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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

MW

March 19, 2020

Opposition No. 91243006

Dolce Vita Intimates LLC

v.

Thirdlove, Inc.

**Before Zervas, Kuczma, and Johnson,
Administrative Trademark Judges.**

By the Board:

Thirdlove, Inc. (“Applicant/Petitioner” or “Applicant”) seeks registration of the standard character mark 24/7 for “Bras; Lingerie; Women’s underwear,” in International Class 25.¹ Dolce Vita Intimates, LLC (“Opposer/Respondent” or “Opposer”) filed a notice of opposition to registration of the mark on the ground of likelihood of confusion based on prior common law use and ownership of a registration for the standard character mark 24/7 COMFORT for “Undergarments” in International Class 25.² 1 TTABVUE.

¹ Application Serial No. 86710362 was filed on July 30, 2015, based on Applicant’s claim of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

² Registration No. 3599363 issued on March 31, 2009. Opposer filed a statement of use on January 16, 2009. The registration includes a disclaimer of the term “COMFORT” apart from the mark as shown. Opposer filed a combined Declaration of Use and Applicant for Renewal

In its answer and counterclaim, Applicant denies the salient allegations in the notice of opposition and asserts, among other defenses, that Opposer lacks standing to maintain the opposition. In addition, Applicant counterclaims to cancel Opposer's pleaded registration on the ground of abandonment. 19 TTABVUE 5.

This proceeding now comes before the Board for consideration of Applicant's motion (filed September 10, 2019) for summary judgment on its counterclaim of abandonment and priority of use and Opposer's cross-motion for partial summary judgment on its likelihood of confusion claim. The motions are fully briefed.

I. Summary Judgment Standard

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record must be viewed in the light most favorable to the non-moving party and all justifiable inferences to be drawn from the undisputed facts must be drawn in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). We may not resolve disputes of material fact; we may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

of Registration under Trademark Act Sections 8 & 9, 15 U.S.C. §§ 1058, 1059, on March 22, 2019.

The party moving for summary judgment has the burden of demonstrating that a particular fact cannot be disputed by citing to particular parts of materials in the record, including affidavits or declarations, admissions or interrogatory answers, or showing that the cited materials do not establish the absence or presence of a genuine dispute, or that the adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c)(1). *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). This burden may be met by showing “that there is an absence of evidence to support the nonmoving party’s case.” *Id.* at 323-24. If the moving party carries its burden, the nonmoving party may not rest on mere allegations, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. *See Venture Out Props. LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007); *see also* Fed. R. Civ. P. 56(c)(1).

II. Applicant’s Motion for Summary Judgment

A. Applicant’s Arguments and Relevant Evidence

Applicant seeks summary judgment based on (a) its counterclaim that Opposer abandoned its registered mark due to nonuse for the three year period after Opposer filed its statement of use, and (b) that Opposer cannot establish priority based on common law use of its mark prior to the filing date of the involved application.

Based on Opposer’s document production and responses to Applicant’s discovery requests, Applicant argues that Opposer has failed to produce any evidence of use or intent to resume use of its mark for the three-year period beginning January 16, 2009,

the date Opposer filed its statement of use. As a result of Opposer's failure to produce any documentary evidence of use of its mark or sales of its goods from 2009 to 2012, Applicant contends that there is no genuine dispute that Opposer abandoned its rights in its 24/7 COMFORT mark during that period and, thus, its registration should be cancelled. 22 TTABVUE 17.

In addition, Applicant argues that Opposer cannot establish priority based on common law use because Opposer "has produced no evidence of any kind that could be construed to substantiate use of its purported mark 24/7 COMFORT prior to July 30, 2015." 22 TTABVUE 18.

In support of its motion for summary judgment, Applicant has submitted Opposer's responses to Applicant's first set of interrogatories and requests for production of documents³ in addition to copies of certain documents produced by Opposer. Applicant points to the following discovery responses, in particular, as evidence of Opposer's lack of use of its mark:

- In response to requests for Opposer's gross sales figures for goods under the involved mark for the years 2008 through 2019, Opposer stated that it "does not keep records reflecting gross sales by trademark";⁴

³ 23 TTABVUE 25-63 (Exhibits 4 and 5).

⁴ Interrogatory Response Nos. 7-18, 23 TTABVUE 37-39.

- Opposer stated that it had no yearly U.S. expenditures for the advertising and promotion of goods sold under its mark and no yearly planned future expenditures for advertising and promotion of goods sold under its mark;⁵
- In response to document requests seeking documents identifying Opposer's gross sales for each year from 2008 to 2019 for type of goods sold under Opposer's mark, Opposer objected to each request as overly broad and unduly burdensome and stated that "Dolce Vita does not keep records which identify Respondent's total gross sales for goods sold by trademark";⁶
- Opposer stated that it has no documents relating to advertising or promotion of its goods in the U.S., including sample advertisements, promotional materials, catalogs, or brochures;⁷
- Opposer stated that it has no documents relating to annual advertising or publicity expenditures for its goods under its mark,⁸ and that it "does not advertise and does not keep records of cost of goods, shipping etc. segregated by trademark";⁹
- Opposer produced customer invoices dating from August 1, 2012 to April 26, 2019 which make no reference to Opposer's 24/7 COMFORT mark;¹⁰ and

⁵ Interrogatory Response Nos. 19-20, *id.* at 39.

⁶ Responses to Document Request Nos. 5-17, *id.* at 55-60.

⁷ Responses to Document Request Nos. 22-23, *id.* at 62.

⁸ Responses to Document Request Nos. 24-26, *id.* at 63.

⁹ Responses to Document Request No. 27, *id.*

¹⁰ 24 TTABVUE 4-21 (Confidential Exhibits 7 & 8).

- Opposer produced purchase orders addressed to its manufacturer that reference Opposer’s mark in “packing instructions.” The orders are dated from October 18, 2017 to April 22, 2019, after Applicant’s constructive use date.¹¹

B. Opposer’s Response and Evidence

In response to Applicant’s motion for summary judgment, Opposer argues that there is a factual dispute regarding Opposer’s use of its registered mark because “Applicant offers no evidence that [Opposer] has ever ceased the use of its 24/7 COMFORT trademark for any period after its registration.” 26 TTABVUE 4. In addition, Opposer states that, during discovery, Opposer explained to Applicant that “[Opposer’s] documents relating to its sales prior to 2012 were destroyed by Hurricane Sandy.” *Id.*¹²

In support of its response to Applicant’s motion for summary judgment, Opposer has submitted the declaration of Allan Solomon, Chief Financial Officer of Dolce Vita Intimates LLC. Mr. Solomon testifies to the following, among other things:

- Opposer uses various trademarks on its labels but does not keep financial records that segregate “which label is present on the label”;¹³

¹¹ *Id.* at 2-3 (Confidential Exhibit 6). Applicant states that Opposer produced four purchase orders, but Applicant submitted into evidence only the order with the earliest date. Declaration of Ryan Klarberg, at ¶¶ 12, 13, 23 TTABVUE 4.

¹² In its motion for summary judgment, Applicant states that, after Opposer made its third document production, Applicant was advised by Opposer’s counsel that the responsive documents were destroyed by Hurricane Sandy. 22 TTABVUE 12.

¹³ Solomon Declaration at ¶¶ 5, 7, 26 TTABVUE 11.

- Although he cannot determine the exact number of bras shipped with the 24/7 COMFORT label, he can state “with certainty that over the years since December of 2008, Dolce Vita has continuously shipped tens of thousands of bras with the 24/7 COMFORT label to its customers”;¹⁴
- Documents dated prior to 2012 could not be produced because all of Opposer’s business records were destroyed by Hurricane Sandy in 2012.¹⁵

Mr. Solomon also introduces into the summary judgment record copies of representative sales invoices for the years 2012 to 2019.¹⁶ Although none of the invoices show use of Opposer’s mark, Mr. Solomon states that “[e]ach of the representative Dolce Vita sales invoices for the years 2012 to the present reflect at least one sale to a customer of a bra style actually shipped with the 24/7 COMFORT label and, in most cases, multiple sales.”¹⁷

C. Applicant’s Reply

In its reply, Applicant argues that Opposer failed to rebut Applicant’s prima facie showing that Opposer abandoned its mark because Opposer produced no documents or images showing use or intent to resume use of the mark. In addition, Applicant contends that Mr. Solomon’s statement that all business records were destroyed in hurricane Sandy is “demonstrably false because [Opposer’s] own document

¹⁴ *Id.* at ¶ 11.

¹⁵ *Id.* at ¶ 9.

¹⁶ 27 TTABVUE (Confidential). Many of the invoices are copies of documents that were introduced into the record with Applicant’s motion.

¹⁷ Solomon Declaration at ¶ 8, 26 TTABVUE 11.

production shows that not all of Dolce Vita's business records were destroyed by Hurricane Sandy." 30 TTABVUE 6. Applicant notes that Opposer produced documents dated as early as August 1, 2012, prior to the date of Hurricane Sandy, which occurred on October 22, 2012.¹⁸ In view of this discrepancy, Applicant argues that the veracity of the entire declaration is in question and should not be considered.

Id.

D. Discussion

1. Abandonment Counterclaim

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a mark is deemed abandoned "[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment." Because abandonment is a question of fact, "any inference of abandonment must be based on a proven fact." *Quality Candy Shoppes/Buddy Squirrel of Wis. Inc. v. Grande Foods*, 90 USPQ2d 1389, 1393 (TTAB 2007). The party seeking cancellation of a mark based on abandonment bears the burden of proving a prima facie case by a preponderance of the evidence. *Noble House Home Furnishings, LLC v. Floorco Enters. LLC*, 118 USPQ2d 1413, 1417 (TTAB 2016).

We find that Applicant's evidence demonstrates Opposer has not used its mark for a three year period beginning January 16, 2009. In response to Applicant's discovery requests, Opposer was unable to provide any sales figures or expenditures

¹⁸ Exhibit A to the Declaration of Ryan Klarberg, 30 TTABVUE 14-17.

for advertising and promotion of Opposer's goods under its involved mark. In addition, Opposer provided no documents representing sales or advertising and no invoices or bills for goods showing use of Opposer's mark for at least that three year period.

Opposer's testimony evidence explains why it has no documentary evidence of use of its mark in commerce and disputes Applicant's contention that it has not used its mark for a period of three years. Drawing all justifiable inferences, as we must, in the light most favorable to Opposer as the non-moving party, we find Opposer's testimony sufficient to raise a genuine dispute of material fact regarding whether Opposer did not use its mark for a period of at least three years beginning January 16, 2009. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (evidence submitted by nonmovant is to be believed and all justifiable inferences drawn in its favor).

2. Priority Based on Common Law Use

Turning to Applicant's claim that Opposer cannot establish common law use of its mark prior to Applicant's constructive use date, we note that if Applicant cannot prevail on its abandonment counterclaim and Opposer's registration remains extant, the question of common law priority of use will be irrelevant to the likelihood of confusion claim. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *see, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1328 (TTAB 1992) (because Board dismissed counterclaim, determination of priority was unnecessary). Nonetheless, upon consideration of all

the evidence of record on summary judgment and drawing all inferences in favor of Opposer as the non-moving party, we find that genuine disputes of material fact remain regarding the question of priority of use.

III. Opposer's Cross-Motion for Summary Judgment

By its cross-motion for summary judgment, Opposer seeks judgment as a matter of law on its claim that the Applicant's 24/7 mark is likely to cause confusion with Opposer's registered 24/7 COMFORT mark. Opposer argues,

[g]iven that the marks include the common dominant feature '24/7' and that 'COMFORT' is descriptive of the nature of the bras which both parties sell, and the fact that the parties make and sell the exact same product and are direct competitors in the market, confusion between Opposer's 24/7 COMFORT bras and Applicant's 24/7 bras in the marketplace is not only likely, it is inevitable.

26 TTABVUE 5.

In response, Applicant argues that Opposer is not entitled to summary judgment because Opposer "has provided no record on which the Board can consider the issue of likelihood of confusion and has failed to address the *DuPont* factors." 31 TTABVUE 8-9. In addition, as evidence that the term "24/7" is weak in the marketplace and entitled to only a narrow scope of protection, Applicant has submitted with its response 33 active third party registrations for "24/7 formative marks" for goods in International Class 25,¹⁹ in addition to printouts of third party webpages using variations of the term "24/7" in connection with goods, including clothing.²⁰

¹⁹ 32 TTABVUE 16-233 (Exhibit B).

²⁰ *Id.* at 234-292.

Opposer is entitled to partial summary judgment on its likelihood of confusion claim if it establishes that there is no genuine dispute as to any material fact concerning the relevant evidentiary factors identified in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See* Fed. R. Civ. P. 56(a). Any of the *du Pont* factors “may from case to case play a dominant role.” *Du Pont*, 177 USPQ at 567.

We note that, in its cross-motion, Opposer erroneously states, “the issue of [Opposer’s] rights having been dealt with [by its response] the only remaining issue in this proceeding is whether [the marks are confusingly similar].” *Id.* However, Opposer did not move for summary judgment in its favor on Applicant’s abandonment counterclaim or on the issue of priority of use.²¹ As fully discussed above, genuine disputes of material fact remain for trial regarding the question of priority. Therefore, we construe Opposer’s motion as one for partial summary judgment on the issue of likelihood of confusion. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1047 (TTAB 2014) (“Priority is an element of the likelihood of confusion ground.”).

Opposer has submitted no evidence in connection with its cross-motion to support its arguments regarding the dominant and descriptive features of the parties’ marks and relies solely on the record of its registration and the fact that the Examining

²¹ In its response and cross-motion, Opposer merely argues that “[t]here is a factual dispute regarding the use of [Opposer’s] registered 24/7 COMFORT trademark” that must be resolved in Opposer’s favor. 26 TTABVUE 4. As we noted above, we may not resolve disputes of material fact on summary judgment. We may only determine whether a genuine dispute exists. *See Lloyd’s Food Prods.*, 25 USPQ2d at 2029.

Attorney initially refused Applicant's involved application based on a likelihood of confusion with Opposer's registered mark. *Id.* at 5-6.²² We find that Opposer has failed to carry its initial burden of showing that no genuine disputes of material fact exist regarding its likelihood of confusion claim. At a minimum, we find that genuine disputes of material fact remain for trial regarding the similarity or dissimilarity of the parties' marks in appearance and commercial impression and the commercial strength of Opposer's mark.²³

IV. Decision

In view of the foregoing, Applicant's motion for summary judgment on its abandonment counterclaim and the issue of priority of use is **denied**. In addition, Opposer's motion for partial summary judgment on the likelihood of confusion claim is **denied**.

Proceedings are resumed. Discovery and trial dates are reset as follows:

Expert Disclosures Due	4/30/2020
Discovery Closes	5/30/2020
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	7/14/2020
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	8/28/2020

²² To the extent that Opposer relies on the disclaimer in its registration, "it is inappropriate to give the presence or absence of a disclaimer any legal significance." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

²³ The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial. In addition, the parties are advised that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	9/12/2020
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	10/27/2020
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	11/11/2020
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	12/26/2020
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	1/10/2021
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	2/9/2021
Opening Brief for Party in Position of Plaintiff in Original Claim Due	4/10/2021
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	5/10/2021
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	6/9/2021
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	6/24/2021
Request for Oral Hearing (optional) Due	7/4/2021

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).