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

Proceeding	91243006
Party	Plaintiff Dolce Vita Intimates LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Dolce Vita Intimates LLC,
Opposer,

v.

Thirdlove, Inc.,
Applicant.

Opposition No. 91243006

OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO
OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT

Opposer, Dolce Vita Intimates LLC (“Dolce Vita” or “Opposer”) hereby submits its reply to the opposition filed by Applicant, Thirdlove, Inc. (“Thirdlove” or “Applicant”) to Opposer’s Cross-Motion for Summary Judgment seeking an order granting Dolce Vita’s opposition to the issuance of a registration based upon U.S. Trademark Application Serial No. 86/710,362 for the mark 24/7 (Applicant’s Application”) and refusing Applicant’s Application.

In its opposition brief, Thirdlove argues that Dolce Vita’s cross-motion for summary judgment should be denied because Dolce Vita has not established that there is no genuine issue of material fact on the issue of likelihood of confusion. However, Thirdlove has failed to identify any material issue of fact which is in dispute.

Thirdlove further argues that the Board, in its determination of likelihood of confusion, cannot rely on arguments or findings made during the examination of Applicant’s Application. Thirdlove cites several cases in that regard but those cases do not support Thirdlove’s argument. The cited cases say that the Board is not bound by the determination of the Examining Attorney and must determine the merits based on the record.

Dolce Vita never asserted that the Board is bound by the determination of the Examining Attorney, which was ultimately that Thirdlove’s mark 24/7 is not confusingly similar to Dolce Vita’s registered 24/7 COMFORT mark. Dolce Vita argued that the merits of this case support the Examining Attorney’s well stated initial conclusion that confusion between Thirdlove’s mark 24/7 and Dolce Vita’s registered 24/7 COMFORT mark is likely when the marks are used on the same product (bras), based upon comparison of the marks and the relationship of the goods upon which each of the marks are used.

Thirdlove argues that Dolce Vita is not entitled to summary judgment because it did not address the *Du Pont* factors. However, Dolce Vita did address the most relevant *Du Pont* factors: the similarity of the marks and the relationship of the goods upon which each of the marks are used, as did the Examining Attorney. Thirdlove cites no authority which requires the Board to consider every one of the *Du Pont* factors in every case. The case of *In re Guild Mortgage Co.*, 912 F.3d 1376, 1378-79 (Fed. Cir. 2019), cited by Thirdlove, instead requires consideration of evidence of the *Du Pont* factors about which there is evidence of record.

Thirdlove then argues that it cannot respond to Dolce Vita's summary judgment motion because it needs further discovery on matters relating to likelihood of confusion. However, the Board's rules provide for such a situation. TBMP § 528.06 states that if a party requires discovery in order to respond to a motion for summary judgment, under F. R. Civ. P. 56(d), that party may request the Board issue an order extending the requesting party's response time so that the requesting party may take the discovery it needs. Thirdlove made no such request in this case. Accordingly, Thirdlove cannot rely on a lack of discovery as a reason why it cannot respond to Dolce Vita's motion.

Thirdlove goes on to argue that even though it could not take discovery: "Evidence relating to several of the *Du Pont* factors is of record in this proceeding and must be considered in assessing Opposer/Respondent's claim of likelihood of confusion." Presumably, those factors which Thirdlove admits there is evidence of record are the similarity of the marks and the relationship of the goods on which the marks are used. Clearly, those factors are by far the most important in this case.

With respect to the *Du Pont* factors which Thirdlove asserts that there is no evidence of record, Thirdlove submits the Declaration of Heide Zak Spector. Thirdlove states that the

declaration provides “facts” relating to other *Du Pont* factors.

In paragraph 2 of her declaration, Ms. Spector states that Thirdlove and Dolce Vita sell their goods through different channels of trade, Thirdlove through the Internet and its store in New York City, and Dolce Vita through “low-end” retail stores. The evidence of record shows that Dolce Vita sells its 24/7 COMFORT bras to retail stores. There is nothing of record which indicates that Dolce Vita’s retail customers are “low-end” or that Dolce Vita’s retail customers do not have websites which offer for sale and sell Dolce Vita’s 24/7 COMFORT bras.

Dolce Vita’s retail customers are “brick and mortar” stores, just like Thirdlove’s New York City store. Obviously, both parties sell their bras to the same end users. The end users are women who wear bras.

There is no evidence of record to support the conclusion that Dolce Vita and Thirdlove sell their bras in different channels of trade. There is no evidence of record to support a finding that Dolce Vita’s bras and Thirdlove’s bras are sold to different end users. There is no evidence of record to support an argument that Dolce Vita’s bras and Thirdlove’s bras are in any way different goods.

Ms. Spector states that Thirdlove is not aware of any actual confusion. But she then goes on to say that there has been no evidence of actual confusion, which is a statement that Ms. Spector cannot make of her personal knowledge.

Ms. Spector concludes her declaration with the self-serving conclusion that confusion is “nonexistent or minimal” which is of no probative value. That is for the Board to decide.

Next, Thirdlove, in its brief, points to “extensive third-party usage of 24/7 formative marks” as further evidence of lack of likelihood for confusion. However, the registrations which Thirdlove submits do not support Thirdlove’s argument. Instead, those registrations demonstrate

the weakness of Thirdlove's mark 24/7.

None of the third-party registered marks cited by Thirdlove include Dolce Vita's registered mark 24/7 COMFORT, except for 24/7 COMFORT INSOLES registered for footwear, a product very different from bras.

None of the third-party registered marks cited by Thirdlove are registered for underwear except the mark STRYV 24/7 and TWENTY4SEVEN which is registered for bra tops and sports bras, both of which marks are very different from Dolce Vita's registered mark 24/7 COMFORT. On the other hand, each of the marks include Thirdlove's mark 24/7 and are registered for clothing.

None of the third-party use materials submitted by Thirdlove include Dolce Vita's registered mark 24/7 COMFORT (although the Jockey advertisement does use the term "comfort" in a descriptive sense). On the other hand, each use includes Thirdlove's 24/7 mark.

None of the third-party use materials submitted by Thirdlove involve bras or women's underwear. On the other hand, each of the use materials involve clothing of some kind.

While the strength of a mark may be a factor to be considered in the likelihood of confusion determination, it is the strength of the registered mark that is important, not the strength of the applied-for mark. Thirdlove's evidence shows that Dolce Vita's registered 24/7 COMFORT mark is strong as applied to bras. That Thirdlove's mark 24/7 is weak for clothing generally is of little consequence.

Thirdlove argues that Dolce Vita has abandoned any reliance on common law rights that it may seek to assert and has waived any argument it may have that it has common law rights. However, while registration of a trademark provides certain statutory rights, the registration itself is an official recognition of the common law rights of the registrant, based on use of the registered mark in commerce by the registrant. Moreover, Dolce Vita has presented irrefutable evidence of

use of its 24/7 COMFORT mark in commerce for over a decade. Even absent a registration, that evidence of use in commerce demonstrates that Dolce Vita has common law rights in the 24/7 COMFORT mark.

Finally, in one last desperate attempt to defeat Dolce Vita's motion, Thirdlove argues that Dolce Vita has no standing to bring this opposition. Clearly, Dolce Vita has a legitimate interest in the outcome of this proceeding, as set forth in the Notice of Opposition, and would be damaged by Thirdlove's registration of 24/7 if it were to issue.

Dolce Vita is entitled to summary judgment on the issue of likelihood of confusion. Thirdlove has failed to identify any genuine issue of material fact which is in dispute. The most relevant *Du Pont* factors of the similarity of the marks and the relationship of the goods upon which each of the marks are used have been addressed and undoubtedly favor Dolce Vita's claim of likelihood of confusion. Thirdlove's argument that Dolce Vita has waived its right to assert common law rights has no validity and, in any case, Dolce Vita can rely on its registration to prove ownership of the 24/7 COMFORT mark. The assertion that Dolce Vita lacks standing has no basis in law.

Dolce Vita's motion for summary judgment should be granted and Thirdlove's application to register 24/7 should be denied.

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Dated: November 25, 2019

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing OPPOSER’S REPLY TO APPLICANT’S OPPOSITION TO OPPOSER’S CROSS-MOTION FOR SUMMARY JUDGMENT was served by e-mail on this 25th day of November, 2019 upon Applicant’s counsel at the following address:

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