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

Proceeding	92076531
Party	Defendant FASHIONTV.COM GmbH
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Fashion One Television LLC, Petitioner, v. fashiontv.com GmbH Respondent.	**Cancellation No. 92076531 (Parent case)** **Cancellation No. 92076634** Reg. Nos. 5,477,536; 3,530,563 Marks: F FASHIONTV fashiontv

RESPONDENT'S S REPLY BRIEF TO PETITIONER'S PRELIMINARY RESPONSE TO RESPONDENT'S MOTION FOR JUDGMENT ON THE PLEADINGS AND ALTERNATIVELY FOR SUMMARY JUDGMENT

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD:

In these consolidated cancellation proceedings brought against the mark fashiontv No. 3530563 (the "fashiontv Mark") and the mark F Fashion TV No. 5477536 (the "F Fashion TV Mark" and together with the fashiontv Mark, the "FTV Marks"), Fashiontv.com GmbH ("Respondent") by and through its counsel of record, Dunnington Bartholow & Miller LLP, hereby replies to Petitioner Fashion One Television LLC ("Petitioner")'s "Preliminary Response to Respondent's Motion for a Judgment on the Pleadings or for Summary Judgment" dated October 25, 2021 ("Response") in further support of Respondent's Motion for a Judgment on the Pleadings or, for Summary Judgment dated October 4, 2021 ("Motion").

I. PRELIMINARY STATEMENT

On October 4, 2021, Respondent moved (1) for a judgment on the pleadings because Petitioner's petitions to cancel contain no allegation supporting Petitioner's standing and or any valid ground for cancellation; and (2) alternatively for summary judgment (a) based on admissible

and undisputed evidence of use Respondent provided in the form of a declaration, screenshots from relevant websites and business documents, and (b) because Mr. Gleissner, as former licensee, knew or should have known Respondent's use of the mark and brought these proceedings in bad faith with an intent to deceive the USPTO and the Board.

Petitioner's Response dated October 25, 2021, argues that summary judgment is not warranted because (1) Petitioner and Respondent are competitors with a long history of disputes over the marks FASHION TELEVISION and FASHION ONE and Respondent has misrepresented the status of the Settlement Framework Agreement between the parties, (2) Petitioner has standing because it has spent millions of dollars to acquire the FASHION TELEVISION mark which is confusingly similar to the FASHION TV mark and has pleaded a valid ground for cancellation when it argued that Respondent's "Web Shop" is no longer functional, (3) Petitioner has vigorously defended the FASHION ONE brand despite Respondent's attempts to register the mark FASHION ONE in more than 20 jurisdictions, (4) Petitioner is entitled to discovery because Respondent has produced nothing to substantiate actual use of the FTV Marks, and (5) Petitioner requests a 60-day extension to reply because its key associate who had records of substantiative evidence in support of Petitioner's argument passed away in April 2021.

These arguments should be rejected for the following reasons. *First*, summary judgment is warranted because Petitioner has not satisfied its burden of showing a genuine issue of material fact that the FTV Marks have not been abandoned and Petitioner's recitation of the parties' litigation history is completely irrelevant to the resolution of the Motion. *Second*, judgment on the pleadings is warranted because (a) Petitioner's acquisition of the FASHION TELEVISION brand does not create standing, (b) Petitioner fails to plead a valid ground for cancellation by merely

arguing that one of Respondent's online retail store using the fashiontv Mark is not functional without describing the research or the methodology used to get to this conclusion, and (c) Petitioner fails to even mention Respondent's F Fashion TV Mark. *Third*, summary judgment is warranted because Petitioner has not satisfied its burden of showing a genuine issue of material fact that the FTV Marks have not been abandoned and Petitioner's recitation of disputes between the parties over the FASHION ONE mark is irrelevant to the present proceedings. *Fourth*, Petitioner is not entitled to discovery because Petitioner has not satisfied its burden of showing a genuine issue of material fact that the FTV Marks have not been abandoned that would warrant discovery. *Fifth*, Petitioner is not entitled to an extension because Petitioner fails to provide an affidavit regarding the documents in the possession of Petitioner's deceased key associate, never asked for such extension until the date of its deadline to oppose the Motion, and already had an opportunity to respond but yet failed to show any genuine issue of material fact that Respondent has not abandoned use of the FTV Marks.

II. ARGUMENT

A. Summary Judgment Is Warranted Because Petitioner Has Not Satisfied Its Burden Of Showing A Genuine Issue Of Material Fact That The FTV Marks Have Not Been Abandoned And Petitioner's Recitation Of The Parties' Litigation History Is Completely Irrelevant To The Resolution Of The Motion

Petitioner's Response fails to raise a genuine issue of material fact regarding Petitioner's abandonment claim as Petitioner solely recites the parties' litigation history. This recitation is nothing more than a desperate attempt by Petitioner to mislead the Board as to the real issue of these proceedings, which is to determine whether Respondent uses the FTV Marks in the US.

Once Respondent presented evidence supporting the position that the mark in question was in use, Petitioner has to go beyond the mere pleadings and identify specific facts showing a genuine

issue. See *Little v. Liquid Air Corp.*, 37 F.3d 1069, 1075 (5th Cir. 1994) (en banc) (per curiam). Petitioner's burden to show a genuine issue of material fact is not satisfied with "some metaphysical doubt as to the material facts, by conclusory allegations, by unsubstantiated assertions, or by only a scintilla of evidence." *Id*. (citations omitted).

Petitioner's attempt to raise a genuine issue of material fact is rife with conclusory allegations and unsubstantiated assertions that are convenient for Petitioner's desired outcome. The facts and evidence explicitly demonstrate that Respondent is currently using the FTV Marks.[1]

Instead of addressing Respondent's admissible and undisputable evidence of use of the FTV Marks, Petitioner rehashes the same exact allegations it asserted in its petitions. Specifically, Petitioner alleges that the fashiontv Mark is not in use simply because Respondent's "Web Shop" is no longer functional despite relevant evidence provided by Respondent of at least five other functional online retail stores of Respondent actually using the fashiontv Mark. See Response at 7. Further, Petitioner egregiously fails to even mention the F Fashion TV mark.

In complete disregard to Respondent's admissible and undisputable evidence, Petitioner focuses on the parties' litigation history that has absolutely no relevance here. Specifically, Petitioner alleges that (1) "Respondent … started a campaign for massive attacks, starting in April 2013 and lasting for several years" against Petitioner, (2) "Respondent … started applying for the trademark "Fashion One" in 2013", (3) the "2016 'Settlement Framework Agreement' … never matured into permanency", (3) "Respondent started cancellation actions in 2013 or 2014 related

[1] See Motion at 10-12 and Dowd Decl. Exhibits J-M.

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