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

Proceeding	91269675
Party	Defendant L.A. T SHIRT & PRINT, INC.
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Submission	Motion for Relief from entry of Default Judgment
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Date	08/23/2021
Attachments	VacateRose.pdf(42755 bytes) DismissRose.pdf(123806 bytes)

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

In the matter of:



Application Number 90/354,081 filed on August 4, 2020 in International Class 25

_____)	
Mark-Edwards Apparel Inc./)	
Vetements Mark-Edwards Inc.)	Proceeding No. 91/269,675
)	
Opposer,)	Interlocutory Attorney: WENDY COHEN
)	
v.)	
)	
L.A. T Shirt & Print, Inc.,)	
)	
Applicant.)	
_____)	

Motion to Vacate Default

Applicant L.A. T Shirt & Print, Inc. (“Applicant” or “Riot Society”) requests the Trademark Trial and Appeal Board (“the Board”) Vacate the default noticed on July 24, 2021 because the requirements of Fed. R. Civ. P. 60(b) have been met in this case.

Background

A group of opposition proceedings including 91/269,674, 90/354,219, 91/269,675, 90/354,081, 91/269,673, and 91/269,673 along with cancellation proceeding 92/077,296 (collectively “the TTAB Proceedings”) are related to a lawsuit in federal court *L.A. T Shirt & Print, Inc. v. New rue21, LLC* Civil Action No. 2:20-cv-11785 filed in the United States District Court for the Central District of California (“Federal Court Litigation”). The issues in the Federal Court Litigation substantially overlap with the issues in the TTAB Proceedings. A mediation is scheduled in the Federal Court Litigation which could resolve both the TTAB proceedings and the Federal Court Litigation. As a result, all but three of the TTAB Proceedings have been suspended. Those that have not been suspended are proceedings 91/269,673, 91/269,674, and 91/269,675. Counsel for both the Applicant and the Opposer have been in discussions about suspending proceeding 92/077,296 and have reached an agreement on that

matter. The not-yet-suspended proceedings should have been suspended along with the others, undersigned counsel takes responsibility for this not occurring, but the lack of suspension is not intentional.

Argument

Once default judgment has been entered against a defendant pursuant to Fed. R. Civ. P. 55(b), the judgment may be set aside for the reasons set forth in Fed. R. Civ. P. 60(b). The factors to be considered in determining a motion to vacate default judgment for failure to file an answer include: (1) whether the plaintiff will be prejudiced by the Board's decision to vacate judgment; (2) whether the default was willful; and (3) whether the defendant has a meritorious defense to the action. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991).

The determination of whether a motion under Fed. R. Civ. P. 60(b) should be granted is a matter that lies within the sound discretion of the Board. *Id.* However, because default judgments for failure to timely answer the complaint are not favored by the law, a motion for relief from such a judgment under Fed. R. Civ. P. 55(c) and 60(b) is generally treated with more liberality by the Board than are motions for relief from other types of judgments. *See Information Sys. & Networks Corp. v. U. S.*, 994 F.2d 792, 795 (Fed. Cir. 1993) ("Rule 60(b) is applied most liberally to judgments in default.") (*quoting Seven Elves, Inc. v. Eskenazi*, 635 F.2d 396, 403 (5th Cir. 1981)).

Opposer will not be prejudiced by vacating default.

While Opposer does claim use of a Rose mark as early as July 5, 2013, Opposer does not claim that it is presently selling such goods or that it is presently facing the possibility of an injunction in Federal Court. While Opposer would no doubt like to resolve the matter as quickly as possible. Opposer does not face an urgent risk of harm from which vacating default would make worse.

The default was not willful but rather resulted from confusion about multiple proceedings over a single matter.

Holistically, Applicant desires to have a number of proceedings suspended, many of which presently are suspended in order allocate resources to federal court mediation.

Information Sys. & Networks Corp. v. U. S., 994 F.2d at 796 (failure to file answer and failure to move to vacate entry of default prior to entry of judgment was insufficient to show willful disregard for rules). The Applicant is not acting willfully, but rather is trying to manage a docket of many similar matters at once.

There are many meritorious defenses available in this action.

There are both legal and factual defenses for the claims which the Opposer makes. Turning first to the legal defenses: 1) Opposer fails to adequately plead the Mark has become generic because there is no allegation that the public associates roses generically with clothing. 2) Opposer fails to adequately plead the Mark fails to function as a mark, because there is no allegation as to how the Applicant uses the Mark. 3) Petitioner fails to adequately plead the Mark lacks inherent distinctiveness, because there is a presumption to the contrary and the Respondent does not sell roses. 4) Petitioner lacks valid proprietary rights in a mark that are prior to those of the applicant because the current use of the mark seems to be from unrelated third parties. Those arguments are explained in greater detail in a motion to dismiss.

Turning next to the factual defenses, consistent sales of the product and customer engagement with the Mark shows 1) the mark functions as a mark 2) the Mark has not become generic and 3) the mark is distinctive. Finally, the date and use of Opposer's mark is disputed.

The factual and legal matters present in this case show that default should be vacated and the motion to dismiss should be scheduled for briefing.

Respectfully Submitted,

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Dated: Monday, August 23, 2021

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of **L.A. T SHIRT & PRINT, INC.'S MOTION TO DISMISS** has been served on the following by delivering said copy on July 17, 2021, via email, to counsel for the Petitioner at the following address:

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By: /Michael O'Brien/

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the matter of:



Application Number 90/354,081 filed on August 4, 2020 in International Class 25

Mark-Edwards Apparel Inc./)	
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Opposer,)	Interlocutory Attorney: WENDY COHEN
)	
v.)	
)	
L.A. T Shirt & Print, Inc.,)	
)	
Applicant.)	
)	

Motion to Dismiss

Applicant L.A. T Shirt & Print, Inc. (“Applicant” or “Riot Society”) requests the Trademark Trial and Appeal Board (“the Board”) dismiss the opposition petition of opposer Mark-Edwards Apparel Inc./ Vetements Mark-Edwards Inc. (“Opposer”) because the allegations provided do not amount to a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6) and Trademark Trial and Appeal Board Manual of Procedure 2021-06 (“TMBP”) §503 et seq.

Applicant is a very well-known clothing manufacturer that frequently does business under the name “Riot Society.” Since November 2018, one of the most popular and successful marks used by Riot Society is the Rose Design which uniquely has a red rose flower with a green stem and four green leaves, two leaves on the left side of the stem and two leaves on the right side of the stem.. The Rose Design is covered by Application number 90/354,081 referred to as “the Mark.”

Petitioner does not claim it sells clothing with the Rose in the United States, and does not claim plans do so in the future. Rather, it claims that, “Opposer has provided in interstate and

U.S. commerce tops and other clothing items featuring varying versions of a red rose with a green stem and leaves....” Petition ¶ 12.

Petitioner filed threadbare five-page petition claiming that the Office should not grant Respondent’s application because 1) There is a likelihood of confusion; 2) The mark is or has become generic; 3) Failure to function as a mark; and 4) The mark is not inherently distinctive and has not acquired distinctiveness. All four of these are inadequately plead as explained in more detail below.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has an entitlement to a statutory cause of action to bring the proceeding (formerly referred to as “standing”), and (2) a valid ground exists for denying the registration sought. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face." *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 (TTAB 2013). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014).

As explained in more detail below, the Board should dismiss the opposition the because: 1) Opposer fails to argue it has a valid proprietary interest in a mark that are prior to those of the applicant. 2) Opposer fails to adequately plead the Mark has become generic because there is no allegation that the public associates a rose generically with clothing. 3) Opposer fails to adequately plead the Marks fail to function as a mark, because there is no allegation as to how the Opposer uses the Marks. 4) Petitioner fails to adequately plead the Marks lack inherent distinctiveness, because there is a presumption to the contrary and the Respondent does not sell roses.

Opposer fails to allege it has a valid proprietary interest in a mark that are prior to those of Applicant.

Opposer does not have a proprietary interest in a confusingly similar mark because Opposer fails to argue it currently sells clothing in the United States with a confusingly similar mark. To withstand a motion to dismiss for failure to state a claim, an opposer needs to allege that (1) it has valid proprietary rights in a mark that are prior to those of the applicant, or that it owns a registration, and (2) the applicant's mark so resembles the opposer's mark as to be likely to cause confusion. *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1030 (TTAB 2015).

The Opposition states that, “Since as early as July 5, 2013, Opposer has provided in interstate and U.S. commerce tops and other clothing items featuring varying versions of a red rose with a green stem and leaves....” Contrast this with the garments shown in the Appendix A of the complaint which contains a number of garments that do not appear to show the origin of the Opposer. Where a third party is not continuously using the mark, it is a “mere intermeddler” that fails to allege claim upon which relief can be granted. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). Alternately, if the garments in Appendix A are using licensed images from Opposer, then Opposer needs to plead that contractual relationship in order to state a claim. *Holmes Prods. Corp. v. Duracraft Corp.*, 30 USPQ2d 1549 (TTAB 1994).

Petitioner fails to adequately plead the Marks have become generic because there is no allegation that the public associates a rose generically with clothing.

To sufficiently plead a claim that a mark is generic for the identified goods or services, the plaintiff must plead sufficient facts to allege that (1) the design mark at issue is widely used generically to identify or describe the genus of goods or services identified in the opposed application or registration sought to be cancelled, and that (2) consumers primarily understand the mark to be the generic name or identifier of the genus of goods or services. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed.

Cir. 1986). Opposer has pleaded neither element. First, Opposer has not pleaded that a rose is a symbol that is used to generically identify clothing. Second, Opposer has not alleged that a consumers understand the rose be a generic name for clothing. In fact, Opposer has not pleaded how consumers respond to the rose mark at all.

Petitioner fails to adequately plead the Marks fail to function as a mark, because there is no allegation as to how the Respondent uses the Marks.

To plead that the Mark fails to function as a mark, Opposer must allege that the relevant public would not perceive the Mark as a mark. To make this determination one can look to specimens and other evidence of record showing how the designation is actually used in the marketplace. *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 1229 (TTAB 2010) citing *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). Thus, the determinative factor as far as registrability is concerned is the manner in which the mark is actually used, once use commences. *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

As Opposer has not introduced any evidence as to how the Respondent uses the mark, the only evidence for the Board to consider at this time are the specimens in the trademark applications themselves. The specimen used in the application is shown below:



This photograph shows a mark that is discretely placed on a small area of clothing that purchasers use to look toward to determine the origin of goods. The Office explains, “A small, neat, and discrete word or design feature (e.g., small design of animal over pocket or breast portion of shirt) may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment (or a tote bag, or the like) may be perceived merely as a decorative or ornamental feature of the goods.” TMEP 1201. This can be easily contrasted with the garish images produced in the images provided by Opposer. The Board is “not required to accept as true legal conclusions or unwarranted factual inferences.” *In re Bill of Lading Transmission and Processing System Patent Litig.*, 681 F.3d 1323, 103 USPQ2d 1045, 1051 (Fed. Cir. 2012). The evidence of record does not show that relief is possible on its face, so the claim for the Rose Design to fail to function as a mark should be dismissed.

Opposer fails to adequately plead the Mark lacks inherent distinctiveness, because the Applicant does not sell roses.

There does not appear to be a reason in the Opposition that there is no inherent distinctiveness, for instance Petitioner does not suggest that Respondent uses the Marks to sell roses or similar goods for which the Marks might be considered merely descriptive of the mark. *Virginia Maid Hosiery Mills, Inc. v. Collins & Aikman Corporation*, 203 USPQ 795 (TTAB 1979). This case is similar to *Duramax Marine, L.L.C. v. R.W. Fernstrum & Co.*, 2001 TTAB LEXIS 328 (Trademark Trial & App. Bd. April 26, 2001) where the Board rebuffed allegations of lack of inherent distinctiveness at motion to dismiss because there were no allegations of descriptiveness or functionality for which distinctiveness would be necessary to either 1) establish that the Mark has not become distinctive of Applicant's goods or 2) that the primary significance Mark is an original descriptive significance. *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101 (TTAB 1982).

For all of these reasons the Applicant requests that the motion to dismiss be granted.

Respectfully Submitted,

NOVIAN & NOVIAN, LLP

Dated: Monday, August 23, 2021

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