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

In re Application No. 76/089852
Published March 13, 2001



10-22-2001
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

Prada S.A.

Opposer,

v.

Opposition No.

Rajesh Pratap Singh

Applicant.

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, Va 22202-3513

NOTICE OF OPPOSITION

Prada S.A., a corporation organized and existing under the laws of Luxembourg with an office at Rue Aldringen 23, Luxembourg believes that it will be damaged by registration of the mark shown in Application Serial No. 76/089852 and hereby opposes the same.

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As grounds for opposition, it is alleged that:

1. Opposer is the owner of the following **PRADA** registrations and pending applications:
 - (a) Registration No. 1,264,243 for leather goods, namely leather and leather like articles, namely wallets, purses, travelling bags, and hand bags, hides, trunks, and suitcases, rain umbrellas, parasols and walking sticks, whips, harness and saddlery articles.
 - (b) Registration No. 1,400,409 for women's clothing articles namely jackets, pants, jeans, shorts, shirts, skirts, hosiery, bathing suits, wind resistant jackets, overcoats,

raincoats, scarves, ski pants, neckties, capes, undershorts; footwear, namely shoes, boots, sandals, and slippers; women's knitwear, namely sweaters, pullovers, cardigans.

(c) Registration No. 1,599,091 for detergents, bleaching and softening substances for laundry use, perfumes, essential oils for use in the manufacture of perfumes and cosmetics; cosmetics, namely face and body moisturizers, tonics, creams, and lotions, suntan and sunblock lotions and creams, lipsticks, eye shadows, coloring pencils, mascara, blush, face powder, foundations, nail polish, hair lotions, and dentrifices.

(d) Registration No. 1,869,578 for handbags, suitcases, wallets, briefcases, school bags, handbags for men, trunks for travel, leather and imitation leather sold in bulk, hide and imitation hide sold in bulk, parasols, patio umbrellas, umbrellas, walking sticks, harnesses and other saddlery articles; clothing articles for men, women and children; namely, shirts, blouses, skirts, coats, trousers, pants, vests, jerseys, pajamas, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, headscarves, neckties, raincoats, overcoats, greatcoats, bathing suits, sports overalls, wind-resistant jackets, ski pants, belts, fur coats, scarves, gloves, dressing gowns, footwear; namely, shoes, sports shoes, slippers and boots.

(e) Registration No. 1,873,854 for brief cases; tote bags; shoulder bags; satchels; handbags; trunks; suitcases; traveling bags; purses; brief case-type portfolios; hand bags for men; beach umbrellas; umbrellas; walking sticks; harnesses; saddles; whips; attache cases; wallets; clothing for men, women and children; namely, suits, trousers, women's suits, skirts, men's formal dress shirts, tuxedos, dinner jackets, formal dress suits, vests, ties, cummerbunds; sweaters, cardigans; shirts; collars; blouses; sports shirts; polo shirts; underpants;

slacks; camisoles; slips; night gowns; pajamas; scarves; belts, sun visors, gloves, hats and suspenders.

(f) Registration No. 2,135,219 for eyeglasses; eyeglass frames; eyeglass lenses; sunglass lenses; protective eyeglasses; contact lenses; sports eyeglasses; televisions; radios; audio tape recorders; radio transmitters; phonograph record players; phonograph records featuring music; pre-recorded audio tapes featuring music; magnetic tape recorders; digital audio tape players; radio telephones; cameras; videocameras; photographic projectors and photographic enlargers; sound reproducing apparatus; cash registers; calculators; electric irons; electric vacuum cleaners; Gold, silver, platinum, precious metals and their alloys, in bar and sheet form; goods in precious metals and their alloys, namely, rings, necklaces, bracelets, brooches, earrings, hair ornaments, tie pins, tie clasps; diamonds, brilliants; precious gemstones; jewelry articles, jewels; wristwatches; clocks in general; chronometers; fitted cases for watches and jewels.

(g) Registration No. 2,162,795 for handbags, wallets, luggage, attache cases, tote bags, briefcases, all purpose sport bags, traveling trunks, carry-on bags, shoulder bags, garment bags for traveling, keycases, umbrellas, parasols, walking sticks, whips harnesses and saddlery; clothing for men, women, and children, namely coats, raincoats, waistcoats, blouses, and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear, socks and stockings, gloves, ties, scarves, hats and caps, belts, boots, shoes and slippers.

(h) Registration No. 2,286,904 for Cosmetics, namely, night and day creams, cleaning preparations for the face and body, bathfoams, shaving foams; aftershaves, foundation

makeup, nail polishes, deodorants for men and women, hand and baby soaps, hair shampoos and rinses, hair sprays, toothpastes and fragrances, namely, perfumes, toilet water and essential oils for personal use for men and women.

(i) Registration No. 2,303,400 for cosmetics, namely night and day cream, cleaning preparations for the face and body, bathfoam, shaving foam, aftershave, foundation makeup, nail polish, deodorants for men and women, hand and baby soap, hair shampoo and rinses, hair spray, toothpaste and fragrances, namely perfume, toilet water and essential oils per personal use for men and women; lenses; spectacles; sunglasses; lenses for spectacles and for sunglasses; frames for spectacles and for sunglasses; spectacles cases vehicles; apparatus for locomotion by land, air or water watches, clocks, costume jewelry and precious jewelry; precious stone books and magazines; stationery articles, namely exercise books, address books and notebooks, numerical and alphabetical inserts, envelopes, calendars and agendas; writing and marking instruments, namely fountain pens, ball pens, felt-tipped pens and roller pens, markers, highlighters, pencil and leads, refills for pens handbags, wallets, luggage, attache cases, tote bags, briefcases, all purpose sport bags, traveling trunks and carry-one bags, shoulder bags, garment bags for traveling, keycases, umbrellas, parasols and walking sticks, whips, harnesses and saddlery; clothing for men, women and children, namely coats, raincoats, belts, waistcoat, blouses and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear, socks and stockings, gloves, ties, scarves, hats and caps, boots, shoes and slippers games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.

(j) Registration No. 2,374,118 for books and magazines in the fashion field; stationery articles, namely, exercise books, address books and notebooks, numerical and alphabetical inserts, envelopes, calendars and agendas; writing and marking instruments, namely, fountain pens, ballpoint pens, felt-tipped pens and roller pens, markers, highlighters, pencils and lead pencils, refills for pens; Window blinds, non-metal tool boxes, plastic boxes, wood boxes, boxes not of metal (jewelry), bone, ivory, plastic, plaster, wax or wood figures and busts, bone and wood carvings, closures for perfume, cosmetics and bottles, containers not of metal for commercial use, picture frames, furniture, gift package decorations made of plastic, cushions, plastic drawer lining material, fitted fabric furniture covers, hand fans, jewelry boxes not of metal or precious metal, key chains, key fobs, key holders, key rings not of metal, hand-held mirrors, furniture mirrors, pillows, furniture screens; Kitchen utensils, namely, serving spoons, basting spoons, cork screws and napkin rings not of precious metal; household containers, namely, ice buckets, containers for food and soap; beverage glassware; porcelain dishes in general; earthenware, namely, mugs, hand, wash and sugar basins, beverage ware; bowls, boxes for dispensing paper towels, non-metal decorative boxes, soap boxes, buckets, cake servers; candle holders; chamber pots, commemorative plates; containers for food and beverages; soap containers; cookware, namely, cups, kitchen ladles, jugs, bowls, decorative plates, dishes, door knobs made of porcelain or earthenware; china, crystal, earthenware, glass, porcelain and terracotta figurines, vases; Textile fabrics for clothing, home furnishings, wall coverings, bed and table goods, upholstery fabric; Smokers' articles, namely, ashtrays not of precious metal, cigarette cases not of precious metal, cigarette lighters not of precious metal,

cigarettes, cigars, pipes, matches, tobacco; Restaurant, hotel, motel, bar, cocktail lounge, tourist home services; social club services; beauty salon services.

(k) Serial No. 75/799,517 for briefcases, suitcases, travelling bag, handbags, trunks and bags, travel bags, change-purse not in precious metals; small bags, men's handbags, parasols, umbrellas and walking sticks; animal harnesses and saddlery, document's bag, wallets; Men's women's and children's clothes including shirts, coats, trousers dressers, pullovers, pyjamas, socks and stockings, jumpers, corselet, suspenders, underpants, underclothes, sweaters, gilets, hats, scarves, ties, raincoats, overcoats, swimming costumes, wind jacket, sky trousers, belts, fur coat, headscarves, gloves, dressing-gowns and bath-robos, shoes, including shoes, sports shoes, slippers and boots; Retail store services; consulting services for business organization and administration; hotel administration; organizing commercial or promotional expositions; shelf presentation of items; presentations with mannequins for advertising purposes or sales promotion; advertising agencies; Services rendered by hotels, motels, bars, cafes and cocktail bars, tourist house services, services rendered by social clubs, services rendered by country side clubs; services rendered by beauty centers; services rendered by sauna centers, cosmetical research; services in apparel designing; apparel renting; fashion information; services rendered by packaging designers; photographic services; textile tests.

3. Applicant filed intent to use Application No. 76/089852 on July 14, 2000 to register **PRATAP** in connection with "clothing".

4. Opposer has long used and promoted the trademark **PRADA** and as a result of such long term use, the mark is well known and famous.

5. Opposer's use and registration of **PRADA** is long prior to the filing date of Applicant's intent to use application and therefore Opposer has priority.

6. Applicant's mark **PRATAP** is substantially similar to Opposer's mark, **PRADA**.

7. The goods upon which Applicant intends to use its mark are commercially related to the goods upon which Opposer has used and registered its trademark.

8. Due to the fame and renown of Opposer's mark, there is a probability purchasers will be confused as to source.

9. In view of the substantial similarity between the respective marks and the commercial relationship between the goods, registration of the mark **PRATAP** is likely to cause confusion, mistake or deception to purchasers as to the source of Applicant's goods, and therefore it is requested that registration to Applicant be refused under Section 2(d) of the Trademark Act.

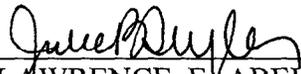
10. Opposer hereby incorporates Paragraphs 1-9 and as a further ground for opposition alleges that Applicant's mark **PRADA** is famous.

11. Applicant's use of **PRATAP** commenced after the established fame of Opposer's **PRADA** mark.

12. Registration of the trademark **PRATAP** will cause dilution of the distinctive quality of Opposer's famous mark.

WHEREFORE, Opposer believes that it will be damaged by the registration of Application Serial No. 76/089852 and respectfully requests that registration be refused under the likelihood of confusion provision of 15 USC §1052 and the dilution provision of 15 USC §1063 and 43(c).

Respectfully submitted,



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10-22-2001

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #70

October 22, 2001

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attention: TRADEMARK TRIAL AND APPEAL BOARD

Our Ref:

Re: NOTICE OF OPPOSITION
to Trademark Application No. 76/089852
for PRATAP

Dear Sir:

1. We submit herewith two copies of Notice of Opposition to the above-referenced application.
2. The official fee of \$300.00 is covered by the attached check. Please charge Deposit Account No. 01-0035 for any additional fees not fully covered by said check.
3. Kindly acknowledge receipt by returning the attached card.

Respectfully submitted,

Julie Seyler
LAWRENCE E. ABELMAN
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LEA/JBS:rd

"Express Mail" No.:EF174015711US
Date of Deposit : October 22, 2001
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.
<u>JULIE B. SEYLER</u>
<i>Julie Seyler</i>
(signature of person mailing paper or fee)

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