

ESTTA Tracking number: **ESTTA1118833**

Filing date: **03/08/2021**

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

Proceeding	91267248
Party	Defendant Doctors Daughters LLC
Correspondence Address	DAVID B. SUNSHINE COZEN O'CONNOR 175 GREENWICH STREET, 55TH FLOOR 3 WORLD TRADE CENTER NEW YORK, NY 10007 UNITED STATES Primary Email: tmdocketing@cozen.com Secondary Email(s): dsunshine@cozen.com 212-883-4911
Submission	Answer and Counterclaim
Filer's Name	David B. Sunshine
Filer's email	dsunshine@cozen.com , ipdocketing@cozen.com
Signature	/David B. Sunshine/
Date	03/08/2021
Attachments	Doctors Daughters Answer Notice of Opposition.pdf(274307 bytes)

Registration Subject to the filing

Registration No.	6092249	Registration date	06/30/2020
Registrant	DANI FOX, ASSOCIATES, LLC 7700 SW 104TH ST., SUITE #201 MIAMI, FL 33156 UNITED STATES		

Goods/Services Subject to the filing

Class 003. First Use: 2020/02/10 First Use In Commerce: 2020/04/27

All goods and services in the class are requested, namely: Beauty serums; cosmetic creams for skin-care; exfoliant creams; non-medicated facial and eye serum containing antioxidants; non-medicated skin care preparations; skin cleansers; skin conditioners; skin moisturizer; sun screen preparations; cosmetics

assigned Application Serial No. 90/049,470. Applicant further admits that it is a California limited liability company having a mailing address of 1545 Calle Camille, San Diego, CA 92037. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in the first unnumbered paragraph and therefore denies the same.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and therefore denies the same.

2. Applicant denies that Opposer has prior rights to Opposer's DOCTOR'S DAUGHTER mark. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in Paragraph 2 of the Notice of Opposition and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and therefore denies the same.

4. Applicant denies the allegations set forth in Paragraph 4 of the Notice of Opposition.

5. Applicant admits that its application for DOCTOR'S DAUGHTERS covers the following goods "[s]uperfood rolled oats; dairy-free ice cream; dairy free-ice cream sandwiches" in International Class 30, which goods Applicant currently sells with Applicant's mark.

6. Applicant denies the allegations set forth in Paragraph 6 of the Notice of Opposition.

7. Applicant denies the allegations set forth in Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations set forth in Paragraph 8 of the Notice of Opposition.

9. Applicant denies the allegations set forth in Paragraph 9 of the Notice of Opposition.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 10 of the Notice of Opposition and therefore denies the same.

11. Applicant incorporates its admissions and denials in Paragraphs 1-10 as if fully set forth herein.

12. Applicant denies the allegations set forth in Paragraph 12 of the Notice of Opposition.

13. Paragraph 13 consists of citation to case law and legal conclusions to which no admission or denial is required. To the extent one is required, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 13 of the Notice of Opposition and therefore denies the same.

14. Applicant denies the allegations set forth in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in Paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations set forth in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations set forth in Paragraph 18 of the Notice of Opposition.

19. Applicant incorporates the admissions and denials in Paragraphs 1-18 as if fully set-forth herein.

20. Applicant denies the allegations set forth in Paragraph 20 of the Notice of Opposition.

21. Applicant denies the allegations set forth in Paragraph 21 of the Notice of Opposition.

22. Applicant incorporates the admissions and denials in Paragraphs 1-21 as if fully set-forth herein.

23. Applicant denies the allegations set forth in Paragraph 23 of the Notice of Opposition.

24. Applicant denies the allegations set forth in Paragraph 24 of the Notice of Opposition.

25. Applicant incorporates the admissions and denials in Paragraphs 1-24 as if fully set-forth herein.

26. Applicant denies the allegations set forth in Paragraph 26 of the Notice of Opposition.

27. Applicant denies the allegations set forth in Paragraph 27 of the Notice of Opposition.

28. Applicant denies the allegations set forth in Paragraph 28 of the Notice of

Opposition.

AFFIRMATIVE DEFENSES

1. Opposer failed to state a claim for likelihood of confusion under Section 2(d) of the Trademark Act since, among other reasons, the parties offer substantially different goods under their respective marks. Applicant's goods are health food products whereas Opposer allegedly offers various skincare products. Opposer's argument that the respective goods are *per se* related because they can be found in the same grocery stores (e.g. Whole Foods) has been soundly rejected by the Federal Circuit. *See e.g. Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

2. Opposer has failed to state a claim for dilution either by blurring or by tarnishment. To state a claim for dilution, Opposer must allege, among other elements, that it (a) owns a famous mark and (b) Applicant's use of the mark at issue began after Opposer's mark became famous. *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025 (TTAB 2015) (citing *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012)). Here, Opposer fails to allege that its mark is famous (nor can it). Accordingly, Opposer's dilution claims fail as a matter of law.

3. Opposer has failed to state a claim for deceptive matter or false connection under Section 2(a) of the Trademark Act. To state a claim under Section 2(a), Applicant's mark must lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See e.g. Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB1992). Here, Opposer has failed to adequately plead a claim for deceptive matter or false connection and, therefore, that claim fails

as a matter of law.

4. As to Opposer's claim of prior rights, Applicant used its DOCTOR'S DAUGHTER mark in interstate commerce prior to Opposer's date of first use in interstate commerce and prior to the filing date of Opposer's application. As such, Applicant's trademark rights in its DOCTOR'S DAUGHTER mark is superior to Opposer's trademark rights in its pleaded mark.

5. As Applicant's investigation is ongoing and discovery has not yet been taken and as many facts are likely in the possession of Opposer and third parties, Applicant reserves the right to amend its answer, including its affirmative defenses.

COUNTERCLAIM FOR CANCELLATION OF U.S. REGISTRATION NO. 6,092,249

1. Applicant repeats and re-alleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

2. Applicant is the owner of Application Serial No. 90,049,470 for the mark DOCTOR'S DAUGHTERS for "superfood rolled oats; dairy-free ice cream; dairy free-ice cream sandwiches" ("Applicant's Mark") in International Class 30.

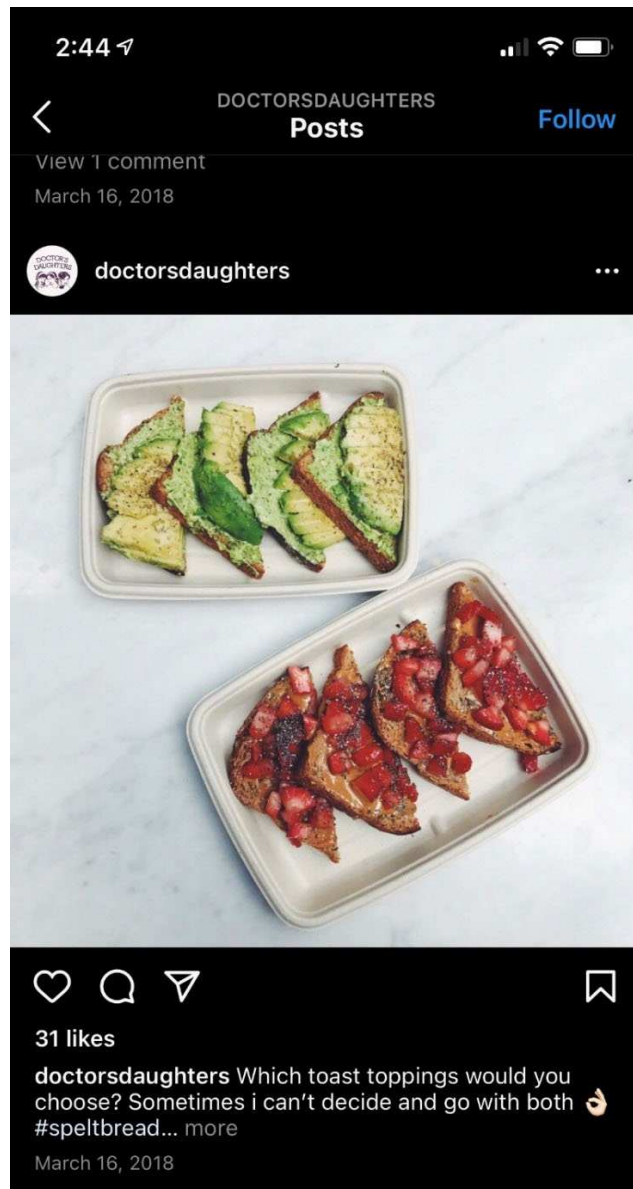
3. Upon information and belief, Opposer is the owner of U.S. Registration No. 6,092,249 for the mark DOCTOR'S DAUGHER for "beauty serums; cosmetic creams for skin care; exfoliant creams; non-medicated facial and eye serum containing antioxidants; non-medicated skin care preparations; skin cleansers; skin conditioners; skin moisturizer; sun screen preparations; cosmetics" ("Opposer's Mark") in International Class 3.

4. Applicant does not believe there is a likelihood of confusion between its Applicant's Mark and Opposer's Mark. However, *pleading in the alternative*, in the event that the Board does find that such a likelihood of confusion exists between Opposer's Mark and

Applicant's Mark, then Applicant is the senior user and Opposer's pleaded registration No. 6,092,249 for Opposer's Mark should be cancelled in its entirety.

5. Applicant has used Applicant's Mark in interstate commerce in the United States since at least March 2018 in connection with the promotion of healthy foods and eating.

6. Below is a representative example demonstrating Applicant's use of Applicant's Mark on or about March 16, 2018:



7. Applicant's use of Applicant's Mark also constitutes use analogous to trademark use for the purposes of establishing priority. As a result of Applicant's use of Applicant's Mark, the relevant consuming public associates Applicant's Mark with Applicant.

8. Applicant's date of first use in interstate commerce of March 2018 predates Opposer's date of first use in commerce of April 24, 2020 as well as the May 24, 2019 filing date of Opposer's Section 1(b) intent to use trademark application. In fact, Applicant's date of first use predates Opposer's constructive first use date by well over one year.

9. Applicant's prior use of Applicant's Mark constitutes evidence of Applicant's ownership of Applicant's Mark, and thus the exclusive right to use Applicant's Mark in commerce.

10. Applicant has developed extremely valuable goodwill in Applicant's Mark, by virtue of its longevity of usage in commerce, expenditure of in promotional activities, and the impeccable quality and excellence of its products and services. In view of this use, consumers have become familiar with Applicant's Mark in connection with healthy foods and the promotion thereof.

11. Based on Applicant's prior use in interstate commerce of Applicant Mark and/or as use analogous to trademark use, there is no issue as to priority and Applicant's rights in and to Applicant's Mark are superior to that of Opposer.

12. Due to Applicant's longstanding and continuous use of Applicant's Mark, Applicant's Mark has become well-known as designating the goods and services offered by Applicant.

13. In the event that the Board determines that there is a likelihood of confusion between Opposer's Mark and Applicant's Mark, such a finding of likelihood of confusion

should be in Applicant's favor since, among other reasons, Applicant has priority of rights.

14. Applicant is and continues to be damaged by Opposer maintaining a registration for Opposer's Mark since such registration would grant to Opposer evidence of the exclusive right to use Opposer's Mark in conjunction with Opposer's goods and would cause irreparable harm to Applicant.

WHEREFORE, Applicant prays as follows:

- (a) that this Opposition proceeding be dismissed;
- (b) that the registration for Applicant's Mark be issued to Applicant;
- (c) that Registration No. 6,092,249 be cancelled in its entirety; and
- (d) that the Board grant Applicant any other relief to which Applicant is entitled.

Dated: March 8, 2021

Respectfully submitted,

COZEN O'CONNOR

By: /David B. Sunshine/
David B. Sunshine
3WTC, 175 Greenwich Street, 55th Floor
New York, NY 10007
Tel: (212) 883-4900
Fax: (212) 986-0604
dsunshine@cozen.com

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on March 8, 2021, I served the foregoing Answer to Notice of Opposition, Affirmative Defenses and Counterclaim for Cancellation by sending a true and correct electronic copy via email to lead counsel of record for Opposer in this proceeding as follows:

Christopher A. DiSchino, Esq.
DiSchino & Schamy, PLLC
4770 Biscayne Blvd., Suite 1280
Miami, Florida 33137
christopher@dsmiami.com
brenda@dsmiami.com
michael@dsmiami.com
admin@dsmiami.com

/David B. Sunshine/