow-Up - FRE 408

Hi Mark,

Thanks for the email.

I showed the case to four mentors, they each reviewed the application, the website at issue and your complaint, and advised me prior to filing our answer. I almost always ask for a consensus before seeking sanctions/Motion to Dismiss (as I intended to do initially, but later decided against). So yes, I did. The consensus was that you have **no chance** of proving likelihood of confusion based on the facts, but that seeking sanctions was not appropriate and better to let you try to present a case and for me to just defeat it. I find it unbelievable that you apparently haven't been told the same.

Also, the descriptions are not so broad as you suggest, they are limited to **Online** stores, **Luxury** goods, **authenticated** new and used handbags. Your client does not sell online! There is no overlap. Ask your client how many Luois Vuitton handbags it has sold in its 350 stores? (I certainly will in discovery)

In addition, your client should not be concerned about confusion because Savers' customers are not going to shop at my client's website, and vice versa.

I could argue that the Louie Vuitton purse you describe appearing in a thrift store was an isolated event, likely planted by the thrift store owner in an effort to promote shopping at that location (fake news). Nevertheless, the point is not whether a Louis Vuitton article ever ended up in a thrift store, the point is that a relevant consumer looking for an authentic Louis Vuitton article would NOT look to a thrift store for the purpose of procuring such an item.

In fact, I can probably find more stories on the net about people duped into buying fake luxury items at thrift stores:

<http://www.fairfaxunderground.com/forum/read/2/1299076.html>

<https://forum.purseblog.com/threads/fake-purse-from-boutique-thrift-store-question.871806/>

<https://forum.purseblog.com/threads/when-you-find-a-fake-in-a-thrift-store.756864/>

<http://ask.metafilter.com/44291/Can-a-consignment-shop-get-away-with-selling-fake-designer-purses>

My favorite: <https://forum.purseblog.com/threads/savers-and-counterfeit-bags.342816/>

Next, you may not have discovery for me, but I have discovery for your client. You made certain allegations about the millions of dollars sold by your client and substantial amounts of money expended since the marks were registered (circa 2006.. I believe... 10 years?)... We will need to explore your client's financials 2006 to date in order to verify these claims.

I just got off the phone with my client, and she will not make any further changes other than what we proposed. We think our proposal is more than fair to your client. I ask you to reconsider, or alternatively please let me know if your client refuses so that I can start preparing my initial disclosures, discovery requests and motion.

You should know that I just informed my client that I am sure she has a strong case, and I will be taking the remainder of the case on as part of my pro bono work. For this reason, cost is no longer a concern to my client. ACR is off the table, we will run a full discovery and overturn every rock. I will file every motion and discovery request permissible and pertinent to the case. I will even be requesting oral argument if it gets there.

Regarding your vacation, I note that you are not named as lead counsel on the matter (Christopher Pirnke is), and there are several other attorneys with POA (D DASCENZO, J KOVALENKO, C PIRNKE). This is the downside to having four attorneys listed on the matter. Your vacation does not seem to be a necessary excuse to delay the case since you are only one of four competent attorneys, and not lead counsel. No disrespect, but if you take it to the Board, I will just point out these facts in my opposition. I hope it doesn't come to this, because the proposed settlement we are offering seems reasonable.

Last chance, we propose to amend as follows in exchange for your withdraw of the Opposition:

IC 035: "On-line retail store services featuring new and used luxury goods; ~~On-line retail store services featuring new and used handbags~~; On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring authenticated new and used handbags"

Take it or leave it.

Please let me know by end of day tomorrow or you can expect us to remove the offer and begin motions/discovery.

Best Regards,

Josh

From: Mark S. Leen [<mailto:mleen@insleebest.com>]
Sent: Monday, July 31, 2017 11:38 AM
To: 'Joshua S. Schoonover, Esq.'
Cc: 'Shannon Whitemore'; Jerilyn K. Kovalenko
Subject: RE: Follow-Up - FRE 408

Josh,

Thanks for your prompt response. I am including Shannon Whitmore, Corporate Counsel at Savers and my client contact, on this email. Please feel free to include her on your response.

Did you explain to your mentors (including the USPTO judge) that you have an intent-to-use application featuring a standard character mark and broad descriptions such as “On-line retail store services featuring luxury goods” and “On-line retail store services featuring new and used handbags”? I suspect that, if you did, you would get a very different response than the ones you are passing onto me.

Your understanding of the thrifting industry and pop culture also appears dated. For example, see:

<http://www.pe.com/2012/08/09/riverside-shoppers-unearth-treasures-at-savers-thrift-store/> (“The moment Sonia Martinez, 50, of Riverside, walked in, a Louis Vuitton wallet marked \$100 stopped her cold. “This would be \$300 retail,” she exclaimed.”);

<http://vidafashionista.com/savers-thrift/> (“It’s great to be trendy and have new things but some of the greatest treasures can be found in a thrift store. I walked out with a new Louis Vuitton purse and flute!”);

Season Three, Episode Eighteen of *Sex and the City* (Carrie and Miranda in a thrift store digging for treasure).

That said, I think we are close, but my client will not settle unless your client removes “On-line retail store services featuring new and used luxury goods” and makes a couple *small* additional tweaks that would leave the description as “On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring new and used authenticated luxury handbags.”

Your indication that you would file a motion that cuts into my vacation played no role in this determination (although neither I nor my client appreciated it). If we do not settle, I request you extend me the courtesy of not filing a motion that cuts into my vacation. The result of doing so will just require me to take the issue to the Board.

As far as formal settlement terms:

1. Your client changes their ID of services to “On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring new and used authenticated luxury handbags.”
2. The parties agree to dismiss the pending proceeding without prejudice, each side to bear their own fees and costs incurred in relation to the proceeding.
3. The parties otherwise reserve all of their rights.

This offer shall stay open until August 3, 2017, at 5:00pm.

Sincerely,

Mark

From: Joshua S. Schoonover, Esq. [<mailto:jschoonover@coastalpatent.com>]
Sent: Monday, July 31, 2017 10:17 AM
To: Mark S. Leen <mleen@insleebest.com>
Cc: Tawnya A. Sarazin <tsarazin@insleebest.com>; Jerilyn K. Kovalenko <Jkovalenko@insleebest.com>; Christopher W. Pirnke <CPirnke@insleebest.com>
Subject: RE: Follow-Up - FRE 408

Hi Mark,

So you have it in email to take to your client:

My client is willing to amend the services connected with her mark THE REAL STYLE YOU as follows:

IC 035: “On-line retail store services featuring new and used luxury goods; ~~On-line retail store services featuring new and used handbags~~; On-line retail store services featuring authenticated luxury goods; On-line retail store services featuring authenticated new and used handbags”

Please have your client visit my client’s website, if they haven’t already: www.StyleYou.com

I think they will find that there truly is no similarity of services, as my client sells: (i) **online** (no physical store) as explicitly identified in the description of her services (above); (ii) **exclusively on her website**; and (iii) **luxury articles** (Louis Vuitton [now], and Hermes, Burberry, Prada , etc. [coming soon]), (iv) which are **authenticated**.

No reasonable person could come to a conclusion that a consumer of these luxury articles would expect to find them at a thrift store, such as Savers. The consumers are different as one looks to buy \$1000+ handbags from my client, the other looks to buy a \$10 handbag from your client. Consumers who patronize my client’s online store would not be caught in a thrift store such as Savers for obvious reasons (have you seen the movie clueless?). Likewise, customers of Savers are looking for a budget buy, I bet through discovery we can find the average price of your client’s handbags is less than \$50, and probably less than \$25 (i.e. Savers customers are distinguished by what they spend on the relevant articles) and it is highly unlikely that one with that budget would shop on my client’s website. The channels of trade are different (your client’s physical stores and being thrift stores, vs. my clients high end online ecommerce website for trading used and new luxury articles). The consumers are different as described above. Surely you and TVI can see this. I beg you to try to be objective before you cause further monetary harm to my client, a nice young lady just trying to launch a small business. It does not serve justice to milk her resources dry before she gets any momentum going, or to delay her registration of this mark without good cause.

I think you know in your heart that none of the du Pont factors weigh in your client’s favor; though I don’t expect you to admit it. I would hope that you would counsel your client on the true and objective likelihood of prevailing, which is very slim to none (consensus of **ALL** of my mentors asked to weigh in, one is former USPTO TTAB Judge others are more experienced attorneys than I). I wonder if anyone with TTAB experience at your firm objectively believes that you have a winning case? The only similarity is the word STYLE, but that term is heavily connected with handbags and has little distinguishing effect on the overall marks, therefore will be given little weight by the Board.

Keep in mind the ultimate question is whether the consuming public would be confused as to the source of the services. Ask yourself, who is likely to be confused? I can’t think of a reasonable person that would confuse my client’s website with the services your client offers through its 350+ thrift stores. Can your client, or anyone on your team objectively believe that there is a likelihood of confusion? Who would believe that a

high-end luxury goods website is connected to a bargain-bin brick and mortar thrift store? Also, a review of your client's website shows the subject marks are not even used online, but exclusively in physical stores! I can go on... so many distinguishing facts... but this email is long enough already and I think you get the point.

My client wants this registration badly, she is committed to see it through, though she knows the cost of the process could wipe her out in the end. Don't do that to her, she deserves better.

Thank you in advance for discussing with your client and considering with an objective mind the merits of this case, and the possibility of settling should my client amend as above.

Regards,

Josh

Joshua S. Schoonover, Esq.

Patent Attorney



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Cell: 858.945.7817

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jschoonover@coastalpatent.com

www.CoastalPatent.com

From: Mark S. Leen [<mailto:mleen@insleebest.com>]
Sent: Monday, July 31, 2017 9:07 AM
To: 'Joshua S. Schoonover, Esq.'
Cc: Tawnya A. Sarazin; Jerilyn K. Kovalenko; Christopher W. Pirnke
Subject: Follow-Up

Josh,

FYI, I have a planned vacation from August 18 through the 24 that affects my ability to get a motion done in this case. I may be able to get it done before I leave on vacation, but I also have some other matters competing for interest. I hope this explanation makes the timeline I was talking about for the motion a little more understandable.

In addition, I understand your desire to know definitively re expert discovery, but the TTAB authority I have looked at leaves open the possibility that expert discovery could be required in this case to establish a basis for the board to make the conclusions it has made in other cases. The type of expert testimony I would be looking at are in the area of (1) consumer expectations re websites, (2) consumer tendencies to shorten trademarks, and (3) industry standard in terms of websites among retail stores.

At this point, I don't see the need for discovery of your client given that they are pursuing an intent-to-use application. I read the authority to indicate that the analysis of your client's application will, therefore, be based on the mark and scope of services.

On the settlement front, I understand your client's and your gut reaction that an online store featuring only new and used authenticated Luis Vuitons (and similar high-end-authenticated hand bags) is not going to be confused with my client's stores, which sell a broad array of used goods. However, your application's description of services is *much broader*, extending to "On-line retail store services featuring ... used handbags[.]" If your client were open to narrowing the scope of services, we *might* be able to get this resolved. Let me know, and I can discuss this with my client along with the ACR schedule you proposed.

Sincerely,



Mark S. Leen | Shareholder

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