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

Proceeding	91243006
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application  
Serial No. 86/710,362  
Mark: 24/7

DOLCE VITA INTIMATES LLC,

Opposer/Respondent,

-against-

THIRDLOVE, INC.,

Applicant/Petitioner.

Proceeding No. 91/243,006

**APPLICANT/PETITIONER'S OPPOSITION TO  
OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT**

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Applicant/Petitioner ThirdLove, Inc. (“Applicant/Petitioner” or “ThirdLove”) submits this Opposition in response to the cross-motion for summary judgment filed by Opposer/Respondent Dolce Vita Intimates LLC (“Opposer/Respondent” or “Dolce Vita”).<sup>1</sup>

In response to Applicant/Petitioner’s Motion for Summary Judgment, Opposer/Respondent has cross-moved for summary judgment, asserting that “Applicant’s 24/7 mark is confusingly similar to Opposer’s registered 24/7 COMFORT trademark.” Cross-Motion at 4. For the reasons set forth below, Opposer/Respondent’s cross-motion for summary judgment should be denied, and Applicant/Petitioner’s Motion for Summary Judgment should be granted.

### **I. Legal Standards for Summary Judgment**

Summary judgment is appropriate where the moving party shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the initial burden of demonstrating the absence of any genuine dispute of material fact, and that he is entitled to a judgment under applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793, 1796 (Fed. Cir. 1987). The burden on the non-movant to respond arises only if the summary judgment motion is properly supported. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-161 (1970). If the evidence produced in support of the summary judgment motion does not meet the moving party’s burden, “summary judgment must be denied even if no opposing evidentiary matter is presented.” *Id.* (quoting Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments).

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<sup>1</sup> Opposer/Respondent’s cross-motion for summary judgment appears to be limited to pages 4-6 of its submission in response to Applicant/Petitioner’s Motion for Summary Judgment.

A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992).

**II. Opposer/Respondent Relies Solely on the Examining Attorney's Rejection, Which Applicant/Petitioner Overcame, and Fails to Show There Is No Genuine Issue of Material Fact**

Opposer/Respondent does not establish that there is no genuine issue of material fact or that it is entitled to summary judgment on the issue of likelihood of confusion. Instead, Opposer/Respondent merely regurgitates the Examining Attorney's initial rejection of Applicant/Petitioner's application for the mark 24/7 and summarily concludes that the Examining Attorney's rejection was correct without providing any independent reasoning or probative evidence supporting its conclusion. Cross-Motion at 4. Opposer/Respondent does admit, however, that Applicant/Petitioner *overcame* the rejection based on its arguments that Opposer/Respondent's mark is distinguishable from Applicant/Petitioner's 24/7 mark.<sup>2</sup> *Id.* at 5.

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<sup>2</sup> Applicant/Petitioner's Office Action Response to the Examining Attorneys' rejection is included as Exhibit A to the accompanying Declaration of Ryan S. Klarberg ("Klarberg Dec."). In the Response, Applicant/Petitioner explained the differences between its 24/7 mark and the cited marks, including Opposer/Respondent's alleged 24/7 COMFORT mark, based on (1) the marks' having different connotations and (2) dilution of the term 24/7 among registered marks in Class 25.

Significantly, in considering the question of likelihood of confusion, the Board cannot rely on arguments or findings made during examination. *Henne Inc. v. Worldwide Jr Wood, LLC*, No. CANCELLATION 9205143, 2011 WL 11535912, at \*3 (T.T.A.B. Sept. 14, 2011) (“[T]he Board must determine the merits of petitioner’s claim on the record before it and is not bound by the determination of the examining attorney.”) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 U.S.P.Q.2d 1564 (Fed. Cir. 2001)); *see also Southwest Specialty Food Inc. v. Crazy Uncle Jester’s Inferno World, LLC*, No. CANCELLATION 9206080, 2016 WL 3771779, at \*11 (T.T.A.B. June 24, 2016) (“Petitioner’s reliance on the Examining Attorney’s Section 2(d) refusal of its replacement application does not establish the absence of any genuine dispute of material fact regarding likelihood of confusion. We must determine the merits of Petitioner’s Section 2(d) claim on the record before us and are not bound by the determination of the examining attorney.”); *In re Rodale Inc.*, 80 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 2006) (holding a mark not registrable, the court noted that “[a]lthough consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us.”) (citing *In re Nett Designs*, 236 F.3d at 1339). Opposer/Respondent has provided no basis for the Board to find that there is no genuine issue of material fact on the issue of likelihood of confusion, and thus Opposer/Respondent’s cross-motion for summary judgment should be denied.

**III. Opposer/Respondent Is Not Entitled to Summary Judgment Because It Did Not Address the *DuPont* Factors**

Applicant/Petitioner cannot proffer a complete, substantive response to Opposer/Respondent’s cross-motion for summary judgment. In particular, Applicant/Petitioner needs further discovery on matters relating to likelihood of confusion. Moreover, Opposer/Respondent has provided no record on which the Board can consider the issue of

likelihood of confusion and has failed to address the requisite *DuPont* factors. Based on these matters alone, the Board should deny Opposer/Respondent's cross-motion for summary judgment.<sup>3</sup>

Opposer/Respondent did not address the *DuPont* factors, as it was required to do. *See In re Guild Mortgage Co.*, 912 F.3d 1376, 1378-79 (Fed. Cir. 2019) (vacating and remanding the Board's decision because it "failed to consider relevant argument and evidence directed to *DuPont* factor 8," and noting, "[i]n every case turning on likelihood of confusion, it is the duty of the examiner, the Board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely. In discharging this duty, the thirteen *DuPont* factors must be considered when [they] are of record.") (internal & other citations & quotations omitted; emphasis in original). Evidence relating to several of the *DuPont* factors is of record in this proceeding and must be considered in assessing Opposer/Respondent's claim of likelihood of confusion. *See* Declaration of Heidi Zak Spector (stating facts relating to *DuPont* factors 3, 4, 7, 8 10 & 12).

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<sup>3</sup> Applicant/Petitioner cannot effectively oppose the cross-motion for summary judgment without first taking discovery on matters relating to likelihood of confusion, particularly the *DuPont* factors. *See* Fed. R. Civ. P. 56(d); Klarberg Dec. ¶ 3. Applicant/Petitioner needs further discovery to substantiate facts that would be essential to oppose the cross-motion on additional grounds and which, when established, these facts would provide additional genuine material issues and preclude summary judgment in Opposer/Respondent's favor. *Id.* For example, trial deposition testimony of Opposer/Respondent will be needed to establish that the channels of trade for the parties' goods (third *DuPont* factor) are different because Applicant/Petitioner sells its products on the Internet on its own website and in its own retail store (*see* Spector Dec. ¶ 2), while, upon information and belief and in view of Opposer/Respondent's document production, Opposer/Respondent allegedly sells its products through its customers' low-end retail stores. *Id.*; *CBB Group, Inc. v. Trademark Tools Inc.*, No. CANCELLATION 92063979, 2017 WL 3718331, at \*1 (T.T.A.B. Aug. 7, 2017) ("If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment."). Thus, even if the Board does not both grant Applicant/Petitioner's motion for summary judgment and deny Opposer/Respondent's cross-motion for summary judgment, the Board cannot grant Opposer/Respondent's cross-motion.

Moreover, evidence adduced thus far makes clear that there is no likelihood of confusion between Applicant/Petitioner's 24/7 mark and Opposer/Respondent's purported 24/7 COMFORT mark. In particular, extensive third-party usage of 24/7 formative marks weakens Opposer/Respondent's ambit of protection. The sixth *du Pont* factor assesses the number and nature of similar marks in use on similar goods, *i.e.*, "[e]vidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (citations omitted). "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338, 115 U.S.P.Q.1671, 1674 (Fed. Cir. 2015)).<sup>4</sup> The Board gives weight to evidence of third-party use of marks containing terms in common with the mark subject to opposition to demonstrate that confusion is not likely to occur in the marketplace. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1077 (T.T.A.B. 2011) (relying in part on third-party evidence to conclude that "the mere fact that the parties' marks both contain the

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<sup>4</sup> As explained in *Juice Generation*, extensive evidence of third-party use and registrations is "powerful on its face." 794 F.3d at 1339, 2015 WL 4400033, at \*4 (detailing the extensive use of marks used in connection with the food service industry that incorporate the words "Peace" and "Love"). For example, evidence of third-party registrations is relevant to "show the sense in which a mark is used in ordinary parlance," that is, some segment that is common to both parties' marks may have "a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Id.* (citation & quotations omitted). In addition, evidence of third-party use of similar marks on similar goods "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Id.* at 1338, 2015 WL 4400033 at \*3 (citation & quotations omitted).

term ELEMENT(S) is not a sufficient basis on which to find likelihood of confusion”). The rationale is that the presence of marks with common terms extensively used by unrelated third parties may cause purchasers to not rely upon such common terms as source indicators, but to look to other features of the marks to distinguish the goods and services. *Palm Bay*, 396 F.3d at 1374, 73 U.S.P.Q.2d at 1694.

Similarly, with respect to the present Proceedings, the term 24/7 is diluted in the marketplace with respect to goods in Class 25. There is extensive co-existence, both on the Principal Register and in the marketplace, of third-party 24/7 formative marks; there are at least 33 third-party federal registrations for marks that incorporate the term 24/7 for use in connection with clothing-related goods in Class 25, and there is significant evidence of these third-party registrants using their 24/7 formative marks in connection with their goods in Class 25. *See Klarberg Dec.* at ¶¶ 4-5 & Exs. B & C (list of third party registrations for 24/7 formative marks in Class 25 with corresponding registrations certificates and TSDR printouts showing status and title to those registrations; Internet printouts showing that the public has extensive exposure to numerous marks containing the term 24/7 for the goods identified in Opposer’s registration and related goods in Class 25). This evidence supports a finding that Opposer’s 24/7 COMFORT mark is weak--both on the Principal Register and in the marketplace--and entitled to only a narrow scope of protection; consequently, there is room on the Principal Register for Applicant’s 24/7 mark to peacefully co-exist in this crowded field. Thus, the Board should find, *inter alia*, that the sixth *DuPont* factor strongly favors Applicant, and deny Opposer/Registrant’s cross-motion for summary judgment on the issue of likelihood of confusion because there is at least a genuine issue of material fact with respect to the strength of the mark in light of third-party use.

#### **IV. Opposer/Respondent Waived Its Arguments Based on Common Law Use of Its Alleged Mark and Therefore Lacks Standing**

In its cross-motion for summary judgment, Opposer/Respondent asserts, “The issue of Dolce Vita’s rights having been dealt with, the *only remaining issue* in this proceeding is whether Applicant’s 24/7 mark is confusingly similar to Opposer’s registered 24/7 COMFORT trademark.” Cross-Motion at 4 (emphasis added). Thus, after having argued in its submission on pages 2-4 that its alleged 24/7 COMFORT mark was not abandoned due to nonuse and intent not to resume use during the three-year period commencing on at least January 16, 2009, Opposer/Respondent stated in its cross-motion for summary judgment that the only *other* issue remaining in this proceeding is likelihood of confusion between the parties’ marks. Opposer/Respondent has abandoned any reliance on common law rights in its alleged 24/7 COMFORT mark that it might seek to assert, whether as a basis for its claim of likelihood of confusion or for its Opposition to registration of Applicant/Petitioner’s 24/7 mark.

In the course of pursuing its cross-motion for summary judgment of likelihood of confusion, Opposer/Respondent has *waived* any argument it may have had that it has common law rights in its alleged 24/7 COMFORT mark. *See Bell’s Brewery, Inc. v. Innovation Brewing*, 125 U.S.P.Q.2d 1340, at \*9 (T.T.A.B. 2017) (where opposer neglected to argue that a specific mark was confusingly similar in its brief, the Board held the opposer “did not make that argument in its brief, and the claim as to the latter mark standing alone therefore is deemed waived.”) (citing *Swatch AG v. M. Z. Berger & Co.*, 108 U.S.P.Q.2d 1463, 1465 n.3 (T.T.A.B. 2013), *aff’d*, 787 F.3d 1368, 114 U.S.P.Q.2d 1892 (Fed. Cir. 2015)); *Horizon Healthcare Servs., Inc. v. Allied Nat’l, Inc.*, No. 03-cv-4098 (JAG), 2006 WL 344277, at \*11 (D.N.J. Feb. 14, 2006) (holding that a party’s “failure to

articulate” its argument that its registration for a mark creates rights of priority “in the opening brief for its cross-motion” rendered the arguments “deemed waived.”) (citation omitted).

Therefore, not only should Opposer/Respondent’s cross-motion for summary judgment be denied, but also Applicant/Petitioner’s Motion for Summary Judgment should be granted. Opposer/Respondent has waived its arguments based on common law use of its alleged 24/7 COMFORT mark. This waiver with respect to common law use, along with cancellation of Opposer/Respondent’s U.S. Trademark Registration No. 3,599,363 pursuant to granting Applicant/Petitioner’s Motion for Summary Judgment, eliminates any basis of support for Opposer/Respondent’s Opposition or any basis for a claim of likelihood of confusion. Lacking a supportable trademark registration or evidence of common law use of its alleged 24/7 COMFORT mark, Opposer/Respondent has no standing to maintain its Opposition to Applicant/Petitioner’s trademark applicant. *See Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 1023 (T.T.A.B. 2009) (petitioner must show earlier common law use in absence of registration). The utter lack of evidence that Opposer/Respondent has proffered on the issue of likelihood of confusion further points to the propriety of the Board’s granting Applicant/Petitioner’s Motion for Summary Judgment. Accordingly, there is no genuine factual dispute preventing the Board from granting summary judgment in favor of Applicant/Petitioner and against Opposer/Respondent.

**V. Conclusion**

For all of the reasons set forth above, Applicant/Petitioner respectfully requests that the Board deny Opposer/Respondent's cross-motion for summary judgment and enter summary judgment in favor of Applicant/Petitioner. Based on the foregoing, Applicant/Petitioner requests that the Board enter an order (i) dismissing Opposer/Respondent's opposition in the present Proceeding No. 91/243,006 with prejudice; and (ii) allowing U.S. Trademark Application Serial No. 86/710,362 for the mark 24/7 to proceed to registration.

Dated: November 7, 2019

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DOLCE VITA INTIMATES LLC,

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-against-

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Applicant/Petitioner's Opposition to Opposer's Cross-Motion for Summary Judgment, Declaration of Ryan S. Klarberg in Opposition to Opposer's Cross-Motion for Summary Judgment, and Declaration of Heidi Zak Spector have been served upon Opposer/Respondent's counsel by email on November 7, 2019 at the following e-mail addresses:

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