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

Proceeding	91191947
Party	Plaintiff HLT Domestic IP LLC
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**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 of 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.

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