

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

TTAB

In the Matter of
Intent to Use Trademark Application
Serial No. 75/456,742
Published in the Official Gazette
on July 18, 2000

----- X
MAGASCHONI APPAREL GROUP, INC., :
: :
Opposer, : :
: :
v. : :
: :
JOHANNES L. KAPPETEIN, : :
: :
Applicant. : :
----- X

Opposition No. 120,332

"Express Mail" mailing label No.:	EL 857432742 US
Date of Deposit:	August 16, 2004
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514.	
Name:	Jane Williams
Signature:	<i>Jane Williams</i>

FIRST AMENDED NOTICE OF OPPOSITION

Box TTAB -NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Commissioner:

In the matter of U.S. Trademark Application Serial No. 75/456,742, filed on March 26, 1998, by Johannes L. Kappetein ("Applicant") and published for opposition in the July 18, 2000 issue of the Official Gazette of the United States Patent and Trademark Office, for the trademark MAG & Design, as applied to:



08-16-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

clothing, namely shirts, pants, jeans, dresses, jackets and tops; footwear in International Class 25 (the "Subject Application").

Magaschoni Apparel Group, Inc. a New York corporation maintaining its principal place of business at 525 Seventh Avenue, New York, New York 10018 ("Opposer"), believes that it will be damaged by the registration of this trademark with respect to the foregoing International Class and hereby opposes the same.

As grounds for the opposition of the trademark, Opposer, by and through its attorneys, alleges as follows:

1. Opposer manufactures and sells wearing apparel, and, since at least as early as February 22, 1994, has used the trademark MAG in conjunction with a line of its wearing apparel.

2. Opposer is the owner of Application Serial No. 75/382,020 seeking to register the mark MAG for wearing apparel, namely, jackets, skirts, pants, camisoles, vests, dresses, tank tops, blazers, tops, shorts, shirts, sweaters and t-shirts.

3. Opposer's use of the MAG mark in conjunction with wearing apparel, namely, jackets, skirts, pants, camisoles, vests, dresses, tank tops, blazers, tops, shorts, shirts, sweaters and t-shirts, has been continuous since at least as early as February 22, 1994 and since that time millions of dollars worth of goods bearing such mark have been sold by Opposer.

4. Opposer sells its clothing bearing the MAG mark throughout the country in major department stores such as Nordstrom's, Macy's and Bloomingdale's, as well as in

boutiques and its own retail stores. Opposer's MAG clothing has been extensively promoted and has been advertised in major fashion magazines such as *Vogue*, as well as newspapers such as *The New York Times*. Based on the foregoing, Opposer's MAG mark has gained widespread recognition from the trade and purchasing public, and has acquired secondary meaning.

5. Upon information and belief, long after Opposer commenced use of the mark MAG mark in conjunction with wearing apparel and after this mark had acquired secondary meaning, Applicant began using the MAG & Design mark in connection with footwear.

6. Applicant's MAG & Design mark is confusingly similar to Opposer's MAG mark and the Subject Application covers identical goods, e.g., apparel. The Subject Application also covers footwear, which is closely related to apparel.

7. Applicant's use of the MAG & Design mark, in view of Opposer's prior use of MAG, is likely to cause confusion, to cause mistake or to deceive.

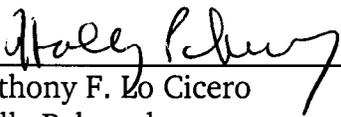
8. Accordingly, it is Opposer's belief that if Applicant is granted registration of the application opposed herein, Opposer will suffer irreparable harm and damage.

WHEREFORE, Opposer respectfully requests that the mark shown in U.S. Trademark Application Serial No. 75/456,742 be refused registration in International Class 25 and that this Opposition be sustained.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Opposer
90 Park Avenue
New York, New York 10016
(212) 336-8000 (telephone)
(212) 336-8001 (Facsimile)

Dated: August 16, 2004
New York, New York

By: 

Anthony F. Lo Cicero
Holly Pekowsky

CERTIFICATE OF SERVICE

Holly Pekowsky, the undersigned attorney, hereby certifies that she is one of the attorneys for Opposer Magaschoni Apparel Group, Inc. in the captioned action, and that on the date which appears below she served a copy of the annexed FIRST AMENDED NOTICE OF OPPOSITION on Applicant Johannes Kappetein by causing a copy thereof to be placed in a depository under the care and custody of the United States Postal Service, First Class postage prepaid affixed thereto, addressed to the attorneys for Applicant, as follows:

Joseph A. Calvaruso, Esq.
Cindy M. Zelson, Esq.
Morgan & Finnegan, L.L.P.
3 World Financial Center
New York, New York 10281-2101



Holly Pekowsky

Dated: New York, New York
August 16, 2004