ESTTA Tracking number: **ESTTA429952**

Filing date: **09/12/2011**

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

Proceeding	91191947
Party	Plaintiff HLT Domestic IP LLC
Correspondence Address	JESSICA E LEWIS ALSTON & BIRD LLP ONE ATLANTIC CENTER, 1201 W PEACHTREE STREET ATLANTA, GA 30309-3424 UNITED STATES david.stewart@alston.com
Submission	Opposition/Response to Motion
Filer's Name	David J. Stewart
Filer's e-mail	david.stewart@alston.com, jessica.lewis@alston.com
Signature	/David J. Stewart/
Date	09/12/2011
Attachments	Response in Opposition to Applicant's Motion for Summary Judgment.pdf (85 pages)(5447515 bytes)

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

In the matter of U.S. Application Serial No. 77/633,434
Mark: WOOFDORF-ASTORIA DOG HOTEL & DAY SPA
Filing Date: December 15, 2008
Published: March 17, 2009

HLT Domestic IP LLC Opposer, v. ERIC MARCUS, Applicant.	Opposition No. 91191947

RESPONSE IN OPPOSITION TO
APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Opposer HLT Domestic IP LLC ("Hilton") submits this Response in Opposition to the Motion for Summary Judgment filed by Applicant Eric Marcus ("Applicant"), and, in support hereof, shows the Board as follows:

I. INTRODUCTION

Hilton has opposed Applicant's application to register the service mark WOOFDORF ASTORIA DOG HOTEL & DAY SPA on the grounds that the mark dilutes and infringes Hilton's famous WALDORF ASTORIA mark. Applicant moves for summary judgment on both claims; however, Applicant cites no evidence in support of his motion and engages in no analysis of the dilution factors under the Trademark Dilution Revision Act ("TDRA") or the likelihood of confusion factors under *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Application has thus failed to discharge his burden of establishing that no genuine issue of material fact remains and that he is entitled to judgment as a matter law.

Instead of engaging in the required factor analyses, Applicant bases his motion solely on the claim that his mark is a parody of Hilton's famous WALDORF ASTORIA mark. Applicant's mark is not a valid parody because it does not comment upon or criticize Hilton or its services. Rather, Applicant concedes that he designed his mark so that consumers would associate the mark with the Waldorf Astoria and thereby conclude that, like the Waldorf Astoria, Applicant's services are 5-star luxury services. Such free riding on the goodwill of Hilton's famous mark for Applicant's profit does not constitute a protectable parody under the TDRA.

With regard to Hilton's infringement claim, parody is not, as Applicant suggests, a talisman that wards off infringement claims. If a mark is likely to cause consumer confusion, it is not a defensible parody as a matter of law. Applicant must thus demonstrate through an analysis of the *du Pont* factors that confusion is not likely as a matter of undisputed material fact to prevail on his motion. Because he has not engaged in any analysis of these factors, Applicant has failed to meet his heavy burden on this motion. Applicant's motion should therefore be denied in full.

II. ARGUMENT & CITATION OF AUTHORITIES

A. Summary Judgment Standard

Summary judgment is appropriate only when there are no genuine issues of material fact in dispute, leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). As the movant, Applicant bears the burden of demonstrating the absence of any genuine issue of material fact. *Celotex Corp. v. Catrett,* 477 U.S. 317, 322-37 (1986). A fact is genuinely in dispute if the record evidence would permit a reasonable fact finder to return a verdict in favor of the nonmoving party. *See Lloyd's Food Prods., Inc. v. Eli's Inc.*, 987 F.2d 766 (Fed. Cir. 1993).

To survive Applicant's motion for summary judgment, Hilton need only show that a reasonable fact finder could resolve the matter in its favor. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200 (Fed. Cir. 1992); *see also Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc.*, 220 U.S.P.Q. 740, 742 (T.T.A.B. 1983) (on a summary judgment motion, "[t]he nonmoving party need only show that there is a genuine issue as to a material fact and that, therefore, there is a need for a trial."). The Board does not resolve issues of fact on summary judgment; it only determines whether a genuine issue exists. *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 1461 (Fed. Cir. 1990). As the nonmovant, the evidence should be viewed in a light most favorable to Hilton and all justifiable inferences should be drawn in its favor. *See Lloyd's*, 987 F.2d at 767 (Fed. Cir. 1993).

B. Applicant's Summary Judgment Motion Should Be Denied Because It Lacks Evidentiary Support

When a movant fails to submit evidence to support his motion for summary judgment, he has "failed to carry [his] burden of establishing that no genuine issues of material fact exist." *Immunes Corp. v. Applied Med. Research, Inc.*, No. 91153080, 2004 WL 1701270, *2 (T.T.A.B. July 12, 2004) (*available at* http://ttabvue.uspto.gov/ttabvue/v?pno=91153080). Notably absent from Applicant's brief are any citations to any evidence of any kind, whether it be documents, deposition testimony, or declarations. By failing to provide the Board with any evidence on which to evaluate his motion or support the conclusory statements made therein, Applicant has failed to satisfy his summary judgment burden. His motion should therefore be denied. *Id.* ("The Board finds that applicant, having submitted no evidence in support of its motion for summary judgment, has failed to carry its burden of establishing that no genuine issues of

material fact exist.") Nevertheless, even if the Board were to consider the motion notwithstanding this failing, the motion should be denied for the reasons set forth below.

C. Applicant's Motion for Summary Judgment as to Hilton's Trademark Dilution Claim Should be Denied

When evaluating a claim of dilution by blurring, the board looks to the factors set forth in the text of the TDRA, namely, (1) whether the opposer's mark is famous; (2) whether the opposer's mark became famous prior to the applicant's use of its mark; and (3) whether the applicant's mark is likely to blur the distinctiveness of the opposer's famous mark. *See Nat'l Pork Bd. & Nat'l Pork Producers Council v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479 (T.T.A.B. 2010); 15 U.S.C. § 1125(c). The parties agree that the WALDORF ASTORIA mark is famous and acquired such fame prior to Applicant's first use of his mark. Indeed, Applicant admits that his mark is an "adaptation of opposer's famous mark."[1] (Applicant's Motion at p. 3). However, Applicant does not address the remaining two factors of the dilution analysis. By failing to do so, Applicant has failed to discharge his burden of demonstrating that no genuine issues of material fact exist as to Hilton's dilution claim.[2]

Applicant's apparent reason for failing to address the dilution factors is the belief that his mark is a parody and therefore shielded from action under the TDRA pursuant to the parody exclusion set forth in 15 U.S.C. § 1125(c)(3)(A). Applicant's belief is mistaken for two reasons: (1) the WOOFDORF ASTORIA DOG HOTEL & DAY SPA mark does not constitute a parody, and (2) even if it did, Applicant is using the mark in a manner that falls outside the scope of the TDRA's narrow parody exclusion.

---

[1] Applicant's parody argument depends upon a finding that the WALDORF ASTORIA mark is famous because, if it is not famous and thus well known to Applicant's customers, they could not understand that Applicant's mark is allegedly a parody of the WALDORF ASTORIA mark.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.