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

Proceeding	91235735
Party	Defendant Gucci America, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/206,686
Published in the *Official Gazette* on May 23, 2017

FOREVER 21, INC.,

Opposer,

-against-

GUCCI AMERICA, INC.,

Applicant.

Opp. No. 91/235,735

**REQUEST THAT THE BOARD
MAINTAIN THE CURRENT TRIAL
SCHEDULE**

Applicant Gucci America, Inc. (“Applicant”) submits this Request That The Board Maintain The Current Trial Schedule, in response to the filing by Opposer Forever 21, Inc. (“Opposer”) on October 2, 2017 of a Notice of All Pending Actions. Applicant respectfully requests that the Trademark Trial and Appeal Board (the “Board”) not suspend the instant action before it for the following reasons.

1. Applicant Will Suffer Prejudice From Suspension

Applicant will be prejudiced from the delay that will result from any suspension and the consequent lag time in obtaining its federal registration. While common law rights in trademarks are unquestionably valuable, registration affords additional concrete and valuable rights to a trademark owner that are often essential to its business operations. Among the legal rights conferred by a federal trademark registration on the Principal Register are the following:

- Registration constitutes prima facie evidence (a) that the mark is valid, (b) that the registrant owns the mark, and (c) that the registrant has the exclusive right to use the mark in commerce on or in connection with the goods or services specified by the registration.
- Once a registration is more than five years old, it can be cancelled only on limited statutory grounds.

- Once a registration becomes incontestable, it provides “conclusive evidence” of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark, subject to certain statutory defenses.
- Registration provides constructive notice of the registrant’s ownership of the registered mark.
- Registration affords the trademark owner constructive use priority, providing a nationwide right of priority against third parties.
- Registration allows the trademark owner to pursue counterfeiting claims and the special remedies for counterfeiting contained in the Lanham Act.
- Registration supports a claim that the trademark owner’s mark is famous for dilution purposes and provides the registrant a complete defense against dilution claims asserted under state law.
- Registration allows the trademark owner to record its registered rights with the U.S. Customs and Border Protection Service in order to prevent importation of infringing products bearing the registered mark.
- Registration allows the trademark owner to obtain registration in foreign countries under international trademark treaties.
- Registration improves the effectiveness of trademark searching and deters infringement of registered marks.
- Registration affords the trademark owner the right to use the registration symbol, giving notice that the mark is federally registered.
- Registration supports a claim of distinctiveness for subsequent applications filed by the registrant covering the same or a related mark.
- The prior registration defense can allow the registrant to overcome an opposition and to obtain subsequent registrations for the same or a substantially identical mark covering the same or substantially identical goods.

Without these legal and other rights and benefits, a trademark owner’s ability to enforce and defend its rights is significantly hampered. The U.S. Supreme Court has itself recognized the importance and value that inhere in the rights conveyed by registration. *See B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (“[r]egistration is significant” because it

“confers important legal rights and benefits”) (quotations omitted). Delaying the acquisition of such important rights thus prejudices Applicant.

For an owner such as Applicant, whose famous trademarks are frequently the subject of imitation and counterfeit, including across international borders, the harm is particularly severe, as every day without a federal registration is potentially costly, given that Applicant’s products are particularly susceptible to counterfeiting. See <https://blog.brandbastion.com/how-counterfeit-goods-are-hijacking-luxury-brands-on-instagram> (listing Gucci as among five most-targeted brands for fake Instagram accounts selling counterfeit goods). The global protections afforded by the U.S. Customs and Border Protection Service’s seizure of infringing imports are especially valuable to Applicant, such that any delay in obtaining its federal registrations has the potential to cause significant and concrete harm to Applicant. Likewise, delay in availing itself of the registration-related benefits and presumptions that would be available in legal actions against third-party infringers (of whom there are many) will unfairly prejudice Applicant in the enforcement of its rights domestically.

2. The Board Has Primary Jurisdiction Over The Registration Process

The Board’s role is to determine issues related to the registrability of trademarks; the instant proceeding concerns fundamental trademark-qualifying questions that are squarely within the United States Patent and Trademark Office (“USPTO”)’s mandate to address. This case should not be suspended because of a later-filed civil action centering around trademark confusion and dilution. The issues herein, involving alleged trademark genericness and functionality, and inherent and acquired distinctiveness, are most appropriately resolved by the Board. *Cf.* 15 U.S.C. § 1119 (giving district court jurisdiction over trademark *registrations*, not *applications*). They align precisely with the “fundamental purpose of the USPTO, which is to

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CERTIFICATE OF PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing Request That The Board Maintain The Current Trial Schedule has been served on Opposer Forever 21, Inc. by forwarding said copy on October 5, 2017 via email to the following email addresses:

- lchapman@sheppardmullin.com
- tqiu@sheppardmullin.com
- mtom-hum@sheppardmullin.com

Dated: October 5, 2017

/Jessica A. Rose/

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