

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

In re Application Serial No. : 76/605,581
Mark : JUICY MACARON
International Class : 3
Applicant : Lancôme Parfums et Beaute & Cie
Filed : August 5, 2004
Published : September 14, 2005

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L.C. Licensing, Inc., :
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Opposer, :
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v. : Opposition No.
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Lancôme Parfums et Beaute & Cie, :
:
Applicant. :
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, PO BOX 1451, Alexandria, Virginia 22313-1451, on September 30, 2005.

ERICA D. Klein
Name of Applicant, Assignee or Representative
[Signature]
Signature
September 30, 2005
Date of Signature

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NOTICE OF OPPOSITION

L.C. Licensing, Inc., a corporation organized under the laws of the State of Delaware, located and doing business at 1441 Broadway, New York, New York 10018 (hereinafter "Opposer") believes that it would be damaged by a grant of a registration to Lancôme Parfums et Beaute & Cie, located at 29, rue du Faubourg Saint-Honore, Paris 75008,



France (hereinafter "Applicant"), Applicant for Application Serial No. 76/605,581 for the mark JUCY MACARON filed in International Class 3 on August 5, 2004 and published for opposition on September 14, 2005 (hereinafter the "Application"), and hereby opposes said Application.

The grounds for opposition are:

1. Opposer is the owner of Federal Registration No. 2,285,232, for the mark JUCY issued October 12, 1999 for "clothing, namely, shirts, dresses, pants, skirts and jackets" in International Class 25¹. This registration claims a date of first use at least as early as September 15, 1996 and a date of first use in commerce at least as early as October 30, 1996. A true copy of this registration is attached as Exhibit A.

2. Opposer is the owner of Federal Registration No. 2,348,674, issued May 9, 2000 for the mark JUCY COUTURE for "women's clothing, namely, jackets, dresses, skirts, shorts, pants, shirts and T-shirts" in International Class 25. This registration claims a date of first use at least as early as June 1997 and a date of first use in commerce at least as early as June 1997. A true copy of this registration is attached as Exhibit B.

3. Opposer is the owner of Federal Registration No. 2,387,924, for the mark JUCY JEANS issued September 19, 2000 for "girls' and women's clothing, namely, jeans, pants, shorts, skirts, T-shirts, shirts, tops, jackets, vests, bandannas" in International Class 25. This registration claims a date of first use at least as early as January 15, 1997 and a date of first use in commerce at least as early as March 1, 1997. A true copy of this registration is attached at Exhibit C.

¹ Opposer is the owner of all registrations and applications originally filed in the United States Patent and Trademark Office by Travis Jeans, Inc. Travis Jeans' change of name to Juicy Couture, Inc. is recorded with the United States Patent and Trademark Office at Reel/Frame 2789/0254. An assignment of all marks owned by Juicy Couture, Inc. to L.C. Licensing, Inc. is recorded with the United States Patent and Trademark Office at Reel/Frame 2789/0312. A corrective assignment correcting L.C. Licensing's state of incorporation from California to Delaware is recorded at Reel/Frame 2817/0506.

4. Opposer is the owner of allowed Application Serial Nos. 76/376,638 and 76/977,226 for the mark JUCY COUTURE filed February 28, 2002 for a variety of fashion-related goods and services including lip gloss, lipstick, other cosmetics, perfumery, candles, eyewear, jewelry, handbags, housewares, bedding, clothing, and retail sales of the same in International Classes 3, 4, 6, 9, 14, 16, 18, 21, 24, 25 and 35. A true copy of the Notice of Allowance issued in Application Serial No. 76/376,638 (prior to the division of Application Serial No. 76/977,226 therefrom) is attached as Exhibit D.

5. Opposer is the owner of allowed Application Serial No. 76/376,646 for the mark JUCY JEANS filed February 28, 2002 for a variety of fashion-related goods including lip gloss, lipstick, other cosmetics, perfumery and handbags in International Classes 3 and 18. A true copy of the Notice of Allowance for this application is attached as Exhibit E.

6. Opposer is the owner of allowed Application Serial No. 76/497,677 for the mark JUCY GIRL filed March 17, 2003 for a variety of fashion-related goods and services including lip gloss, lipstick, other cosmetics, perfumery, candles, handbags, and clothing in International Classes 3, 4, 18 and 25. A true copy of the Notice of Allowance for this application is attached as Exhibit F.

7. Opposer is the owner of allowed Application Serial No. 75/718,579 for the mark JUCY GIRL filed June 1, 1999 for T-shirts in International Class 25. A true copy of the Notice of Allowance for this application is attached as Exhibit G.

8. Opposer is the owner of allowed Application Serial No. 76/355,508 for the mark JUCY BABY filed January 3, 2002 for a variety of clothing, footwear and headwear in International Class 25. A true copy of the Notice of Allowance for this application is attached as Exhibit H.

9. Opposer is the owner of Federal Registration No. 2,882,280 for the mark CHOOSE JUICY filed January 3, 2002 for a variety of clothing, footwear and headwear in International Class 25. A true copy of this registration is attached as Exhibit I.

10. The above-referenced marks, namely, JUICY, JUICY COUTURE, JUICY JEANS, JUICY GIRL, JUICY BABY and CHOOSE JUICY are hereinafter referred to collectively as "Opposer's Marks".

11. In addition to the marks referenced herein, JUICY is the common element of several other marks that are used and/or pending registration by Opposer, and is a common name by which Opposer and its brand are known.

12. Opposer's Marks identify Opposer as a source of a variety of high quality and high fashion consumer goods.

13. Opposer's Marks and products have been the subject of extensive press and media coverage.

14. In part due to the media attention given to Opposer's Marks, and in part due to Opposer's extensive use of Opposer's Marks, they have acquired enormous value and good will and have become extremely well-known and famous.

15. The Application seeks registration of the mark JUICY MACARON for "cosmetics namely creams, milks, lotions, gels and powders for the face, the body and the hands; make-up preparations namely eye shadows, eyebrow pencils, eye liner pencils, mascara, lipsticks, nail-polish, foundation creams, blushers, rouge for cheeks" in International Class 3.

16. The mark JUICY MACARON combines Opposer's famous JUICY mark with the word MACARON to form a composite mark in which JUICY is the dominant and most distinctive portion.

17. There is a strong likelihood that consumers viewing the mark JUICY MACARON in respect of the goods for which registration is sought are likely to believe that such goods derive from the same source as the goods sold under Opposer's Marks, or are affiliated, connected, associated, sponsored, approved or authorized by Opposer, whereby registration of the JUICY MACARON mark to Applicant would seriously damage Opposer in that it would be likely to cause confusion, deception or mistake among consumers and dilute the distinctiveness of Opposer's Marks.

WHEREFORE, Opposer prays that this opposition be sustained and that Application Serial No. 76/605,581 for the proposed mark JUICY MACARON be refused registration.

This Notice is being filed in duplicate and a check in the amount of \$300.00 is enclosed herewith to cover the requisite filing fee. Please charge any additional fees and/or credit any overpayments to Deposit Account No. 50-0540.

Please direct all communications regarding this Opposition proceeding to Opposer's counsel at the address shown below.

KRAMER LEVIN NAFTALIS & FRANKEL LLP
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Date: September 30, 2005

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