Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: ESTTA946428 Filing date:

01/09/2019

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

Proceeding	91216585
Party	Defendant Thatch, LLC
Correspondence Address	FRANK J GILBERT SCHWARTZ & CERA CA PC 88 KEARNY STREET SUITE 1850 SAN FRANCISCO, CA 94108 UNITED STATES frank@schwartz-cera.com, ryg@cll.com, dks@cll.com, trademark@cll.com, jam@cll.com, doug@schwartz-cera.com, ken@schwartz-cera.com 415-956-2600
Submission	Brief on Merits for Defendant
Filer's Name	Joelle A. Milov
Filer's email	jam@cll.com, dks@cll.com, jzk@cll.com, trademark@cll.com, doug@schwartz-cera.com, ken@schwartz-cera.com, frank@schwartz-cera.com
Signature	/Joelle A. Milov/
Date	01/09/2019
Attachments	Part 1 of 2 - FINAL - REDACTED Applicants Trial Brief Filings.pdf(3557052 bytes) Part 2 of 2 - FINAL - REDACTED Applicants Trial Brief Filings.pdf(3423179 bytes) Applicants Trial Brief Certificate of Service.pdf(9652 bytes)

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

In the matter of: Application Serial No. **85/932,097** Mark: PATIO BY THE SPADES Published in the *Official Gazette* on April 29, 2014

Kate Spade LLC,

Opposer,

v.

Thatch, LLC

Applicant.

In the matter of: Application Serial No. **86/179,137** Mark: THE SPADES Published in the *Official Gazette* on June 10, 2014

Kate Spade LLC,

DOCKE

R

Μ

Opposer,

v.

The Spades Trademark Company, LLC

Applicant.

Opposition No.: 91216585 (PARENT)

Opposition No.: 91217168

COWAN, LIEBOWITZ & LATMAN, P.C.

PUBLIC REDACTED VERSION

APPLICANTS' BRIEF ON FINAL HEARING¹

114 West 47th Street New York, New York 10036 (212) 790-9200

¹ Redacted for confidential information pursuant to protective order. An unredacted version is being filed separately under seal.

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

TAB	LE OF AUTHORITIES	ii
PRE	LIMINARY STATEMENT	1
DES	CRIPTION OF THE RECORD	2
STA	TEMENT OF THE ISSUES	5
STA	TEMENT OF FACTS	6
	A. PATIO BY THE SPADES and THE SPADES Applications	6
	B. Applicants THATCH and STC	6
	C. Opposer Kate Spade LLC	9
	D. Extensive Third Party Use of SPADE-Formative Marks	10
ARG	UMENT	20
I.	THE BOARD SHOULD DISREGARD OPPOSER'S EVIDENCE OF USE AND ALLEGED FAME OF THE KATE SPADE MARKS	
II.	THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANTS' AND OPPOSER'S MARKS	
Α.	The Parties' Marks Are Dissimilar in Sight, Sound and Meaning	24
	1. PATIO BY THE SPADES	
	2. THE SPADES	
В.	Market Interface: The 1999 Agreement Reflects The Parties' View that Applicants' Marks Will Not Cause Confusion	
C.	Opposer Has Failed to Prove the Fame of Its Marks	
		36
	2.	
D.	Widespread Third-Party Use of SPADE-Formative Marks Further Weakens	
	Opposer's KATE SPADE Marks	42
E.	The Expense of Opposer's Goods and the Sophistication of its Purchasers Weigh Against a Likelihood of Confusion	
F.	Applicants Adopted their Marks in Good Faith	44
G.	Opposer Sells The Majority of Its Goods Through Its own Stores and Website	
H.	The Balance of Factors Tips Against A Likelihood of Confusion	45
Ш.	THERE IS NO LIKELIHOOD OF DILUTION OF OPPOSER'S MARKS.	
CON	CLUSION	

TABLE OF AUTHORITIES

Cases

Ahold Licensing SA v. Premium Nutritional Products, Inc., Opp. No. 91180170, at *12-13 (TTAB Nov. 7, 2011)	40
Bell South Intellectual Property Corporation v. VCS Technologies Inc., Opp. No. 91119656 (TTAB June 30, 2004)	22
Bose Corp. v. QSC Audio Prods., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002)	
Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581 (TTAB 2008)	
Burton-Dixie Corp. v. Restonic Corp., 43 CCPA 950, 110 USPQ 272 (CCPA 1956)	
Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc., 77 USPQ2d 1492 (TTAB 2005)	40, 41
Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998)	24
Citigroup Inc. v. Capital City Bank Group, Inc., 94 USPQ2d 1645 (TTAB 2010), aff'd on other grounds, 637 F.3d 1344 (Fed. Cir. 2011)	41
Coach Servs. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012)	passim
Conde Nast Publs., Inc. v. Miss Quality, Inc., 184 USPQ 422 (CCPA 1975)	
Edison Bros. Stores v. Cosmair, Inc., 651 F. Supp. 1547, 2 USPQ2d 1013 (S.D.N.Y. 1987)	35, 39
Fisher Radio Corp. v. Bird Electronic Corp., 162 USPQ 265	
Fossil, Inc. v. The Fossil Grp., 49 USPQ2d 1451 (TTAB 1998)	
Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 212 USPQ 233 (CCPA 1981)	
H-D Michigan, Inc. v. Hog Cream Enterprises, Inc Opp. No. 91152998 (TTAB Mar. 5, 2001)	
Houlihan v. Parliament Imp. Co 921 F.2d 1258, 1262, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990)	
I.C.E. Mktg. Corp. v. Neutrogena Corp., Cancellation No. 92043193 (TTAB June 16, 2009)	22
In re Allen Street Owner LLC, Ser. No. 87138386 (TTAB Oct. 26, 2018)	

ii

DOCKET ALARM Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

In re Covalinski, 113 USPQ2d 1166 (TTAB 2014)	
In re Dietrich, 91 USPQ2d 1622 (TTAB 2009)	
In re E.I. Du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)	, 31, 32
In re Etablissements Darty et Fils, 759 F.2d 15, 25 USPQ 652 (Fed. Cir. 1985)	
In re Four Seasons Hotels Ltd., 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993)	
In re Hall Wines, LLC, Ser. No. 78926151 (TTAB Feb. 10, 2009)	
In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992)	
In re Highlights for Children, Inc., 118 USPQ2d 1268 (TTAB 2016)	
In re Isabella Fiore LLC, 75 USPQ2d 1564 (TTAB 2005)	27
In re Monotype Corp., 14 USPQ2d 1070 (TTAB 1989)	27
Institut Nat'l Des Appellations D'Origine v. Vinters Int'l Co., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992)	42, 43
In re Reebok International Limited, Ser. No. 78271326 (TTAB Oct. 26, 2005)	27
In re Tokutake Industry Co., 87 USPQ2d 1697 (TTAB 2008)	
In re Trendsettah, Inc., Ser. No. 85623619, at *4 (TTAB Aug. 17, 2018)	25
In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000)	27
In re Vrana, Ser. No. 86716357 (TTAB June 26, 2018)	25
In re White Jasmine LLC, 106 USPQ2d 1385 (TTAB 2013)	
INTS It Is Not The Same, GmbH v. Disidual Clothing, LLC, Opp. No. 91212768 (TTAB Sept. 28, 2017)	
JA Apparel Corp. v. Abboud, 568 F.3d 390, 91 USPQ2d 1095 (2d Cir. 2009)	33
Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015)	42

iii

DOCKET A L A R M



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.