

ESTTA Tracking number: **ESTTA1174118**

Filing date: **11/22/2021**

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

Proceeding	91266006
Party	Plaintiff Lap of Luxury
Correspondence Address	ROSEZENA J PIERCE R.J. PIERCE LAW GROUP P.C. 200 W. MADISON SUITE 2100 CHICAGO, IL 60606 UNITED STATES Primary Email: rosezena@rjpiercelaw.com Secondary Email(s): jonelle@rjpiercelaw.com, jasmine@rjpiercelaw.com, info@rjpiercelaw.com 312-217-0799
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Sarah Peterson
Filer's email	sarah@rjpiercelaw.com, oscar@rjpiercelaw.com, rosezena@rjpiercelaw.com, legal@rjpiercelaw.com, info@rjpiercelaw.com
Signature	/Sarah Peterson/
Date	11/22/2021
Attachments	211121 Third Amd Pleading Notice of Opp SP Final.pdf(171824 bytes)

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

)	
DONELLE JARVIS D/B/A LAP OF LUXURY)	
NY,)	
an Individual,)	
)	Opposition No. 91266006
Opposer,)	Mark: LAP OF LUXURY
)	Serial No. 88954120
v.)	
)	
ICONIC DECOR RENTALS, LLC)	
)	
Applicant.)	

THIRD AMENDED NOTICE OF OPPOSITION

NOW COMES, Lap of Luxury NY (hereinafter “OPPOSER”), a sole proprietorship organized in New York and composed of Donelle Jarvis, a citizen of United States, having a principal place of business at 938 E 87th St, Brooklyn, New York, 11236, by and through its Counsel, Rosezena J. Pierce of R.J. Pierce Law Group P.C, said Opposer believes it will be damaged by the registration of the mark shown in the above-identified application, and hereby opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 ("Lanham Act"), 15 U.S.C. § 1063(a).

As grounds for the opposition, it is alleged that:

1. Opposer is an event planning and rental company based in the state of New York operating under the name Lap of Luxury NY.

2. Opposer is the owner of U.S. Trademark Application Serial No. 90052982, filed on July 14, 2020, for LAP OF LUXURY in connection with “Rental of chairs, tables, table linen, glassware; Rental of furniture; Rental of tableware, silverware, dishes, and table accessories for special events” in class 043 (“Opposer’s Application”).

3. In addition to Opposer’s Application, Opposer has longstanding common law rights in LAP OF LUXURY from Opposer’s use of the mark, dating back to at least as early as November 2014.

4. Opposer has had significant commercial success under the LAP OF LUXURY mark, having established a tremendous amount of goodwill and a valuable reputation for the last six years.

5. Applicant filed application Serial No. 88954120 for the mark LAP OF LUXURY on June 8, 2020, as a 1(b) Intent to Use application for:

Rental of bar equipment; Rental of beverage fountains; Rental of chairs, tables, table linen, glassware; Rental of cooking apparatus; Rental of cooking stoves; Rental of cotton candy making machines; Rental of dishes; Rental of drink dispensing machines; Rental of electric chocolate fountains; Rental of food service equipment; Rental of furniture; Rental of popcorn poppers; Rental of rugs; Rental of table linens; Rental of tableware; Rental of tents; Rental of chafing dishes; Rental of tableware, silverware, dishes, and table accessories for special events

in Class 43 (“Applicant’s Application”).

6. In submitting its application, Applicant made a false representation to the Trademark Office regarding Applicant’s knowledge and belief that no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance.

7. Applicant’s application was signed by Applicant.

8. Applicant's signature in Applicant's application is preceded by the following declaration:

The signatory believes that: if the applicant is filing the application under 15 U.S.C. § 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant is using the mark in commerce on or in connection with the goods/services in the application; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e), the applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

9. Applicant's false representation was material to the registrability of the mark because a truthful statement would demonstrate that Applicant was not the owner of the mark.

10. Applicant was aware of the falsity of the representation but nonetheless filed Applicant's Application based on 1(b), and signed a verified statement alleging that it believes no other person had the right to use the mark in commerce either in identical form or in such near resemblance as to be likely when applied to the goods and services of such other person, to cause confusion, or mistake, or to deceive.

11. The mark in the Applicant's Application is identical to the mark in the Opposer's Application.

12. Applicant made the false statement with the intention of deceiving the Trademark Office. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ 1938, 1941 (Fed. Cir. 2009.).

13. When Applicant filed Applicant's Application, it was aware of Opposer's Mark and filed its application to take advantage of Opposer's business and goodwill.

14. Applicant knew Opposer's rights in LAP OF LUXURY were superior.

15. Applicant either believed that a likelihood of confusion would result from Applicant's use and registration of the LAP OF LUXURY mark or had no basis for believing otherwise.

16. Upon information or belief Applicant has habitually appropriated the trademarks of others in an attempt to pass the marks off as its own and is currently involved with another dispute over the use of a name Applicant appropriated from another business owner.

COUNT I
LIKELIHOOD OF CONFUSION

17. Opposer restates the allegations contained in paragraphs 1 through 16 above.

18. Opposer opposes Applicant's Application on the ground that there is a likelihood of confusion between the mark in Applicant's Application and "a mark or trade name previously used in the United States by another and not abandoned", i.e. Opposer's Mark. 15 U.S.C. §1052(d).

19. As a result of using Opposer's mark in interstate commerce, Opposer has acquired substantial goodwill and consumer recognition for LAP OF LUXURY, resulting in common law trademark rights.

20. The mark in Applicant's Application is virtually identical to Opposer's Mark.

21. The services in Applicant's Application closely resemble Opposer's Services.

22. The similarity of the marks and services are such that registration is likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Trademark Act. 15 U.S.C. §1052(d).

23. Thus, Opposer would be damaged by the registration of Applicant's mark and prays that Applicant's Application be denied.

COUNT II
FALSE CONNECTION

24. Opposer restates the allegations contained in paragraphs 1 through 23 above.

25. Opposer opposes Applicant's Application on the ground that the mark in Applicant's Application falsely suggests a connection with Opposer's name or identity. 15 U.S.C. §1052(a).

26. There is no evidence that the mark LAP OF LUXURY is generic, descriptive or suggestive in the respective industry and/or among the relevant target market.

27. The mark LAP OF LUXURY is a highly distinctive name in the respective industry and among the relevant target market and thus uniquely and unmistakably identifies Opposer.

28. The mark in Applicant's Application is virtually identical to Opposer's business name and trademark.

29. The services in Applicant's Application closely resemble the Opposer's Services.

30. Notwithstanding Applicant's Application, there are only five (5) records for the name LAP OF LUXURY recorded on the USPTO Database.

31. Of the five (5) recorded marks, Applicant's Application is the only mark that is *at least* confusingly similar to Opposer's mark.

32. Notwithstanding Applicant's Application, Opposer's Application is the only other mark filed in the same or similar class and/or for the same or similar goods and services.

33. There is no evidence of any general or specific third-party common law use of the mark LAP OF LUXURY for the relevant goods and services.

34. Prior to its Application, Applicant knew of Opposer's business name.

35. The business identified in Opposer's mark has not and is not connected with Applicant in any way.

36. Opposer's LAP OF LUXURY mark through its distinctive nature and longstanding common law rights as early as 2014 has acquired such a fame, especially in the relevant market, that a connection with Opposer would indisputably be presumed when Applicant's mark is used on its goods and/or services.

37. Applicant intentionally used the mark with the intent of suggesting a connection with Opposer's business name and to capitalize on the goodwill of Opposer.

38. Thus, Opposer would be damaged by the registration of Applicant's mark and prays that Applicant's Application be denied.

COUNT III
LACK OF BONA FIDE INTENT

39. Opposer restates the allegations contained in paragraphs 1 through 38 above.

40. In the event the Board finds that Applicant did not use the mark, Opposer opposes Applicant's Application on the ground that Applicant did not have a good faith bona fide intent to use the mark in commerce as to the goods and services listed in the application.

41. Applicant has not established any evidence probative of a bona fide intent to use the mark in commerce, including but not limited to; (i) obtaining a domain name; (ii) establishing a business entity; (iii) conducting a search to establish whether the LAP OF

LUXURY name was available; (iv) obtaining any relevant regulatory permits; and/or (v) performing preparatory design work.

42. At the time Applicant filed the Application, Applicant had actual knowledge of (i) Opposer's longstanding common law rights in the name LAP OF LUXURY; (ii) Opposer's present use of the name LAP OF LUXURY; (iii) Opposer's acquired fame; and (iv) Opposer's intent to expand using the name LAP OF LUXURY.

43. As a result, Opposer, Applicant did not have a right to file the mark, nor the good faith bona fide intention to use the mark in commerce.

44. Thus, Opposer would be damaged by the registration of Applicant's mark and prays that Applicant's Application be denied.

COUNT IV
FRAUD ON THE U.S. PATENT AND TRADEMARK OFFICE

45. Opposer restates the allegations contained in paragraphs 1 through 44 above.

46. Opposer opposes Applicant's Application on the ground that it contains knowingly false statements about the use and ownership of the mark, which were made with the intent to deceive the USPTO and constitute fraud on the USPTO.

47. Applicant was not the owner of the mark in Applicant's Application at the time Applicant filed Applicant's Application.

48. Applicant did not have a bona fide intention to use the mark at the time Applicant filed Applicant's Application.

49. Applicant was not entitled to use the mark at the time Applicant filed Applicant's Application.

50. Applicant knew that Opposer had the exclusive right to use the mark at the time Applicant filed Applicant's Application.

51. Applicant's sworn declaration stating that "the [Applicant] is the owner of the trademark/service mark sought to be registered; the [Applicant] or the [Applicant's] related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the [Applicant's] related company or licensee inures to the benefit of the [Applicant]" was false.

52. Applicant's sworn declaration that "the [Applicant] believes that the [Applicant] is entitled to use the mark in commerce; the [Applicant] has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date on or in connection with the goods/services in the [Application]."

53. Applicant's false declaration was made knowingly and with the intent to deceive the USPTO for the purpose of obtaining registration.

54. Applicant's sworn declaration acknowledges that willful false statements jeopardize the validity of registration.

55. Applicant's sworn declaration was knowingly false, made with the intent to deceive the USPTO and was material to Applicant's Application.

56. As a result of Applicant's false statements and material deception, Applicant committed fraud against the USPTO.

57. Accordingly, Applicant's Application is fraudulent.

58. Thus, Opposer would be damaged by the registration of Applicant's mark and prays that Applicant's Application be denied.

WHEREFORE, LAP OF LUXURY believes that it will be damaged by the registration of Applicant's mark and prays that it be denied.

Dated: November 21, 2021

Respectfully Submitted,

/Sarah Peterson/ & /Oscar R. Trejo/

Sarah Peterson

Oscar R. Trejo

IL Bar No. 6293971

Attorney for Petitioner

R.J. Pierce Law Group, P.C.

205 N. Michigan Ave

Suite 810

Chicago, IL 60601

sarah@rjpiercelaw.com

oscar@rjpiercelaw.com

CERTIFICATE OF SERVICE

I hereby certify that, on November 22, 2021, a true and correct copy of the foregoing **Third Amended Notice of Opposition** has been duly served by sending such copy by email to counsel for Applicant, at **diane@chubbiplaw.com**

/Sarah Peterson/ and /Oscar R. Trejo/

Sarah Peterson

Oscar R. Trejo

IL Bar No. 6293971

Attorney for Petitioner

R.J. Pierce Law Group, P.C.

205 N. Michigan Ave

Suite 810

Chicago, IL 60601

sarah@rjpiercelaw.com

oscar@rjpiercelaw.com